

1986 April 19

[PIKIS, J.]

IN THE MATTER OF ARTICLE 146
OF THE CONSTITUTION

PELETICO LIMITED.

Applicant,

v.

THE REGISTRAR OF TRADE MARKS.

*Respondents.**(Case No. 542/85).*

Trade Marks—The Trade Marks Law, Cap. 268, ss. 13 and 19—Distinctiveness—Laudatory words—Association between the mark and the goods—If strong, it may import distinctiveness—When considered as strong—Application for registration of the word TROPHY for paints and related products—In the circumstances correctly rejected.

5

The respondent refused registration of the word TROPHY as a trade mark for applicant's products, namely paints and related products, on the following grounds, i.e. (a) Connection of the mark with the character or quality of the goods, and (b) Lack of distinctiveness.

10

As a result applicants filed the present recourse.

Held, dismissing the recourse: (1) The word TROPHY in whatever context it may be used signifies a prize or reward. It is a laudatory word connoting praise. For this reason its use is not neutral about the character or quality of the goods. The inference that it is descriptive of the character or quality of the goods cannot be denied.

15

(2) Distinctiveness is the hallmark of registration as well as the test of determining the likelihood of deception under s.13 of Cap. 268. A word may be created with imagination and sound 'or look attractive, but it must not be des-

20

criptive, confusing or deceptive as to the origin, quality and attribute of the goods.

5 (3) Strong association of the mark with the goods may exceptionally import distinctiveness. For this to be the result there must be long user in point of time and trading on a large scale. There was evidence of neither in this case, nor can anyone suggest that the association between TROPHY and the applicant's products was such as to import distinctiveness.

10 *Recourse dismissed.*
No order as to costs.

Cases referred to:

Crosfield (Joseph) and Sons App. (1910) 1 Ch. 130;
Stavrinides Clothing v. The Republic (1983) 3 C.L.R. 98;
15 *Plough Inc. v. The Republic* (1985) 3 C.L.R. 1687;
Granada v. The Republic (1985) 3 C.L.R. 207;
El Greco Distillers v. The Republic (1985) 3 C.L.R. 1189;
Societe Anonyme v. The Republic (1986) 3 C.L.R. 350.

Recourse.

20 Recourse against the decision of the respondent refusing registration of "TROPHY" as trade mark for the paints and related products of the applicants.

K. Chrysostomides, for the applicants.

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

25 *Cur. adv. vult.*

30 PIRIS J. read the following judgment. At issue is the validity of the decision of the Registrar of Trade Marks refusing registration of "TROPHY" as trade mark for the paints and related products of the applicants, manufacturers of building material. Applicants applied, in the first place, for the registration of "TROPHY" in class 2 of part 'A' of the register. After the initial refusal of the Registrar

(communicated on 24.10.1984), applicants sought a hearing of their application under the Trade Mark Rules requesting registration of "TROPHY" in part 'B' of the register as an alternative in the event of the Registrar finally ruling out registration in part 'A' of the register(1). It is doubtful whether it was at all open to the Registrar to consider the alternative application of the parties in view of the provisions of s. 19 of the Trade Marks Law - Cap. 268 - envisaging an application to the Registrar in the prescribed form for registration in either part 'A' or part 'B' of the register. However, it is unnecessary to pursue the matter further for the reasons of the Registrar refusing registration in part 'A' of the register are equally relevant and applicable to the disposal of an application for registration in part 'B' of the register. After reconsideration of the matter the Registrar persisted in his views reaffirming his original decision(2). The reasons for refusal were:-

(a) Connection of the mark with the character or quality of the goods, and

(b) Lack of distinctiveness.

The word "TROPHY" in whatever context it may be used it invariably signifies a prize or reward(3). It is a laudatory word connoting praise. For this reason its use is not neutral about the character or quality of the goods. In the opinion of the Registrar it is descriptive of the character or quality of the goods, an inference that cannot be denied having regard to the settled meaning of the word.

The position with regard to laudatory words is summarized in *Kerly*(4) as follows: "A merely laudatory epithet

(1) See letter dated 4 3 1985

(2) See letter of 4 4 1985

(3) See *The Concise Oxford Dictionary*, 6th Ed., p 1244, and *Mega Angloelliniko Lexiko*, Tome 4, p 713

(4) *Law of Trade Marks and Trade Names*, 10th Ed., p 124

is not registrable as a trade mark regardless of the extent of use. This was established in the "Perfection" case. The same rule applies to nouns with a settled laudatory signification⁽¹⁾. The registrability of "Perfection" as a trade mark was debated in *Crosfield (Joseph) & Sons Appn.*⁽²⁾. The registration was refused because the word was not adapted to distinguish the goods tending to be descriptive of the goods sold under that name. To the same tenor and effect is the decision of A. Loizou, J., in the Cyprus case of *Stavrinides Clothing v. The Republic* ⁽³⁾. The learned Judge found the word "YOUNGSTER" to lack distinctiveness and refused registration on the ground that it aimed to be descriptive of the goods sold thereunder.

Distinctiveness is, as I had occasion to point out in *Plough Inc. v. Republic*⁽⁴⁾ the hallmark of registrability as well as the test for determining the likelihood of deception or confusion under s. 13, Cap. 268⁽⁵⁾. In *Plough Inc.* the Court refused registration of "TROPICAL BLEND" for lack of distinctiveness. Distinctiveness is ordinarily achieved by coining a word and making its use thereafter the property of the owner of the goods. Of course a word may be created with imagination and sound or look attractive as a brand name for the goods. What it must not be is descriptive of the goods, confusing or deceptive as to the origin, quality and attributes of the goods.

Strong association of the mark with goods sold under it may exceptionally⁽⁶⁾ import distinctiveness. For this to be the result of the association, there must be long user in point of time and trading under that name on a large

⁽¹⁾ See Kerly (*supra*), p. 114.

⁽²⁾ [1910] 1 Ch. 130.

⁽³⁾ (1983) 3 C.L.R. 98.

⁽⁴⁾ (1985) 3 C.L.R. 1687.

⁽⁵⁾ *Granada v. The Republic* (1985) 3 C.L.R. 207; *El Greco Distillers v. The Republic* (1985) 3 C.L.R. 1189; *Societe Anonyme des Eaux Minerates d'Evian v. Republic* (judgment delivered on 22.2.1986, published in (1986) 3 C.L.R. 350.

⁽⁶⁾ See s. 12(3) Cap. 268.

scale. There was evidence of neither in this case nor can anyone conceivably suggest that the association between "TROPHY" and the products of the applicants was such as to impart distinctiveness.

For the above reasons the application fails. It is dismissed. Let there be no order as to costs. 5

Recourse dismissed.
No order as to costs.