

1987 November 3

[SAVIDES J]

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

AMERICAN TELEPHONE AND TELEGRAPH,
COMPANY OF U S A :

Applicant.

v

THE REGISTRAR OF TRADE MARKS,

Respondent

(Case No 981/85)

Trade marks — Registrability of proposed word — Judicial control — Principles applicable

Trade marks — Meaning of proposed word — Permissible to look at dictionanes in order to find it

Trade marks — Distinctiveness — The Trade Marks Law, Cap 268, sections 11(1)(e), 11(2) and 11(3) — Meaning of «Inherent distinctiveness» — Review of authorities — Trade mark adapted to distinguish by reason of its use — Use does not make a mark distinctive, if the inherent unsuitability of such marks is so strong that no degree of distinctiveness can in fact counterbalance it 5

Trade marks — Distinctiveness — Registration in foreign countrnes — Of limited significance 10

Applicant's application for registration of the word «TELEPLAN» as a trade mark in Part A, Class 9 of the Register of Trade Marks was turned down by the Registrar of Trade Marks on the ground that the proposed mark contravened the provisions of section 11(1)(d) of the Trade Marks Law, Cap 268, in that it had direct reference to the character or quality of the goods and it lacked distinctiveness and also that it contravened the provisions of section 13 as it was likely to deceive or cause confusion 15

Hence this recourse

Held *dismissing the recourse* (1) This Court cannot interfere with the discretion of the Registrar once the sub judice decision was reasonably open to him and properly taken 20

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5 (2) It is settled that looking at dictionanes to find the meaning of a word is an accepted practice in law. The Registrar was right in looking at dictionanes in order to find the meaning of «TELEPLAN». The word «tele» originating from the Greek word «τηλε» is a well known and widely used word and is commonly used as a combining form prefix to indicate, inter alia, distant, at a distance or over a distance. The word «plan» bears also a clear meaning, it means plan, draft plan, programme or method of achieving something, a way of carrying out a design, device. The combination of these two words can easily lead to the impression that the goods sought to be registered under this trade mark are in the nature of material for use in a telecommunications plan or part thereof

10 (3) The interpretation of the word «distinctive» appearing in sub-section (1) of section 11 is given under subsection (2) of the same section. Relevant, is, also, sub-section (3) of section 11

15 (4) In this case the applicant has failed to discharge the burden of proving that the use made in Cyprus was such that in the circumstances, the proposed mark is in fact adapted to distinguish.

20 (5) In the light of the authorities as regards the meaning of «inherent distinctiveness» the word TELEPLAN cannot be considered as «inherently distinctive».

(6) The fact that the proposed word has been registered as a trade mark in other countries is of a secondary significance

*Recourse dismissed Costs
in favour of respondents*

25 *Cases referred to:*

Societe Nationale Elf Acquitaine v. The Registrar of Trade Marks (1987) 3 C.L.R. 1420;

I.W.S. Nominee Co. Ltd. v. The Republic (1967) 3 C.L.R. 582,

Merck v. The Republic (1972) 3 C.L.R. 548,

30 *Yorkshire Copper Works Limited's Application* [1954] 71 R.P.C. 150;

Registrar of Trade Marks v. W and G Du Cros Ltd. [1913] A.C. 624;

Perfection Soap case [1909] 26 R.P.C. 837;

Peletico v. Registrar of Trade Marks (1986) 3 C.L.R. 490.

Needle-Tip Trade Mark [1973] R.P.C. 113.

Recourse.

Recourse against the refusal of the respondent to register the word «TELEPLAN» in part A, Class 9 of the Register of Trade Marks in respect of printed matters related to telecommunications equipment. 5

Chr. Theodoulou, for the applicant.

St. Ioannides, for the respondent.

Cur. adv. vult.

