

1983 February 12

[A. LOIZOU, J.]

P.M. & G. STAVRINIDES CLOTHING INDUSTRIES LTD.,
Applicants,

v.

THE REPUBLIC OF CYPRUS, THROUGH
THE OFFICIAL RECEIVER AND REGISTRAR,
IN HIS CAPACITY AS REGISTRAR OF TRADE MARKS,
Respondents.

(Cases Nos. 175/81, 176/81 and 177/81).

Trade marks—Registration—Application to register the marks “JESUS”, “FERRARI” and “YOUNGSTER” in Part “A” Class 25, of the Register—Geographical name, surname, and mark having immediate relation with the character or quality of the goods and devoid of any distinctive characteristic, respectively— Principles governing registration—Restriction of registration of surnames extends to foreign as well as Cypriot names—Sections 11(1)(d) and (e) and 13 of the Trade Marks Law, Cap. 268. 5

The applicant company applied to the respondent Registrar to have the marks “JESUS” and “FERRARI” registered in Part “A”, Class 25 of the Register, in respect of dresses, shirts, trousers, ties, including shoes and slippers. It also, applied to have the mark “YOUNGSTER” registered in the same Part and Class of the Register in respect of shirts and ties. 10

The respondent Registrar refused the above applications on the ground that mark “JESUS” was a geographical name and that it was contrary to section 13 of the Trade Marks Law, Cap. 268 because the said mark could cause confusion as regards the origin of the goods. The registration of the mark “FERRARI” was refused on the ground that it was a surname and that it was contrary to section 13 of the law because it could cause confusion as regards the origin of the goods. Registration of the mark “YOUNGSTER” was refused in view of the provisions of paras. (d) and (e) of section 11(1) of the Law on the ground 15 20

that (a) it had immediate relation with the character or the quality of the goods and (b) was devoid of any distinctive characteristic.

Upon a recourse by the applicants:

5 *Held*, (1) that the mark "JESUS" being a geographical name, the purchasing public will be caused to wonder as to the origin of the goods concerned and this will cause confusion or deception within the meaning of section 13 of the Law; that the recourse against the refusal to register the mark "JESUS"
10 should fail as the respondent properly directed himself on the law and lawfully took the subject decision in the proper exercise of his powers and discretion under the Law and the Rules made thereunder, having duly taken into consideration all relevant matters placed before him on behalf of the applicant Company
15 and in the light of the absence of any evidence of distinctiveness or user having been adduced.

20 (2) That the restriction on the registration of surnames extends to foreign as well as Cypriot names, and the fact that such surname is not an indigenous one cannot have the effect claimed on behalf of the applicant; that no evidence of distinctiveness has been adduced to bring this case within the provisions of section 11(1)(e) of the Law and that section 13 is equally applicable; accordingly the recourse against the refusal to register the mark "FERRARI" should fail.

25 (3) That the mark "YOUNGSTER" propounded for registration has a direct reference to the character or quality of the goods and that its registration is prohibited by the provisions of section 11(1)(d) of the Law and that no evidence of distinctiveness has been produced at the hearing before the respondent
30 to bring the case of the applicant Company within the provisions of section 11(1)(e); that, moreover, objection could be taken under section 13 of the Law; accordingly the recourse against the refusal to register the mark "YOUNGSTER" should, also, fail.

35 *Applications dismissed.*

Cases referred to:

MADAME, [1966] R.P.C. 541 at p. 545.

Recourses.

Recourses against the decision of the respondent whereby he refused the registration under the Trade Marks Law, Cap. 268 of three trade marks "Jesus", "Ferrari" and "Youngster" to the applicants. 5

X. Xenopoulos, for the applicants.

S. Georghiades, Senior Counsel of the Republic, for the respondents.

Cur. adv. vult.

