

1988 January 29

[TRIANAFYLLIDES, P., SAVVIDES, LORIS, STYLIANIDES
AND KOURRIS, JJ.)

PLOUGH INC.,

Appellants.

v.

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

Respondents.

(Revisional Jurisdiction Appeal No. 523).

Trade marks—The Paris Convention for the Protection of Industrial Property, ratified by Law 63165, Article 6 quinquies—Comparison with sections 11 and 13 of The Trade Marks Law, Cap. 268—A passage from Merck v. Republic (1972) 3 C.L.R. 548 at pp. 561, 562, adopted.

5 *Trade marks—Registrability—Foreign registrations—Of no consequential significance.*

Trade marks—Registrability—Use in Cyprus—Significance.

Trade marks—Registrability—Distinctiveness under s. 11 of The Trade Marks Law, Cap. 268—The case-law on the matter.

10 *Trade marks—Registrability—Part B of register—Section 12 of The Trade Marks Law, Cap. 268—The case-law on the matter.*

Trade marks—Registrability—Confusion or deception—Likelihood of — Section 13 of the Trade Marks Law, Cap. 268—The case-law on the matter.

15 The respondent Registrar refused registration of the words "Tropical Blend" as a trade mark for appellant's products either in Part A or in Part B of the Register of Trade Marks on the grounds of lack of distinctiveness and a serious likelihood of confusion or deception.

His reason for finding lack of distinctiveness was based, as explained by him, on the ground that "Tropical Blend" connotes primarily association with the tropics which in no way is diminished by the addition of the word "Blend". Therefore, the mark was not capable to distinguish the appellants' 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. 5

The present appeal is directed against the Judgment of a Judge of this Court, whereby appellants' recourse, impugning the aforesaid refusal, was dismissed. 10

Counsel for appellants submitted that:

(a) The Registrar failed to apply the provisions of the Paris Convention for the Protection of Industrial Property, as subsequently revised, which was ratified by Laws 63/65 and 66/83. It must be noted in this respect that the trade mark presently under consideration was registered in the United States, a signatory and adherent to the convention. 15

(b) The Registrar was wrong in reaching the conclusion that the words in question lacked distinctiveness and are likely to cause confusion or deception.

(c) The Registrar failed to pay due cognizance to the fact of the long and extensive use of the trade mark in question and to the fact that the mark had been accepted for registration and was in fact registered in a number of Commonwealth and other countries having a similar law and procedure as in Cyprus. 20

Held, *dismissing the appeal*: (1) A comparison of Article 6 quinquies of the Convention with sections 11 and 13 of the Trade Marks Law and its effect upon such provisions has been made by A. Loizou, J. in the case of *E. Merck v. The Republic* (1972) 3 C.L.R. 548 at pp. 561, 562. In the light of this passage, which this Court adopts, the relevant ground of appeal fails. 30

(2) In the light of principles emanating from the case-law relating to the distinctiveness of a mark under section 11, its registrability under section 12 (Part B of the Register) and the likelihood of deception or confusion and in the light of the findings of the trial Judge, the appeal, in so far as it relates to the aforesaid matters, is bound to fail. 35

(3) Foreign registrations are of no consequential significance. The trial

Judge rightly came to the conclusion that in the absence of sufficient particulars to illuminate the background to foreign registration the decision of the Registrar was properly taken.

5 (4) Though use of a mark in Cyprus is a matter which may be taken into consideration by the Registrar in reaching his decision it is not by itself a criterion which may weigh the scales in favour of the registration of the trade mark. However, undue weight cannot be given to such element to outweigh the requirement under s. 11 for distinctiveness of the mark in question.

10 (5) 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 it does not substitute its own evaluation in the place of that of the Registrar. The sub judice decision was, indeed, reasonably open to the Registrar.

15 *Appeal dismissed. No order as to costs.*
Cases referred to:

Merck v. Republic (1972) 3 C.L.R. 548;

Curzon Tobacco Co. Ltd. v. The Republic (1975) 3 C.L.R. 363; and on appeal (1979) 3 C.L.R. 151;

20 *Stavrinides Clothing v. The Republic* (1983) 3 C.L.R. 98;

Peletico v. Registrar of Trade Marks (1986) 3 C.L.R. 490;

Societe Nationale Elf Aquitaine v. The Registrar of Trade Marks (1987) 3 C.L.R. 1420;

Blue Bell Inc. v. The Registrar of Trade Marks (1987) 3 C.L.R. 542;

25 *American Telephone and Telegraph Company v. The Registrar of Trade Marks* (1987) 3 C.L.R. 1966;

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

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

The Perfection [1909] R.P.C. , Vol .26, p. 561;

Appeal.