SAVVIDES J. read the following judgment. The applicant, a company incorporated in U.S.A., submitted an application dated the 28th September, 1984, for the registration of the word «TELEPLAN» written in plain capital letters as a trade mark in Part A, Class 9 of the Register of Trade Marks in respect of telecommunications equipment. The application having been considered by the respondent was on the 24th October, 1984, objected to on the ground that the proposed mark contravened the provisions of section 11(1)(d) of the Trade Marks Law, Cap. 268, in that it had direct reference to the character or quality of the goods and it lacked distinctiveness and also that it contravened the provisions of section 13 as it was likely to deceive or cause confusion. 10 15 20

The applicant on 14.3.1985 applied, through its advocate, for a hearing which in fact was held on 19.9.1985. After hearing the arguments raised by counsel for the applicant on the objections raised by the respondent against the registration of the said mark, the respondent reached his decision which was communicated to the applicant by letter dated 11th October, 1985, whereby he dismissed the application, confirming his objections. 25

As a result, the applicant filed the present recourse challenging the sub judice decision and praying for its annulment. 30

By his written address counsel for applicant expounded on his grounds of law and rejected the contention of the Registrar that the mark in question has immediate or indeed any relation with the character or quality of the goods or that it lacks distinctiveness. Even if it were so, counsel submitted, there is evidence of use in Cyprus since 1978, as well as advertisement in Cyprus, according to the affidavits of G.E. Murphy dated 9.8.1985 and of Miss Yiannoulla Theophanous dated 14.9.1985. He further contended that the decision of the Registrar was not duly reasoned, that he 35

misdirected himself and/or proceeded on wrong principles in arriving at his decision and that he did not take into account all the facts of the case. Counsel concluded his address by submitting that when there is an appeal to the Court from the Registrar's decision, such appeal is by way of rehearing and the Court is free to exercise its own discretion on the matter irrespective of the decision reached by the Registrar.

Counsel for the respondent by her written address in support of the decision of the Registrar contended that the word «TELEPLAN» has direct reference to the character and quality of the goods for which it is sought to be registered, as the word «TELEPLAN» consists of the word «tele» which, according to the dictionanes has the meaning of «far off» and the word «plan» which has the clear grammatical meaning of device or programme. She made reference in this respect to dictionaries explaining the prefix «tele» and the word «plan», the meaning of which, she submitted, is that the goods are telecommunication's plan or part of it.

She submitted that the trade mark in question is in no way inherently adapted to distinguish, and the evidence adduced by the applicant, as contained in the affidavits filed on its behalf, that the trade mark was in use in Cyprus and had been used in respect of goods manufactured by it, at the Hilton and Ledra hotels in Nicosia, is not sufficient to establish use. Counsel also contended that the objection raised by the respondent on section 13 that the proposed mark would be highly deceptive and confusing was a reasonable one as the use of the said words may suggest that the goods concerned possess certain qualities (i.e. that they are a telecommunications plan) which qualities have not been proved. She further contested the submission of counsel for applicant that this Court can deal with the case as a case for retrial and can substitute its own discretion to that of the Registrar, as being entirely wrong and contrary to our case law, and concluded by submitting that the sub judice decision was reasonably open to the Registrar.

Before proceeding to deal with the main question, I shall briefly dispose of the question raised by counsel for applicant concerning the approach of this Court in dealing with a recourse against a decision of the Registrar of Trade Marks. The same submission was made by the same counsel in Case No. 365/84 (*Société Nationale Elf Aquitaine v. The Registrar of Trade Marks*) in which

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judgment was delivered by me on 7.10.1987 (to be reported in (1987) 3 C.L.R.)*.

In that case I have held, following the case of *I.W.S. Nominee Co. Ltd. and the Republic* (1967) 3 C.L.R. 582 that although the decisions of the Registrar were subject to an appeal to the Court before 1960, after the Independence of Cyprus such decisions, being administrative acts, are subject to a recourse under Article 146 of the Constitution and this Court cannot interfere with the discretion of the Registrar once the decision concerned was reasonably open to him and properly taken.

I fully adopt, for the purposes of this recourse, what I have said in the above case, regarding this submission of counsel for applicant.

I will now proceed to the substance of the case.

Counsel for applicant sought to rely on two affidavits which were before the Registrar at the hearing of the case.

