

1985 March 23

[TRIANTAFYLIDES, P.]

IN THE MATTER OF ARTICLE 146  
OF THE CONSTITUTION

FISONS LTD.,

*Applicants,*

v.

THE REGISTRAR OF TRADE MARKS,

*Respondent.*

(Case No. 139/82).

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*The Trade Marks Law, Cap. 268 ss. 13 and 14(1)—The English Trade Marks Act, 1938 ss. 11 and 12(1)—Sub judice decision allowing registration of the word “Intagen”—Such registration had been opposed by the owners of trade mark “Intal”—On the ground that “Intagen” was likely to cause confusion or deception to the public in view of its resemblance with “Intal” in respect of goods of the same description—Respondent registrar correctly disregarded opinion evidence adduced before him—And applied the relevant principles of law to the facts in a manner which was reasonably open to him.*

*Administrative Law—Administrative act—Powers of the Supreme Court, as an administrative Court, to interfere in a case such as the present one where the sub judice decision is the product of the exercise of discretion by the respondent Registrar.*

The applicants, who are the registered owners of the Trade Mark “Intal” in respect of inter alia pharmaceutical products, veterinary and sanitary substances and disinfectants and who had opposed the application of the interested party for the Registration as a Trade Mark of the word “Intagen” on the ground mainly that the registration of “Intagen” was likely to cause confusion or deception

to the public in view of its resemblance to the applicants' said trade mark "Intal" in respect of goods of the same description. impugned by means of the present recourse the respondent's decision whereby the respondent allowed the registration of the word "Intagen" as a trade mark in the name of the interested party.

The Registrar decided the matter by applying the provisions of ss. 13 and 14(1) of the Trade Marks Law, Cap. 268 which are identical with the provisions of ss. 11 and 12(1) of the Trade Marks Act, 1938, in England. In taking the sub judice decision the Registrar stated that he disregarded opinion evidence adduced before him.

*Held*, dismissing the recourse:

(1) In the light of the case law the Registrar correctly disregarded opinion evidence adduced before him.

(2) As regards the issue of resemblance the dictum of Lord Granworth, in *Seixo v. Provezende* [1865] L. R. 1 Ch. 192 at 196, that "What degree of resemblance is necessary from the nature of things, is a matter incapable of definition a priori...." as well as the powers of this Court, as an administrative Court to interfere in a case of this nature where the sub judice decision is the product of the exercise of discretion by the respondent registrar, should be borne in mind. (A passage concerning such powers in the Judgment of A. Loizou, J. in *Beecham Group Ltd. v. The Republic* (1982) 3 C.L.R. 622 was cited with approval).

(3) In this case the respondent registrar applied correctly to the facts of this case, in a manner reasonably open to him, the relevant principles of law such as those expounded in *Pianotist Co. Ltd. Application* [1906] 23 R.P.C. 774 and *Bailey*, 52 R.P.C. 136.

*Recourse dismissed.*

*No order as to costs.*

Cases referred to:

*The Seven-Up Company v. The Republic* (1973) 3 C.L.R. 612;

- Bourne v. Swan and Edgar Ltd. In Re Bourne's Trade Marks* [1903] 1 Ch. 211;
- The North Cheshire and Manchester Brewery Co. Ltd. v. The Manchester Brewery Co. Ltd.* [1899] A.C. 83;
- Payton and Co. Ltd. and Snelling, Lampard and Co. Ltd.* 5 [1901] A.C. 308;
- Harker Stagg Limited's Trade Mark* [1954] 71 R.P.C. 136;
- Seixo v. Provezende* [1865] L.R. 1 Ch. 192;
- The Company Carlo Erba Spa. (Via Carlo Imbonati) v. The Republic* (1977) 3 C.L.R. 427; 10
- Beecham Group Ltd. v. The Republic* (1982) 3 C.L.R. 622;
- Pianotist Co. Ltd.'s Application* [1906] 23 R.P.C. 774;
- Bailey*, 52 R.P.C. 136;
- P.M. and G. Stavrinides Clothing Industries Ltd. v. The Republic* (1938) 3 C.L.R. 98. 15

**Recourse.**

Recourse against the decision of the respondent whereby he allowed the registration of the word "Intagen" as a trade mark in the name of the interested party.

*X. Clerides*, for the applicant. 20

*R. Gavrielides*, Senior Counsel for the Republic, for the respondent.

*G. Nicolaidis*, for the interested party.

*Cur. adv. vult.*

TRIANTAFYLLIDES, P. read the following judgment. By 25  
this recourse the applicants challenge the validity of the  
decision of the Registrar of Trade Marks, dated 31st De-  
cember 1981, by means of which he allowed the registration  
of the word "Intagen" as a trade mark in the name of  
Bocm Silcock Limited, of England, the interested party in 30  
these proceedings.

