

1987 October 7

(SAVVIDES, J)

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

SOCIETE NATIONALE ELF AQUITAINE,

Applicants,

v.

THE REGISTRAR OF TRADE MARKS,

Respondent.

(Case No. 356/84)

Trade marks — Registrability of — Judicial control — Principles applicable.

Trade marks — Registrability of — Invented words — Meaning of.

Trade marks — Registrability of — Fact of registration in other countries — Weight to be attached to it.

Trade marks — Registrability of — The Trade Marks Law, Cap. 268, sections 11(1) and 13. 5

Acts or decisions in the sense of Art. 146.1 of the Constitution — Trade marks — Decision refusing registration — It is an administrative act in the domain of public law.

Administrative law — General principles — Recourse for annulment — Facts which had not been placed before the administration cannot be accepted at the hearing. 10

By means of this recourse the applicants impugn the decision of the Registrar of Trade Marks, whereby their application for registration of the words «ATLANTA MARINE» as a trade mark in respect of industrial oils and greases, lubricants, motor fuels, and oils, specially formulated for cross-head engine lubricants, was dismissed on the following grounds, namely: 15

(a) The proposed trade mark, contrary to section 11(1)* of Cap. 268 had direct reference to the character or quality of the goods, it was a geographical name and it lacked distinctiveness. 20

(b) The proposed trade mark violated section 13* of Cap. 268.

* Quoted at p 1427 post

3 C.L.R. Societe National v. Reg. Trade Marks

In support of his case counsel for applicants submitted inter alia, that

(a) The recourse is by way of re-trial and the Court is free to exercise its own discretion. Apparently, this submission was based on section 50 of Cap 268

(b) The proposed trade mark consists of invented words

5 (c) The mark has use in Cyprus and is registered in England as «ATLANT MARINE»

(d) The Registrar overlooked the fact that the mark was registered in other countries

10 It must, however, be noted that the fact referred to in submission «c» hereinabove had not been placed before the Registrar

Held, *dismissing the recourse* (1) Prior to the Independence of Cyprus the decision of the Registrar of Trade Marks could be challenged by an appeal, which was by way of rehearing. After the Independence of Cyprus, however, a decision of the Registrar of Trade Marks being an administrative act, is subject to a recourse under Article 146 of the Constitution and not an appeal

15 (2) The powers of the Supreme Court as an administrative Court are well settled and it is established that the Court will not interfere with the discretion of the administration so long as the decision was reasonably open to it if due weight has been given to all material facts. It has not been based on a misconception of law or fact and it was not exercised in excess or abuse of powers. And this is so even if in exercising its own discretion on the merits, it would have reached a different conclusion

20 (3) Facts which had not been placed before the Registrar and in fact came into existence after the sub-judice decision cannot be accepted at the hearing of a recourse, but may constitute new material in respect of an application to the Registrar for reconsideration of the matter

25 (4) In the present case the Registrar after making reference to well known dictionaries refused registration of the proposed mark on the ground that the word «Atlanta» is a geographical name of a city in the United States and of four other smaller cities and the word «manne» has a clear grammatical meaning, that of pertaining to the sea, and that the combination of the two words, which could not be considered as invented words in relation to the goods covered by such trade mark might create the wrong impression about the goods and was likely to cause confusion or to deceive

30 (5) In the light of the authorities concerning the meaning of the term «invented word», the decision that the mark in question did not consist of invented words was reasonably open to the Registrar

35 (6) The Respondent did not overlook the fact of registration of the proposed trade mark in other countries. However, the mere fact of such registration is

«of little or no bearing on whether the mark is capable of distinguishing the applicant's goods in this country» (*Needle-Tip Trade Mark* [1973] R P C 113 at p 118)

(6) In the light of the material before the Court the conclusion is that the sub-judice decision was reasonably open to the Registrar of Trade Marks

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Recourse dismissed
Costs against applicants

Cases referred to

White Horse Distillers Ltd v El Greco Distillers Ltd and Others (1987) 3 C L R 531

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The Eastman Photographic Materials Company Ltd v The Comptroller-General of Patents, Designs and Trade Marks [1898] A C 571

De Cordova v Vick [1951] 68 R P C 103,

Minnesota Mining & Manufacturing Co 's Appn [1948] 65 R P C 229,

I W S Nominee Co Ltd v The Republic (1967) 3 C L R 582

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Tsangans v The Republic (1975) 3 C L R 518,

Merck v The Republic (1972) 3 C L R 548,

Effems A G v The Republic (1985) 3 C L R 793

Needle-Tip Trade Mark [1973] R P C 113

Recourse.