The first is an affidavit sworn on the 9th August, 1985, by the Trade Mark and Copyright Counsel of the applicant, namely, Mr. G.E. Murphy, to the effect that the trade mark «TELEPLAN» had been registered in Austria, Benelux, France, Kenya, Monaco, Paraguay, Peru and Tunisia and there were pending applications for its registration in a number of other countries including Great Britain. Also, that the products in question «are known in Cyprus and have been used and sold in Cyprus since 1978» and are used by the Hilton and Ledra hotels in Nicosia. It is also alleged that such goods are advertised in Cyprus. In para. 5 of the said affidavit it is admitted that «sales figures are unavailable».

The second affidavit is dated 14th September, 1985 and was sworn by Yianoula Theophanous, a clerk in the law office of counsel for applicant, in which reference is made to the contents of the previous affidavit and to which various brochures were attached which, according to the allegation of the affiant, show use and advertisement of the goods in Cyprus.

I had the opportunity of examining such brochures, which also appear in the file of the Registrar (exhibit 1), but I could not derive from them any assistance as to the trade use and extent of such use in Cyprus, of the goods of the applicant and with the trade mark in question.

* Reported in (1987) 3 C.L.R. 1420.

Further evidence was adduced by counsel for applicant at the hearing, consisting of two affidavits, the first sworn by the same affiant, Mr Murphy, on the 15th January, 1987 which contains mainly legal arguments which have already been advanced by
5 counsel and of a repetition of the allegations in his previous affidavit as to the use of the goods by Ledra and Hilton hotels

The second affidavit is sworn by A Hj. Loizou, a clerk of counsel for applicant and is dated the 30th January, 1987 It is stated therein that the applicant is a graduate of a secondary school and
10 that by looking at and hearing the word «TELEPLAN» she believes that it has no relation to the character or quality of the goods sought to be covered by the subject matter trade mark

I wish to state, at this stage, however, that the opinion of this advocate's clerk, a graduate of the Gymnasium, by itself, cannot
15 have any weight in the determination of this case in the light of the legal arguments and cannot outweigh the opinion expressed by the Registrar in this respect

The first question raised by the Registrar on the registrability of the trade mark in question, is based on section 11(1)(d) of the
20 Trade Marks Law, Cap. 268 and its subsequent amendments, in that the suggested name has direct reference to the character or quality of the goods

Counsel for applicant objected to the way in which the Registrar reached his conclusion by making use and reference to well
25 known dictionaries It is well settled, however, that looking at dictionanes to find the meaning of a word, is an accepted practice in law (E *Merck v. Republic* (1972) 3 C L R 548 at pp. 562, 563)

The word «tele» originating from the Greek word «τηλε» is a well known and widely used word and is commonly used as a
30 combining form prefix to indicate, inter alia, distant, at a distance or over a distance The word «plan» bears also a clear meaning and according to the dictionanes, to which reference was made by the Registrar, it means plan, draft plan, programme or method of achieving something, a way of carrying out a design, device. The
35 combination of these two words can easily lead to the impression that the goods sought to be registered under this trade mark are in the nature of material for use in a telecommunications plan or part thereof and it was reasonably open to the Registrar to reach the

conclusion that the combined word «TELEPLAN» has direct reference to the character or quality of the goods.

Another objection raised by the Registrar is that the trade mark in question lacks distinctiveness contrary to section 11(1)(e) of the Trade Marks Law. 5

Section 11(1)(e) of Cap. 268 provides as follows:

«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) 10
- (b)
- (c)
- (d)
- (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.» 15

The interpretation of the word «distinctive» appearing in sub-section (1) of section 11 is given under sub-section (2) of the same section as follows: 20

«(2) For the purposes of this section 'distinctive' means adapted, in relation to goods in respect of which a trade mark is registered or proposed to be registered, to distinguish goods with which the proprietor of the trade mark is or may be connected in the course of trade from goods in the case of which no such connection subsists ...» 25