A. LOIZOU J. read the following judgment. By these three recourses which, because of their nature, have been heard together, the applicant Company challenges the decisions of the respondent, Registrar of Trade Marks by which he refused the registration under the Trade Marks Law, Cap. 268 (hereinafter to be called the "law"), of three trade marks "JESUS", "FERRARI", and "YOUNGSTER", on the grounds set out in his respective decisions which were communicated to the applicant Company and to which reference will be shortly made. 10 15

The applicant Company applied to have the mark "JESUS", registered in Part "A", Class 25, of the Register, in respect of dresses, shirts, trousers, ties, including shoes and slippers. The respondent by his letter dated the 27th December, 1980, informed the applicant Company that on the basis of paras. (d) and (e) of section 11(1) of the Law, same could not be accepted as the proposed mark was a geographical name and devoid of any distinctive character and also as there was objection on the basis of the provisions of section 13 of the Law which provides that: 20 25

"It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, 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". 30

By the same letter the attention of the applicant was drawn to regulation 32 of the Trade Marks Regulations, 1951 in accordance with which they could either ask for a hearing or send to the respondent a written reply within two months from the date of the said letter. The applicant Company asked for a hearing and a date was given by the respondent pointing out, inter alia, that 35

any evidence to be adduced at the hearing should be in accordance with the provisions of section 52 of the Law, otherwise it would not be accepted. In compliance thereto, an affidavit was filed claiming that the applicant Company was entitled to the registration of the said mark for two reasons:-

- (a) That the mark is not a geographical name and that it is not devoid of any distinctive characteristic, and
- (b) That as regards the objection on the basis of section 13, the said mark in no way could create any confusion and that this provision had no application to the case.

After counsel for the applicant Company was heard, the respondent informed the applicant of his decision by letter dated the 30th March, 1981, (see exhibit 2), which reads as follows:

"I wish to refer to the hearing dated 6th March, 1981, with regard to the aforesaid mark and inform you that your application has been re-examined on the basis of what was stated at the said hearing, including also the affidavit dated 28.2.1981 and it has not been possible to accept same as:

- (a) The aforesaid mark is a geographical name and it appears in the dictionary "Lippincott's Gazetteer" as follows:

Jesus: town (Dist. pop. 16,777) Paraguay.

" village (Pop. 1,763) Balearic Isls.

" Resort (Pop. 19) Peru.

" Island (Pop. 21,631).

Jesus Maria: 4 towns (Pop. 46,840), etc.

- (b) Is contrary to section 13 because the said mark can cause confusion as regards the origin of the goods.

Hence my objection which is contained in my letter dated 27th December, 1980, continues to exist and by the present letter same is confirmed".

With regard to the mark "FERRARI", the application again was to register same in Part "A" of the Register, Class 25, again in respect of the same goods as with the first mark.

By letter dated the 27th December, 1980, the applicant was informed that same could not be so registered because on the basis of the provisions of para. (d) of section 11(1) of the law, the proposed mark is a geographical name and surname and there was also objection under section 13 of the law. 5

The procedure of hearing was gone through, and an affidavit was filed on behalf of the applicant Company claiming therein that they are entitled to its registration for two reasons: (a) That it is possible to be used as a surname or it is possible to be a geographical name but this does not affect its distinctive characteristic and it is not possible to exclude its registration, and 10 (b) Regarding the objection on the basis of section 13 that it could not create any confusion and that same had no application to the case.

The decision of the respondent was communicated to the applicant Company by letter dated the 30th March, 1981, (see exhibit 3) who were informed that their application had been re-examined and that it did not become possible to accept same as: 15

“(a) The said mark is a surname and appears in the following telephone directories: 20

Roma Dir. — Ferrari — about 800 times

London Dir. — ” — ” 70

Paris Dir. — ” — ” 75 ”

(b) Is contrary to section 13 as the said mark can cause confusion as regards the origin of the goods. 25

Consequently my objection which is referred to in my letter dated 27th December 1980, continues to exist and is confirmed by this letter.”

The third mark “YOUNGSTER” was also sought to be registered in part “A” of the register, in Class 25, in respect of shirts and ties. The respondent by his letter dated the 27th December, 1980, refused its registration in view of the provisions of paras. (d) and (e) of section 11(1) of the Law, on the ground that (a) it had immediate relation with the character or the quality of the goods, and (b) Is devoid of any distinctive characteristic. Moreover, as there were objections on the basis of 30 35

section 13 of the Law and a note was made thereto that the said mark indicates that the goods will be intended for young people (11(1)(d)), if not, then it is deceptive (section 13).