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Recourse against the refusal of the respondent to waive the objections against the registration of the words «ATLANTA MARINE» written in plain letters as a trade mark in Class 4 of Part A of the Register of Trade Marks

Chr Theodoulou, for the applicants

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St Ioannides (Mrs), for the respondent

Cur adv vult

SAVIDES J. read the following judgment. The applicants a company incorporated in France, applied on the 10th October, 1980, for the registration of the words «ATLANTA MARINE» written in plain letters, as a trade mark in class 4 of Part A of the Register of Trade Marks, in respect of industrial oils and greases, lubricants, motor fuels, oils specially formulated for cross-head

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- engine lubricants. The respondent before taking any decision on the matter, asked the applicants' advocate to give him the meaning of the words «ATLANTA MARINE» in Greek according to Rule 29 of the Trade Marks Rules, 1951-1971. On the 13th
- 5 December, 1980 applicants' advocate informed the Registrar that the words «ATLANTA MARINE» are invented words. The application having been considered by the respondent, was on the 30th December, 1980 objected to on the ground that the proposed trade mark, contrary to the provisions of section 11(1) of
- 10 the Trade Marks Law, Cap. 268, had direct reference to the character or quality of the goods, it was a geographical name, and it lacked distinctiveness. Also, that it could not be registered as it was violating the provisions of section 13 of the Trade Marks Law, Cap. 268.
- 15 On the 16th February, 1981, the applicants applied, through their advocate, for a hearing and the case was partly heard, after several adjournments, on the 9th October, 1981 and was further adjourned. On the 21st January, 1983 the applicants' advocate
- 20 filed an application for the amendment of the trade mark to «ATLANT' MARINE». The application having been considered again, was, on the 26th February, 1983, objected to on the same grounds as the original application. The applicants' advocate applied for another hearing which took place, after a number of adjournments, on the 10 May, 1984 on which date an affidavit was
- 25 filed on behalf of the applicants to the effect that the words «ATLANTA MARINE» or «ATLANT' MARINE» are invented words, that the word «MARINE» refers to the sea and the word «ATLANTA» to the Atlantic Ocean and also that the same mark was registered in many countries. Meanwhile, however, on the 8th
- 30 May, 1984, the applicants' advocate again applied for amendment of the trade mark to «ATLANTA MARINE» as in the original application. After the new hearing was concluded the respondent informed the applicant of his decision by letter dated the 22nd May, 1984, stating that the objections contained in his
- 35 letter of the 30th December, 1980 could not be waived and were confirmed. The applicants' advocate applied for a reasoned judgment which was communicated to him by letter dated the 16th July, 1984.

As a result the applicants filed the present recourse challenging

40 the sub judge decision and praying for its annulment.

The grounds of law relied upon by counsel for the applicants are that -

1. The decision is not duly reasoned.
2. The respondent misdirected himself and or proceeded on wrong principles in arriving at his decision. 5
3. The respondent acted under a misconception of Law and or fact.
4. The respondent failed to consider whether the proposed mark was inherently adapted to or capable of distinguishing the applicants' goods. 10
5. The respondent wrongly translated the words constituting the mark and/or made wrong assumptions about their meaning etc.
6. The respondent failed to take into consideration the fact that the mark is world famous and registered in many countries of the world and failed also to take into consideration the affidavit of Mrs. Elisabeth Kazatchkine. 15
7. The respondent exercised his discretion wrongly.

The affidavit of Mrs. Kazatchkine is the one filed by counsel for the applicants on 10.5.1984, reference to which has already been made in the explanation of the facts of the case, and appears as reds 29-30 in the file of the case, which is Exhibit 1. 20

It should be stressed at this stage, that the words finally sought to be registered were «ATLANTA MARINE» and not «ATLANT' MARINE». 25