Appeal against the judgment of a Judge of the Supreme Court of Cyprus (Pikis, J.) given on the 30th August, 1985 (Revisional Jurisdiction Case No. 115/84)* whereby appellant's recourse against the refusal of the registration of "Tropical Blend" either in part A or part B of the Register of trade marks was dismissed. 5

A. Dikigoropoulos for the appellant.

St. Ioannidou (Mrs.), for the respondents. 10

Cur. adv. vult.

TRIANAFYLLIDES P. The judgment of the Court will be delivered by Savvides, J.

SAVVIDES. J.: This is an appeal from the judgment of a Judge of this Court sitting in the first instance in the exercise of the original jurisdiction of the Court whereby he dismissed the recourse of the appellants challenging the decision of the respondent Registrar of Trade Marks to accept registration of their trade mark "Tropical Blend". (See *Plough Inc. v. Republic* (1985) 3 C.L.R. 1687). 15

The facts of the case are briefly as follows: Appellant, an American company, manufacturers of cosmetics, applied on the 17th March, 1983 for the registration of their trade mark "Tropical Blend" under class 3, Part A of the register as a trade mark for their products. About a month later registration was refused on the ground that: 20

* Reported in (1985) 3 C.L.R. 1687.

(a) The mark was immediately connected with the character or quality of the products and

(b) it lacked distinctiveness.

5 Objection was also raised to its registration under s. 13 of the Trade Marks Law, Cap. 268 on the ground that it was likely to cause deception or confusion as to its use.

10 In response to an intimation by the respondent that the appellants could, under regulation 32 of the Trade Marks Regulations 1951-1971, seek a hearing if they wanted to pursue the application further, the appellants filed a reply to the objections raised to the registration of the said trade mark, accompanied by an affidavit sworn by 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. Appellants signified readiness to disclaim "blend"
15 as well as to accept registration in Part B of the Register.

Appellants also stressed the long association of the above mark with their products and the upward trend of their trading in Cyprus.

20 By letter dated 20th December, 1983, the respondent communicated to the appellants his decision refusing the registration of such mark. By a subsequent letter dated 18th February, 1984, he gave the grounds of his decision which in fact were the same as those embodied in his original objection to the registration. His reason for finding lack of distinctiveness was
25 based, as explained by him, on the ground that "Tropical Blend" connotes primarily association with the tropics which in no way is diminished by the addition of the word "Blend". Therefore, the mark was not capable to distinguish the appellants products in the
30 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.

35 Furthermore, there was serious likelihood for deception or confusion resulting from the use of the mark that suggested an association of the products with the tropics whereas they had

none.

As a result the appellants filed recourse No. 115/84. challenging the above decision.

The learned trial Judge came to the conclusion that the objections raised by the Registrar for the refusal of registration were sound and that the decision reached was reasonably open to him and dismissed the recourse. 5

A ground which was argued at length before the trial Court was based on the allegation that the Registrar failed to apply the provisions of the Paris Convention for the Protection of Industrial Property, as subsequently revised, which was ratified by Laws 63/65 and 66/83. 10

The learned trial Judge found as follows on this ground (at pp. 1691-1692):

"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 misconception of the Convention. The reservations made in SB 2 of Article 6 make registration largely a matter of domestic law and preserve distinctiveness as the hallmark for registration."* 15
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* 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 Kerley's Law of Trade Marks and Trade Names, 10th Ed., pp. 499 - 500 summing up the effect of the Convention on the English Law.

In contesting the finding of the trial Court on this ground counsel for the appellants submitted that the trial Judge misinterpreted the provisions of the Paris Convention for the Protection of Industrial Property and that he wrongly arrived at the above conclusion.

The said Convention was ratified and became part of our domestic legislation by the Convention for the Protection of Industrial Property (Ratification) Law of 1965 (Law No. 63/65). It is clearly provided by our Constitution, under Article 169.3 that treaties, conventions and agreements concluded in accordance with the provisions of paragraphs 1 and 2 of the said Article have as from their publication in the official Gazette of the Republic superior force to any domestic law on condition that such treaties, conventions and agreements are applied by the other party thereto.

The question of reciprocity in this case is not in issue as from what emanates from the affidavit filed on behalf of the appellants the United States of America is a party and applied the Convention.

