

1985 March 29

[L. LOIZOU, J.]

IN THE MATTER OF ARTICLE 146  
OF THE CONSTITUTION

EFFEMS A.G., OF SWITZERLAND,

*Applicant,*

v.

THE REPUBLIC OF CYPRUS, THROUGH  
1. THE MINISTER OF COMMERCE AND  
INDUSTRY, AND/OR  
2. THE REGISTRAR OF TRADE MARKS,

*Respondents.*

(Case No. 122/76)

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*Trade marks—Registration—Objection to—“Marathon”—Whether a geographical name—Principles applicable—No evidence of distinctiveness—Reasonably open to the respondent Registrar to reach the conclusion that the said word was unregistrable under section 11(1)(d) and (e) of the Trade Marks Law, Cap. 268—Fact of registration in other countries not relevant for registration in Cyprus—Court cannot substitute its own discretion for that of the Registrar.*

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10 *Equality—Discrimination—Articles 6 and 28 of the Constitution—There can be no valid claim to equal treatment on an illegal basis.*

15 The applicants, a Swiss company, applied to the Registrar of Trade Marks to accept for registration in Part A or Part B of the Register the trade mark “Marathon” in respect of confectionery, biscuits and chocolates under class 30 of the Trade Marks Rules, 1951-1971.

20 The Registrar informed the applicants that their application could not be accepted in view of the provisions of s. 11 (1) (d) and (e) of the Trade Marks Law, Cap. 268,

as the proposed trade mark (a) was a geographical name and (b) was devoid of any distinctive character, unless they were in a position to produce evidence of distinctiveness which could bring it under the provisions of s.11 (1) (e) of the Trade Marks Law, Cap. 268. 5

Upon a recourse by the applicants against the above decision it was contended that the word "Marathon" in its ordinary signification is not a geographical name but according to Webster's International Dictionary it may mean "a race", an "endurance contest" and also a blend of certain colours. It was, further, contended that the decision of the Registrar was contrary to the provisions of Articles 6 and 28 of the Constitution because the Registrar in other cases had accepted geographical names such as the word "Troodos" for registration. 10 15

*Held*, (1) that in deciding whether a name is, in its ordinary signification, a geographical name regard must be had to what is the ordinary meaning of the word in the minds of the people of the place where the particular trade mark is sought to be registered; that it was reasonably open to the Registrar to decide that the ordinary meaning of the word "Marathon" in the minds of the people of Cyprus is that of a geographical name; and that it was, therefore, unregistrable under section 11(1) (d) of Cap. 268; and that since no proper evidence of distinctiveness was adduced to render it registrable under s. 11 (1) (e) it was entirely open to the Registrar, on the material before him, to reach the conclusion that he did. 20 25

(2) That even if the word "Troodos" was registered on an erroneous view of the Law, this fact would not entitle the applicants to similar treatment as there can be no valid claim to equal treatment on an illegal basis. 30

*Held, further* (1) that the fact that the same mark was accepted for registration in other countries is not relevant for registration in Cyprus. 35

(2) That this Court cannot substitute its own discretion for that of the Registrar.

*Application dismissed.*

Cases referred to:

*Magnolia Metal Company's Trade Marks* [1897] 14  
R.P.C. 621;

5 *Karayiannis v. Educational Service Committee* (1979) 3  
C.L.R. 371 at p. 378;

*Proestou v. Republic* (1981) 3 C.L.R. 314 at p. 320;

*Curzon Tobacco Co. Ltd. v. Republic* (1979) 3 C.L.R.  
151;

*Merck v. Republic* (1972) 3 C.L.R. 548 at p. 564.

10 **Recourse.**

Recourse against the decision of the respondents where-  
by applicant's application for the registration of the trade  
mark "Marathon" in Part A or Part B of the Register of  
Trade Marks was dismissed.

15 *G. Platritis*, for the applicant.

*R. Gavrielides*, Senior Counsel of the Republic, for  
the respondents.

