

1988 July 12

[KOURRIS, J.]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

FROMAGERIES BEL,

Applicant

v.

THE REPUBLIC OF CYPRUS, THROUGH

1. THE MINISTER OF COMMERCE AND INDUSTRY,

2. THE REGISTRAR OF TRADE MARKS,

Respondents.

(Case No. 519/86).

*Trade marks—Registrability—Resemblance to a mark already registered—
Course to be followed—Principles applicable—The Trade Marks Law,
Cap. 268, section 14 (1).*

*Trade marks—Registrability—Confusion or deception, likelihood of—Test ap-
plicable—The Trade Marks Law, Cap. 268, section 13.*

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Trade marks—Registrability—Judicial control—Principles applicable.

*Trade marks—Evidence—No use yet of proposed mark in Cyprus—
Allegations as to confusion or deception—Correctly treated, in the circum-
stances, as opinion evidence—Such evidence correctly disregarded by the
Registrar of Trade Marks.*

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By means of this recourse the applicants impugn the decision of the Registrar of Trade Marks to allow the registration of the trade mark of the interested party.

The mark of the applicants depicts a heard of a cow with words in French "La Vache Qui Rit" and in Greek "I agelada pou gela", whereas the mark of the interested party depicts a whole cow in profile view with the English words "Lucky Cow" and Greek words "Laky Kaou Gala Evapore".

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It must be noted that there were already several marks on the register which included the device of the cow and that the device of the cow is common to the trade.

5 This recourse raised the issue of whether the Registrar, in dismissing the objection of the applicant and allowing the registration of the sub judice mark, acted contrary to section 14(1) and 13 of Cap. 268.

10 Held, dismissing the recourse: (1) In determining the question whether the mark in question offended s.14(1) the Registrar had, first, to consider whether the goods of the applicants were of the same description with those of the interested party and, if yes, whether the degree of resemblance between the two marks was such as to be likely to deceive or cause confusion.

15 In this case the Registrar followed the aforesaid path. She applied the correct principles, as such principles emanate from the case law. She judged the resemblance both by reference to the eye as well as to the ear. Her decision was reasonably open to her.

20 (2) In determining the objection under section 13 the Registrar correctly applied the test in *Jellinek's Trade Mark* [1946] 63 R.P.C. 59; As the mark had not been used in Cyprus, she correctly treated allegations of confusion as opinion evidence, which she had to discard.

(3) This Court does not interfere with a decision as to the registrability of a trade mark, if it was reasonably open to the Registrar.

Recourse dismissed with costs.

Cases referred to:

25 *Jellinek's Application* [1946] 63 R.P.C. 59;

Seixo v. Provezende [1895] L.R.1 Ch. 192;

Smith Hayden and Co. Ltd. Application [1946] 63 R.P.C. 97;

The 7 - up Company v. The Republic (1973) 3 C.L.R. 612;

Beecham Group Ltd. v. The Republic (1982) 3 C.L.R. 622;

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

Recourse.

Recourse against the dismissal of applicants' opposition in
Appl. Nos. 23717 and 23718 for the registration of the words 5
Lucky Cow and Cow and device as trade mark in class 29 of
Schedule IV of the Trade Marks Rules, 1951 - 1984.

J. Spanopoulos, for applicant.

L. Koursoumba (Mrs.), for the respondent.

A. Liatsos for K. Michaelides, for interested party. 10

Cur. adv. vult.

KOURRIS J. read the following judgment. The present re-
course is directed against the decision of the Registrar of the
Trade Marks, dated 7th June, 1985, whereby he dismissed the
opposition of the applicants in Applications Nos. 23717 and 15
23718 of the words "Lucky Cow" and Lucky Cow and device as
trade marks in Class 29 of Schedule IV of the Trade Marks Rules
1951 - 1984 in respect of evaporated milk and milk products of
the interested party.

The salient facts of the present recourse are briefly as follows:- 20

On 28.4.1983 Kommanditgesellschaft, Dimex Nahrungsmittel
Import and Export GmbH & Co. , (hereinafter referred to as
"Kommanditgesellschaft") a company organized and existing un-
der the laws of Federal Republic of Germany, filed applications
No. 23717 and 23718 with the Registrar of Trade Marks, for the 25
registration of the words Lucky Cow and Lucky Cow and device
as trade marks in class 29 of Schedule IV of the Trade Marks
Rules 1951 - 84, in respect of evaporated milk and milk products.
The devices of their trade marks are depicted in para 1 of the De-

cision of the Assistant Registrar of Trade Marks which is appended to the Application as Exhibit-1 and which for the purposes of this Opposition will be referred to as "the Decision".

