

1979 April 16

[TRIANTAFYLIDIS, P., STAVRINIDES, HADJIANASTASSIOU,
A. LOIZOU, MALACHTOS, JJ.]

CURZON TOBACCO CO. LTD.,

Appellants.

v.

THE REPUBLIC OF CYPRUS, THROUGH
THE REGISTRAR OF TRADE MARKS,

Respondent.

(*Revisional Jurisdiction Appeal No. 166*).

5 *Trade Marks—Registration—Revocation of registration accepted in the first instance and without opposition by third parties—Possible if application has been accepted in error—Section 21(1) of the Trade Marks Law, Cap. 268—Principles of administrative Law on revocation cannot be invoked once question of revocation is regulated by Law.*

10 *Administrative Law—Administrative acts—Revocation—Registration of trade mark—Once matter of revocation regulated by section 21(1) of the Trade Marks Law, Cap. 268 and the administration acts within the powers conferred thereunder principles of Administrative Law on revocation cannot be invoked.*

15 *Trade Marks—Registrability—Invented word—"Premier"—Cannot merely by reason thereof be considered as an invented word—Application for registration of word "Premier" in respect of cigarettes, cigars and tobacco products—Said word not an "invented word"—And has direct reference to the character and quality of the goods—Its registration properly refused under section 11(1)(c) and (d) of the Trade Marks Law, Cap. 268—Mere fact that it was registered in Canada and in Greece—And*
20 *provisions of Convention for the Protection of Industrial Property (ratified by Law 64 of 1965) could not change the situation.*

Administrative Law—Discretionary powers—Judicial control—Principles applicable.

The appellants, a tobacco company registered in Canada, applied to the respondent for the registration of the word "Premier" in respect of cigarettes, cigars and tobacco products in Part A of the register of Trade Marks. Eventually the said word was registered in Part B of the register and the registration was published in the official Gazette of the 25th August, 1972. On December 9, 1972 the respondent Registrar informed the appellants that after further consideration of the matter he decided to withdraw his acceptance of the application for registration of the trade mark in question on the ground that it had been accepted in error.

The trial Judge dismissed the appellants' recourse, against the respondent's said decision to withdraw his acceptance, on the ground that under section 21(1)* of the Trade Marks Law, Cap. 268 the Registrar had "power to refuse registration even though the application has been accepted in the first instance and there has been no opposition to the registration if such application has been accepted in error". The trial Judge further held that the said word could not be registered under section 11(1)(c) and (d)** of Cap. 268 because it was not an invented word in the sense that it is "new and freshly coined" as described in the "*Solio*" case [1898] A.C. 571 and because it could not be said that it had no direct reference to the character and quality of the goods.

Upon appeal against the dismissal of the recourse:

Held, dismissing the appeal, (1) that section 21(1) of the Trade Marks Law, Cap. 268 empowers the Registrar of Trade Marks to re-examine and refuse registration where same was accepted in error even in cases where an application had been accepted in the first instance and there had been no opposition filed thereafter within the prescribed by the rules period; that any other approach would have rendered the words in section 21(1) "unless the application has been accepted in error" without any meaning, significance or effect; and that once the matter of cancellation of a registration is expressly regulated by law and the Administrative Authority concerned acts within the powers so conferred, the general principles of Administrative Law on

* Quoted at p. 156 *post*.

** Quoted at p. 157 *post*.

revocation cannot be invoked to defeat the prescribed powers and procedure on the matter.

5 (2) That the appellants have failed to persuade this Court that either the judgment of the trial Court relating to section 11(1)(c) and (d) of Cap. 268 was wrong in law or that the *sub*
judice administrative decision was contrary to law or reached in
 10 excess or abuse of power; that this Court will not interfere with the discretion of the administration if due weight has been given to all material facts, if it has not been based on a misconception
 of law or fact, and if it was not exercised in excess or abuse of
 power; that it was reasonably open to the respondent to arrive
 at the decision that he did on the material before him and the
 mere fact that the word "Premier" was registered in Canada and
 in Greece could not change the situation.

15 (3) That, moreover, the Convention for the Protection of Industrial Property, ratified by Law No. 63 of 1965, could not change the outcome of this appeal as there does not appear to be
 any conflict between the grounds upon which registration was
 refused and the corresponding provisions of the said Convention.
 20 (See *Merck v. Republic* (1972) 3 C.L.R. 548 at pp. 561, 562).

Appeal dismissed.

