

1986 January 17

[LORIS, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

MARS INCORPORATED OF THE STATE OF
DELAWARE, U.S.A.,

Applicant,

v.

- THE REPUBLIC OF CYPRUS, THROUGH
- 1. THE MINISTER OF COMMERCE AND
INDUSTRY, AND/OR
- 2. THE REGISTRAR OF TRADE MARKS,

Respondents.

(Case No. 5/84).

The Trade Marks Law, Cap. 268, ss.19(3), 11(1)(d) and (e), 11 and 12—When can an application for registration of a trade mark in part “A” of the Register be treated as an application for registration in Part “B”—Differences between the requirements for registration in Part “A” and the requirements for registration in Part “B”—Requirements for registration in Part “B”—According to s.12(2) the proposed mark should be “inherently capable of distinguishing” and by reason of its use or of any other circumstances “in fact capable of distinguishing”—As regards the second requirement the applicant should adduce evidence before the Registrar as to the use of the proposed trade mark.

Constitutional Law—Constitution, Article 28.1.

The applicants applied to the Registrar of Trade Marks for the registration in part “A” of the Register of trade mark “MR. DOG”. (Written in plain capital letters) for goods in respect of foodstuffs for animals and animal litter, classified in class 31 of the International Classification of goods.

The respondent Registrar raised three objections to the said registration. As a result the applicants applied for a hearing before the Registrar. During such hearing they produced the consent of the proprietors of the registered Trade Mark "TOP DOG" to their proposed registration and submitted without adducing any evidence that the proposed registration be accepted in part "B" of the Register.

On 17.12.83 the respondent gave his decision on the matter. He reaffirmed one of his objections, namely his objection under s. 11 (1) (d) and (e) of Cap. 268 to the effect that the words so sought to be registered had direct reference to the character or quality of the goods in question, and dismissed the application on this ground.

Hence the present recourse. The applicants complained, inter alia, that the sub judice decision is contrary to the Constitution. In their written address they referred to Article 28.1 of the Constitution as the basis of their such complaint.

Held, dismissing the recourse (1) According to the provisions of s. 19(3) of Cap. 268 the Registrar, in dealing with an application for registration in part "A" of the Register, may, if the applicant is willing, instead of refusing it, treat such application as an application for registration in Part "B" of the Register. In this case the applicants were not only so willing, but in fact they themselves abandoned their claim for registration in Part "A" and invited the registrar to treat their application as an application for registration in Part "B". It follows that the recourse should not have included any complaints for refusal to register the proposed trade mark in Part "A" of the register.

(2) The relevant section of our Trade Marks Law, Cap. 268 in respect of registration of trade marks in Part "B" of the Register is section 12.

Section 12(2) reads as follows:

"12(2) In determining whether a trade mark is capable of distinguishing as aforesaid the Registrar may have regard to the extent to which -

- (a) the trade mark is inherently capable of distinguishing as aforesaid; and
- (b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.”

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(3) In the light of the provisions of s. 12(2) the Registrar had to examine whether (a) the proposed trade mark was inherently capable of distinguishing, and (b) By reason of the use of the proposed trade mark or any other circumstances it was in fact “capable of distinguishing”. The first of these requirements falls to be considered solely by the examination of the marks applied for, irrespective of the peculiarities, if any, of the trade. As regards the second requirement the applicant should adduce evidence of use of the mark in question. As the applicants did not adduce any such evidence the Registrar had to confine his inquiry to the first of the above requirements.

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(4) This Court will not substitute its discretion for that of the Registrar. Since the latter exercised such discretion judicially and as it is apparent that he did not act in abuse or excess of power or contrary to Law his decision cannot be annulled.

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(5) Questions of unconstitutionality have to be raised with sufficient clarity and in quite unequivocal terms. The burden of proving unequal treatment was on the applicants. The applicants in this case simply alleged that the words “TOP DOG” were registered without the adduction of evidence, whilst the Registrar replied that they were so registered after adduction of evidence of long use. The applicant did not call any evidence as to their allegation. It follows that their complaint of unconstitutionality is doomed to failure.

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Recourse dismissed.

No order as to costs.

Cases referred to:

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Mister Donut Trade Mark [1983] R.P.C. 117;

Merck v. The Republic (1982) 3 C.L.R. 548;

Curzon Tobacco v. The Republic (1979) 3 C.L.R. 151;

The Republic v. Nishan Arakian and Others (1972) 3 C.L.R. 294;

5 *Loizides v. Mayor of Nicosia*, 1 R.S.C.C. 59;

The Improvement Board of Eylendjia v. Constantinou (1967) 1 C.L.R. 167;

Ayios Andronicos Development Co. v. The Republic (1985) 3 C.L.R. 2362.

