

1985 April 11

[L. LOIZOU, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

ALFRED DUNHILL LIMITED, CIGARETTE
MANUFACTURERS,

Applicants,

v.

THE COMMISSIONER OF TRADE MARKS,

Respondent.

(Case No. 260/77).

5 *Trade marks—Registration—Objection to—Opposition proceed-*
ings—Evidence of use abroad tending to show possible in-
tended use in this Country—Relevant and admissible—
Registrar misdirected himself by not accepting such evi-
10 *dence—Colour—It has a material bearing on the question*
of resemblance of marks—And by misdirecting himself as
above Registrar did not attach any importance to the factor
of colour—As interested party was not prepared to under-
take any obligation for any limitation as to colour—And
15 *as onus of proof that there was no reasonable possibility*
of deception or confusion on the interested party, said
misdirection a material one—And, therefore, Registrar's
discretion was not properly exercised—Clearly open to
the Registrar to accept the Registration under conditions—
Section 19(2) of the Trade Marks Law, Cap. 268.

20 This was a recourse against the validity of the decision
of the Registrar of Trade Marks to register the
trade mark of the interested party No. B14955 con-
sisting of the word "OSCAR" and design in Part B of the
Register of Trade Marks and dismiss the Opposition of
the applicants against such registration.

Counsel for applicants contended that the Registrar
misdirected himself in finding that he could not accept evi-

dence of user in Greece in deciding the issue of resemblance and confusion. He, further, contended, that colour was a factor to be taken into consideration and that the Registrar should have considered the possibility of imposing conditions. 5

Held, that evidence of use abroad tending to show possible intended use in this country is relevant and admissible; and that, therefore, the respondent Registrar misdirected himself in this respect; that a misdirection in order to affect the validity of the decision of the Registrar must be material; that colour may have a material bearing on the question of resemblance of marks; that having regard to the importance of colour and to the fact that the Registrar by misdirecting himself as to the relevance and admissibility of evidence of use in Greece as tending to show intention of how the mark was likely to be used in Cyprus, did not attach any importance to this factor; and to the statement of the interested party in their counter-opposition to the effect that they are not prepared to undertake any obligation for any limitation as to colour, and also bearing in mind that the onus of proof (at the Opposition proceedings before the Registrar) that there was no reasonable possibility of deception or confusion was on the interested party, the misdirection of the Registrar was, in the circumstances of the case, a material one and, as a result, his discretion was not properly exercised. 10 15 20 25

Held, further, that as regards the possibility of the Registrar accepting registration under conditions this course was clearly open to him under the provisions of s. 19(2) of the Trade Marks Law, Cap. 268. 30

Sub judice decision annulled.

Recourse.

Recourse against the decision of the respondent to register the trade mark of the interested party consisting of the word "Oscar" and design in Part B of the Register of 35

Trade Marks, and the decision dismissing applicant's opposition against such registration.

G. Nicolaidis, for the applicants.

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

L. Demetriades, for the interested party.

Cur. adv. vult.

10 L. LOIZOU J. read the following judgment. The applicant company, by this recourse, challenges the validity of the decision of the Registrar of Trade Marks dated the 18th July, 1977, to register the trade mark of the interested party No. B14955 consisting of the word "OSCAR" and design in Part B of the Register of Trade Marks and dismiss the Opposition of the applicants against such registration, and prays for a declaration that such decision
15 should be declared null and of no effect whatsoever.

The facts are briefly as follows:

20 The applicants are the proprietors of trade marks Nos. 10286 and 14557 registered in Cyprus in 1967 and 1972, respectively, in respect of cigarettes the registration being limited to red or maroon and gold colours (exhibit 1).

25 On the 14th May, 1973, the interested party applied for registration of the trade mark "OSCAR" in respect of cigarettes which was accepted by the Registrar for registration in Part B of the Register, under No. B14955, with no limitation as to colour, having been submitted in black and white. The trade mark was then advertised in the official Gazette of the Republic (exhibit 2), whereupon the applicants filed on the 14th November, 1974, an Opposition
30 against its registration on the grounds that the proposed trade mark so closely resembled their own that it was likely to cause confusion or deception and further that the interested party should enter a condition not to use the proposed mark in the colours used by the applicants (exhibit 5).
35

The interested party filed a counter-opposition (exhibit 6) stating that their trade mark has no resemblance to that of the applicants and is distinguishable from it and

there is no likelihood of confusion if used in the same colours as that of the applicants. They further stated (at paragraph 8) that they were not prepared to undertake any obligation for any limitation with regard to the use of colours. This, in view of the provisions of s. 18 of Cap. 268, in effect means that their trade mark would be deemed to have been registered for all colours. 5

A hearing then took place before the Registrar at which the applicants tendered evidence that the interested party were selling in Greece their "OSCAR" cigarettes in packets of the same colours as those of the applicants which was an indication of their intention to use the same colours in Cyprus, a factor which relates to the possibility of confusion of the two trade marks. 10

The Registrar issued his decision on the 18th July, 1977, dismissing the Opposition of the applicants and directing that the sub judice trade mark do proceed for registration in Part B of the Register as advertised. 15

The main ground on which counsel for applicants argued his case is that the Registrar misdirected himself in certain respects and, as a result, he did not exercise his discretionary powers properly. 20

In his address learned counsel for applicants argued that the Registrar misdirected himself in finding that he could not accept evidence of user in Greece in deciding the issue of resemblance and confusion. He also argued that colour is a factor to be taken into consideration and that the Registrar should have considered the possibility of imposing conditions. 25

Counsel for the respondent argued that evidence of use abroad cannot be taken into consideration and cited, in support of this, from Kerly's Law of Trade Marks, 10th ed., the same passage cited by the Registrar in his decision to which I shall refer presently. 30

Counsel for the interested party adopted the address of counsel for the respondent and submitted that the sub judice decision was in all respects properly taken and that the Registrar was right in refusing to have regard to the "OSCAR" mark as used in Greece. 35

The relevant part of the decision of the Registrar is at pp. 7 and 8 of his decision and reads as follows:

5 "The applicants put forward evidence to prove that the applicants' trade mark is used in Greece in similar colours as those of the opponents. Under the Law and the authorities it is user in this country that is taken into consideration and not user abroad. This is clear from Kerly, 10th ed., p. 146, para. 8-67. I quote.

