

1986 November 29

[PIKIS, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

ARCADIAN CORPORATION INC., OF
NEW YORK STATE (No. 1).

Applicants.

v.

THE REPUBLIC OF CYPRUS, THROUGH
THE REGISTRAR OF TRADE MARKS,

Respondent.

(Case No. 1042/85).

Trade Marks—The Convention for the Protection of Industrial Property (ratified by Law 66/83)—Registration of mark in country of applicant—Convention does not render it registrable in Cyprus—Registration remains subject to domestic law.

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Trade Marks—Registrability—Distinctiveness—The hallmark of registrability—Letter of Alphabet—Lacks distinctiveness—Exception in case of distinctiveness gained by long use and widespread trading—Descriptiveness —NZN—N in white standing for nitrogen and ZN in black standing for zing in respect of fertilizer—Descriptive of quality of goods—Moreover, apt to cause confusion as goods do not contain exclusively said two substances.

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Applicant's application for the registration of NZN—the first letter in white and the second two in black colour—for fertilizers was turned down by the respondent Registrar for lack of distinctiveness, tendency to describe components of the fertilizers and likelihood of confusion.

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Hence the present recourse. It must be noted that letters "N" and "ZN" symbolize nitrogen and zing res-

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5 spectively. In support of applicant's case their counsel referred to the registration of the mark in U.S.A. and other countries and the rights flowing from the Convention for the Protection of Industrial Property ratified by Law 66/83*.

10 *Held, dismissing the recourse:* (1) The Convention does not make the mark registrable in Cyprus on account of registration in U.S.A., the country of incorporation of the applicants. Registration remains subject to domestic law, largely dependent on consideration of distinctiveness.

15 (2) Distinctiveness is the hall-mark of registrability. No one has the right to monopolize the use of letters in the alphabet, common property of mankind. Exceptionally this may be allowed upon proof of distinctiveness gained by the use of the letters over a long period and widespread trading, but this is not the case here. Nor does the representation in this case amount to a visually distinctive device.

20 (3) The mark in question purports to describe the character and quality of the goods, that do contain nitrogen and zing. Descriptiveness is, therefore, a further obstacle to its registration.

(4) The mark in question is apt to cause confusion as the products do not contain exclusively nitrogen and zing.

25 *Recourse dismissed.*
No order as to costs.

Cases referred to:

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

Peletico v. Registrar of Trade Marks (1986) 3 C.L.R. 490;

30 *Birmingham Small Arms C's Appn.* [1907] 2 Ch. 396;

Elliot v. Machine Tools [1970] R.P.C. 79.

* See, also, Law 63/65.

Recourse.

Recourse against the refusal of the respondent to register capital letters NZN as a trade mark in either Register "A" or Register "B".

Chr. Chrysanthou, for the applicants. 5

Sr. Ioannides (Mrs.), for the respondents.

Cur. adv. vult.

PIKIS J. read the following judgment. Sub judice is a decision of the Registrar of Trade Marks refusing registration of capital letters NZN as a trade mark in either register "A" or register "B". Registration was refused for three separate reasons: 10

(a) The descriptive nature of the mark referable to the character or quality of the goods.

(b) Lack of distinctiveness. 15

(c) Likelihood of confusion.

The applicants, an American Corporation, applied for the registration of the mark involving reproduction of the aforesaid three letters of the alphabet in capital form and in equal size portraying the first letter in white and the second two in black colour. Their counsel argued that the presentation of the three letters in the form described constitutes a device distinctive enough to merit their registration as a trade mark in class I of register "A" or in register "B". In further support of the claim to registrability of NZN he referred to the registration of the mark in the trade mark register in the U.S.A. and other countries listed in his address and the rights flowing from the Convention for the Protection of Industrial Property as subsequently revised, ratified by Law 66/83(1). 20 25 30

After reflexion, on the rival submissions, to my mind the Registrar was perfectly entitled to refuse registration for each of the three reasons founding his decision. To be-

(1) See also 63/65.

gin, the Convention for the Protection of Industrial Property does not make the trade mark registrable in Cyprus on account of registration in the U.S.A., the country of incorporation of the applicants. In *Plough Inc. v. The Republic*(1) it was explained that registration of a trade mark in a signatory country does not automatically make registration of the same mark in a fellow signatory country obligatory (see reservations made in SB 2 Article 6). Registration remains, subject to domestic law, largely dependent on considerations of distinctiveness of the mark. In the same case it was explained by reference to English caselaw that registration in another country is per se an inconsequential factor.

Rarely lack of distinctiveness of the mark itself may be remedied by long and wide-spread user, a factor peculiarly associated with the market of a product in a particular country and length of time associated with such user. The applicants began marketing in Cyprus their products in 1984 and though they seemingly gained a foothold in the market for fertilizers, neither the time link nor the general market for the products for the particular brand of fertilizers of applicants could fill the gap from the absence of the element of distinctiveness.

Distinctiveness

Distinctiveness is the hall-mark of registrability, as pointed out in *Peletico v. Registrar of Trade Marks*(2). No one has the right to monopolize the use of letters of the alphabet, common property of mankind. If this were to happen endless disputes would arise. In *Kerly*(3) it is explained that the use of initials and other letters in any combination lacks, as a rule, distinctiveness and cannot be registered. Exceptionally this may be allowed upon proof of distinctiveness gained by the use of the letters over a long period and widespread trading under that name as in the *BSA case* where the initial letters of *Birmingham Small Arms* gained a strong association with the products

(1) (1985) 3 C.L.R. 1687.

(2) (1986) 3 C.L.R. 490.

(3) Law of Trade Marks and Trade Names, 10th Ed., para. 8-63.

of the traders⁽¹⁾. There is no suggestion in this case that NZN is so closely associated with the products of the applicants as to distinguish them on that account. Nor does their representation amount to a visually distinctive device. This can only occur as emphasized in the case of *Elliot Machine Tools*⁽²⁾, if visual distinctiveness is so striking as to override the significance of non distinctive features. This was certainly not the effect of NZN in this case. The prominent features of the mark were the letters themselves and the bell they expected to ring about the content of the fertilizers of the applicants.

Descriptiveness

Assuming contrary to what is stated above that applicants overcame the obstacle of lack of distinctiveness, registration would again stumble on the way their mark purports to describe the character and quality of their products that do contain nitrogen and zing. The lacing of the last two letters in black is designed to stress the association of the two letters, whereas the combination of "N" and "ZN" as two separate elements of the mark tend to be descriptive of the goods. It must be noted that letters "N" and "ZN" symbolize nitrogen and zing respectively.

Likelihood of Confusion

But as the fertilizers do not consist exclusively of nitrogen and zing, the trade mark proposed by the applicant would be apt to cause confusion; therefore, the Registrar was right to reject registration on that account as well.

For all the above reasons the recourse fails. The decision of the Registrar is confirmed pursuant to the provisions of Article 146.4 (a) of the Constitution. No order as to costs.

*Recourse dismissed.
No order as to costs.*

⁽¹⁾ Birmingham Small Arms C's Appn [1907] 2 Ch 396
⁽²⁾ [1970] R.P.C. 79.