

1987 April 8

[SAVVIDES J]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

FERRERO S P A ,

Applicant,

v

THE REGISTRAR OF TRADE MARKS,

Respondents

(Case No 38/84)

Trade Marks — Registration of — Judicial control — Principles applicable

By means of this recourse the applicant challenges the validity of the respondent's decision, rejecting the registration of the word «DUPLO», written in plain capital letters as trade mark in Part A, Class 30 of the Register of Trade Marks in respect of confectionery, biscuits and cakes, tarts, ice-cream, honey, pasta and flour for pasta 5

The respondent, having sought guidance from dictionanes and in particular Cassel's Italian — English and English — Italian Dictionary, 3rd Edition, came to the conclusion that the word «DUPLO», though not very commonly used in modern Italian, nevertheless it had a grammatical meaning that of «Double» In the light of this finding the respondent further concluded that the word «DUPLO» is descriptive of some of the goods sought to be registered and has, therefore, a direct reference to their character or quality (Section 11(1)(d)* of the Trade Marks Law, Cap 268) and that in respect of the other goods its use might be deceptive (Section 13* of the same law) 10 15

Held, dismissing the recourse (1) This Court, as an administrative Court, 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 20

(2) On the matenal before it, this Court came to the conclusion that the sub judice decision was reasonably open to the respondent

*Recourse dismissed
No order as to costs*

* Quoted at p 540

3 C.L.R. Ferrero S.P.A. v. Registrar of Trade Marks

Cases referred to:

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

Recourse.

- 5 Recourse against the refusal of the respondent to register the word «DUPLO» in plain capital letters in Part A in the Register of Trade Marks in respect of confectionery, biscuits and cakes, tarts, ice cream, honey, pasta and flour for pasta.

G.M. Nicolaidis, for the applicant.

- 10 *St. Ioannidou*, for the respondent.

Cur. adv. vult.

- SAVVIDES J. read the following judgment. The applicant, a registered company in Italy, applied on the 17th December, 1982 for the registration of the word «DUPLO» written in plain capital letters as trade mark in Part A, class 30 of the Register of Trade Marks in respect of confectionery, biscuits and cakes, tarts, ice-cream, honey, pasta and flour for pasta. The application was considered by the respondent on the 18th January, 1983, who rejected the application on the ground that the proposed trade mark had, in accordance with section 11(1)(d) and (e) direct reference to the character or quality of the goods and was not distinctive and also that it was deceptive under section 13 of the Trade Marks Law, Cap. 268. The applicant then, through its advocate, applied for a hearing of the application before the Registrar, which was fixed for the 27th October, 1983.

- At the hearing of the case counsel for applicant argued that the word «DUPLO» in Italian did not mean double and that the proper word for double in Italian is «doppio». Even if «DUPLO» is considered as meaning double, counsel submitted, it can have only reference to quantity but not to the quality or character of the goods.

The respondent delivered his judgment on the 11th November, 1983 which was communicated to counsel for applicant by letter of the same date, the contents of which read as follows:

- 35 «I refer to the hearing of the 27th October, 1983 in connection with the above trade mark.

I inform you that the objections to the registration of your trade mark contained in my letter with the same number dated 18.1.1983, have been considered carefully in the light of what was argued at the hearing but unfortunately they cannot be withdrawn and they are hereby confirmed.»

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The reasoned decision of the respondent was issued and communicated to the applicant on 17.1.1984.

As a result the applicant filed the present recourse challenging the said decision and praying for a declaration that the sub judge decision is null and void and of no effect whatsoever.

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Counsel for applicant raised the following grounds of law in support of his application:

1. The respondent acted under a misconception of law and fact.

2. The respondent misdirected himself.

3. It was not open to the Registrar to find that the word «DUPLO» has direct reference to the character or quality of the goods or that it is deceptive as to the character and quality of the goods for which it is to be used.

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By his written address counsel for applicant in expounding on his grounds of law, submitted that the word «Duplo» is an archaic Italian word now obsolete and no longer in use and that the word double in Italian is «doppio». Also, that even if the word «duplo» had the meaning attributed to it by the respondent, it was not open to him to find that it had direct reference to the character or quality of the goods or that it is deceptive.

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In dealing with the objection of the respondent under section 13 of the Law, he made reference to the corresponding English section and submitted that the objection of the respondent on this ground is unfounded and in any event no reasoning is given to explain his objection.