Cases referred to:

Merck v. Republic (1972) 3 C.L.R. 548 at pp. 561, 562.

Appeal.

25 Appeal against the judgment* of a Judge of the Supreme Court of Cyprus (L. Loizou, J.) given on the 15th September, 1975 (Revisional Jurisdiction Case No. 92/73) whereby appellants' recourse against the decision of the respondent to revoke his
 30 earlier decision to accept registration of the word "Premier" was dismissed.

E. Emilianides, for the appellants.

R. Gavrielides, Counsel of the Republic, for the Respondent.

Cur. adv. vult.

35 TRIANTAFYLIDIS P.: The judgment of the Court will be delivered by Mr. Justice A. Loizou.

A. LOIZOU J.: The appellants, a tobacco company registered in Canada, applied to the respondent for the registration of the

* Reported in (1975) 3 C.L.R. 363.

word "Premier" in respect of cigarettes, cigars and tobacco products in Part A of the register of Trade Marks. The respondent informed the appellants that their application could not be accepted on the grounds that the proposed trade mark had a direct reference to the character and quality of the goods, was devoid of any distinctive character and also it offended against the provisions of s. 13 of the Trade Marks Law, Cap. 268 (hereinafter to be referred to as "the Law"). He further informed them of the fact that if a trade mark satisfied the provisions of s. 12 of the Law, same could, in accordance with the provisions of s. 19(3) thereof, and provided the applicants agreed, be examined for the purpose of registering it in Part B of the register instead of refusing its registration. Thereupon in accordance with rule 32 of the Trade Marks Rules, 1951, the appellants applied for and were granted a hearing after which the respondent informed them that the proposed trade mark was accepted for registration in Part B of the register and in case they agreed to it they could forward stamps to the value of 500 mils for its publication.

Eventually same was duly published in Supplement No. 5, Part II, to the official Gazette No. 958, of the 25th August, 1972, page 64.

There appears that there was a correspondence exchanged between counsel for the appellants and the respondent who, on the 9th December, 1972, informed them by letter that after further consideration of the matter he had decided to withdraw his acceptance of the application for registration of the trade mark in question on the ground that it had been accepted in error and advised them to exercise their right under rule 32 of the aforesaid rules, if they so wished.

Under the said rule, if the Registrar objects to an application and informs an applicant accordingly, unless within two months the applicant applies for a hearing or makes a considered reply in writing to those objections, he shall be deemed to have withdrawn his application.

The appellants then requested the respondent for further particulars for his decision to withdraw his acceptance of their application and in reply the respondent wrote to counsel of the

appellants the following letter, dated 29th December, 1972 (exhibit 4):-

5 " I have to refer to your letters of the 15th and 18th December, 1972, and to inform you that the acceptance of the mark has been withdrawn in view of the following meanings of the word 'PREMIER' which were overlooked at the time of the examination of the application:

- 10 (1) *Webster's New International Dictionary*
Premier - First in position, rank or importance.
Chief, principal, leading.
- (2) *Oxford's Dictionary*
Premier - First in position, importance, or rank.
Chief, leading, foremost.
- 15 (3) *French Dictionary*
Premier, - éere = First".

On the application of the appellant under Rule 32 a hearing took place and on the 26th February, 1972, the application of the appellants for registration was refused, both under parts 'A' and 'B' of the register.

20 Upon this the appellants filed this recourse under Article 146 of the Constitution which was tried by a Judge of this Court under section 11(2) of the Administration of Justice (Miscellaneous Provisions) Law of 1964. This recourse was dismissed with no order as to costs and from that judgment* this appeal
25 was filed.

This appeal was argued on two main grounds:-

- 30 (a) That the learned trial Judge was wrong in concluding that the respondent was still entitled, after having examined repeatedly and having decided in favour of the registrability of the said trade mark and the publication of his decision in the official Gazette to cancel such decision though no objection was lodged against it and with the only justification that he had done so in error; and
- 35 (b) The learned trial Judge was wrong in upholding the

* Reported in (1975) 3 C.L.R. 363.

decision of the respondent that the word "Premier" was not registrable under the law, although same had been registered in Canada and Greece.