The applicants are the registered owners in Cyprus of the trade mark "Intal" in respect of, among others, pharmaceutical products, veterinary and sanitary substances and disinfectants.

5 On the 25th January 1979 the aforementioned interested party applied for the registration of the word "Intagen" as a trade mark in respect of, among others, pharmaceutical, veterinary and sanitary substances and disinfectants.

10 Their application was advertised in the Fifth Supplement to the official Gazette of the Republic on the 12th October 1979.

15 On the 1st February 1980 the applicants filed an opposition to such application on the ground, mainly, that the registration of "Intagen" was likely to cause confusion or deception to the public in view of its resemblance to their already registered trade mark "Intal" in respect of goods of the same description.

20 After a hearing of the parties the sub judge decision was issued on the 3rd December 1981 and against it the present recourse has been filed.

In reaching his decision the respondent Registrar had to apply the following provisions of sections 13 and 14(1) of the Trade Marks Law, Cap. 268.

25 "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.

30 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  
35 description of goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion."

The wording of sections 13 and 14(1) of Cap. 268. above, is the same as that of sections 11 and 12(1) of the Trade Marks Act, 1938, in England (see Halsbury's Statutes of England, vol. 25, pp. 1189, 1190).

It is useful to quote the following part of the sub judge decision of the respondent: 5

“15. Having found that the goods of the applicants' application are of the same description as the goods for which the Opponents are registered I proceed now to a comparison of the marks. 10

16. The manner trade marks are compared, well appears in Chapter 17 of Kerly's Law of Trade Marks, 10th Edition. I shall cite a few passages from that Chapter. I quote page 456 from the summing of Parker, J. in the *Pianotist Co. Ltd.'s Appl.* [1906] 23 R.P.C. 774 at p. 777. 15

‘You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks.’ 20 25

Same book page 465, para. 17-17 (b):

‘(b) The mark is a whole: common elements.

The trade mark is the whole thing—the whole picture on each has to be considered. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity to the part or parts is enough to make the whole dissimilar.’ 30

Same book page 466, para. 17-19: 35

‘Common elements: some dicta.

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

17. Applying carefully to above consideration to the facts of the case in hand and considering the admissible evidence and discarding opinion evidence i.e. evidence as to probability of deception which is a question of the Registrar and not for a witness, (vide *Harker Stagg's Ltd. Trade Mark* [1954] 71 R.P.C. 136, 140; also Kerly's 10th ed. paras. 17-33-41), and considering also Counsel's arguments, I have reached the conclusion that the applicants have discharged the onus which is upon them to establish the non-likeness of confusion and deception among a substantial number of persons if the marks in suit were used by different proprietors in relation to the respective goods concerned. And that of course is the test—(see the judgment of Evershed J., referred to ante at para. 11, in the case of *Smith Hayden and Co.'s Application* [1946] 63 R.P.C. 97 at 101 lines 44-50). Accordingly the Opponents' objection under sec. 14(1) fails.

18. I shall now proceed to consider the case under sec. 13. The provisions of this section are stated in para 9 ante and the question for consideration under sec. 13 (sec. 11 of the English Trade Marks Act, 1938), was formulated in *Smith Hayden & Co.'s Ltd. Application* [1946] 63 R.C.P. 97 at p. 101 as referred to and adapted in para 11(A) ante. In this respect I must state that it is in evidence that the Opponents' mark is in use and has sufficient reputation. On the same question of likelihood of deception or confusion

within the meaning of s.13 I have in mind the test as was laid down by Romer J. In *Jellinek's Trade Mark* [1949] 63 R.P.C. 59 at page 78:

'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? 5

Mr. Burrell, on behalf of the Opponents, submitted to me the following propositions with regard to this section: (1) In all applications for registration of a trade mark the onus is on the applicant to satisfy the Registrar (or the Court) that there is no reasonable probability of confusion. (2) It is not necessary in order to find that a mark offends against the section, to prove that there is an actual probability of deception leading to a passing-off. 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. (3) In considering the probability of deception, all the surrounding circumstances have to be taken into consideration. (4) In applications for registration, the rights of the parties are to be determined as at the date of the application. (5) The onus must be discharged by the applicant in respect of all goods coming within the specification applied for, and not only in respect of those goods on which he is proposing to use it immediately, nor is the onus discharged by proof only that any particular method of user will not give rise to confusion; the test is: What can the applicant do? 10 15 20 25 30

I think that these propositions are, in substance, well founded, and I would merely add, with regard to the second of them, the following extract from the judgment of the late Farwell, J., in *Bailey's* case, reported in 52 R.P.C. 136, at page 153: "I think that the 'Court has to be satisfied not merely that there is a possibility of confusion; I think the 35 40

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 19. Applying carefully the above considerations to the facts of the present application and considering the admissible evidence and discarding opinion evidence and considering also the Counsel's arguments. I have come to the conclusion that the applicants have discharged the onus of establishing that the use  
10 of their mark applied for registration, would not offend against the provisions of sec. 13. In the result I find that opposition under sec. 13 fails."