*Cur. adv. vult.*

20 L. LOIZOU J. read the following judgment. The appli-  
cants, a Swiss company, by this recourse challenge the  
validity of the decision of the Registrar of Trade Marks  
not to accept for registration in Part A or Part B of the  
Register their application for registration of the trade mark  
25 "Marathon" in respect of confectionery, biscuits and choco-  
lates under class 30 of the Trade Marks Rules, 1951-1971  
and pray for a declaration that such decision is void and  
of no effect whatsoever as being contrary to Law and the  
constitution and/or in excess or abuse of powers.

30 The application to the Registrar was made on the 3rd  
November, 1975. By letter dated 30th December, 1975,  
exhibit 1, the Registrar informed the applicants that their  
application could not be accepted in view of the provi-  
sions of s. 11(1)(d) and (e) of the Trade Marks Law, Cap.  
268, as the proposed trade mark (a) was a geographical  
35 name and (b) was devoid of any distinctive character, un-

less they were in a position to produce evidence of distinctiveness which could bring it under the provisions of s. 11 (1) (e). Applicants' attention was also drawn to the provisions of regulation 32 by virtue of which they could either apply for a hearing or make a considered reply to his objections within two months. 5

The applicants forwarded to the Registrar their considered reply on the 22nd January, 1976, exhibit 3, setting out their reasons why registration should be allowed. Their main reason was that the word in its ordinary signification is not a geographical name but has other meanings as well such as a race, an endurance contest and a colour and moreover that names of small places called by the name of marathon were not connected with the manufacture of confectionery and the word, therefore, was registrable on the authority of *Magnolia Metal Company's Trade Marks* [1897] 14 R.P.C. 621. 10 15

On the 20th February, 1976, the respondent informed the applicants by his letter exhibit 2 that having reconsidered their application in the light of their considered reply he found no reason to change his previous decision and that his objection would have to be maintained. 20

The applicants then filed the present recourse which is based on the following grounds of Law:

(1) That the sub judge decision is against the provisions of sections 11, 12 and 19 of the Trade Marks Law, Cap. 268 and the Trade Marks Rules, 1951. 25

(2) That the same mark was accepted for registration in England under the corresponding English Trade Marks Rules and was also registered in Australia and New Zealand. 30

(3) That the decision of the Registrar is also contrary to the provisions of Articles 6 and 28 of the Constitution.

(4) That the discretion of the Registrar was exercised wrongly and/or was based on wrong principles or criteria. 35

Counsel for applicants submitted in his address that the word "Marathon" in its ordinary signification is not a

geographical name but according to Webster's International Dictionary it may mean "a race", an "endurance contest" and also a blend of certain colours. It is, therefore, in counsel's submission, registrable on the authority of the case of *Magnolia* (supra) where it was stated that a name does not become a geographical name simply because a place on the earth's surface has been called by it. Counsel further contended that the Registrar did not exercise his discretion properly because he was misguided by certain authorities where the locality whose name was the word proposed for registration as a trade mark had a direct connection with the goods sought to be registered.

In deciding whether a name is, in its ordinary signification, a geographical name regard must be had to what is the ordinary meaning of the word in the minds of the people of the place where the particular trade mark is sought to be registered. In Halsbury's Laws of England, 4th ed., para. 42, p. 35, we read:

"A place name only ceases to be a geographical name when it can be regarded as commercially of no significance or no potential significance and is unknown in the United Kingdom as a place name. Even where a place name is distinctive it is unlikely to be registrable."

In this respect I find that it was reasonably open to the Registrar to decide that the ordinary meaning of the word "Marathon" in the minds of the people of Cyprus is that of a geographical name, that is a place near Athens where a battle was fought and not any specific blend of colours or the plant fennel or an endurance contest or a race, as suggested by counsel for applicants. This being the position in Cyprus where the name was sought to be registered it cannot be said that the Registrar did not exercise his discretion properly and that, therefore, this Court will not interfere with such discretion.

