

1988 May 25

[DEMETRIADES, J.]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

PHILIP MORRIS INCORPORATED,

*Applicants,*

v.

THE REGISTRAR OF TRADE MARKS,

*Respondent.*

*(Case No. 476/85).*

*Reasoning of an administrative act—May be supplemented by the material in the file.*

*Trade Marks—Part A and Part B of the Register—The considerations of registration in Part B are the same as those of registration in Part A, but less onerous.*

5

This recourse is directed against the refusal of the Registrar of Trade Marks to register applicants' mark in Class 15. The original objection of the Registrar was followed by a hearing and a decision maintaining the original objection about the mark for its lack of distinctiveness. Then upon applicant's request, the Registrar delivered a reasoned decision. Though the latter decision did not contain all the reasons for rejecting application, the Court did not annul the sub judice decision, because the missing reasoning was supplemented from the material in the file.

10

*Recourse dismissed.*

*No order as to costs.*

15

**Recourse.**

Recourse against the decision of the respondent to reject applicants' application for the registration of a trade mark in Class 25

of the Register of Trade Marks in respect of jackets, shirts blouses, shorts, dresses, skirts and tennis shoes.

*G. Nicolaidis*, for the applicants.

*St. Ioannides (Mrs.)*, for the respondent.

*Cur. adv. vult.* 5

DEMETRIADES J. read the following judgment. The applicants challenge, by this recourse, the decision of the respondent dated the 13th February, 1985, whereby he rejected the application of the applicant for the registration of a trade mark in Class 25 of the Register of Trade Marks in respect of jackets, shirts, slacks, blouses, shorts, dresses, skirts and tennis shoes. 10

The applicants, a company registered in U.S.A., applied on the 20th March, 1984, for the registration of a trade mark under No. 24799, in class 25 of the Register. The mark appears in the file of the application, which is exhibit "X" before the Court, under reds 3, 4 and 5. 15

The respondent, after considering the application, replied by letter dated the 15th May, 1984, addressed to the applicants' counsel, that an objection was raised to the registration of the proposed mark, on the ground that "it lacks distinctiveness and that it is comprised of simple colours". 20

The applicants requested a hearing which took place on the 25th January, 1985. During the hearing, applicants' counsel stated that the trade mark was registered in England, that it is distinctive, that the same mark was accepted for registration in Cyprus in respect of cigarettes and became well known from the cigarettes. He also filed the Trade Mark Journal of the United Kingdom to show that the trade mark was accepted for registration in the United Kingdom. 25

The respondent, by letter dated the 13th February, 1985, com- 30

5 municated his reserved decision to applicants' counsel, stating that after considering what was stated at the hearing, he found it impossible to withdraw his original objections. Upon the applicants' request, the Assistant Official Receiver and Registrar delivered, on the 5th April, 1985, her reasoned decision to their counsel. As a result, the applicants filed the present recourse challenging the above decision.

10 Counsel for the applicants mainly rested his case on the grounds that the sub judice decision is not duly reasoned and that the respondent acted under a misconception of the law. His arguments in this respect are, firstly, that it is deduced from the contents of the reasoned decision that the respondent failed to consider whether the proposed mark was inherently adapted to distinguish the goods of the applicants in respect of which the registration was sought, as is provided by section 11(3)(a) of the Trade Marks Law, Cap. 268; and, secondly, that the respondent, by failing to allow registration of the mark in Part B of the Register, acted under a misconception of the Law, in that he considered that the criteria for registration in Part B' are the same as those applicable for registration in Part A' of the Register.

20 Counsel for the respondents argued, on the other hand, that the sub judice decision is duly reasoned and that its reasoning may be supplemented from the material in the file and that such decision was reasonably open to the respondent.

25 Before proceeding to consider the arguments of counsel I shall make a brief reference to the contents of the reasoned decision of the respondent. The reasoned decision starts in fact at p. 2 para. 7, which reads as follows:

"7. Under s.11(1)(e) the Registrar has to consider whether the mark propounded for registration is in fact distinctive."

30 The respondent then quotes what was said on behalf of the applicants at the hearing and proceeded to consider and answer the points raised at such hearing. As regards registration of the mark

in England, the respondent decided that it is of secondary significance, if any, and in reference to the registration and use of the mark in Cyprus in respect of cigarettes, the decision was to the effect that the mark already registered is not the same but contains other matter and use of it in Cyprus in that other form cannot have any bearing on the case which concerns registration of the mark in respect of different goods. The decision then concludes as follows: 5

"15. The applicants did not prove by reason of use or any other circumstances that their mark has in fact become distinctive in Cyprus for the goods of the application ..... 10

16. Having therefore, carefully considered the mark propounded for registration in the light of the above considerations, I have come to the conclusion that it is not entitled for registration under the provisions of section 11(1)(e) of the law, as it has not become distinctive in fact, in Cyprus. 15

17. I have also considered whether the mark would be acceptable for registration in part 'B' of the Register under the provisions of section 12 of the Law. It seems to me however, that for the same reasons already advanced for which the trade mark is not registrable in part 'A' of the Register, the said mark cannot be capable of distinguishing those goods. 20

Therefore, registration in part 'B' is also refused.

18. The application is, therefore, refused under s.19(2) of the Trade Marks Law Cap. 268, because the mark fails to satisfy the provisions of s.11, and s.12 of the Law." 25

It is obvious from the above that the reasoned decision of the respondent deals with and answers only the matters raised on applicants' behalf during the hearing before the Registrar, and finds that the mark is not in fact adapted to distinguish the goods for which registration is sought. Although it is desirable that all matters considered by the Registrar should appear in detail in such 30

5 reasoned decision, I would not go so far as to say that the sub ju-  
dice decision is not duly reasoned. The sub judge decision is not  
just the reasoned decision in question, which is only part of it and  
if the missing reasoning is supplemented by any material con-  
tained in the file, the decision should not be annulled on this  
ground.

10 The Registrar, by his letter dated the 13th February, 1985, in  
fact maintained his objections which were originally raised. For  
this purpose reference may be made to red 6 in the file, which is  
the letter of the Registrar containing his original objections. The  
objections are, as stated earlier on in this judgment, that the pro-  
posed mark lacks any distinctive character and is comprised of  
simple colours. It is to be assumed, having also regard to the  
principle of regularity, that the Registrar, at this stage, has con-  
sidered whether the mark is inherently adapted to distinguish, as  
15 provided in section 11(3) (a) of the Law.

I, therefore, find that this part of the reasoning of the sub ju-  
dice decision which is missing from the reasoned decision of the  
respondent is supplemented from the material contained in the file  
of the administration and, as a result, this ground is dismissed.  
20

As regards the second ground raised by the applicants, the ma-  
terial part of the decision of the Registrar is to be found in para.  
17 quoted above. The burden of providing misconception of ei-  
ther fact or law lies on the applicants. Both counsel are in agree-  
ment that the considerations for registration in Part B' are the  
same as those for registration in Part A', but less onerous.  
25

Although the decision of the Registrar on this point is very  
concise, he found that the mark cannot be capable of distinguish-  
ing the goods and I cannot say that he was acting under a miscon-  
ception of the law and that he viewed the considerations for regis-  
tration in Part B' with the same force as in part A'. I will  
therefore, dismiss this ground also.  
30

In the result this recourse fails and is hereby dismissed but in  
the circumstances, I will make no order as to costs.

*Recourse dismissed.*

*No order as to costs.*