By his written address counsel for the applicants in expounding on his grounds of law submitted that the mark «ATLANTA MARINE» consists of invented words, a fact supported by the affidavit of Mrs. Kazatchkine, which have no immediate or any relation with the character or quality of the goods. He further contended that the words forming part of the trade mark should have been taken together and not separately, as was wrongly done by the Registrar. In dealing with the grammatical and geographical meaning of the words, counsel submitted that the mark is registrable since Atlanta city has no particular reputation for the production of the goods referred to in the application, and that the Registrar could have accepted the mark under the 30 35

condition that the goods would not be manufactured in Atlanta. As to the word «marine» he submitted that such word in combination with the word «Atlanta» and the fact that some of the goods are oils for ships, gives to the mark its distinctiveness. Counsel further
5 argued that the respondent failed to take into account the fact that the particular trade mark is world famous and registered in many countries of the world, that he has acted under a misconception of fact and law, that he failed to consider whether the proposed mark was inherently adapted or capable of distinguishing the
10 applicants' goods, that the decision is not duly reasoned and that the respondent exercised his discretion wrongly.

Counsel for the respondent, on the other hand, contended that the sub judice decision was properly and lawfully open to the Registrar in the exercise of his powers under the Trade Marks Law.
15 She submitted that the proposed trade mark is not registrable either in Part A or Part B of the Register as it consists of words which are directly descriptive and not adapted to distinguish the goods of the applicants and the Registrar rightly reached the sub judice decision. In concluding, counsel for the respondent
20 submitted that:-

(a) The applicants failed to discharge the onus cast upon them to satisfy the respondent that the proposed trade mark is adapted or capable of distinguishing their goods within the meaning of sections 11 and 12 of Cap. 268. Also that they failed to satisfy the
25 respondent that the registration of their mark will not contravene the provisions of section 13 of the Law.

(b) The respondent rightly came to the conclusion that the mark propounded for registration did not consist of invented words since they are neither new nor freshly coined words and are to be
30 found in dictionaries.

After the written addresses had been concluded and the case was fixed for clarifications and evidence counsel for the applicants filed two affidavits. (a) One dated 13th September, 1985 sworn by the same affiant (Mrs. Kazatchkine), including, inter alia, the
35 contention that «the mark has use in Cyprus and is registered in England under No. B 1,165,800 as «ATLANT' MARINE». (B) An affidavit sworn by Yiannoula Theofanous, advocate's clerk at the office of counsel for the applicants, dated 15th October, 1985,

Attaching a photocopy of a page from the Trade Marks Journal of England dated the 7th August, 1985 in which the registration of the trade mark «ATLANT' MARINE» was advertised under No. 1,165,800.

Counsel for the respondent in her address in clarification stated that the matters raised in the affidavits of the 13th September and the 15th October, 1985 had not been placed before the Registrar either at the hearing or at any stage before the sub judge decision was taken and therefore they could not be advanced in support of the applicants' case. 5 10

As I pointed out to counsel for the applicants in the course of the hearing the registration of the trade mark in England was not in respect of «ATLANTA MARINE» but «ATLANT' MARINE» and that any material which was not placed before the Registrar and in fact came into existence after the sub judge decision, could not be accepted at the hearing but might be new material in support of an application to the Registrar for reconsideration of the case. I still hold the same view and I consider such material as relevant for the purposes of the validity of the sub judge decision and any argument based on it by applicant's counsel is also relevant. 15 20

The approach of our Supreme Court, as to when the Court may interfere with an administrative decision regarding the registrability of a trade mark, has been recently reviewed by the Full Bench in Revisional Appeal No. 505 (*White Horse Distillers d. v. El Greco Distillers Ltd. and others*) in which judgment was delivered on 20th February, 1987 (not yet reported)*. It was held that case that:- 25

«It is the well established approach of our Supreme Court, on the basis of the principles governing the exercise of its jurisdiction as an administrative Court in the first instance and on appeal, that it does not interfere with an administrative decision regarding the registrability of a trade mark if such decision was reasonably open to the Registrar of Trade Marks and does not substitute its own evaluation in the place of that of the Registrar». 30 35

With the above in mind I come now to consider the position in the present case.

*reported in (1987) 3 C.L.R. 531.

The relevant provisions relied upon by the respondent in arriving at his decision to object to the registration of the trade mark, the subject matter of this recourse, are sections 11(1) and 13 of the Trade Marks Law, Cap. 268.

5 Section 11(1) provides as follows:-

«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:-

10 (a) The name of a company, individual, or firm, represented in a special or particular manner;

(b) the signature of the applicant for registration or some predecessor in his business;

(c) an invented word or invented words;

15 (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;

20 (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), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.»

and section 13 reads as follows:-

25 «It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.»