10 **Recourse.**

Recourse against the decision of the respondent not to accept the registration in Part A or Part B of the Register of the trade mark "MR. DOG".

G. Platritis, for the applicants.

15 *St. Ioannides (Mrs.)*, for the respondents.

Cur. adv. vult.

LORIS J. read the following judgment. The applicants, a concern registered as a company under the laws of the State of Delaware, U.S.A., applied, through their advocate
20 in Cyprus, under application No. 23355 dated 12th January, 1983 to respondent No. 2, the Registrar of Trade Marks, Cyprus, for the registration in part "A" of the Register, of trade mark "MR. DOG" (written in plain capital letters) for goods in respect of foodstuffs for animals
25 and animal litter, classified in class 31 of the International Classification of goods.

The respondent Registrar raised the following three objections to the aforesaid proposed registration set out in his letter dated 4.2.83 (vide red 6 in exh. 1) addressed to
30 counsel for applicants:

- (a) An objection under s. 14(1) of the Trade Marks Law Cap. 268, to the effect that goods proposed to be registered were identical and/or they did so nearly resemble to a trade mark belonging to a different pro-

prietor already on the register (i.e. Trade Mark "TOP DOG" under registration No. B 15455).

- (b) An objection under s.11(1)(d) & (e) of Cap. 268 to the effect that the words so sought to be registered had direct reference to the character or quality of the goods in question. 5
- (c) An objection under s.13 of Cap. 268 which prohibits the registration of a trade mark by reason of its being likely to deceive or cause confusion etc... 5

The applicants applied for a hearing before the Registrar which was held on the 4th October 1983; during the afore-said hearing (the minutes of which appear in red 14 of ex. 1) the applicants produced the consent of the proprietors of the registered trade mark under No. B 15455 ("TOP DOG") to their proposed registration under Application No. 23355 ("MR. DOG"). 10 15

Learned counsel for applicants without adducing any evidence submitted that the proposed registration be accepted in part "B" of the Register.

The respondent Registrar reserved his decision on 4.10.1983, after hearing counsel for applicants; on 17.12.83 he gave his decision appearing in red 15 of ex. 1, whereby he waived his objection under s.14(1) of Cap. 268 only, but reaffirmed his previous objections under s.11(1)(d) & (e) of Cap. 268 refusing to register the proposed trade mark of the applicants. 20 25

The applicants filed the present recourse praying for "Declaration by the Court that the decision of the Registrar of Trade Marks dated 17.11.83, and communicated to the applicants through their agents in Cyprus and by which the Registrar did not accept the registration in Part A or Part B of the Register their application No. 23355 MR. DOG, is void and of no effect whatsoever, as decided against the Law, the provisions of the Constitution and/or in excess or abuse of powers." 30 35

It is significant to note that in paragraph 5 of the statement of facts relied upon in support of the present case the applicants state verbatim the following:

5 "5. Hence the present application by which the applicants submit that trade mark No. 23355 'MR. DOG' is a good and registrable mark in Part A of the Register in as much as the above mentioned trade mark No. B 15455 'TOP DOG' was accepted and registered in Part B of the Register."

10 In this connection it must also be noted that learned counsel for applicant in his written address, filed four and a half months after the filing of the recourse, states the following verbatim.

15 "However, the applicants having met with the refusal of the Registrar to accept their application in Part A of the Register decided to abandon Part A registration and proceeded only for its registration in Part B of the Register.

They have also done so during the hearing of the 4.10.83 when they invited the Registrar to have the application transferred for registration from Part A, to one in Part B of the Register.

20 It is therefore my submission that the mark applied for by the applicants namely No. 23355 'MR. DOG' in plain block letters is a good and registrable mark in Part B of the Register."

25 And the written address filed on behalf of the applicants goes on to add further down under the heading "Facts" the following:

30 "And in spite of the fact that... during the hearing of the application the applicants requested the transfer of the mark from part A of the Register to Part B thereof, this was entirely ignored and not dealt with by the Registrar as he had a duty to do..."

35 It must be stated at the outset that the following facts are abundantly clear from the statement of facts of both sides, their written address and the relevant material in ex. 1:

- (a) The application submitted on behalf of the applicants on 12.1.83, was an application for the pro-

posed registration of the trade mark in question, in part A of the Register.

- (b) The said application was converted by the applicants themselves into an application for registration in Part B of the Register as early as 4.10.1983 i.e. the date of the hearing of the aforesaid application by the Registrar. (Vide red 14 in ex. 1 - as well as the relevant statement of the applicants themselves in their written address.)