5 The applications were accepted for registration in part B of the Register of Trade Marks and, as to application 23718, on condition of disclaimer of the device of the cow and the words "evaporated milk" and "Γάλα εβαπορέ με όλες τις βιταμίνες του" and limitation to be used only for evaporated milk, and, as to both applications, on condition that after advertisement in the official Gazette of the Republic notice of such advertisement should be sent to the owners of the trade mark 8998 La Vache Qui rit, η αγελάδα που γελά and device.

10 On 12.4.84 notices of opposition to both applications were filed by the advocate of the Applicants, Messrs Fromageries Bel, Mr. J. Spanopoulos from Nicosia, who are the registered owners of trade marks Nos. 8998 in class 29 La Vache qui rit and device for all the goods of class 29 of Schedule IV of the Trade Marks Rules 1951 - 84. The device of their trade Marks is as depicted in para 2 of the Decision.

15 On 20.7.84 a counter - statement was filed by the advocate of Kommanditgesellschaft, Mr. Kyriakos Michaelides. - R. 7 in exhibits 1 & 2.

20 On 5.9.84 five (5) affidavits were filed by advocate for the Applicants which referred to both oppositions and were returned to the advocate to be sworn separately for each case.

25 On 21.9.84 three of those affidavits were filed again separately for each opposition:

30 a) Affidavit dated 18.9.84 and declared by Demetris Kalavanas, the general manager of IMEXPO Ltd in Nicosia, the sole trade representatives in Cyprus of the Applicants - R. 20 in exhibits 1 and 2.

b) Affidavit dated 19.9.84 declared by Kyriacos Leptos, grocer in Nicosia. - R.19 in exhibits 1 and 2.

c) Affidavit dated 19.9.84 and declared by Charalambos Roubinas, grocer in Nicosia. - R.18 in exhibits 1 and 2.

On 15.3.85 both parties agreed that the Oppositions 419 and 420 be consolidated.- R. 28 of Opposition files 419 and 420. 5

On the 26.7.85 Kommanditgesellschaft, filed an affidavit dated 25.7.85 declared by Takis Pilavas owner of a Supermarket - R. 36 in exhibits 1 and 2.

Both oppositions were fixed for hearing on 9.10.85. At the said hearing Mr. A. Liatsos and Mr. Marios Georghiou appeared for Kyriakos Michaelides, advocate for the Kommanditgesellschaft, and Mr. J. Spanopoulos appeared for the Applicants. 10

The Registrar, having considered very carefully everything properly put before him by the parties to those proceedings, including all the material facts and considering the admissible evidence and counsels' submissions, came to the conclusion that Kommanditgesellschaft had discharged the onus of establishing that the use of their mark applied for registration would not offend against the relevant legislative provisions and therefore found that the oppositions failed, and consequently be dismissed the Opposition and directed that applications Nos 23717 and 23718 be proceeded to registration as advertised. 15 20

On 12.6.1986, the Respondent's Decision as aforesaid was communicated to counsel for the Applicant - Exhibit 1 appended to the application. 25

As a result, the interested party filed the present recourse challenging the sub judice decision and praying for its annulment on the ground that the Registrar acted under a misconception of law and/or facts, in abuse and/or in excess of power and/or that he exercised his discretion wrongly. The interested party further alleg- 30

es that the Registrar was wrong in evaluating the evidence adduced by the applicants.

5 As rightly stated by the respondent Registrar in his sub judge decision, in reaching his decision the Registrar had to apply the following provisions of s.13 and s.14(1) of the Trade Marks Law, Cap. 268 which read as follows:-

10 "s.13. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which could 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.

15 s. 14(1) Subject to the provisions of subsection 2 no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods or description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion."

20 The wording of ss.13 and 14(1) of Cap. 268 above, is the same as that of sections 11 & 12 (1) of the Trade Marks Act, 1938 in England.

25 Therefore, the Registrar had to consider whether the relevant applications offended against s.14(1) and for this purpose he had to consider (i) whether the goods in respect of which the applicants (interested party in this recourse) were seeking registration, were the same or the same description as any of the goods of the respondents (applicants in this recourse); (ii) if so, the degree of resemblance presuming normal and fair manner of use of the goods. Also, he had to consider whether it offended s.13.