10 'On an application to register a mark for use in the United Kingdom, it is distinctiveness in the United Kingdom that is in question.'

15 Therefore, evidence of use abroad is irrelevant and I did not take it into consideration. In Cyprus applicants' trade mark is not used and this is clear from the evidence even of the opponents."

20 It is clear from the above part of the decision of the Registrar that in not considering the evidence tendered by the applicants he relied solely on the passage from Kerly cited above. But this passage relates to evidence of use abroad not in general, but with regard to registrability of a trade mark on the ground of distinctiveness under s.11 (1)(e) and it is for the purposes of proving such distinctiveness that evidence of use abroad is irrelevant, the issue there being whether the particular mark is distinctive in the country where it is sought to be registered. I, therefore, find, as a result, that the Registrar misdirected himself in this respect.

30 As to whether such evidence is, in fact, relevant and admissible or not, reference may be made to certain passages from Kerly. Thus, at p. 472 (para. 17-27) it is stated that "evidence as to how an applicant in fact means to use his mark is always admissible" and at p. 175 (para. 10-04):

35 "If, in fact, it is known what use an applicant intends to make of a mark, that use cannot be excluded. Thus evidence that an intended use is particularly likely to be confusing is helpful to an opponent, to prevent such use being dismissed as unfair or fanciful."

It is also stated at p. 61 (para. 4-31) that:

“Evidence of deception and confusion abroad may be relevant in Opposition proceedings before the Registrar, particularly if the logical inference from such evidence is that there would be a corresponding likelihood of deception or confusion in the United Kingdom.” 5

Since evidence as to the likelihood of deception or confusion is relevant and admissible, it is difficult to see why, in the absence of any authority to the contrary, evidence of use abroad tending to show possible intended use in this country should be excluded. This of course should not be taken as meaning that by admitting such evidence the Registrar would be, in any way bound by it or that he would be fettered in the exercise of his discretion in the matter. 10

A misdirection, however, in order to affect the validity of the decision of the Registrar, must be material. In this respect it is a matter of conjecture as to what conclusion the Registrar would have reached, in the present case, had he considered such evidence and had he directed his mind to the similarity of the colours used 15 20

With regard to the importance of colours in deciding a question of deception or confusion it is again stated at p. 148 (para. 8-68) of Kerly that-

“The colours in which a mark is actually used, or is *likely to be used*, have often a material bearing upon questions of alleged resemblance calculated to deceive, or of infringement.” (The underlining is mine). 25

and at p. 470 (para. 17-25) under the heading ‘Colour’:

“Where marks are used in colour, it may undoubtedly affect the likelihood of confusion that the colours are or are not the same. Whilst, however, this is often a circumstance of great importance in relation to passing off, it is (except in the rare cases where a mark is registered in particular colours only) ordinarily of less importance in considering infringement; for the owner of a registered mark may use it in any colour. Even so, however, colour should seldom be entirely ignored.” 30 35

and at p. 471 same instances of decided cases are given on the matter of colours:

5 "1. If a star be registered, naturally the word star for the same goods would be calculated to deceive. But since the registered proprietor of the device of a star could use it in any colour, the words 'Red Star' are as objectionable as the word star by itself: *Société Anonyme de Varreries de l' Etoile's T.M.* [1894] 1 Ch. 61; 10 R.P.C. 436; [1894] 2 Ch. 26; 11 R.P.C. 142 ("Red Star Brand").

15 2. The words 'The Golden Fan Brand' were refused registration as an essential particular of a mark, on account of the presence on the Register of a fan which was in fact coloured gold in use: *Dewhurst's Appn.* [1896] 2 Ch. 137; 13 R.P.C. 288.

20 3. A triangular frame with the picture of a church inside was rejected on the ground that it would, if the whole were coloured red, too nearly resemble Bass's wellknown solid red triangle: *Worthington's* case [1880] 14 Ch.D. 8; and see *Hanson's T.M.* [1887] 37 Ch.D. 112 (red, white & blue coffee label not distinctive without colours)."

25 In Halsbury's Laws of England, 4th ed., vol. 48, at p. 41 it is stated that "colour may have a material bearing on the question of resemblance of marks."

30 Having regard to the above quoted passages as to the importance of colour and to the fact that the Registrar by misdirecting himself as to the relevance and admissibility of evidence of use in Greece as tending to show intention of how the mark was likely to be used in Cyprus, did not attach any importance to this factor; and to the statement of the interested party in their counter-opposition to the effect that they are not prepared to undertake any obligation for any limitation as to colour, and also bearing in mind that the onus of proof (at the Opposition proceedings before the Registrar) that there was no reasonable possibility of deception or confusion was on the interested party, 35 I have come to the conclusion that the misdirection of the Registrar was, in the circumstances of the case, a material

one and, as a result, his discretion was not properly exercised.

In view of the conclusion that I have reached on this point I consider it unnecessary to deal with the other arguments of counsel, except to mention, that as regards the possibility of the Registrar accepting registration under conditions this course was clearly open to him under the provisions of s. 19(2) of the Law. 5

In the result this recourse succeeds and the sub judice decision is annulled for wrong exercise of discretion. 10

*Sub judice decision annulled.
No order as to costs.*