

1985 August 30

[PIKIS, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

PLOUGH INC.,

Applicants,

v.

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

Respondent.

(Case No. 115/84).

5 *Administrative Act—Executory Act—The reasoning of a decision is not in itself an executory act—The test of justiciability under Art. 146 of the Constitution is whether the recourse is directed against an identifiable executory act, communicated within the preceding 75 days.*

10 *Trade Marks—Trade Marks Law, Cap. 268 ss. 11, 12 and 13—Distinctiveness of a mark is the common characteristic for all tests of registrability provided in section 11—The provisions of s.13 prohibit registration, if the mark is likely to deceive or cause confusion—Distinctiveness also a requisite for registration under s.12—The words “tropical blend” are not registrable either under s. 11 or s. 12—Their registration is also prohibited under s. 13.*

15 *Trade Marks—The Paris Convention for the Protection of Industrial Property—Part of our domestic law (Laws 63/1965 and 66/1983)—Art. 6 of the Convention—Reservations made under S.B. 2 of Art. 6.*

Trade Marks—Registrability—Fact of registration in foreign country—Weight to be given to such a fact.

20 Respondent rejected applicants' application for registration of their Trade Mark “Tropical Blend” in Part A

Register for their products. In response to an intimation by the respondent that the applicants could, under regulation 32 of the Trade Marks Regulations 1951-1971, seek a hearing, if they wanted to pursue the application further, the applicants filed a reply to the objections raised to the registration of "tropical blend", accompanied by an affidavit of their Vice-President, a table of the annual sales of their products in recent years and a list of Commonwealth Countries in which registration of the mark was accepted albeit in some with a disclaimer of "blend". Applicants signified readiness to disclaim "blend" as well as accept registration in Part B Register. Applicants also stressed the long association of the above mark with their products and the upward trend of their trading in Cyprus.

Registration was again refused. The refusal was communicated to the applicants by letter dated 12.12.1983. In "Grounds of Decision", furnished subsequently, analysis is made of the reasons of the said refusal*.

As a result the applicants filed the present recourse which on the face of it is directed against the "Grounds of Decision".

Held, dismissing the recourse (1) The reasoning of a decision is not in itself an executory act, but in this case what is essentially challenged is the decision explained by the "Grounds of Decision". The test of reviewability of a decision under Art. 146 of the Constitution is whether the recourse is directed against an identifiable executory decision communicated within the preceding 75 days. The objections raised as to the justiciability of this recourse are, therefore, overruled.

(2) Applicants' contention that, since the mark in question was registered in the United States, a signatory to the Paris Convention for the Protection of Industrial Property, as revised, which has been made a part of our domestic law by Laws 63/1965 and 66/1983, the respondent was bound by virtue of Art. 6.1 of the Convention to register the said mark in Cyprus, is based on a misconception of the Convention as the reservations made in

* The «grounds of decision» appear at pp. 1691-1693 post.

S.B. 2 of Art. 6 make registration largely a matter of domestic law and preserve distinctiveness as the hallmark of registration.

5 (3) The law does not in terms make registration in any other country a consideration relevant to registration in Cyprus. The value of foreign registration lies in large measure in the persuasiveness of the reasoning behind such registration provided always that similar circumstances apply for registration in the two countries. In the
10 absence of sufficient particulars to illuminate the background to the foreign registrations to applicants mark, the fact of such registrations is inconsequential.

(4) The separate tests for registration laid down in s.11 (1) of Cap 268 have one characteristic in common,
15 the mark must be distinctive. "Tropical" is primarily a descriptive word, lacking the element of distinctiveness. The word is equally apt to bring to mind the place of origin of the goods, and, therefore, it is likely to lead to deception and confusion. The mark is not, therefore,
20 registrable under s.11 for lack of distinctiveness. Its registration is also prohibited under s.13 as it is likely to deceive or cause confusion. The word "tropical" with or without "blend" is neither designed nor adapted to distinguish goods of the applicants from the goods
25 of other traders; therefore, it does not qualify for Registration in Part "B" Register; distinctiveness is also a requisite of registrability under s.12 of Cap. 268.