30 In considering the application under s.14(1) the Registrar examined first, whether the goods were of the same description. After analysing properly the legal position with reference to the well

- established criteria for determinating such questions and applying the test laid down in the Judgment of Romer, J. in the case of Jellinek's Application 1946, 63 R.P.C. 59 at p. 70, the Registrar came to the conclusion that the goods were of the same description. Having found that the goods were of the same description, the Registrar then proceeded to the second issue which called for consideration, namely a comparison of the marks. The Registrar quite legitimately compared the trade marks in the manner which well appears in Cap. 17 of Kerley's Law of Trade Marks and Trade Names, 11th edn., paragraphs 17 - 07 to 17 - 41, pp. 407 - 430.

At p. 407 of that book from the summing up of Lord Cranworth, in *Seixo v. Provezende*, [1895] L.R. , 1 Ch. 192, it is stated:-

"What degree of resemblance is necessaryis from the nature of things incapable of definition a priori.

And the standard of course is not always the same."

And further down on the same page of that book-

"It follows that except in so far as they lay down any general principle, the decided cases are of little assistance in the determination of new questions of fact raised upon materials.....
In all cases as states above, it should be borne in mind that a decision on the question whether a mark so nearly resembles another as to be likely to deceive or cause confusion is not an exercise of discretion by a tribunal but a finding of fact."

Same book pages 415 - 416 para 17 -19

"Common elements: some dicta

In *Broadhead's Application*, Evershed M.R. followed the observations of Lord Russell in *Coca Cola Canada v. Pepsi*

5. *Cola Canada*, where he stated: 'Where you get a common denominator, you must in looking at the competing formulae pay much more regard to the parts of the formulae which are not common - although it does not flow from that that you must treat the words as though the common part was not there at all'. Where common marks are included in the trade marks to be compared, or in one of them, the proper course is to look at the marks as wholes, and not to disregard the parts which are common.

10. In the *Kleenoff*, case Maugham L.J. said: 'In the present case my view is that the test of infringement where the trade mark has a descriptive element is the same as the test where it has no descriptive element, except so far as the descriptive element is itself common to the trade.'

15. In *Harrods' Application*, the Registrar stated: 'It is a well-recognised principle that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, *where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features*. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the markets in which the marks under consideration are being or will be used'."

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Same book p. 417 para 17 - 22

30. "The resemblance between two marks must be considered with reference to the ear as well as to the eye."

Same book p. 423 para 17 - 30

"In general, *the existence of a number of marks, either as*

common marks or as trade marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter."

The relevant passage of the decision of the respondent Registrar is stated in paras. 20 & 21 of the Decision which read as follows:-

"20. Further and despite the provisions of s.16 on disclaimers I proceeded to compare further the two marks: The manner trade marks are compared, well appears in Chapter 17 of Kerly's Law of Trade Marks, 11th Ed. , paras 17 - 07 - 17 - 41. Comparing therefore the marks in the light of the said legal principles and bearing in mind that the resemblance must be considered with reference to the ear as well as to the eye I have reached the conclusion that they do not have considerable similarity both visually and phonetically to the extent prohibited by s.14(1) of the Trade Marks Law Cap. 268 (as amended).

21. Bearing in mind the above considerations and giving to the matter the most careful attention and considering the admissible evidence and considering also the Counsels' submissions, I have reached the conclusion that the Opponent's objection under sec. 14(1) fails."

In the light of the above - quoted legal principles, and the reasoning of the sub judice decision of the Respondent Registrar, the Registrar was correct in his Decision and it was reasonably open to him to reach his decision.

In particular, the mark of the applicant depicts a head of a cow with words in French "La Vache Qui Rit" and in Greek "I agelada pou gela", whereas the mark of the interested party depicts a whole cow in profile view with the English words "Lucky Cow"

and Greek words "Laky Kaou Gala Evapore". Further, as already stated in the sub judge decision of the respondent in paragraphs 15 - 19, there were already several marks on the register which included the device of the cow and the device of the cow is common to the trade. In point of fact, trade mark No. 12847 of the Morinaga Milk Industry Co. Ltd. seems to have more resemblance to the mark of the applicant, whereas marks 9993 and 7944 resemble more the mark of the interested party.