5 The same procedure for a hearing was gone through, an affidavit was filed on behalf of the applicant Company in which it is claimed that they were entitled to the registration of the said mark on two grounds:

- 10 (a) The mark has no relation with the character or the quality of the goods, nor is devoid of distinctive characteristic and nowhere from its contents as well as its construction and meaning it can be inferred that the mark indicates that the goods are intended for young people (11(1)(e)) and in nowhere the mark is in any way deceptive, and
- 15 (b) With regard to the objection on the basis of section 13 it was claimed that it could not create confusion and that this section has no application to this case.

20 The decision of the respondent was communicated by letter dated 21.3.1981 (see exhibit 4), to the applicant Company whereby they are informed that the application was re-examined and that the objections contained in the letter of the 27.12.1980 continued to exist and the application was therefore, dismissed.

25 As against the aforesaid decisions, these three recourses have been filed. In Recourse No. 175/81 the argument advanced on behalf of the applicant Company was that the geographical names referred to by the respondent were very remote and in any case not connected with Cyprus at all. Section 11 of the law, in so far as relevant, reads as follows:

30 "11(1) In order for a trade mark to be registrable in Part A of the register, it must contain or consist of at least one of the following essential particulars:-

- (a) _____
- (d) a word or words having no direct reference to the character or quality of the goods, and not being according to its ordinary signification a geographical name or a surname;
- 35 (e) any other distinctive mark, but a name, signature, or

word or words, other than such as fall within the descriptions in the foregoing paragraphs (a), (b), (c) and (d), shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness".

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In *Kerly's Law of Trade Marks and Trade Names*, 10th Ed., para. 8-33, page 116, it is pointed out that "when the Act of 1883 allowed the registration of fancy words not in common use, an objection to a word on the ground of its being geographical was, in many cases, upheld. As will be seen from what is said below, many words, especially coined words, that on their face are eminently suitable for use as trade marks, are excluded from section 9(1)(d) as geographical names. It does not follow that they are totally unregistrable: they may or may not be registrable on proof that they are distinctive in fact: see below the discussion of section 9(1)(e). Thus, the important question under this head is less often 'Is this mark a geographical name?' than 'How strong must the evidence of distinctiveness be, to render this mark registrable?'".

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Likewise in *Halsbury's Laws of England*, 3rd Ed., Vol. 38, para. 867, the following is said:-

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"*Geographical names* - The words not being 'according to its ordinary signification a geographical name' in the fourth essential particular are not to be given such a wide interpretation that a word becomes a geographical name simply because some place upon the earth's surface has been called by it".

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A word, however, is not debarred from registration under section 9(1)(e) as a distinctive word merely because it is geographical and so cannot be registered under section 9(1)(d). As pointed out in *Kerly's* (supra), para. 8-51, p. 129:-

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"..... Some geographical names can be inherently adapted to distinguish the goods of particular traders: but only if it can be predicted that they are such names as it would never occur to any other trader in such goods to use. At the other extreme, the name of a major industrial area or city will be totally unregistrable in respect of almost any goods. In between come the marks calling for more

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or less evidence that they are distinctive in fact: see the illustrations below. It may tip the balance that the applicant can show that he has a natural or legal monopoly of the production of the goods concerned in the place concerned: but that alone will not make a geographical name registrable without substantial evidence of distinctiveness”.

In the light of the above statement of the law, which I fully adopt, it was pointed out on behalf of the respondent that the mark “JESUS” could be registered under the provisions of section 11(1)(e) of the law as a distinctive mark, but the applicants failed to submit evidence of distinctiveness to bring their case within the said provision.

On these grounds alone and without reference to section 13 of the law at length, except to say that being a geographical name, the purchasing public will be caused to wonder as to the origin of the goods concerned and this will cause confusion or deception within the meaning of the said section, this recourse should fail as the respondent properly directed himself on the law and lawfully took the subject decision in the proper exercise of his powers and discretion under the Law and the Rules made thereunder, having duly taken into consideration all relevant matters placed before him on behalf of the applicant Company and in the light of the absence of any evidence of distinctiveness or user having been adduced.

