

1988 February 18

[LORIS, J.]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

OASIS,

Applicant,

v.

THE REGISTRAR OF TRADE MARKS,

Respondent.

(Case No. 674/84).

General principles—Reference to a law—Presumption that it includes reference to any amending laws.

5 *Due inquiry—Trade marks—Registration of—Burden to adduce material before the Registrar—Registrar acting on the material actually adduced before him by the applicants, who did not raise any objection when the decision was reserved nor did they apply for an adjournment in order to produce additional material—Applicants cannot complain for insufficient inquiry.*

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

10 The respondent refused registration of the word "OASIS" as a trade mark in class 32 for beer, ales, porter, mineral and aerated water and other non alcoholic drinks, syrups and other preparations for making drinks, on account of the provisions of section 14(1) of the Trade Marks Law, Cap. 268, because of its resemblance with trade mark "Assis" for such products as aforesaid.

15 In support of applicants' case counsel for applicants put forward certain allegations, which however, had not been placed before the respondent and contended that the failure of the Assistant Registrar to wait for him to have an answer from his clients before proceeding to decide the case shows that she did not conduct a due inquiry in the matter.

20 Moreover counsel for applicants suggested, inter alia, that the reference to "the provisions of section 14(1) of Cap. 268" is not accurate and may be

fatal to the whole case, since today's Law of Trade Marks is not only Cap. 268, but also, subsequent amending Laws.

Held, dismissing the recourse: (1) Section 14(1) of Cap. 268 has never been amended. In any event, it is presumed that reference to a law includes reference to its amending laws.

(2) The burden was on the applicants to produce such material as to satisfy the Registrar that the proposed mark should be accepted. In this case, the applicants, did not raise any objection when the Registrar reserved the decision nor did they apply for an adjournment in order to produce additional material. Therefore, they cannot now complain that the Registrar acted on insufficient material.

(3) This Court does not interfere with a decision regarding the registrability of a trade mark, if such decision was reasonably open to the Registrar; in this case the respondent conducted a due inquiry in order to ascertain the material facts and thereafter duly applied the law to the facts, reaching at the sub-judice decision which cannot be faulted.

*Recourse dismissed.
No order as to costs.*

Cases referred to:

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

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

Plough Inc. v. Republic (1988) 3 C.L.R. 145;

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

Recourse.

Recourse against the refusal of the respondent to register the word "OASIS" as a trade mark in class 32 for beer, ales and porter, mineral and aerated water and other non alcoholic drinks, syrups and other preparations for making drinks.

Chr. Theodoulou, for the applicants.

St. Joannides (Mrs), for the respondents.

Cur. adv. vult.

5 LORIS J. read the following judgment. By means of the present recourse the applicants, a company registered in France, challenge the refusal of the respondent Registrar of Trade Marks, acting through the Assistant Registrar of Trade Marks, to register the word "OASIS" as a trade mark, in class 32, for beer, ales and porter, mineral and aerated water and other non alcoholic drinks, syrups and other preparations for making drinks.

10 The relevant application was made on behalf of the applicants on 28th July 1983 and on 13th August 1983, it was objected to by the respondent on account of the provisions of section 14(1) of the Trade Marks Law, Cap. 268, because of its resemblance with trade mark "ASSIS", registered already in class 32, for
15 beers, ale and porter, mineral and aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages.

On 21 March 1984 counsel for the applicants filed a reply con-
20 tending that trade mark "OASIS" has no similarity with trade mark "ASSIS" either phonetically or optically and that the goods are different.

As it was found that the objection could not be waived the case was fixed for hearing which was held on 27 September 1984. During such hearing counsel for the applicant stated that though
25 he had written to the applicants since 27 July 1984 he did not receive a reply and submitted that the two marks do not resemble each other and that the proposed mark could be registered by giving notice to the proprietors of the mark "ASSIS".

On 9 October 1984 the Assistant Registrar, who heard the
30 case, decided that the objections could not be waived and communicated such decision to counsel on 16 October, 1984.

Upon a request, in this respect, dated 8 December 1984, the Assistant Registrar gave her written grounds for the decision on 26 February, 1985.

By means of his written address counsel for the applicants submitted that the Registrar's reference to the Law, namely "the provisions of section 14(1) of Cap. 268" is not accurate and may be fatal to the whole case, since today's Law of Trade Marks is not only Cap. 268, but, also, subsequent amending Laws. 5

With respect to counsel, the reference by the Registrar to section 14(1) of Cap. 268 is more than accurate since section 14(1) has never been amended, but, in any case, it is always to be presumed, without need for so stating, if it is not otherwise necessary, that reference to a Law included, also, any of its amending laws. 10

Coming to the merits of the case, counsel for applicants maintained that the two marks do not resemble each other, as they are different both optically and phonetically, and also, that the goods are different. 15

He further stated that the mark "OASIS" is a world famous product and world famous mark within the meaning of Article 6 (bis) of the Paris Convention for the Protection of Industrial Property, which has been made part of our domestic Law by Laws 63/1965 and 66/1983; that the applicants have sold in France and in other countries products in the class of the mark amounting to 350 million French Francs and that they have spent for publicity 30 million French Francs worldwide and that in Greece the well known company ION SA withdrew the registered mark OASIS for its products after the deposit of the mark of the applicants. 20 25

These last statements were never placed before the Assistant Registrar but before the Court for the first time and counsel contended that the failure of the Assistant Registrar to wait for him to have an answer from his clients before proceeding to decide the 30

case shows that she did not conduct an inquiry in the matter.

I entirely disagree with this stand of counsel for the applicants because the burden was on him to produce such material and to adduce evidence before the Registrar so as to satisfy him that the proposed registration of the mark should be accepted. In this particular case no objection was raised by him when the case was reserved by the Assistant Registrar for decision, no adjournment was sought by him in order to bring before the Assistant Registrar any other material substantiating his claim and, therefore, he cannot now complain that the Assistant Registrar had acted on insufficient material, because the Assistant Registrar had conducted a due inquiry in the matter, to the extent to which it was possible reaching at the sub-judice decision on the material placed before her by counsel for the applicants (vide *Beecham Group Ltd. v. The Republic*, (1982) 3 C.L.R. 622, 631, 632).

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, 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 (vide *White Horse Distillers Limited v. El Greco Distillers Ltd.* (1987) 3 C.L.R. 531 and *Plough Inc. v. The Republic* (1988) 3 C.L.R. 145).

Section 14(1) of Cap.268, reads as follows:

"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."

The Assistant Registrar having considered, under section 14

(1), above, two main questions (in *Jellinek's Application* [1946] 63 R.P.C. 59), namely whether the goods for which the registration was sought were of the same description as any other goods for which a mark has already been registered, and whether there was a likelihood of deception or confusion of the public, decided, for the reasons explained by her, that there was no real difference between the two marks both phonetically and visually, that they could cause confusion and that the goods in respect of the two marks were of the same description. 5

Having carefully gone through the material before me, I hold the view that the respondent conducted due inquiry in order to ascertain the material facts and thereafter duly applied the Law to the facts, reaching at the sub-judice decision which cannot be faulted. 10

As regards reasoning same appears clearly in the administrative file, (vide reds 19-22 in Exhibit "X" before me) and counsel for applicant was duly informed of such reasoning at his own request. 15

In the result present recourse fails and is accordingly dismissed; let there be no order to costs.

Recourse dismissed.
No order as to costs. 20