

1988 December 28

[KOURRIS, J.]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

YIANGOS PENTALIOTIS AND CO. LTD. ,

*Applicants,*

v.

THE REGISTRAR OF TRADE MARKS,

*Respondent.*

(Case No. 291/87).

*Trade Marks—Registrability—Resemblance with a trade mark already in the Register—The Trade Marks Law, Cap. 268, section 14(1)—The Rules of comparison—Passages from Kerly's Law of Trade Marks and Trade Names, 11th Ed. Chapter 17, paras 17-07 to 17-41, pages 407-430 cited with approval—Disclaimed part of trade mark—In making the comparison, it should be taken into account.* 5

*Trade Marks—Registrability—Confusion or deception—The Trade Marks Law, Cap. 268, section 13—Mere possibility of confusion not enough—A tangible danger of confusion necessary—Matters to be considered in determining likelihood of deception—Similar to those which must be considered.* 10

*Trade Marks—Registrability—Judicial control—Principles applicable.*

In this case the Registrar accepted registration of "M MASER" as a trade mark for goods in class 25 with a disclaimer of "A" and on condition that notice should be given to inter alia, the owner of trade mark MAYER, registered for goods in the same class. The owner of the latter mark opposed the registration of "M MASER". The Registrar considered the opposition under sections 13 and 14(1) of Cap. 268 and, finally found that the opposition failed in that: 15

a) The similarity between the two marks was not to an extent prohibited 20

by section 14(1) and b) There was not tangible danger of confusion as to justify prohibition of registration under section 13.

Hence this recourse. The Court dismissed the recourse. In doing, so, the Court expounded the principles summarized in the hereinabove head-note.

*Recourse dismissed  
with costs.*

*Cases referred to:*

*Jellinek's Application* [1946] 63 R.P.C. 59;

10 *Seixo v. Provezende* [1895] L.R. 1 Ch. 192;

*Pepsi Co. v. The Republic* (1985) 3 C.L.R. 1092;

*Fisons Ltd. v. The Registrar of Trade Marks* (1985) 3 C.L.R. 2318;

*Beecham Group Ltd. v. The Republic* (1982) 3 C.L.R. 622;

15 *White Horse Distillers Limited v. El Greco Distillers Ltd. and others* (1987)  
3 C.L.R. 531.

**Recourse.**

20 Recourse against the dismissal of applicant's opposition to the registration of the words M MASER as a trade mark in Class 25 of Schedule IV of the Trade Marks Rules, 1951-1984 in respect of clothing made from woven and knitted material in favour of the interested party.

*G. Platritis*, for the applicant.

*L. Koursoumba (Mrs.)*, for the respondent.

*St. Triantafyllides*, for the interested party.

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*Cur. adv. vult.*

**KOURRIS J.** read the following judgment. The present recourse is directed against the decision of the Registrar of Trade Marks, dated 10th February, 1987, whereby he dismissed opposition No. 542 of the applicants to the registration of the words **M MASER** as trade mark in class 25 of Schedule IV of the Trade Mark Rules 1951-1984 in respect of women's, men's and children's clothing made from woven and knitted material in favour of the interested party.

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The salient facts of the present recourse are briefly as follows: On 5.7.1984, Mrs. Maria Maser Hedwing Thurnher and Rosemarie trading as Benedikt Maser from Austria (hereinafter called Maria Maser) filed Application No. 25111 with the Registrar of Trade Marks, for the registration of the words **M MASER** as trade mark in class 25 of Schedule IV of the Trade Marks Rules 1951-1984, in respect of women's, men's and children's clothing made from woven and knitted material.

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The application was accepted for registration in Part A of the Register of Trade Marks with disclaimer of the letter "M" and on condition that after advertisement in the Official Gazette of the Republic, notice of such advertisement should be sent to the owners of the following trademarks: B 14270 Mayer and 2340 NASR.

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On 8th January, 1985, notice of opposition was filed by Yiangos Pentaliotis and Co. Ltd. , who have been the registered owners of the Trade Mark No. B 14270 in class 25 **MAYER** written in plain capital letters for shoes, slippers, since 6.6.1972. On 17.9.1985, an affidavit sworn by Yiangos Pentaliotis, one of the directors of Yiangos Pentaliotis and Co. Ltd. , was filed. Another affidavit Sworn by E. Evangelou, an employee of the same company, we also filed on their behalf.

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On 26.2.1986, Maria Maser filed an affidavit declared by Nearchos Theodorou of Nicosia, one of the directors of Inter-sport Alpine and Marine Ltd. , who are the sole representatives of Maria Maser in Cyprus.

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On 11.3.1986, Yiangos Pendaliotis and Co. Ltd. , filed another affidavit. On 15.5.1986, Maria Maser applied to the Registrar for permission to file further evidence and such permission was granted with permission also to Yiangos Pendaliotis and Co. Ltd. to file further evidence in reply.