It is farther provided under sub section 3 of section 11 as follows:-

«In determining whether a trade mark is adapted to distinguish as aforesaid the Registrar may have regard to the extent to which 30

(a) the trade mark is inherently adapted to distinguish as aforesaid; and

(b) by reason of the use of the trade mark or of any other circumstances, the trade mark is in fact adapted to distinguish as aforesaid.» 35

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Applicant's counsel tried to prove by filing affidavit evidence that the mark in question qualifies for registration as being distinctive since it has been used in Cyprus. Though the applicant alleges in those affidavits that the goods in question had been used by the Hilton and Ledra hotels Ltd, it was not in a position to supply the Registrar with any yearly sale figures as to the quantity of the goods sold. The applicant has therefore failed to discharge the burden of proving that the use made in Cyprus was such that in the circumstances, the proposed mark is in fact adapted to distinguish

- 10 Even if evidence of use is established, such evidence does not make a trade mark distinctive enough to enable it to be registered if the inherent unsuitability of such mark is so strong that no degree of distinctiveness in fact can counterbalance it

- 15 In Kerly's Law of Trade Marks and Trade Names 12th Edition at pp 100 - 101, paragraph 8-43 under the heading «inherent distinctiveness» we read the following

- 20 «To be inherently adapted to distinguish, a word must be one which, as a word, is adapted to distinguish the goods, and not a word which may by user acquire the capacity of distinguishing the goods. 'The Act means that a trader may take a word which from something in the word itself - say the fact that no one had ever heard the word before, that it was an invented word, or that it indicated the particular trader as distinguished from another trader, but always from something found in the word itself as distinguished from the way in which it is used - is such as to answer the description of being adapted to distinguish the goods * 'By 'inherently adapted',** I take the Act to mean adapted of itself, standing on its own feet '

- 25
30 The House of Lords has adopted a somewhat different approach, which seems more appropriate to the evaluation of the factor of inherent distinctiveness in cases of marks shown to be distinctive in fact***

- 35 'However, long before the reference to inherent adaptability had been incorporated in the current statutes dealing with trade marks, it had been held upon grounds of public policy that a trader ought not to be allowed to obtain by

* Cassella [1910] 2 Ch 40 27 R P C 453

** Per Harman L J in Weldmesh [1966] R P C 220 at p 228

*** Per Lord Diplock in Smith, Kline and French [1976] R P C 511 at 538

registration under the Trade Marks Act a monopoly in what other traders may legitimately desire to use. The classic statement of this doctrine is to be found in the speech of Lord Parker in the *W. & G. Case* [1913] 30 R.P.C. 660 at page 672 where he said that the right to registration should largely depend on whether other traders are likely, in the ordinary course of their business and without any improper motive, to desire to use the same mark, or some mark nearly resembling it, upon or in connection with their own goods. The reference to 'inherently adapted' in section 9(3) of the Consolidation Act of 1938, which was first enacted in 1937, has always been treated as giving statutory expression to the doctrine as previously stated by Lord Parker.

Thus the mere proof or admission that a mark does in fact distinguish does not ipso facto compel the judge to deem that mark to be distinctive. It must further be 'adapted to distinguish', which brings within the purview of his discretion the wider field of the interests of strangers and of the public.»

Also, in paragraph 8-41 at p. 99 of the same book, it reads:

«... the Registrar, in considering an application to register a mark, must consider both its inherent adaptation (i.e. aptitude) to distinguish and also the extent to which it is shown by evidence (if there is such evidence) to be distinctive.»