Article 6 quinquies, of the Convention reads as follows:

"A. - (1) Every trade mark duly registered in the country of origin shall be accepted for filing and protected in its original form in the other countries of the Union, subject to the reservation indicated below in the present Article. These countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate.

(2) The country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has not such an establishment within the Union, the Union country where he has his domicile or, if he has no domicile in the Union, the country of his nationality if he is a national of a

Union country shall be considered his country of origin.

B. Trade marks under the present Article may not be denied registration or cancelled except in the following cases:

1. When they are of such a nature as to infringe rights acquired by third parties in the country, where protection is claimed. 5

2. When they have no distinctive character, or consist exclusively of signs or indications which may serve in trade to designate the kind, quality, quantity, intended purpose, value, place of origin of the goods or time of production, or which have become customary in the current language or in the bona fide and established practices of the trade in the country where a protection is sought. 10

3. When they are contrary to morality or public order and, in particular, of such a nature as to deceive the public. It is understood that a mark may not be considered contrary to public order for the sole reason that it does not conform to a provision of the law relating to trade marks, except where such provision itself relates to". 15

The aforesaid is, however, subject to Article 10 bis of the Convention which stipulates that the Convention countries are bound to assure the persons entitled to the benefits of the Convention an effective protection against unfair competition. 20

Section 11 of the Trade Marks Law, Cap. 268, reads-

"11. (1) In order for a trade mark to be registrable in Part A of the register, it must contain or consist of a least one of the following essential particulars: 25

(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;

5 (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;

10 (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."

Section 13 of the Law reads:-

15 "13. 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."

20 A comparison of Article 6 quinquies of the Convention with sections 11 and 13 of the Trade Marks Law and its effect upon such provisions has been made by A. Loizou, J. in the case of *E. Merck v. The Republic* (1972) 3 C.L.R. 548 at pp. 561, 562 as follows:

25 "It appears from a comparison of the aforesaid texts that the requirements under sections 11 and 13 of the Trade Marks Law to the extent that they have been invoked by the Registrar in arriving at the sub judice decision and which are similar to the corresponding provisions of the Trade Marks Law obtaining in England, are not in conflict with the reservations in Article 6 quinquies paragraph B of the Convention.

30 As pointed out in Kerly's Law of Trade Marks and Trade Names, 9th Edition, paragraph 964, p.510-

'Article 6 quinquies states every trade mark duly registered in its country of origin shall be admitted for deposit and protected in its original form in the other countries of the Union, subject to certain reservations. These reservations refer to marks which have no distinctive character and marks which are contrary to morality or public order.'

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And then it says:

'.....the requisites for registration provided under sections 9, 10, 11, and 12 of the Trade Marks Act, 1938, will in nearly all cases coincide with the provisions of article 6 of the Convention'

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The conditions for filing a registration of trade marks are left to the domestic law by Article 6.1 of the Convention, and such a law is valid to the extent that it does not offend the provisions of the Convention.

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In the present case, the grounds upon which the Registrar of Trade Marks refused registration of the trade mark in question, coincide with the provisions of Article 6 quinquies of the Convention and the reservations laid down in paragraph B thereof. There being no conflict between the law and the Convention in this respect, this ground of law must fail."

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We are in agreement with the opinion expressed above. We agree also with the findings of the learned trial Judge in the present case on this issue. In the result this ground of appeal fails.

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Counsel for the appellants further contended that the learned trial Judge was wrong in affirming the decision of the Registrar on the grounds of lack of distinctiveness and the likelihood of deception under sections 11 and 13 of the Law and his refusal to register the trade mark in part B under s. 12. He further submitted that the Registrar whose decision was affirmed by the

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trial Court was wrong as he had failed to pay due cognizance to the fact of the long and extensive use of the trade mark in question and the fact that the mark had been accepted for registration and was in fact registered in a number of
5 Commonwealth and other countries having a similar law and procedure as in Cyprus.

