

1987 January 5

[TRIANAFYLLIDES P SAVVIDES LORIS STYLIANIDES
KOURRIS JJ]

G A KERANIS A E KAPNOVIOMICHANIA «ETHNOS» OF GREECE
Appellant-Interested Party

v

ALFRID DUNHILL LIMITED
CIGARETTE MANUFACTURERS OF U K
Applicants-Respondents.

v

THE COMMISSIONER OF TRADE MARKS
Respondent

(Revisional Jurisdiction Appeal No 497)

*Trade Marks—The Trade Marks Law Cap 268 ss 11(1)(e) 13 and 14—User
abroad—Irrelevant as to registrability on ground of distinctiveness (s 11(1)(e))
but relevant and admissible in cases of deception or confusion (s 13 and 14)*

*Administrative Law—Due inquiry—Trade marks—Application for registration of—
Application opposed—In reaching sub judice decision the Registrar ignored
relevant and admissible evidence—Sub judice decision annulled for failure to
carry out a due inquiry*

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The applicants respondents who are the proprietors of registered trade
marks in respect of cigarettes the registration being limited to red or maroon
and gold colours opposed an application submitted by the appellant
interested party for registration of the word OSCAR in respect of cigarettes
The respondent-Registrar however accepted registration of the said word in
Part B of the Register with no limitation as to colours and as a result the
applicants respondents filed a recourse to this Court The Judge of this Court
who tried the recourse annulled the said decision of the Registrar for wrong
exercise of discretion Hence the present appeal

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In reaching the sub judice decision the Registrar treated as irrelevant
evidence to the effect that in Greece the appellant-interested party uses his
trade mark in similar colours as those of the applicants-respondents on the
ground that under the law and the authorities it is user in this country that is
taken into consideration and not user abroad

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Held dismissing the appeal (1) It is clear that the Registrar misconceived
the issue before him Even if the issue was confined to relevance and

admissibility of evidence, evidence of user abroad is irrelevant and inadmissible only for purposes of registrability of a trade mark on the ground of distinctiveness (Section 11(1) (e) of Cap. 268) but not in cases of deception or confusion (sections 13 and 14 of Cap. 268).

- 5 (2) The primary duty of the Registrar was to carry out a proper and diligent inquiry before reaching the sub-judice decision. In this case by ignoring the evidence aforesaid, which might be indicative of the intention of the interested party to use the same colours in Cyprus the Registrar failed to carry out a due inquiry and it is for this reason that the sub-judice decision ought to have been annulled.

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Appeal dismissed
No order as to costs

Cases referred to

Ioannides v The Republic (1972) 3 C.L.R. 318

15 Appeal.

- Appeal against the judgment of a Judge of the Supreme Court of Cyprus (L. Loizou, J.) given on the 11th April, 1977 (Revisional Jurisdiction Case No.260/77)* whereby the decision of the respondent to register the trade mark of the interested party
- 20 No. B. 14955 consisting of the word «Oscar» and design in part of the register of Trade Marks was annulled.

L. Demetriades with I. Loizidou (Mrs), for the appellants interested party.

G. Nicolaidis with T. Economou, for respondent-applicant

- 25 No appearance for the respondent.

Cur. adv. vult

TRIANTAFYLLIDES P.: The Judgment of the Court will be delivered by Lons, J.

- LORIS J.: The present appeal of the interested party, is directed against the judgment of a Judge of this Court in recourse No. 260/77 whereby the decision of the Registrar of Trade Marks dated the 18th July 1977, (to register the trade mark of the interested party No. B 14955 consisting of the word «OSCAR» and design in part B of the register of Trade Marks and dismiss the Opposition of the

*Reported as *Alfred Dunhill Ltd v The Commissioner of Trade Marks* (1985) 3 C.L.R. 318

application against such registration) was annulled «for wrong exercise of his discretion»

The salient facts are briefly as follows.

The applicants are the proprietors of trade marks under Nos. 10286 and 14557 registered in Cyprus in 1967 and 1972 respectively, in respect of cigarettes the registration being limited to red or maroon and gold colours 5

On the 4th May, 1973, the interested party applied for registration of the trade mark «OSCAR» in respect of cigarettes, which was accepted by the Registrar for registration in Part B of the Register under No. B 14955, with no limitation as to colour 10

The trade mark was then advertised in the official Gazette of the public, whereupon the applicants filed an opposition against its registration on the grounds that the proposed trade mark so closely resembled their own that it was likely to cause confusion or deception and further that the interested party should enter a condition not to use the proposed mark in the colours used by applicants 15

The interested party filed a counter-opposition stating that their trade mark has no resemblance to that of the applicants and is distinguishable from it and that there is no likelihood of confusion if used in the same colours as that of the applicants 20

After the filing of the opposition and the counter-opposition as aforesaid a hearing took place before the respondent Registrar who gave his decision on the 18th July 1977, dismissing the opposition of the applicant and directing that the sub-judice trade mark do proceed for registration in Part B of the Register as advertised 25

The relevant part of the decision of the Registrar is at pp 7 and 8 of his decision and reads as follow 30

«The applicants, put forward evidence to prove that the applicants' trade mark is used in Greece in similar colours as those of the applicants. Under the Law and the authorities it is user in this country that is taken into consideration and not user abroad. This is clear from Kerly 10th edition page 146, para 8-67 35

I quote

‘On an application to register a mark for use in the United Kingdom, it is distinctiveness in the United Kingdom that is in question.’

Therefore evidence of use abroad is irrelevant and I did not take it into consideration. In Cyprus applicant’s trade mark is not used and this is clear from the evidence even of the opponents.»

It is clear from the above extract of the sub-judice decision of the Registrar that the latter misconceived the issue before him; even if the issue was confined to relevance and admissibility of evidence of use abroad is irrelevant and inadmissible only for purposes of registrability of a trade mark on the ground of distinctiveness under s. 11(e) of Cap. 268. But this does not extend to cases of deception or confusion (ss 13 and 14 of Cap. 268). As stated in Kerly’s 10th ed. at p.61 (para. 4-31) «evidence of deception and confusion abroad may be relevant in opposition proceedings before the Registrar, particularly if the logical inference from such evidence is that there would be a corresponding likelihood of deception or confusion in the United Kingdom.»

In fact the primary duty of the Respondent Registrar, as an Administrative Organ, was to carry out a due and proper inquiry before reaching at the sub-judice decision; and it is crystal clear from the aforesaid extract of his decision that he failed to carry out such an inquiry by ignoring altogether the evidence tendered by the applicant at the hearing that the interested party was selling in Greece its ‘OSCAR’ cigarettes in packets of the same colours as those of the applicants, which might be indicative of their intention to use the same colours in Cyprus, a factor which might be found to be relevant to the issue of the probability of causing deception or confusion. It is well settled in administrative Law that failure to make a due enquiry is a ground for annulment; «it is an independent sufficient by itself, ground of annulment» (*Ioannides v. The Republic* (1972) 3 CLR 318 at p.326).

The sub judice decision therefore ought to have been annulled on the ground of failure of the respondent to carry out a due inquiry, which he should now proceed to conduct.

In the result the appeal is dismissed with no order as to its costs.

Before concluding we must observe, for purposes of guidance
in the future, that learned counsel for the Republic who appeared
in the litigation at the first instance level for the Respondent
Registrar, did not appear before us on appeal but he informed the
Court in writing that he agreed with the judgment of the trial
judge. We are of the view that the Court would have been assisted
considerably if he had appeared also before us in order to explain
in viva voce the stand of the respondent in this appeal and we expect
his course to be followed in future.

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Appeal dismissed with 10
no order as to costs.