With regard to the first ground above, reference should be made to s. 21(1) of the Law which reads as follows:- 5

" 21(1)—When an application for registration of a trade mark in Part A or in Part B of the register has been accepted, and either -

- (a) The application has not been opposed and the time for notice of opposition has expired; or 10
- (b) The application has been opposed and the registration has been decided in favour of the applicant,

the Registrar shall, unless the application has been accepted in error or unless the Court otherwise directs, register the trade mark in Part A or Part B, as the case may be, and the trade mark, when registered, shall be registered as of the date of the application for registration, and that date shall be deemed for the purpose of this law to be the date of registration". 15 20

The learned trial Judge had this to say on this point:-

" It is quite apparent from the wording of this section that the Registrar has power to refuse registration even though the application has been accepted in the first instance and and there has been no opposition to the registration if such application has been accepted in error. It is significant that under rule 53 of the Trade Marks Rules 1951, entry in the Register after the expiration of two months from the date of the advertisement in the Gazette is made subject to the determination of any opposition and also subject to the provisions of section 21(1). Furthermore, both the initial acceptance and the advertisement of the application are merely interim measures leading to the final act, the registration of the trade mark, and in view of this and of the express provision in the law it is not correct to say that under administrative law it was not open to the Registrar to withdraw his acceptance". 25 30 35

We agree fully with this statement of the law regarding s. 21(1) which empowers the Registrar of Trade Marks to re-examine

and refuse registration where same was accepted in error even in cases where an application had been accepted in the first instance and there had been no opposition filed thereafter within the prescribed by the rules period. Any other approach
 5 would have rendered the words in s. 21(1) "unless the application has been accepted in error" without any meaning, significance or effect. Once, therefore, the matter of cancellation of a registration is expressly regulated by law and the administrative Authority concerned acts within the powers so conferred, the general principles of Administrative Law on revocation
 10 cannot be invoked to defeat the prescribed powers and procedure on the matter.

With regard to the second ground of law, reference should be made to s. 11(1) of the law which reads as follows:-

15 " 11(1)—In order for a trade mark to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) the name of a company, individual, or firm, represented in a special or particular manner;
- 20 (b) the signature of the applicant for registration or some predecessor in his business;
- (c) an invented word or invented words;
- (d) a word or words having no direct reference to the character or quality of the goods, and not being
 25 according to its ordinary signification a geographical name or a surname;
- (e) any other distinctive mark, but a name, signature, or word or words, other than such as fall within the descriptions in the foregoing paragraphs (a),
 30 (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness".

The paragraphs that might have a bearing in the case in hand were paragraphs (c) and (d) hereinabove set out and the learned
 35 trial Judge had this to say:-

" As to paragraph (c), I think it is impossible to suggest that the word 'Premier' is an invented word in the sense that it is 'new and freshly coined' as very aptly described by Lord Macnaghten in the 'Solio' case (*The Eastman Photo-*

graphic Materials Co. Ltd. and The Comptroller-General of Patents, Designs and Trade Marks [1898] A.C. 571). It is a word in ordinary and common use and is to be found in any English or French dictionary; and there is ample authority in support of the proposition that a foreign word cannot merely by reason thereof be considered as invented word. 5

Regarding paragraph (d), I agree with the submission of learned counsel for the respondent that having regard to the meanings of the word it cannot be said that it has no direct reference to the character and quality of the goods". 10

The appellants have failed to persuade us that either the judgment of the learned trial Judge on the point hereinabove quoted was wrong in law or the *sub judice* administrative decision was contrary to law or reached in excess or abuse of power. As repeatedly stated, this Court will not interfere with the discretion of the administration if due weight has been given to all material facts, if it has not been based on a misconception of law or fact and if it was not exercised in excess or abuse of power. In the present case we have come to the conclusion that it was reasonably open to the respondent to arrive at the decision that he did on the matter before him. The mere fact that the word "Premier" was registered in Canada and in Greece, could not change the situation. 15 20

Before concluding we would like to say that the Convention for the Protection of Industrial Property ratified by Law No. 63 of 1965, to which learned counsel for the appellants has referred us, could not change the outcome of this appeal as there does not appear to be any conflict between the grounds upon which registration was refused and the corresponding provisions of the said Convention, a matter examined in the case of *Merck v. The Republic* (1972) 3 C.L.R., p. 548, at pp. 561, 562, where it was held that the conditions for filing a registration of trade marks are left to the domestic law by Article 6(1) of the Convention and such a law is valid to the extent that it does not offend the provisions of the Convention. 25 30 35

For all the above reasons this appeal is dismissed, but in the circumstances we make no order as to costs.

Appeal dismissed. No order as to costs. 40