On 23.5.1986, Maria Maser filed further evidence and on 3.6.1986, Yiangos Pendaliotis and Co. Ltd. filed their reply.

On 19.6.1986, Maria Maser submitted their written address and on 23.7.1986, Yiangos Pendaliotis and Co. Ltd. submitted their own written address on 6.10.1986, Maria Maser submitted their reply and the case was fixed for clarifications on 12.12.1986.

The Registrar, having considered very carefully everything, properly put before him by the parties to those proceedings, including all the material facts and considering the admissible evidence and counsel's submissions, came to the conclusion that Maria Maser had discharged the onus of proof cast upon them that the opposition is not justified and, therefore, found that the opposition failed, and consequently she dismissed the opposition and directed that Application No. 25111 be proceeded to registration as advertised.

On 10.2.1987, the respondent's decision as aforesaid, was communicated to counsel for the applicant - Exhibit A appended to the opposition.

As a result, the applicant filed the present recourse challenging the sub judice decision and praying for its annulment on the ground, inter alia, that the Registrar acted under a misconception of law and/or fact and that the decision is not duly reasoned, and that the respondent registrar erred in admitting uncorroborated evidence which was also contradictory to the contents of paragraph 3 of the applicants' counter statement while she ignored the opponent's overwhelming corroborated evidence and documentary evidence generally and particularly about the opponent's use of the

mark in Cyprus.

As rightly stated by the respondent Registrar, in her sub judice decision, in reaching her decision the Registrar had to apply the following provisions of Section 13 and Section 14(1) of the Trade Marks Law, Cap. 268, which read as follows:-

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"Section 13. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which could 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.

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Section 14(1). Subject to the provision 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."

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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.

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Therefore, the Registrar had to consider whether the relevant applications offended against Section 14(1) and for this purpose she had to consider (i) whether the goods in respect of which the applicants (interested party in this recourse) were seeking registration were of the same description as any of the goods of the respondents, (applicants in this recourse): and (ii) if so the degree of resemblance presuming normal and fair manner of use of the goods. Also, she had to consider whether it offended Section 13.

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In considering the application under Section 14(1) the registrar examined first, whether the goods were of the same description after analysing properly the legal position with reference to the

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5 well-established criteria for determining such questions, and applying the test laid down in the judgment of Romer, J. in the course of *Jellinek's Application*, [1946] 63 R.P.C. 59 at page 70, the Registrar came to the conclusion that the goods were of the same description. Having found that the goods were of the same description, the Registrar then proceeded to the second issue which calls for consideration, namely a comparison of the marks. The Registrar quite legitimately compared the trade marks in the manner which well appears in Chapter 17 of Kerly's Law of Trade Names, 11th Edition, paragraphs 17-07 to 17-41, pages 10 407-430.

At page 407 of that book from the summing up of Lord Cranworth, in *Seixo v. Provezende* [1895] L.R. 1 Ch. 192, it is stated:-

15 "What degree of resemblance is necessary ..... is from the nature of things incapable of definition a priori.

And the standard of course is not always the same."

And further down on the same page of that book:-

20 "It follows that except in so far as they lay down any general principle, the decided cases are of little assistance in the determination of new questions of fact raised upon materials ..... In all cases, as stated above, 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 25 not an exercise of discretion by a tribunal but a finding of fact."

Same book pages 415-416 paragraph 17-19:-

30 "Common elements: some dicta. In *Broadhead's Application*, Evershed M.R. followed the observations of Lord Russell in *Coca Coca Canada v. Pepsi Coca 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 common - although it does not flow from 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 whole, and not disregard the parts which are common. 5

In the '*Kleenoff*' case Maugham L.J. said: 'In the present case my view is that the test of infringement where the trade mark has a descriptive element is the same as the test where it has no descriptive element, except so far as the descriptive element is itself common to the trade.' 10

In *Harrod's Application*, the Registrar stated: 'It is a well-recognised principle that has to be taken into account in considering the possibility of confusion arising between any two trade marks, that, where those two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features. This principle clearly requires that the marks comprising the common element shall be in fairly extensive use and, as I have mentioned, in use in the markets in which the marks under consideration are being or will be used.'" 15  
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Same book page 417 paragraph 17-22:-

"The resemblance between two marks must be considered with reference to the ear as well as to the eye."

And at page 418:-

"Examination of the reported case, shows that where the marks are meaningless words, or words of essentially similar character, the courts give as much weight to phonetic as to vis- 30

5 ual resemblance. But for a mere accidental phonetic resemblance (in the sense that the idea of the marks, once properly grasped is quite different) to convince the court of deceptive resemblance calls for something special: for a convincing demonstration that some context likely to occur in actual commerce would convert the accidental resemblance into something approaching identity of sound."