(5) The contention that the respondent failed to consider the impact of the words "tropical blend" in Cyprus
30 is untenable as similar considerations apply as regards registrability of foreign words to those applicable in respect of Greek words.

Recourse dismissed.
No order as to costs.

35 Cases referred to:

Ford-Werker A.-G's Application [1955] R.P.C. 191;

Needle Tip Trade Mark [1973] R.P.C. 113;

Granada v. The Republic (1985) 3 C.L.R. 207;

El Greco Distillers v. The Republic (1985) 3 C.L.R. 1189.

Recourse.

Recourse against the decision of the respondent refusing the registration of "Tropical Blend" either in Part "A" or in Part "B" of the Register of trade marks. 5

A. I. Dikigoropoulos, for the applicants.

St. Ioannides (Mrs.), for the respondent.

Cur. adv. vult.

PIKIS J. read the following judgment. Applicants, American manufacturers of cosmetics, applied for the registration of "Tropical Blend" in class 3, in Part "A" Register as a trade mark for their products⁽¹⁾. About a month later registration was refused because (a) the mark was immediately connected with the character or quality of the products and (b) lacked distinctiveness. Objection was also raised to its registration under s.13 of the Trade Marks Law, Cap. 268, because of deception or confusion likely to arise from its use. Webster's dictionary is referred to as a guide to the meaning of the words "tropical" and "blend". It was intimated to applicants they could, under r. 32 of the Trade Marks Regulations, 1951-1971, seek a hearing if they wanted to pursue the application further. In response thereto applicants gave a reply to the objections raised to the registration of "tropical blend". The reply is accompanied and supported by an affidavit of Mr. Hardeman, a Vice President of the applicants, a table of the annual sales of the products of the applicants in recent years and a list of Commonwealth countries in which registration of the mark was accepted, albeit in some with a disclaimer of "blend". Applicants signified readiness to disclaim "blend" as well as accept registration of the mark in Part "B" Register. In his affidavit Mr. Hardeman stresses the long association of the mark under consideration with their products and the upward trend of their trading in Cyprus. 10
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Registration was again refused, a fact communicated to

⁽¹⁾ See application dated 17th March, 1985.

the applicants by a letter dated 12th December, 1983. In "Grounds of Decision", furnished subsequently, analysis is made of the reasons that led to the aforesaid decision. Lack of distinctiveness of the proposed mark was the root cause of the refusal. "Tropical" connotes primarily association with the tropics, as explained in the decision, an association in no way diminished by the word "blend". Therefore, the mark was not designed to distinguish applicants' products in the manner envisaged by s.11 and for much the same reasons it was not capable of distinguishing their goods from other goods in the trade in order to justify registration under s. 12. The proposed mark was not registrable under either Part "A" of Part "B" of the Register. Further, there was serious likelihood of deception or confusion resulting from the use of a mark that suggested an association of the products with the tropics whereas they had none. In the words of the Registrar the goods of the applicants were not produced from "ingredients found in the Tropic".

Though the application is on the face of it directed against the "Grounds of Decision", nevertheless it is clear that it challenges the decision explained therein, a decision taken less than 75 days prior to the initiation of the proceedings. Whereas I agree with the submission of the respondents that the reasoning of a decision is not in itself an executory act and as such not justiciable independently of the decision, in this case what is essentially challenged is the decision explained by the reasoning embodied in "Grounds of Decision". Therefore, objections raised to the justiciability of the recourse are overruled. The test of reviewability under Art. 146 is whether the recourse is directed against an identifiable executory decision communicated within the preceding 75 days.

The first ground upon which the decision is challenged is based on the Paris Convention for the Protection of Industrial Property, as subsequently revised, a part of our domestic law by Laws 63/65 and 66/83, and failure on the part of the Registrar to apply it to the facts of the present case. Inasmuch as the trade mark presently under consideration was registered in the United States, a signatory and adherent to the Convention, the Cyprus authorities

were, in the contention of applicants, bound to register it in Cyprus by virtue of Art. 6.1 of the Convention. No such obligation was cast on the Registrar. As counsel for the respondents rightly pointed out in her supplementary address, the above submission rests on a misconstruction of the Convention. The reservations made in SB 2 of Art. 6 make registration largely a matter of domestic law and preserve distinctiveness as the hallmark for registration (1).