The question of distinctiveness and direct reference to the character and quality of the goods under s. 11, registrability of a mark under s. 12 and the possibility of deception or confusion
10 under s.13 of the law as well as the principles underlying them have been considered in a number of cases of this Court in which the English Case Law on the matter has been reviewed and we need not repeat them. (See, inter alia, *E. Merck v. The Republic* (supra); *Curzon Tobacco Co. Ltd. v. The Republic* (1975) 3
15 C.L.R. 363, and on appeal (1979) 3 C.L.R. 151; *Stavrinides Clothing v. The Republic* (1983) 3 C.L.R. 98; *Peletico v. Registrar of Trade Marks* (1986) 3 C.L.R. 490; *Societe Nationale Elf Aquitaine v. The Registrar of Trade Marks* (1987) 3 C.L.R. 1420; *Blue Bell Inc v. The Registrar of Trade Marks* (1987) 3
20 C.L.R. 542; *American Telephone and Telegraph Co. v. The Registrar of Trade Marks* (1987) 3 C.L.R. 1966; *White Horse Distillers Ltd. v. El Greco Distilles Ltd. and Others* (1987) 3 C.L.R. 531.

The learned trial Judge in dealing with the merits of the case
25 had this to say at p. 1693 of the judgment:

"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
30 I very much feel the decision of the Registrar was inevitable. Rightly the Registrar found that 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.
35 11(1) have one characteristic in common, the mark must be

distinctive. 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. 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".

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We are in agreement with the principles emanating from the aforesaid cases and with the above findings of the learned trial Judge.

Counsel for appellants further argued that the registration in Commonwealth and other countries is an indirect consideration to which the Registrar should have referred in view of the provisions of s. 11 (3) (b), Cap. 268 which provides that circumstances other than those enumerated in s.11 may be taken into account if because of its use the trade mark is in fact adapted to distinguish.

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In dealing with a similar argument advanced by counsel for appellants the learned trial Judge concluded that the law does not in terms make registration in other countries a consideration relevant to registration in Cyprus and in the absence of sufficient particulars to illuminate the background to foreign registration the factor of foreign registration was inconsequential.

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The question of registration of a mark 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 covered by such mark in this country has been considered in the cases of *Societe Nationale Elf Aquitaine* (supra) and *American Telephone and Telegraph Company* (supra) in which reference has been made in this respect to the English Case Law and to Kerly's Law on Trade Marks and Trade Names, 12th Ed. in which the principle was adopted that foreign registrations are of no consequential significance. In Kerly's Law of Trade Marks and Trade Names (supra) at p. 123, paragraph 8-67 we read:

10 "Use of registration abroad.

On an application to register a mark for use in the United Kingdom, it is distinctiveness in the United Kingdom that is in question. Thus extent of registration and use of the mark abroad are of secondary significance, if any."

15 Useful reference may be made in this respect to the decision in *Needle-Tip Trade Mark* [1973] R.P.C. 113 and in particular the following at p.118:

20 "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 Swifts 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."

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The learned trial Judge, therefore, rightly came to the conclusion that in the absence of sufficient particulars to illuminate the background to foreign registration the decision of Registrar was properly taken.

We come next to the question of the use of the trade mark in question in Cyprus.

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Counsel for the appellant contended that the Registrar failed to pay due cognizance to such fact. The affidavit of the Vice-President of the appellants in which the allegation of long and extensive use of the trade mark in Cyprus was made was before the Registrar and was part of the material which the Registrar took into consideration in reaching his decision. Though it is a matter which may be taken into consideration by the Registrar in reaching his decision it is not by itself a criterion which may weigh the scales in favour of the registration of the trade mark. However, undue weight cannot be given to such element to overweigh the requirement under s. 11 for distinctiveness of the mark in question.

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In the case of *The Perfection* [1909] R.P.C., vol. 26, p.561 in which the refusal of the Registrar to register the trade mark in question was in issue, Swinfen Eady, J., in considering an appeal and after having dealt in his judgment with the evidence adduced as to the user of the trade mark in question in England, concluded as follows, at p.587:

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5 "Considering the evidence as a whole, I have come to the conclusion that the word perfection is not a distinctive mark, and is not adapted to distinguish the goods of the Applicants from the goods of other persons. I have taken into consideration the evidence of user, and still am of opinion that the word is not adapted to distinguish the goods of the Applicants".

10 The approach of our Supreme Court as to when Court should 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 Ltd. v. El Greco Distillers Ltd. and others* (supra) in which it was held that the 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 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 place of that of the Registrar.

20 In the present case, on the material before us and having carefully considered the reasons given by the Registrar of Trade Marks for refusing the registration of the trade mark in question we have come to the conclusion that it was reasonably open to him to decide as he did and that the learned trial Judge was correct in affirming his decision and dismissing the recourse.

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In the result this appeal fails and is hereby dismissed but in the circumstances we make no order for costs.

*Appeal dismissed.
No order as to costs.*