With regard to the mark “FERRARI”, the subject of Re-course 176/81, the same applies in respect thereof that has just been said about geographical names. As to the question of being a surname, it was argued on behalf of the applicant Company that it is a very rare name and non-existing in Cyprus at all as such. The restriction regarding registration of surnames is contained in section 11(1)(d) hereinabove set out and in *Kerly's* (supra) at para. 8-37, p. 120, it is stated:

“..... The restriction extends to foreign as well as English surnames.

It seems now established that any application for the admittance of a surname to registration ought to be most

closely scrutinised and acceptance of it obtained only where its distinctive character is quite clearly proved'. Very common surnames are registrable, if at all, only upon overwhelming proof that in fact they are distinctive: see the discussion, on proving distinctiveness of surnames below, in connection with section 9(1)(e). The Registrar's practice is to require some evidence of distinctiveness for any word which is a surname at all, unless it is both a very rare surname and also is an ordinary English word, with an overwhelmingly commoner and better-known meaning otherwise than as a surname. Since, however, spelling is important in distinguishing surnames from each other, there is little room for objecting to a mark on the ground that it is a misspelt surname." 5 10

An approach regarding distinctiveness and their possibility of registration as such is to be found in *Kerly's* (supra), para. 8-52, p.130, where it is stated: 15

"Surnames (and, a fortiori, complete personal names) may undoubtedly be registered, upon sufficient proof of distinctiveness. But such registrations should not be granted lightly: the tribunal must consider not merely any other persons of the same surname who may at the time be engaged in related trades, but also any who may wish to do so in the future". 20

Further elaboration of the subject is to be found in para. 8-53 of *Kerly's* (supra) but for the purposes of this judgment a further reference to it is unnecessary. No doubt the restriction on the registration of surnames extends to foreign as well as Cypriot names, and the fact that such surname is not an indigenous one cannot have the effect claimed on behalf of the applicant. Moreover, as in the other case, no evidence of distinctiveness has been adduced to bring this case within the provisions of section 11(1)(e) of the law. Section 13 is equally applicable for the same reasons as in the previous case. 25 30

On these grounds this recourse should also fail. 35

With regard to the mark "YOUNGSTER", the subject of Recourse 177/81, it has been argued on behalf of the applicant Company that according to the Oxford Concise Dictionary, the

word "youngster" is a noun and it means a child, active or lively boy and it has been submitted that the objection that the mark has direct reference with the nature or character of the goods cannot stand as it will cover shirts and ties which, of course, have no relation with the word "child". The answer to this submission advanced on behalf of the respondent is that the word "YOUNGSTER" is in general a word which should be left open for traders to use free not only in describing their goods but in framing publicity of a more general nature in connection with their goods and that they should not be embarrassed in such use by having to exercise caution lest they use the word in a way which could be taken as being used as a trade mark or as indicating a connection in the course of trade. Reference in that respect has been made to the case of "*MADAME*" [1966] R.P.C. 541, at p. 545. If, on the other hand, the contention of the applicant Company that this trade mark will cover shirts and ties is accepted, then the mark is contrary to section 13 of the law as being deceptive as to the character or quality of the goods. Support can be found in *Kerly's* (supra), para. 10-31, where it is stated:

"A mark may be disentitled to protection, as being deceptive as to the quality of goods on which it is used. In particular, a mark which would be objectionable on particular goods, as being directly descriptive, is likely to be deceptive for somewhat different goods, which do not have the quality described".

It is the case for the respondent that the mark propounded for registration has a direct reference to the character or quality of the goods and that its registration is prohibited by the provisions of section 11(1)(d) of the Law and that no evidence of distinctiveness has been produced at the hearing before the respondent to bring the case of the applicant Company within the provisions of section 11(1)(e). Moreover objection could be taken under section 13 of the Law.

For all these reasons this recourse should also fail.

On the material before me, I have come to the conclusion that the decisions of the respondent Registrar were reasonably open to him, they were arrived at by proper exercise of his power and discretion under the Law and the rules made there-

under and after having taken into consideration all relevant matters and therefore all recourses are dismissed but in the circumstances I make no order as to costs.

*Recourses dismissed. No order
as to costs.*

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