As regards the question of the matter of proof adduced before the respondent useful reference may be made to  
15 the case of *The Seven-UP Company v. The Republic*, (1973) 3 C.L.R. 612, and to case-law referred to therein, such as *Bourne v. Swan & Edgar Ltd. In re Bourne's Trade Marks*, [1903] 1 Ch. 211, 224, *The North Cheshire and Manchester Brewery Co. Ltd. v. The Manchester Brewery  
20 Co. Ltd.*, [1899] A.C. 83, 84, *Payton & Co. Ltd. and Snelling, Lampard & Co. Ltd.*, [1901] A.C. 308, 311 and *Harker Stagg, Limited's Trade Mark*, [1954] 71 R.P.C. 136.

In the light of the aforequoted case-law I have reached  
25 the conclusion that the respondent Registrar has correctly discarded opinion evidence adduced before him.

As regards the issue of resemblance between the words "Intal" and "Intagen" it is pertinent to bear in mind the following dictum of Lord Cranworth in *Seixo v. Provezende*, [1865] L.R. 1 Ch. 192, 196: "What degree of resemblance is necessary from the nature of things, is a matter incapable of definition a priori....", which was referred to with approval in *The Company Carlo Erba Spa (via Carlo Imbonati) v. The Republic*, (1977) 3 C.L.R.  
35 427, 439.

There must also be borne in mind the principles governing interference by this Court, as an administrative Court, in a case of this nature where the sub judice decision is in essence the product of the exercise of discretion by the



respondent Registrar. In this respect A. Loizou J. stated the following in *Beacham Group Ltd. v. The Republic*, (1982) 3 C.L.R. 622, 632, 633:

“In the case of *Merck v. Republic* (1972) 3 C.L.R. 548, in dealing with a similar issue I said at p. 564 5 the following:

‘To my mind, the Registrar in exercising his discretion, is not limited to any particular type of consideration. He must exercise it judicially on reasonable grounds which are capable of being clearly 10 stated. He has to examine the possible confusions or difficulties which might arise in consequence of the registration of the trade mark or the possible impairment of the rights of other traders to do that 15 which, apart from the registration, might be their ordinary mode of carrying on their business.

The point, therefore, that arises for consideration, is the extent to which this Court will interfere with the exercise of administrative discretion. This matter has been the subject of judicial pronouncement in 20 a number of cases (see inter alia, *Iacovos Iacovides v. The Republic* (1966) 3 C.L.R. p. 212, *Impalex Agencies Ltd. v. The Republic* (1970) 3 C.L.R. 361, and *Pсарas v. The Ministry of Commerce and Industry* (1971) 3 C.L.R. 151). This Court will not 25 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.’

Having in mind the material which was before the 30 Registrar in this case, I have come to the conclusion that it was reasonably open to him to arrive at the conclusion that he did; and I will not substitute my discretion for that of the Registrar, the appropriate 35 authority in this case, since he exercised same judicially and neither in abuse or excess of power, nor contrary to law. Moreover the respondent Registrar directed himself correctly on the Law pertaining to the issues raised regarding the effect of a mark having 40 been registered in a foreign country, by referring to

Kerly's Law of Trade Marks, 10th edition pp. 146-157, paragraphs 8-67 and the 'Needle-Tip' trade mark case (1973) R.P.C. 113, whereby the principles are aptly summed up and which I adopt fully."

5 After carefully perusing the decision of the respondent and the material which had been placed before him I have reached the conclusion that the respondent has applied correctly to the facts of this case, in a manner that was reasonably open to him, the relevant principles of Law,  
10 such as those expounded in the cases of *Pianotist Co. Ltd.'s Application* [1906] 23 R.P.C. 774, 777 and *Bailey*, 52 R.P.C. 136, 153. I have, therefore, come to the conclusion that the sub judice decision was reached in the proper exercise of the discretion of the respondent and consequently  
15 the present recourse fails and has to be dismissed (and see, also, in this respect, *P. M. & G. Stavrinides Clothing Industries Ltd., v. The Republic*, (1983) 3 C.L.R. 98, 107, 108).

I will not make any order as to the costs of this case.

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*Recourse dismissed.  
No order as to costs*