The second ground to which the recourse is fastened is founded on the implications of registration in seven Commonwealth countries. The law does not in terms make registration in any other country a consideration relevant to registration in Cyprus. Counsel for applicants argued that registration in other countries is an indirect consideration to which the Registrar should have regard in view of the provisions of s. 11(3)(b) - Cap. 268, that provides that circumstances other than those enumerated in s. 11 may be taken into account if because of the use of the trade mark "the trade mark is in fact adapted to distinguish it as aforesaid". The implications of foreign registration were examined by Lloyd Jacob, J., in *Ford-Werker A-G's Application* [1955] R.P.C. 191. The learned Judge observed that foreign registration is not necessarily relevant unless associated with widespread use. To the same effect is the decision in *Needle Tip Trade Mark* [1973] R.P.C. 113, 118, where it was explained that the value of foreign registration lies in large measure in the persuasiveness of the reasoning behind such registration, provided always that similar circumstances apply for registration in the two countries. We have nothing before us to indicate why a descriptive term such as "tropical" with or without "blend" was found to be sufficiently distinctive to merit registration as a trade mark. The learned authors of *Kerly's* conclude that foreign registration is a factor of secondary, if of any importance (1). In the absence of sufficient particulars to illuminate the

(1) See the explanatory note to the application of the Convention by Professor G.H.C. Bodenhausen, Director of BIRPI p. 116; it is explained that registration may be refused if the proposed mark is purely descriptive. Also see *Kerly's Law of Trade Marks and Trade Names*, 10th Ed., pp. 499-500 summing up the effect of the Convention on English Law.

(2) *Kerly's*, 10th Ed., p. 148.

background to foreign registration, I find the factor of foreign registration to be inconsequential.

Finally, the recourse is directed against the merits of the decision, i.e. the propriety of the negative decision of the Registrar. Not only applicants failed to persuade me that the decision is for any reason erroneous, but at the end of the day I very much feel the decision of the Registrar was inevitable. Rightly the Registrar found the proposed trade mark does not qualify under anyone of the separate criteria for registration listed in s. 11(1), Cap. 268, and cannot for that reason be registered. The separate tests for registration laid down in s. 11(1) have one characteristic in common, the mark must be distinctive (1). As indicated "tropical" is primarily a descriptive word lacking the necessary element of distinctiveness. The word is equally apt to bring to mind the place of origin of the goods. For that reason the word is inherently likely to lead to deception and confusion as noted by the Registrar. Consequently, the word "tropical" with or without the accompaniment of "blend" is not registrable for lack of distinctiveness under s. 11, while its registration is also prohibited under s. 13 making unlawful the registration of marks likely to deceive or cause confusion (2). Also the word "tropical" with or without "blend" is neither designed nor adapted to distinguish the goods of the applicants from the goods of other traders, it does not qualify for registration in Part "B" of the Register. An element of distinctiveness is also a requisite of registrability under s. 12.

The submission that the reasoning of the Registrar is defective for lack of consideration of the specific impact of the words "tropical blend" in Cyprus is untenable. As stated in the judgment of Lloyd Jacob, J., in *Ford-Werker* (supra), similar considerations apply as regards registrabi-

(1) Kerly's (supra), p. 96.

(2) Recently I had occasion to survey some of the implications of s. 13 in the cases of *Granada v. The Republic* (1985) 3 C.L.R. 207. and *El Greco Distillers Ltd. v. The Republic* (1985) 3 C.L.R. 1189.

lity of foreign words to those applicable in respect of English words.

For the reasons indicated above, the recourse fails. It is dismissed. Let there be no order as to costs.

Recourse dismissed.

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No order as to costs.