

1988 March 29

[TRIANTAFYLIDIS, P., MALACHTOS, DEMETRIADES, STYLIANIDES,  
PIKIS, JJ.)

FERRERO S.P.A.,

*Appellants-Applicants,*

v.

THE REGISTRAR OF TRADE MARKS,

*Respondents.*

*(Revisional Jurisdiction Appeal No. 723).*

5 *Trade Marks—The Trade Marks Law, Cap. 268, section 11(1)(d)—Word descriptive of the quality or character of the goods—Test applicable—Archaic word in foreign language—It may still be descriptive as aforesaid—DUPLO in Italian—Though archaic it still means DOUBLE in English or ΔΙΠΛΟ in Greek—The word ΔΙΠΛΟ has an identical meaning with DUPLO and is, soundwise, very similar to it—Therefore sub judice decision refusing registration of the word DUPLO was reasonably open to the respondent.*

10 *Trade Marks—The Trade Marks Law, Cap. 268, section 13—Confusion or deception—Only on the rarest of occasions will a word that lacks distinctiveness be held to be inoffensive under section 13.*

*Trade Marks—Distinctiveness—The hallmark of registration and the test of determining the likelihood of deception or confusion.*

15 *Trade Marks—Refusal to register the word DUPLO on the ground that it means DOUBLE and is, therefore, descriptive of the character or the quality of the goods—Complaint in respect of the failure of the respondent to afford the appellant an opportunity to explain the meaning of the word—As there was no suggestion that the word meant anything other than DOUBLE,*  
20 *such failure cannot lead to annulment.*

*Trade Marks—The Trade Marks Law, Cap. 268, section 19(1)—Registration in Part B of the Register—Refusal to register the word DUPLO on the ground that it means DOUBLE and is, therefore, descriptive of the character or quality of the goods—Complaint as to the respondent's omission to offer registration in Part B a precondition of the registrability in Part B is that the word in question should be "capable of distinguishing" the goods—In this case the Registrar correctly did not make such an offer.* 5

The issue in this appeal, which is directed against the decision, whereby the relevant recourse was dismissed, is whether it was reasonably open to the Registrar of Trade Marks to refuse registration of the word DUPLO for confectionery in Class 30 on the ground that such word means, in Italian, DOUBLE, and, is, therefore, descriptive of the character or quality of the goods and apt to cause confusion. The legal principles expounded by the Court in dismissing this appeal are indicated in the hereinabove headnote. 10

Appeal dismissed. 15

*Cases referred to:*

*Granada v. The Republic* (1985) 3 C.L.R. 207;

*Societe Anonyme v. Republic* (1986) 3 C.L.R. 356;

*Arcadian Corporation Inc. (No. 1) v. The Republic* (1986) 3 C.L.R. 2160;

*Plough Inc. v. The Republic* (1985) 3 C.L.R. 1687; 20

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

*Solio v. Eastman* [1989] A.C. 571;

*Philippart v. Whiteley* [1908] 25 R.P.C. 569.

**Appeal.**

Appeal against the judgment of a Judge of the Supreme Court of Cyprus (Savvides, J.) given on the 8th April, 1987 (Revisional Jurisdiction Case No. 38/84)\* whereby appellant's recourse against the refusal of the respondent to register the word "DUPLO" in plain capital letters in Part A of the Register of Trade Marks was dismissed. 25

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\* (Reported in (1987) 3 C.L.R. 536). 30

*G.M. Nicolaidis*, for appellants.

*D. Papadopoullou (Mrs.)*, for respondents.

*Cur. adv. vult.*

5 TRIANTAFYLLIDES P.: The judgment of the Court will be delivered by Pikis J.

10 PIKIS J.: This appeal is directed against a judgment of Savvides, J., dismissing appellant's recourse against a decision of the Registrar of Trade Marks refusing their application for registration of the word "DUPLO" in class 30 (Confectionery, etc.) of the register of Trade Marks. The learned Judge sustained the decision of the Registrar or, more precisely, he held it was reasonably  
15 open to him to refuse registration of the suggested mark because of the descriptive character of the word (s. 11(1) (d) Cap. 268), and the likelihood of confusion or deception resulting therefrom contrary to s. 13 of the Trade Marks Law. The Registrar had refused the registration of "DUPLO" on the ground that it was descriptive of the character and quality of the goods to be traded under that name, biscuits, as well as the likelihood of deception or confusion arising therefrom.

20 The trial Court found that the word "duplo" "though not very commonly used in modern Italian, nevertheless, it had a grammatical meaning, that of double". Therefore, he upheld the approach of the Registrar that the numerical connotation imported by the word was descriptive of the character and quality of the biscuits to be traded under that name. Furthermore confusion as  
25 well as deception might result from the likelihood of confusing the products of the appellants with those of their competitors that had similar properties.

30 Counsel for the appellants strenuously argued that the Registrar acted under a misconception in holding that the word "duplo" means "double" in Italian. Moreover, he was not given an opportunity to controvert this finding of the Registrar, or the meaning

ascribed to the word by Cassell's English - Italian Dictionary (3rd edition). Counsel suggested that the Italian word signifying "double", currently in use, is "doppio". The word "duplo", on the other hand, though it means "double", is obsolete and is classified by Italian dictionaries of repute as archaic. For the purpose we were referred to the dictionaries of Zingarelli and Mandeson. Nonetheless, no suggestion was made that the word "duplo", archaic though it may be, means anything other than "double"; nor does it take a linguistic expert to infer that "doppio" is a modern variation of "duplo". The suggestion, therefore, that the Registrar misconceived the meaning of the word "duplo" or that he attributed to it a meaning different from its true meaning, is ill founded. Although correct that the Registrar did not afford a specific opportunity to the appellants to controvert the meaning of "duplo", it is evident that use of that opportunity would not have cast a different light on the meaning of the word. It is clear on authority that a word does not lose its descriptive character by the mere fact that it is not in current use; for this to happen the word must be dead (See, Kerly's law of Trade Marks and Trade Names, 12th edition, para 8-30 p. 89). Consequently, the submission that the Registrar misconceived the meaning or implications of the word "duplo" or that the learned trial Judge misdirected in reviewing this aspect of the decision of the Registrar, cannot be sustained.