The same book under the heading "Evidence" page 424, states at paragraph 1734:-

10 "The question whether one mark so nearly resembles another as to be likely to deceive is a question for the tribunal and is not a matter for a witness. Thus where the case turns on phonetic resemblance, once the evidence has established how  
15 the marks are pronounced in use, the judicial ear has the final say. The question of infringement, the question whether one mark is likely to cause confusion with another, is a matter upon which the judge must make up his mind and which he and he alone must decide. He cannot abdicate the decision in that matter to witnesses before him. On the other hand, it is  
20 equally true that he must be guided in all these matters by the evidence before him and where the evidence is that there been no confusion that is a material matter which the judge must take into account."

And at pages 427-428 paragraph 17-38:-

25 "Proof of actual deception, if the mark is in the opinion of the tribunal likely to deceive or if it has been substantially copied from another is unnecessary. Nevertheless, if one or more cases of actual deception are made out to the satisfaction of the court, this will, of course, afford very strong evidence  
30 that the resemblance of the marks in question is so close as to be likely to deceive. The absence of evidence of actual deception is a circumstance which varies greatly in weight according to the nature of the case. Even where the proper inference to be drawn is that there has been no confusion, this cannot be con-



clusive by itself: the decision is for the court which cannot abdicate in favour of the witnesses. There may be differences of get-up or presentation which preclude confusion in the case of the particular goods concerned, notwithstanding that the marks are in themselves confusing similar. Nevertheless, where the marks have been circulating side by side in the market where deception is alleged to be probable, the fact that no one appears to have been misled is very material, unless satisfactorily explained."

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Same book page 423 paragraph 17-30:-

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"In general, the existence of a number of marks either as common marks or as trade marks, may operate to render a finer distinction allowable than would otherwise be the case, for the persons concerned in the trade in question may have had their attention directed to the kind of distinction which exists between the mark propounded and any of the others, because it is analogous to the known distinctions existing between the latter."

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The relevant passage of the decision of the respondent Registrar as stated in paragraphs 20 and 21 of the decision read as follows:-

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"20. Further and despite the provisions of s.16 on disclaimers I proceeded to compare further the two marks: The manner trade marks are compared, well appears in Chapter 17 of Kerly's Law of Trade Marks, 11th Ed. , paras 17-07-17-41. Comparing therefore the marks in the light of the said legal principles and bearing in mind that the resemblance must be considered with reference to the ear as well as to the eye I have reached the conclusion that they do not have considerable similarity both visually and phonetically to the extent prohibited by s. 14(1) of the Trade Marks Law Cap. 268 (as amended).

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21. Bearing in mind the above considerations and giving to the matter the most careful attention and considering the admis-

sible evidence and considering also the Counsel's submissions, I have reached the conclusion that the Opponent's objection under sec. 14(1) fails."

5 In the light of the above-quoted legal principles and the reasoning of the sub judge decision of the respondent Registrar, the Registrar was correct in her decision and it was reasonably open to her to reach her decision.

10 The above answers the contention of learned counsel for the interested party that the trade mark applied for covers goods not of the same description as those of the goods covered by the trade mark of the applicants. In my view the Registrar did not err in holding that these two categories of goods are goods of the same description.

15 Learned counsel for the applicants argued that the Registrar was wrong in finding that the two marks do not have considerable similarity both visually and phonetically to the extent prohibited by Section 14(1) of the Trade Marks Law, Cap. 268 (as amended).

20 I am of the view, that a mere comparison of the facsimiles of the two marks, the one proposed for registration under Application No. 25111 (which appears at R.3 of Exhibit B) and the one of the opponent under Registration No. B14270 (which appears at Rs. 12-11 of Exhibit A) and bearing in mind the rules of comparison expounded upon above, supports and substantiates the view of the Registrar that the similarity of the marks, if any, is  
25 not to an extent prohibited by Section 14(1).

Learned counsel for the applicants also alleged that the letter "M" which appears on top of the mark proposed for registration was disclaimed and therefore, did not count for registration.

30 On this point, I agree with learned counsel for the respondent that this view is not correct. Registrations subject to disclaimer are governed by the provisions of Section 16 of the Trade Marks

Law, Cap. 268 (as amended). The purpose and effect of disclaimer, however, which appears in Kerly's Book at pages 129-132, has nothing to do with the test of similarity, that is, one still has to look at the mark as a whole and does not exclude disclaimed words or letters in the comparison of the two marks. 5

The Registrar looked at the marks as a whole, paid more attention to dissimilar parts such as the shape, design, size, lettering and colour, without disregarding the similar parts, and considered them visually and phonetically.