The respondent Registrar in examining an application for registration in Part A, may, according to the provisions of s. 19(3) of Cap. 268, instead of refusing the application treat it, if the applicant is willing, as an application for registration in Part B of the Register.

Section 19(3) of the Trade Marks Law, Cap. 268 reads as follows:

“19 (1)

(2)

- (3) In the case of an application for registration of a trade mark in Part A of the register, the Registrar may, if the applicant is willing, instead of refusing the application, treat it as an application for registration in Part B and deal with the application accordingly.”

In this particular case as the applicants themselves admit they were not only willing to have their application treated as an application for registration in Part B, but in fact they abandoned their claim, on 4.10.83, for registration in Part A and they themselves invited the Registrar to treat their application for registration in Part B.

Therefore it is clear that the Registrar after the production of the consent of the proprietors of the registered trade mark under No. B15455, and the waiving of his objection under s. 14(1) of Cap. 268, had only to examine the application for registration of the applicants, treating it same as an application for registration in Part B of the Register.

In the circumstances the present recourse (filed on 7.1.84 i.e. more than three months after the hearing before the Registrar, when the claim for registration under Part A of the Register was abandoned) should not include any
 5 complaints for refusal of the Registrar in registering the proposed trade mark in Part A of the register, and submissions like the one appearing in paragraph 5 of the statement of facts, should be avoided.

Reverting now to the task of the respondent Registrar; as already stated above after the production of the consent
 10 of the proprietors of the registered trade mark under No. 15455 and the consequential waiver of his objection under s. 14(1) of Cap. 268, he had to examine only the application of the applicants in the light of their request treating
 15 same as an application for registration in Part B of the Register.

The relevant section of our Trade Marks Law, Cap. 268 in respect of registration of trade marks in Part B of the Register is section 12.

20 Section 12(2) reads as follows:

“12. (2) In determining whether a trade mark is capable of distinguishing as aforesaid the Registrar may have regard to the extent to which -

(a) the trade mark is inherently capable of distinguishing as aforesaid; and
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(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact capable of distinguishing as aforesaid.”

Both sections of our Trade Marks Law, Cap. 268
 30 dealing with registrability of trade marks i.e. section 11 in respect of registrability in Part A of the Register and section 12 in respect of registrability in part B of the Register are identical with the relevant sections 9 and 10 of the English Act of 1938.

35 In Kerly's Law of Trade Marks and Trade Names, 10th edition, the following are stated at p. 153.

"It will be apparent on comparing section 10 with section 9 that so far as registrability is concerned, the differences between Part A and Part B are (1) that in the former the mark must be 'adapted to distinguish' and in the latter 'capable of distinguishing' (the context being virtually identical); and (2) that in the case of names, signatures or words which do not fall within paragraphs (a) to (d) of section 9(1), so registration in Part A can only be granted upon evidence of distinctiveness, such evidence is not required in Part B if it is possible without evidence to satisfy the tribunal that the mark is capable of distinguishing the goods..."

Dealing with the question of "capability of distinguishing" the same textbook at pages 154 and 155 states the following:

"Since the 1938 Act, however, most registrations in part B have been of new marks, whereas under the 1919 Act two years' use of the mark was a precondition of the registration. In relation to applications for registration of new marks, the language of section 10 calls for further consideration. The section draws a distinction between marks that are 'inherently capable of distinguishing', and marks that (although inherently not capable of distinguishing), have nevertheless acquired that capability in use. Accordingly, it is not enough for the applicant in such a case to establish that the mark 'may thereafter become distinctive' of his goods (in Lawrence L.J's words): where he cannot point to actual use of the mark (or to 'other circumstances' showing some degree of distinctiveness) he must show an inherent capacity for distinctiveness going beyond the mere possibility of the mark's some day becoming distinctive and 'there are degrees of inherent capacity.' The difference is not an easy one to put into words, perhaps because the language of the section is not entirely consistent... Perhaps a rough rule might be, that the applicant must show the two year's use required under the old section, and then bring himself within the observations in the 'Ustikon' case that were quoted earlier in this paragraph."

In the application of *Mister Donut Trade Mark* [1983] R.P.C. 117 the applicant sought part A registration of the mark MISTER DONUT; objection to the application was taken under sections 9, 10 and 11 of the Trade Marks Act, 1938. At a later stage the section 11 objection was not maintained. The remaining objections were maintained and the application refused under part A; the applicant then sought to register under part B. There was no evidence that the mark had been used.

