

1974
Nov. 25

NICOS M.
MARCANTONIS

v.

DEMETRIOS A
NICOLAIDES

[TRIANAFYLLIDES, P., STAVRINIDES, HADJIANASTASSIOU, JJ.]
NICOS M. MARCANTONIS,

Appellant - Plaintiff,

v.

DEMETRIOS A. NICOLAIDES,

Respondent - Defendant.

(Civil Appeal No. 5147).

Jurisdiction—District Court—Passing off action—District Court possesses jurisdiction to try it—Section 35 of the Civil Wrongs Law, Cap. 148.

Statutes—Construction—Section 4 of the Trade Marks Law, Cap. 268 and section 35 of the Civil Wrongs Law, Cap. 148.

Civil Wrongs Law, Cap. 148—Passing off action—Section 35 of the Law.

Trade Marks Law, Cap. 268—Construction of section 4 of the Law.

Passing off—Action for—Jurisdiction of District Court.

Trade Mark—Action for infringement of—And action for passing off—Whether the two kinds of action are different.

The appellant (plaintiff) brought an action at the District Court for passing off goods, under s. 35 of the Civil Wrongs Law, Cap. 148.

The trial Court, after upholding an objection, raised by the respondent (defendant), to the effect that, as in respect of the goods in question there existed a trade mark registered in Cyprus, a District Court had no jurisdiction in the matter and that the only court possessing jurisdiction was the Supreme Court, dismissed the action for lack of jurisdiction.

On appeal counsel for the appellant submitted that there should be made a distinction between an action for infringement of a trade mark and an action for passing off, and that in relation to the latter proceeding the trial Court had, in any event, jurisdiction.

Counsel for the respondent argued that section 4 of the Trade Marks Law, Cap. 268, is drafted in such a way that it excludes an action for passing off goods under section 35 of Cap. 148, unless in respect of such goods there does not exist a trade mark registered in Cyprus. (Note. Both sections are quoted in full in the judgment post).

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Held, (1) The view taken by the trial judge that there was no essential difference between the said two kinds of action was not a correct view of the law: The two proceedings in question are distinctly different, though they may overlap to a certain extent (See, in this respect, Kerly's Law of Trade Marks and Trade Names, 10th ed., at pp. 307, 371, where it appears that when a trade mark action fails a passing off action may still succeed on the same evidence).

(2) If we were to construe section 4 of the Trade Marks Law (*supra*) in the way suggested by counsel for the respondent we would be adopting an interpretation of such section which is not warranted at all by its wording, and, in such a case, we would have to go further and reach the equally unwarranted, in our view, conclusion that the term "goods" in section 35 of the Civil Wrongs Law (*supra*) means only goods in respect of which there does not exist a trade mark registered in Cyprus

(3) The appeal is allowed and the trial judge, who has been found in this appeal to possess jurisdiction to try the action, should now proceed to give his judgment on the merits

Appeal allowed

Appeal.

Appeal by plaintiff against the judgment of the District Court of Nicosia (Papadopoulos, S.D.J.) dated the 18th December, 1972, (Action No. 5376/71) whereby his claim for an order prohibiting the defendant, his agents and servants from offering for sale or selling wine

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gums in boxes or other packets bearing the words "Tower" or "Tower Brand" was dismissed.

C. *Indianos*, for the appellant.

A. *Emilianides*, for the respondent.

The judgment of the Court was delivered by :-

TRIANTAFYLLIDES, P. : In this case the appellant, who was the plaintiff before the trial court, has filed an action which, as it appears clearly from the pleadings, is an action for passing off goods, under section 35 of the Civil Wrongs Law, Cap. 148.

The trial court heard the action in full, but, in delivering its judgment, it limited itself to only one of the issues raised during the hearing, namely that of its jurisdiction to entertain the action.

In this connection an objection had been raised by counsel for the respondent, who was the defendant at the trial, that, as in respect of the goods in question there existed a trade mark registered in Cyprus, the trial court, being a District Court, had no jurisdiction in the matter, and that the only court possessing the relevant jurisdiction was the Supreme Court.

Counsel for the appellant submitted that there should be made a distinction between an action for infringement of a trade mark and an action for passing off, and that in relation to the latter proceeding the trial court had, in any event, jurisdiction.

But the judge took the view that there was no essential difference between the said two kinds of action.

We do not think that this was a correct view of the law : The two proceedings in question are distinctly different, though they may overlap to a certain extent; and, in this respect, useful reference may be made to, *inter alia*, Kerly's Law of Trade Marks and Trade Names, 10th ed., at pp. 307, 371, where it appears that when a trade mark action fails a passing off action may still succeed on the same evidence.

It has been, also, argued before us that section 4 of the Trade Marks Law, Cap. 268, is drafted in such a way that it excludes an action for passing off goods

under section 35 of Cap. 148, unless in respect of such goods there does not exist a trade mark registered in Cyprus :

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Section 4, above, reads as follows :-

“No person shall be entitled to institute any proceeding to prevent, or to recover damages for, the infringement of an unregistered trade mark, but nothing in this Law shall be deemed to affect rights of action against any person for passing off goods as the goods of another person or the remedies in respect thereof”.

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Section 35, above, reads as follows :-

“Any person who by imitating the name, description, sign, label or otherwise causes or attempts to cause any goods to be mistaken for the goods of another person, so as to be likely to lead an ordinary purchaser to believe that he is purchasing the goods of such other person, shall commit a civil wrong against such other person :

Provided that no person shall commit a civil wrong by reason only that he uses his own name in connection with the sale of any goods.”

We are of the opinion that if we were to construe section 4 in the way suggested by counsel for respondent we would be adopting an interpretation of such section which is not warranted at all by its wording, and, in such a case, we would have to go further and reach the equally unwarranted, in our view, conclusion that the term “goods” in section 35 means only goods in respect of which there does not exist a trade mark registered in Cyprus.

For the above reasons this appeal is allowed and the trial judge, who has been found by us in this appeal to possess jurisdiction to try the action, should now proceed to give his judgment on the merits.

The costs of this appeal, as well as the costs for the 18th December, 1972, when the parties appeared before

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the trial court to hear its decision on the issue of jurisdiction, are awarded against the respondent. The other costs of the action remain costs in the cause.

*Appeal allowed. Order
for costs as above.*