In the case of *Yorkshire Copper Works Limited's Application* [1954] 71 R.P.C. 150, the House of Lords held that the Registrar must by virtue of section 9(3) (our section 11(3)), consider both whether a mark is inherently adapted to distinguish and whether it is in fact adapted to distinguish and that the mark «Yorkshire» which was in issue in that case, although in fact adapted to distinguish the Applicant's goods was inherently not adapted to distinguish the goods of any trader, and the mark was not distinctive. In his opinion to the House, in the above case, Lord Cohen, at p. 157, adopted the observations of Lord Parker in the *W. & G case (Registrar of Trade Marks v. W & G Du Cros Ltd.* [1913] A.C. 624) where he said:

«But the tribunal is not bound to allow registration even if the mark be in fact distinctive. A common law mark is still not necessarily registrable. If the tribunal finds that a mark is anywhere, or among any class of people, in fact, distinctive of the goods of the applicant, it may be influenced by this fact in

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determining whether it is adapted to distinguish these goods from those of other persons but distinctiveness in fact is not conclusive »

5 Lord Cohen further quoted the following principle as put by Sir Herbert Cozens-Hardy in the *Perfection Soap* case: [1909] 26 R P C 837

10 «Wealthy traders are habitually eager to enclose part of the great common of the English language and to exclude the general public of the present day and of the future from access to the enclosure »

and to the observation of Farwell L.J. in the same case that:

15 «The Court is careful not to interfere with other persons' rights further than is necessary for the protection of the claimant, and not to allow any claimant to obtain a monopoly further than is consistent with reason and fair dealing' »

The question of distinctiveness has been considered by this Court in a series of cases. In the recent decision of *Peletico v. Registrar of Trade Marks* (1986) 3 C.L.R. 490 the position is summarised as follows at p. 493:

20 «Distinctiveness is, as I had occasion to point out in *Plough Inc. v. Republic* the hallmark of registrability as well as the test for determining the likelihood of deception or confusion under s. 13, Cap. 268. In *Plough Inc.* the Court refused registration of 'TROPICAL BLEND' for lack of distinctiveness.
25 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
30 deceptive as to the origin, quality and attributes of the goods.»

Counsel for applicant further argued that the mark is registered abroad in several countries. It is well established that foreign registrations are of secondary significance. In Kerly's *Law of Trade Marks and Trade Names* (supra) at p. 123, under paragraph 8-67,
35 we read:

«Use or registration abroad

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

question. Thus extent of registration and use of the mark abroad are of secondary significance, if any».

As to the position when a mark has been registered in a foreign country and the bearing of such registration in proceedings for registration in Cyprus, as well as whether the mark is capable of distinguishing the goods of the applicant in this country. I wish to refer to the judgment I delivered in the case of *Soci t  Nationale Elf Aquitaine* (supra) in which reference is made to the decision in *Needle-Tip Trade Mark* [1973] R.P.C. 113 and, in particular, to the following:

«It seems to me that the mere fact that a mark has been registered in a foreign country has little or no bearing on whether the mark is capable of distinguishing the goods of the applicant in this country. Registration in the foreign country will have been allowed according to the law and practice in that country which may differ from that of this country and may have been allowed in the light of particular circumstances and trading conditions in that country and which may be very different to those obtaining in this country. It may be that, in a case where a mark applied for here has already been registered in a foreign country with a system of trade mark law similar to our own, if a written decision of the foreign tribunal allowing registration in the foreign country and which showed the grounds of the decision and the matters taken into consideration were to be adduced on the application here, it might be persuasive as a piece of reasoning as to whether the mark should be registered here, if but only if, similar considerations applied in this country; but that, it seems to me is as far as registration in a foreign country could be relevant to registrability here. It is to be noted that in Swifts' case the Divisional Court was influenced by what was referred to as 'a scholarly and persuasive judgment of the Full Court of the High Court of Australia'. On the present appeal, however, all that has been relied upon is the mere fact of registration in the countries mentioned and that mere fact, as I have already stated, is of little or no bearing on whether the mark is capable of distinguishing the applicants' goods in this country».

In the present case on the material before me and having carefully considered the contents of the decision of the Registrar and the reasons for his objections, I have come to the conclusion

that it was reasonably open to him to decide against the registrability of the trade mark in question relying on sections 11 and 13 of the Law.

Bearing in mind the well established principles that the trial
5 Court does not interfere with 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 a good cause for interference with the Registrar's
10 decision.

In the result, the recourse fails and is hereby dismissed with costs
in favour of the respondent.

*Recourse dismissed with
costs in favour of respondents.*