The application was refused as failing to satisfy the provisions of either section 9 or section 10 of the Act. Dismissing the application for registration in part B of the Register the Registrar stated the following:

“I have considered whether this application could be accepted as one for registration in part B of the Register, assuming the applicants would be willing to have it so treated under the terms of section 17(3) of the Act. Bearing in mind the laudatory nature of the mark when applied to doughnuts, and the common practice of other traders to refer to themselves in this way. I am of the opinion that it is not prima facie ‘capable of distinguishing’ as required by section 10 of the Act, and the applicant’s existing registrations are insufficient to overcome its inherent defects.” (Vide p. 121 of the report lines 14-20).

It is noteworthy from the statement of the facts in the aforesaid case at page 118 (lines 11-14) that “on their form of application the applicants state that the mark is being used but they have filed no evidence of such use of the mark in the United Kingdom prior to the date of application.”

Reverting now to the facts of this case:

The respondent Registrar had to examine (after the waiver of his objection under s. 14(1) of Cap. 268) according to the provisions of s. 12(2) whether (a) the trade mark proposed to be registered was inherently capable of distinguishing.

(b) By reason of the use of the trade mark or of any

other circumstances, the trade mark was in fact "capable of distinguishing."

As regards the first of these requirements, the matter falls to be considered solely by examination of the mark applied for; that is to say irrespective of the peculiarities, if any, of the trade (vide Kerly - supra - at p. 156). 5

As regards the second requirement, having considered the wording of s. 12(2) (b) and the authorities cited above in this connection I hold the view that the applicant ought to adduce evidence of use of the trade mark in question. The form of such evidence according to the provisions of s.52 of Cap. 268 should be evidence by affidavit in the absence of directions to the contrary. 10

The applicants failed to adduce any evidence whatever: in fact they did not even assert in their application or even orally at the hearing that there was any use of the trade mark in question in Cyprus, prior to the date of the application. 15

So the respondent Registrar had to confine his enquiry to the requirement under (a) of s. 12(2) i.e. he had to consider solely the trade mark applied for; this he did; it is clear from red 15 of ex. 1, and to hold otherwise I must have before me evidence which rebuts the presumption of regularity, which is not the case. After all the Registrar had nothing else to examine after the waiver of his objection under s. 14(1) of Cap. 268 and the absence of any evidence in respect of s. 12(2) (b). 20 25

This Court will not substitute its discretion for that of the Registrar, the appropriate authority under the Law in this case, since he exercised same judicially and as it is apparent from all the material before me including the various documents in ex. 1 he neither acted in abuse or excess of power nor contrary to Law (*Merck v. The Republic* (1972) 3 C.L.R. 548 at p. 564, *Curzon Tobacco v. Republic* (1979) 3 C.L.R. 151 at p. 158). 30 35

Before concluding I feel dutybound to deal with the last ground of Law I have omitted to deal so far; the ground of

alleged unconstitutionality of the decision of the respondent Registrar.

The ground is stated verbatim as follows in the grounds of law on the main application.

5 “The decision of the Registrar is also against the provisions of the Constitution.

 The words ‘MR. DOG’ are a good and registrable mark inasmuch as the Registrar accepted and registered trade mark No. B15455 ‘TOP DOG’ which is almost
10 the same mark.”

My first observation is that applicants were not put at pains even to mention the Article of the Constitution which is being allegedly violated.

15 It is true that in the written address filed on behalf of the applicants reference is made to the *Republic v. Nishan Arakian and others* (1972) 3 C.L.R. 294 and Article 28.1 of the Constitution.

20 I feel that I should stress once more that questions of alleged unconstitutionality have to be raised with sufficient clarity and in quite unequivocal terms. (*Loizides v. Mayor of Nicosia* 1 R.S.C.C. 59, *The Improvement Board of Eyledjia v. Constantinou* (1967) 1 C.L.R. 167, *Ayios Andronikos Development Co. v. The Republic* R.A. 388 in which judgment was delivered on 20.11.85. still unreported).*

25 The burden of proving unequal treatment was on the applicants and the applicants failed to establish such unequal treatment; mere reference to the decision in trade mark N.B.15455 is not enough.

30 The applicants allege that the decision of the respondent Registrar in that case was reached at without the adduction of any evidence. The respondent on the contrary maintains that the trade mark in question was placed on the Register of Trade Marks properly after adduction of evidence of long use.

35 The applicants had the opportunity in reply to challenge

* Reported in (1985) 3 C.L.R. 2362.

this disputed, by the respondent, fact; instead they confined themselves in reply to mention "that they would not like to add any argument about the provisions of the Constitution," and they refrained from calling any evidence about the alleged unequal treatment they are complaining, or any other evidence whatever concerning the facts and circumstances of the case in trade mark under No. B15455. 5

The complaint for unconstitutionality therefore is doomed to failure as well.

In the result the present recourse fails and it is accordingly dismissed. 10

Let there be no order as to costs.

Recourse dismissed.
No order as to costs.