30 Counsel on both sides made extensive reference to Kerly's Law of Trade Marks and Trade Names and to a number of relevant English cases referred to therein.

35 The term «invented word» was discussed at some length by the House of Lords in the «*Solio*» case, *The Eastman Photographic Materials Company Ltd. v. The Comptroller-General of Patents, Designs and Trade Marks* [1898] A.C. 571. The following passages from the speeches in the «*Solio*» case sum up the position (See *Kerly's Law of Trade Marks and Trade Names*, 12th Edition, pp. 80-82., paras 8-18):-

«Lord Macnaghten said; 'If it is an invented word - if it is 'new and freshly coined' (to adapt an old and familiar quotation) - it seems that it is no objection that it may be traced to a foreign source, or that it may contain a covert and skilful allusion to the character or quality of the goods. I do not think that it is necessary that it should be wholly meaningless.' 5

Lord Halsbury said: 'I desire to give my opinion with reference to the particular word, and not go behind it. I can quite understand suggesting other words - compound words, or foreign words - as to which it would be impossible to say that they were invented words, although, perhaps, never seen before, or that they did not indicate the character or quality of the goods, although as words of the English tongue they had never been seen before. Suppose a person were to attempt to register as a single English word 'Cheapandgood', or even without taking so gross an example, using a word so slightly differing from an ordinary and recognised word as to be neither an invented word nor, avoiding the prohibited choice of a word, indicating character or quality. The line must be sometimes difficult to draw; but, to my mind, the substance of the enactment is intelligible enough, and the Comptroller has to make up his mind whether in substance there has been an infringement of the rule.' 10 15 20

Lord Herschell said: 'If the word be an 'invented' one, I do not think the quantum of invention is at all material. An invented word is allowed to be registered as a trade mark, not as a reward of merit, but because its registration deprives no member of the community of the rights which he possesses to use the existing vocabulary as he pleases. It may, no doubt, sometimes be difficult to determine whether a word is an invented word or not. I do not think the combination of two English words is an invented word, even although the combination may not have been in use before; nor do I think that a mere variation of the orthography or termination of a word would be sufficient to constitute an invented word, if to the eye or ear the same idea would be conveyed as by the word in its ordinary form. Again, I do not think that a foreign word is an invented word simply because it has not been current in our language. At the same time, I am not prepared to go so far as to say that a combination of words from foreign 25 30 35 40

languages so little known in this country that it would suggest no meaning except to a few scholars might not be regarded as an invented word.'

5 Lord Shand said: 'I agree ... in thinking, especially after the
decision to be given in this case, that the Comptroller-General
will be fully warranted in taking care that there shall not be
admitted, under the guise or cover of words called 'invented'
by the applicant, words really in ordinary use, which might, in
10 a disguised form, have reference to the character or quality of
the goods. There must be invention, and not the appearance
of invention only. It is no possible to define the extent of
invention required, but the words, I think, should be clearly
and substantially different from any word in ordinary and
common use. The employment of a word in such use, with a
15 diminutive or a short and meaningless syllable added to it, or
a mere combination of two known words, would not be an
'invented' word, and a word would not be 'invented' which,
with some trifling addition or very trifling variation, still leaves
the word one which is well known or in ordinary use, and
20 which would be quite understood as intended to convey the
meaning of such a word.»

In *De Cordova v. Vick* [1951] 68 R.P.C. 103 it was held by the
Privy Council that «Vapour rub» had an obvious meaning and thus
not quite to be invented, it being «only common sense to infer that
25 the word produced by this combination («vapour» and «rub») was
intended, not to conceal, but actually to suggest the nature of the
substance that it was to be applied to». (See Kerly (supra) p. 82
paras 820).

In *Minnesota Mining & Manufacturing Co.'s Appn* [1948] 65
30 R.P.C. 229 it was held that the word «Scotchlite» was merely a
combination of the word «Scotch» and the misspelt word «light»
and so it was neither an invented word nor distinctive. (see Kerly
(supra) p. 28, paras 8-20).

In the present case the Registrar after making reference to well
35 known dictionaries refused registration of the proposed mark on
the ground that the word «Atlanta» is a geographical name of a city
in the United States and of four other smaller cities and the word
«marine» has a clear grammatical meaning, that of pertaining to
the sea, and that the combination of the two words, which could
40 not be considered as invented words in relation to the goods

covered by such trade mark, might create the wrong impression about the goods and was likely to cause confusion or to deceive.