In conclusion, the Registrar in testing the resemblance with reference both to the ear as well as to the eye, and bearing in mind that there existed a number of the marks in the same trade containing that common element, a fact which is well - recognized as tending to cause purchasers to pay more attention to the other features of the respective marks and to distinguish that by those features it was reasonably open to him to reach the conclusion that the marks did not have a considerable similarity both visually and phonetically to the extent prohibited by s.14(1) and, therefore, this point cannot stand. The Registrar, having decided the matter under s.14(1) he then proceeded to consider the case under s.13.

In doing so, he applied the OVAX test which was formulated by the Court in the case of *Smith Hayden and Co. Ltd. Application*, [1946] 63 R.P.C. 97 at p. 101 and cited in Kerley's Law of Trade Marks and Trade Names 11th edn. at p. 134, paragraph 10 - 02 which reads as follows:-

"Assuming user by Horis Limited of their marks *Hovis* and *Ovi* in a normal and fair manner for any of the goods covered by the registrations of these marks (and including particularly goods also covered by the proposed registration of the mark *Ovax*) is the court satisfied that there will be no reasonable likelihood of deception and confusion amongst a substantial number of persons if Smith Hayden & Co. Ltd. also use their mark *Ovax* normally and fairly in respect of any goods covered by their proposed registration;"

The Registrar further stated that the evidence was adduced by

both of the parties on the question whether it was likely that deception or confusion might arise, which he carefully read and considered, but acted on the principle that, as the proposed marks had not been used in the market yet, the affidavits submitted by the opponents were merely opinions and were not evidence of actual incidents of confusion or incidents of no confusion, and thus, proceeded to decide the matter on the test laid down by Romer J. in *Jelinek's Trade Marks* [1949] 63 R.P.C. 59 at p. 78. 5

The Registrar, on the facts of the case before her, decided that she was not convinced that by using interested party's trade marks in the Cyprus market there was a likelihood of deception or confusion within the meaning of s. 13. In her decision the respondent registrar with regard to this point, said the following: 10

"Reading carefully these affidavits I am not convinced that by using the applicants trade marks in the Cyprus market there is a likelihood of deception or confusion within the meaning of s.13. 15

To decide on this question I have in mind the test as in effect was laid down by Romer J. in *Jellinek's Trade Marks* [1949] 63 R.P.C. 59 at page 78: 20

'Upon the evidence which I have before me, what is the test which I have to apply in considering whether deception or confusion within the meaning of sec. 11 is likely to occur;.....

It is sufficient if the result of the user of the mark will be that a number of persons will be caused to wonder whether it might not be the case that the two products come from the same source. It is enough if the ordinary person entertains a reasonable doubt'. 25

I think that these propositions are the test, and I would merely add, the following extract from the judgement of the late Farwell, J. , in *Bailey's case*, reported in 52 RPC. , 136 at 30

page, 153: I think that the Court has to be satisfied not merely that there is a possibility of confusion; I think the Court must be satisfied that there is *a real tangible danger of confusion* if the mark which it is sought to register is put on the Register."

5 : I am of the view that it was reasonably open to the Registrar to reach this decision and the opposition under s.13 fails.

10 Furthermore, I am satisfied that the respondent Registrar has correctly discarded opinion evidence adduced before her. (See *The 7 - Up Company v. The Republic* (1973) 3 C.L.R. 612, and the case law referred to therein. Furthermore, the respondent Registrar properly directed herself on the law as to the onus of proof in cases of opposition proceedings under ss. 13 & 14 of the Trade Marks Law. The onus of proof is on the applicants who have to establish both that their trade mark is registrable and that
15 the opposition is not justified.

20 The approach of the Supreme Court as to when the Court should interfere with an administrative decision regarding the registrability of a trade mark, is that "this Court will not interfere with such a discretion 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 power. (See *Beecham Group Limited v The Republic* (1982) 3 C.L.R. 622 at p. 633).

25 In a recent case, *White Horse Distillers Ltd. v. El Greco Distillers Ltd. and Others* (1987) 3 C.L.R. 531, it was held by the Full Bench of the Supreme Court that on the basis of the principles governing the exercise of its jurisdiction, as an administrative Court in the first instance and on appeal, 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 it does not substitute its own evaluation in the
30 place of that of the Registrar.

In the present case, on the material before me, which was also before the respondent Registrar, and having carefully considered

the reasons given by the Registrar of Trade Marks for the sub judice decision, I have come to the conclusion that it was reasonably open to her to decide as she did and her decision is, therefore, affirmed.

In the result, the recourse fails and is hereby dismissed with costs in favour of the respondent. Costs to be assessed by the Registrar. 5

*Recourse dismissed with costs
in favour of respondent.*