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Counsel for the respondent, on the other hand, contended that the sub judge decision was properly and lawfully open by the Registrar in the exercise of his powers under the Trade Marks Law. She submitted that the proposed mark is not registrable in Part A of the Register, as it is a word which has direct reference to the character or quality of the goods for which the trade mark is sought to be registered and as such, contrary to section 11(1) of the Trade Marks Law, Cap. 268. She further submitted that the word «Duplo» is directly descriptive of the goods in question because

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they are sold in doubles and secondly it is deceptive both under section 11(1) and section 13 of the Trade Marks Law. In dealing with the meaning of the word «duplo» she submitted that it was reasonably open to the Registrar to reach the conclusion that such
5 word had a grammatical meaning, that of «double», and as such it had direct reference to the character and quality of the goods for which the trade mark was sought to be registered.

Counsel further contended that the said trade mark was not registrable in Part B either, as the applicant on whom the burden of
10 proof lied, failed completely to prove and satisfy the Registrar that the mark applied for registration may become distinctive in future and that it will not contravene the provisions of section 13 of the Trade Marks Law, Cap. 268.

The approach of our Supreme Court, as to when the Court may
15 interfere with an administrative decision regarding the registrability of a trade mark, has been recently reviewed by the Full Bench in Revisional Appeal 505 (*White Horse Distillers Ltd. v. El Greco Distillers Ltd. and others*) in which judgment was delivered on 20th February, 1987 (not yet reported)*. It was held
20 in that case that: -

«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
25 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 (see, inter alia, in this respect, *Merck v. The Republic*, (1972) 3 C.L.R. 548, 564, *Seven-Up Company v. The Republic*, (1973) 3 C.L.R. 612, 621, *Curzon Tobacco Co. Ltd. v. The Republic*, (1975) 3 C.L.R. 363, 369, and on appeal (1979) 3 C.L.R. 151, 158, *Beecham Group Ltd. v. The Republic*, (1982) 3 C.L.R. 622, 632, *P.M. & G. Stavrinides Clothing Industries Ltd. v. The Republic* (1983) 3 C.L.R. 98,
30 107, *Effems A.G. v. The Republic* (1985) 3 C.L.R. 793, 798, *Pepsi Co. Inc. v. The Republic* (1985) 3 C.L.R. 1092, 1102 and *Fisons Ltd. v. The Registrar of Trade Marks*, (1985) 3
35 C.L.R. 2318, 2327).»

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

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

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 on 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;

(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.» 20

and section 13 reads as follows:-

«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.» 25

In the present case the relevant paragraph of section 11(1) is paragraph (d). 30

The respondent came to the conclusion on the basis of the material before him, that the word «DUPLO» though not very commonly used in modern Italian, nevertheless, it had a grammatical meaning, that of double. In so finding he sought guidance from dictionaries and in particular Cassel's Italian- 35

English and English-Italian Dictionary, 3rd Edition at p. 172 where the meaning of the word «Duplo» is given as «Double». Bearing in mind the above he further concluded that the word sought to be registered as a trade mark was a word directly descriptive of some
5 of the goods sought to be registered and therefore having direct reference to the character or quality of such goods contrary to paragraph (d) of section 11(1). In respect of the other goods covered by the same trade mark his finding was that the use of such word might be deceptive. The respondent also found that the
10 proposed registration was likely to deceive under section 13.

Applicant's application was for registration of the said mark in Part A and not in part B. The case was all along considered and decided by the Registrar on that basis under sections 11(1) and 13 of the Law. Although under section 19(3) it is provided that the
15 Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B of the Register, it does not appear either from the contents of the file of the case or the addresses of counsel that the applicant expressed any wish in this respect. Therefore, the lengthy argument of
20 counsel for the respondent concerning registrability under part B is irrelevant and immaterial, bearing also in mind that it does not emanate from the reasoned decision of the Registrar that he has considered registration of the mark in part B.

In the present case, on the material before me, and having
25 considered carefully the reasons given by the Registrar of Trade Marks for refusing the registration of the trade mark in question, I have come to the conclusion that it was reasonably open to him to decide, as he did. On the basis of the well established principle that the Supreme Court, in the exercise of its jurisdiction as an
30 administrative Court, does not interfere with the decision of an administrative organ if such decision is reasonably open to such organ and cannot substitute its own evaluation to that of the appropriate organ, I find no reason to disturb the decision of the respondent in the present case once I have reached the conclusion
35 that such decision was reasonably open to him.

In the result the recourse fails and is hereby dismissed with no order for costs.

*Recourse dismissed.
No order as to costs.*