Counsel for the applicants submitted that when there is a recourse from the Registrar's decision such recourse is by way of retrial and the Court is free to exercise its own mind and discretion. 5
Apparently, this submission was based on section 50 of Cap. 268. This position however was applicable prior to the Independence of Cyprus when an appeal to the Court was the appropriate means of challenging a decision of the Registrar. After the independence of Cyprus however, a decision of the Registrar of Trade Marks, 10
being an administrative act, is subject to a recourse under Article 146 of the Constitution and not an appeal. In *I.W.S. Nominee Co. Ltd. and The Republic* (1967) 3 C.L.R. 582 at pp. 586, 587, it was held that:

«..... the primary and predominant purpose of the 15
registration of a trade mark is its public one and that a decision as the sub judice one is, therefore, one in the domain of public law, and not of private law».

In the light of all the foregoing the sub judice matter falls within the ambit of Article 146. 20

The powers of the Supreme Court as an administrative Court are well settled and it is established that the Court will not interfere with the discretion of the administration so long as the decision was reasonably open to it if due weight has been given to all material facts, it has not been based on a misconception of law or fact and it was not exercised in excess or abuse of powers. And this is so even if in exercising its own discretion on the merits, it would have reached a different conclusion (*Kyriacos Tsangaris and The Republic* (1975) 3 C.L.R. p. 518; *Merck v. The Republic* (1972) 3 C.L.R. 548 *Effems A.G. v. The Republic* (1985) 3 C.L.R. 793 and 25
the recent decision in Revisional Appeal No. 505 *White Horse Distillers Ltd. v. El Greco Distillers Ltd. and Others* (supra) in which our case law regarding the registrability of a trade mark has been reviewed. 30

In the result the suggested by counsel for applicants approach of the Court in cases of registrability of trade marks is erroneous. 35

As to the contention of counsel for the applicants concerning the registration of the trade mark in other countries, a fact which in his submission was overlooked by the respondent, I find myself unable to agree as that fact was brought to his notice and was part 40
of the material on which he relied in reaching his decision and in

fact it is mentioned in his reasoned judgment. As to the position when a mark has been registered in a foreign country and the bearing of such registration in proceedings for registration in Cyprus, as well as whether the mark is capable of distinguishing the goods of an applicant in this country, useful reference may be made to the decision in *Needle-Tip Trade Mark* [1973] R.P.C. 113, in which we read the following at p. 118:

«It seems to me that the mere fact that a mark has been registered in a foreign country has little or no bearing on whether the mark is capable of distinguishing the goods of the applicant in this country. Registration in the foreign country will have been allowed according to the law and practice in that country which may differ from that of this country and may have been allowed in the light of particular circumstances and trading conditions in that country and which may be very different to those obtaining in this country. It may be that, in a case where a mark applied for here has already been registered in a foreign country with a system of trade mark law similar to our own, if a written decision of the foreign tribunal allowing registration in the foreign country and which showed the grounds of the decision and the matters taken into consideration were to be adduced on the application here, it might be persuasive as a piece of reasoning as to whether the mark should be registered here, if, but only if, similar considerations applied in this country; but that, it seems to me is as far as registration in a foreign country could be relevant to registrability here. It is to be noted that in *Switts'* case the Divisional Court was influenced by what was referred to as 'a scholarly and persuasive judgment of the Full Court of the High Court of Australia'. On the present appeal, however, all that has been relied upon is the mere fact of registration in the countries mentioned and that mere fact, as I have already stated, is of little or no bearing on whether the mark is capable of distinguishing the applicants' goods in this country».

In this present case, on the material before me, and having carefully considered the contents of the decision of the Registrar and the reasons for his objection, I have come to the conclusion that it was reasonably open to him to decide as he did. Bearing in mind the well established principle that the Supreme Court does not interfere with decisions of an administrative organ nor does it substitute its own evaluation to that of the administrative organ if

such decision was reasonably open to such organ I have reached the conclusion that the applicants have failed to show a good cause for interference by the Court to upset the decision of the Registrar which as I have already pronounced was reasonably open to him.

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In the result the recourse fails and is hereby dismissed with costs in favour of the respondent.

Recourse dismissed.

Costs in favour of respondents.