

1988 July 18.

[DEMETRIADES, J.]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

FRANCIS MONTESINOS INTERNATIONAL S.A. ,

Applicants,

v.

THE REGISTRAR OF TRADE MARKS,

Respondent.

(Case No. 682/84).

Trade marks—Registrability—Resemblance with a mark already registered likely to deceive or cause confusion—The Trade Marks Law, Cap. 268, section 14(1)—Registration of "Francis Montesinos" refused on account of resemblance likely to cause confusion with "MONTEDISON"—Reasonably open to the Registrar.

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The facts of this case sufficiently appear in the Judgment of the Court.

Recourse dismissed with costs.

Recourse.

Recourse against the refusal of the respondent to accept the registration of the name "Francis Montesinos" as a trade mark in class 25 of the Register for articles of clothing.

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Chr. Theodoulou, for the applicants.

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

Cur. adv.vult.

5 DEMETRIADES J. read the following judgment. By the present recourse the applicants challenge the decision of the respondent dated the 16th October, 1984, by which he refused to accept the application of the applicants No. 24343 for the registration of the name "Francis Montesinos" as a trade mark in class 25 of the Register for articles of clothing.

The facts that led to the present recourse are, in brief, the following:

10 On the 16th November, 1983, Francis Montesinos International S.A., a company registered in Spain, in accordance with the laws of the country, applied to the respondent, through their advocate Dr. C.A. Theodoulou, for the registration of the name "Francis Montesinos", which is written in small hand-written letters, as trade mark in class 25 for articles of clothing including
15 jackets, trousers, dresses, shirts, T-shirts, jean-style clothing and footwear.

20 On the 11th January, 1984, the respondent, after considering the application for acceptance objected to its registration on the ground that the proposed trade mark was similar to trade mark No. 15447 MONTEDISON and device in class 25 and to trade mark No. 24273 MOCASSINO also in class 25. The application for the registration of the latter was, however, on the 5th April, 1984, withdrawn and was not later considered by the respondent when he reached his final decision.

25 On the 28th May, 1984, the applicants' counsel filed a considered reply to the objection of the respondent, the relevant part of which reads:

30 "We submit that your objections concerning the alleged confusibility of our mark with mark no. 15447 Montedison device and mark No. 24273 Mocassino are rather strained.

Our mark is not Montesinos but Francis Montesinos and the effect of the first word (FRANCIS) would, in our view, inevitably avoid any possibility of confusion with either of the cited registrations. Even if the word FRANCIS is ignored, the chances of confusion are minimal in our view. In particular, MOCASSINO is visually and orally quite different to MONTESINOS; even MONTEDISON is easily distinguishable. 5

Further the goods are different concerning both marks especially mark no. 24273 Mocassino.

For these reasons we submit that you should accept our mark. If, however, you are not satisfied with our arguments could you please fix the case for hearing, if possible, on 27/9/84 when we have other trade mark hearings." 10

As the respondent found that on the arguments put forward by counsel in his reply of the 28th May, 1984, he could not waive his objections to the registration of the trade mark, he fixed the case for hearing on the 27th September, 1984. 15

On the date of the hearing counsel for the applicants adopted the contents of his reply of the 28th May, 1984, and, further, submitted that a notice be sent to MONTEDISON. He further submitted that the goods were different. As it appears the respondent did not agree with the suggestion of the applicants' counsel to send a notice to the owners of Montedison trade mark. 20

By letter dated the 26th October, 1984, the respondent informed the applicants' counsel that he had re-examined the objection to the registration of the trade mark in the light of what counsel stated during the hearing of the case but he was unable to waive it and that he was re-affirming it. 25

On applicants' counsel request for the grounds of the decision of the respondent, the latter supplied to him in writing, on the 27th March, 1985, his said reasons, and as a result the present re-course was filed. 30

The Law that provides for the registration of trade marks is the Trade Marks Law, Cap. 268. In the present case the provision of this Law which is relevant is section 14(1) which reads:

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

10 In reaching his decision the respondent considered two questions which he thought that arose under section 14(1) of the Law, namely:

- 15 1) Are any of the goods in respect of which the applicants are seeking registration the same or of the same description as any goods of anyone or more of the relevant trade marks already on the Register and cited against the pending application;
- 20 2) If this question is answered in the affirmative, whether presuming use of the mark in a normal and fair manner, there will be a reasonable likelihood of deception or confusion arising among a substantial number of persons if the mark is allowed to be registered.