A word which is in its ordinary signification a geographical name may still be registrable under s. 11 (1)(e) but only if it is inherently adapted to distinguish the goods of a particular trader and if it can be predicted that it is such name as it would never occur to any other trader in such

goods to use; or if the applicant can show that he has a natural or legal monopoly of the production of the goods concerned in the place concerned: but that alone will not make a geographical name registrable without substantial evidence of distinctiveness. (See, Kerly's Law of Trade Marks and Trade Names, 10th ed., p. 129). What amounts to evidence of distinctiveness is explained in Halsbury's Laws of England 4th ed., vol. 48, p. 41, para. 52, where it is, inter alia, stated that as "distinctiveness" includes inherent adaptability to distinguish, and also the effect of other circumstances, in particular of user, the evidence required to establish distinctiveness may vary with the nature of the mark. And the most significant evidence is of substantial use as a trade mark and such as would distinguish the applicant's goods.

From the material before me, which was also before the Registrar, I find that the Registrar was justified in deciding that no evidence has been submitted to prove distinctiveness of the mark. What was submitted by the applicants in their considered reply, exhibit 3, was not evidence of distinctiveness but legal argument to establish that "Marathon" should not be regarded as a geographical name.

With regard to the point raised by counsel for applicants that the Registrar was misguided by certain authorities it is my view that even if this were so it would have no bearing in this particular case since the Registrar had already properly decided that the proposed trade mark was in its ordinary signification a geographical name and, therefore, unregistrable under s. 11(1)(d) and as no proper evidence of distinctiveness was adduced to render it registrable under s. 11(1)(e) it was entirely open to the Registrar, on the material before him, to reach the conclusion that he did.

Counsel also raised the question of inequality of treatment between his client and other cases where geographical names were accepted for registration.

It is a fact, as it is shown by the documents produced as exhibit 4, 5 and 6 that the following words were accepted for registration in Cyprus:

(a) "Marathon" (in 1947) in respect of articles of clothing but it was subsequently removed. This trade mark however, was accepted because the applicants disclaimed any right to the exclusive use of the word except in the distinctive form shown in the representation.

(b) "Troodos" (in 1911) in respect of cigarettes.

(c) "Troodos" (in 1976) in respect of music records and cassettes.

The explanation given by counsel for the respondent concerning the last two registrations is that the Registrar felt that it can be predicted that nobody will ever produce or manufacture in that place cigarettes or music records and cassettes whereas in the present case he had no evidence on which it could be predicted that confectionery were not already or will not in the future be manufactured at Marathon.

It is not necessary for me to decide, in these proceedings, whether the Registrar was right or wrong in accepting the word "Troodos" which is a geographical name in its ordinary signification and also a local one for the simple explanation that he could predict that nobody will ever produce or manufacture there any of the articles in respect of which the name was registered; for even if I were to hold that the Registrar was wrong in his assumption and the word "Troodos" was registered on an erroneous view of the Law, this fact would not entitle the applicants to similar treatment as it is well settled that there can be no valid claim to equal treatment on an illegal basis. (See, in this respect, Conclusions from the Case Law of the Greek Council of State 1929-1959, p. 182 and the cases of *Karayiannis v. The Educational Service Committee* (1979) 3 C.L.R., 371 at 378 and *Proestou v. The Republic* (1981) 3 C.L.R. 314 at 320 where it was held that "the wrong application of the law in one case does not entitle another person even on the same facts, to insist on the continuation of such wrong application of the Law.")

The ground of discrimination, therefore, fails as well.

Lastly, I will deal, very briefly, with two other points raised by counsel for applicants. The first is that it should

have been taken into consideration that the same mark was accepted for registration in other countries. It has been already decided by this Court that this fact is not relevant for registration in Cyprus. (See, *Curzon Tobacco Co. Ltd. v. The Republic* (1979) 3 C.L.R. 151).

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The other point is that this Court has the same discretionary powers as those of the Registrar and can substitute its own discretion for that of the Registrar. With regard to this I need only refer to the cases of *Merck v. The Republic* (1972) 3 C.L.R. 548 at 564 and the *Curzon Tobacco Co.* (supra).

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In the light of the foregoing this recourse fails and it is hereby dismissed.

There will be no order as to costs.

*Recourse dismissed.*

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*No order as to costs.*