The marks are written in a radically different character and they sound differently and the suggestions of applicant for accidental phonetic resemblance have to be substantiated by the affiant. The Registrar had to decide herself relying upon the evidence which established how the marks are pronounced in use and ignoring opinion evidence as to how they may be mispronounced and taking into account the considerations placed before her by evidence, it had not been contradicted, to the effect that, notwithstanding the long concurrent use of the two marks there had been no incidence of confusion. 10 15

I hold the view that the Registrar in applying the above considerations to the facts of the case in hand and considering the admissible evidence and discarding opinion evidence and properly treating the issue before her as a question of fact for the Registrar and not for a witness, has correctly reached the conclusions that the applicants before her (the interested party in this recourse) had discharged the onus of proof which was cast upon them to establish the non-likelihood of confusion and deception among a substantial number of persons of the marks were used by different proprietors in relation to the respective goods concerned. 20 25

I think that she properly decided that the probability of deception was not of a degree that could reasonably be considered as offending against Section 14 of The Trade Marks Law, Cap. 268. 30

The Registrar, having decided the matter under Section 14(1)

she then proceeded to consider the case under Section 13.

In considering a case under Section 13 it is commonly accepted that, although that Section is not limited to goods of the same description, the matters to be considered in deciding the likelihood of deception are necessarily somewhat similar to those to be considered under Section 14(1) (see *Pepsi Co. v. The Republic* (1985) 3 C.L.R. 1092 at page 1098).

It is pertinent, here to state paragraph 25 of the sub judice decision of the Registrar which reads as follows:-

10 "Reading carefully the affidavits submitted I am not convinced that by using the applicant's trade mark in the Cyprus market there is a likelihood of deception or confusion within the meaning of Section 13. To decide on this question I have in mind the test as in effect was laid down by late Farewell J. ,  
15 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 Court must be satisfied that there is a real tangible danger of confusion if the mark which is sought to be registered is put on the Register."

20 The test applied by the Registrar in relation to Section 13 in the present case was approved in *Fisons Ltd. v. The Registrar of Trade Marks* (1985) 3 C.L.R. 2318.

25 With regard to Section 13, learned counsel for the applicant contended that the Registrar in considering the evidence adduced, wrongly accepted the evidence submitted by the applicant (interested party in the present recourse) that their goods were used in the Cyprus market (though not corroborated) whereas, in his allegation, the Registrar did not accept the evidence of the opponents because it was without corroboration. He also alleged that the  
30 Registrar was wrong in giving undue weight to that fact that she had not been given an instance of actual deception or confusion.

I have considered the points raised by learned counsel for the

applicant and I am of the view that the combined effect of paragraphs 23, 24, 25 and 26 of the sub judice decision is that the Registrar considered all evidence adduced by both sides and in weighing the evidence adduced she was persuaded by the applicants for registration as to the use of their products in the market - though the evidence was not corroborated - partly because they produced invoices as proof of their submission and the Registrar found that this proof could not be rebutted by the uncorroborated opinion evidence of the opponent. 5

I am also of the view that the Registrar did not give undue weight on the issue of actual deception. She applied the established principles pertaining to the issue and she considered that, since no single instance of deception or confusion could be invoked, in spite of the long concurrent use of which she had convincing evidence, there was no real tangible danger of confusion if the mark which was sought to be registered was put on the register. 10 15

The approach of the Supreme Court as to when the Court should interfere with an administrative decision regarding the registrability of a trade mark, is that "this Court will not interfere with such description 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" (see *Beecham Group Ltd. v. The Republic* (1982) 3 C.L.R. 622 at page 633). 20

In a recent case, *White Horse Distillers Limited v. El Greco Distillers Ltd. and Others* (1987) 3 C.L.R. 531, it was held by the Full Bench of the Supreme Court that on the basis of the principles governing the exercise of its jurisdiction, as an administrative Court in the first instance and on appeal, does not interfere with an administrative decision regarding the registrability of a trade mark if such decision was reasonably open to the Registrar of Trade Marks and it does not substitute its own evaluation in the place of that of the Registrar. 25 30

In the present case, on the material before me, which was also

5 before the respondent Registrar and bearing in mind the well established principles that the trial Court does not interfere with the decisions of an administrative organ, nor does it substitute its own discretion to that of the administrative organ if the decision challenged was reasonably open to such organ, I have reached the conclusion that the applicant has failed to show good cause for interference with the Registrar's decision. I have come to the conclusion that it was reasonably open to her to decide as she did and her decision is, therefore, affirmed.

10 In the result, the recourse fails and is hereby dismissed with costs in favour of the respondent and in favour of the interested party. Costs to be assessed by the Registrar.

15 *Recourse dismissed  
with costs in favour of  
respondent and interested party.*