25 The respondent's reasoning in dismissing the arguments put forward by applicants' counsel appear in paragraphs 6 to 10 of the grounds of his decision and are the following:

30 "6. As far as the advocate's first point that the applicants' mark "Francis Montesinos" and "Montedison" are completely different, I find no real difference between the two marks *both phonetically and visually*. Further the name Francis in front of the name Montesinos makes no real difference to the two words 'Montesinos' and 'Montedison'. The two words Montesinos

and Montedison have only one letter different 's instead of d and the letters n and s reversed in the last syllable. These do not make a real difference to the two words, both so nearly resembling that it is likely 'to deceive or cause confusion' under s.14(1).

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"7. Concluding I found no real difference between the two marks and the main idea left on the mind by both may be the same.

"8. As regards the second point raised by the advocate that the goods in respect of the two marks are different, I find that the goods are in the same class 25 being both for clothing including shoes and footwear.

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"9. It is clear from the above classification of the goods of the propounded trade mark and of the cited trade mark that the goods for both, are goods of the same description.

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"10. As regards the 3rd point raised by the advocate to serve notice to the proprietors of the cited mark Montedison, it is important that the public should be protected. It is not a matter of two similar trade marks tolerating each other in the market or even consenting to the use of each other. If the Registrar is of the opinion that the two trade marks are identical or very similar as to cause confusion then the Registrar should refuse registration of the second mark."

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The Registrar then made some references both from Kerly's Law of Trade Marks and Trade Names as well as from decided cases in support of his findings.

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In Kerly's Law of Trade Marks and Trade Names, 12th ed. paragraph 17-03, p. 434, it is stated that the onus of proof, on an application to register when the Registrar objects on the basis of section 12(1), (see s. 14(1) in our Law) is on the applicant to satisfy the Registrar that the trade mark applied for is not reasonably likely to deceive or cause confusion.

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Counsel for applicants stated, amongst others, that the sub-
jice mark is different from the cited one, that is "Montedison" in
that it consists of two words and not merely and word "Montesi-
no". Under paragraph 17-08 (p. 439) of Kerly (supra) it is stated
5 that:

"Two marks, when placed side by side, may exhibit many and
various differences, yet the main idea left on the mind by both
may be the same. A person acquainted with one mark, and not
having the two side by side for comparison, might well be de-
10 ceived, if the goods were allowed to be impressed with the
second mark, into a belief that he was dealing with goods
which bore the same mark as that with which he was acquaint-
ed."

And under paragraph 17-11 (p. 443):

15 "The trade mark is the whole thing - the whole picture 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 of
the part or parts is enough to make the whole dissimilar."

Also, under paragraph 17-13 (p. 445) the following is stated:

20 "It has been accepted in several reported cases that the first syl-
lable of a word mark is generally the most important. It has
been observed in many cases that there is a tendency of per-
sons using the English language to slur the terminations of
words."
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In paragraph 17-15 (p. 446) it is stated that:

30 "The resemblance between two marks must be considered with
reference to the ear as well as to the eye. Whether confusion
will arise in the course of telephone conversations must also be
considered."

Lastly, in paragraph 17-07 (p.439) of the same book it is stated that:

".....it should be borne in mind that a decision on the question whether a mark so nearly resembles another as to be likely to deceive or cause confusion is not an exercise of discretion by a tribunal but a finding of fact." 5

Having carefully considered the merits of the case, in the light of the arguments advanced by counsel and the grounds of the decision of the Registrar, I find, bearing in mind the above, that it was reasonably open to the respondent to reach the sub judice decision and that the applicants have shown no cause for me to interfere with the decision of the Registrar. 10

In the result, this recourse is dismissed with costs against the applicants.

Recourse dismissed with costs against applicant. 15