The next ground taken on appeal is that the word "duplo" is not descriptive of the character or quality of the goods, and as such its registration could not be objected to by reference to the provisions of s. 11(1) (d) of the Trade Marks Law. This subsection of the law allows registration of a word that has no direct reference to the character or quality of the goods. A word descriptive of either is not registrable unless its association with the product by extensive use over the years creates such a close association between the two as to make it distinctive and, as such, registrable under s. 11 (1) (e). The word "duplo" is a numerically descriptive adjective and as such serves to describe both the character as well as the quality of a product. Trade mark legislation is premised on the proposition that no one should be allowed to monopolise words apt to describe a product. Such words lack the

5 element of distinctiveness necessary to single out the products of  
one trader from those of another, and prevent unfair competition  
because of the likelihood of deception or confusion. It is for this  
reason that words are coined in order to individualise the brand  
name of different products, a process that rules out the likelihood  
of both confusion and deception. As I had occasion to remark on  
a number of occasions in the context of discussion of the basic  
aspects of trade mark legislation, distinctiveness is the hallmark  
of registration under s. 11, as well as the test of determining the  
10 likelihood of deception or confusion. (See inter alia *Granada v.  
Republic* (1985) 3 C.L.R. 207; *Societe Anonyme v Republic*  
(1986) 3 C.L.R. 356; *Arcadian Corporation Inc. (No. 1) v. Re-  
public* (1986) 3 C.L.R. 2160). The Full Bench of the Supreme  
Court affirmed this assessment of Trade Mark Law in *Plough  
15 Inc. v. Republic*. (1988) 3 C.L.R. 145; (see also the decision of  
first instance upheld on appeal (1985) 3 C.L.R. 1687).

In appreciating the effect of a foreign word, it is as well to  
bear in mind the observations of *Lord Herschell* in *Solio v. East-  
man*. [1898] A.C. 571 ".....Again I do not think that a fore-  
20 eign word is an invented word simply because it has not been  
current in our language.....". A practical test to determine wheth-  
er a word is distinctive is to ask whether a word conveys an obvi-  
ous meaning to the ordinary member of society (this was the test  
suggested in *Philippart v. Whiteley*) [1908] 25 R.P.C. 569; See,  
25 also, Kerly's Law of Trade Marks and Trade Names, 12th edition,  
para 8-30, p. 89). The word "duplo" is of Latin origin and  
has an identical meaning with the word "διπλό", a word in com-  
mon use in the Greek Language. Not only the two words have an  
identical meaning, but soundwise they are very similar too. In  
30 agreement with the learned trial Judge, I conclude it was reason-  
ably open to the Registrar to find that the word "duplo" was de-  
scriptive of the character and quality of the goods. Furthermore,  
its registration was objectionable under s.13 of the law because of  
the likelihood of deception or confusion resulting therefrom. As I  
35 perceive the law, only on the rarest of occasions will a word that  
lacks distinctiveness be held to be inoffensive under s.13 of the  
Law (Cap. 268).

The last ground of appeal concerns the failure of the Registrar to afford the appellants an opportunity to have "DUPLO" registered in Part B of the register. The complaint is not that the Registrar breached a positive duty but that he failed to exercise his discretion along the above suggested lines. Section 19, subsection 3, confers discretion upon the Registrar to offer in an appropriate case the opportunity to the applicant of seeking registration in Part B of the register as an alternative to refusal of the application of registration in Part A of the register. The Registrar will not be justified to offer this alternative to an applicant if of the opinion that the mark is not registrable in Part B of the register either.

Counsel submitted that "duplo" was registrable in Part B of the register and for that reason the Registrar abused his power by omitting to offer the applicant the alternative envisaged by s. 19 (3) of the law.

Consideration of the statutory evolution of English law (upon which our trade mark legislation is modelled) (See, Kerly, *supra*, para 7 - 73, p. 127 et seq) indicates that originally suggested names were rather freely entered in Part B of the register for the trial period in order to afford a trader an opportunity to establish distinctiveness through association of the mark with his products. In due course the words "capable of distinguishing" were added as a prerequisite for registration in Part B of the register, requiring a degree of distinctiveness as a precondition for registration in Part B of the register as well. This was recognised by the Full Bench of the Supreme Court in the case of *Plough Inc.*, *supra*, by adopting the following passage from the judgment of the trial Court as a sound assessment of the law: "An element of distinctiveness is also a requisite of registrability under s. 12". Having regard to the meaning of the word "duplo" and its qualities, it was not capable of distinguishing the goods of the appellants from similar goods of other traders. Hence the Registrar did not fail to afford the appellants an opportunity that they deserved under the law to have their goods registered in Part B of the register. Registration in Part B of the Register was not an alternative in the mind of the appellants for had that been the case they should have spe-

5 cifically applied for alternative registration in either Part A or Part B of the register (s. 19(1) - Cap.268). Of course the omission did not exonerate the Registrar from affording them such opportunity had the merits of the case so warranted. As it is, the omission of the Registrar to offer the alternative was, for the reasons above indicated, justified.

We shall, therefore, dismiss the appeal.

*Appeal dismissed.*