

1987 March 7

(DEMETRIADES, J)

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

ALFRED DUNHILL LIMITED,

Applicants,

v

THE REGISTRAR OF TRADE MARKS,

Respondent

(Cases Nos 78/81 and 79/81)

*Misconception of fact — Possibility of — Enough to vitiate a decision*

5 By means of these recourses the applicants challenge the validity of respondent's decision, whereby the latter refused to accept registration of applicants' proposed trade marks in respect of cigarettes on the ground that they lack distinctiveness (Section 11(1)(e) of the Trade Marks Law, Cap 268)

10 In paragraph 4 of the reasons given by the respondent it is stated that the colours comprising the proposed marks «are common to the trade for the goods concerned» The applicants, however, had adduced evidence before him to the effect that no other cigarettes are sold in packets of the same colours

Held, *annulling the sub judice decision* (1) There is nothing in respondent's reasoning showing that the applicants' said evidence was either contradicted or not true, nor does it appear that any inquiry was carried out as to the correctness of such evidence

15 (2) The failure to carry out such an inquiry leads to the conclusion that the respondent may have been labouring under a misconception of fact As it has been held in *Foumia Ltd v The Republic* (1983) 3 C L R 262 a mere possibility of a misconception of fact is enough to vitiate a decision

20 *Sub judice decision annulled*  
*Costs in favour of applicants*

*Cases referred to*

*Foumia Ltd v The Republic* (1983) 3 C L R 262

**Recourses.**

Recourses against the refusal of the respondent to accept applicants' proposed marks 19947 and 19948 in respect of cigarettes in class 34.

G. Nicolaidis, for the applicants. 5

St. Joannides(Mrs.), for the respondent.

*Cur. adv. vult*

DEMETRIADES J. read the following judgment. The above two intitled recourses were heard together as both, in view of their nature, present common questions of law and fact. By them the applicants challenge the decision of the respondent, dated the 13th December, 1980, by which he refused to accept registration of the applicants' proposed marks, Nos. 19947 and 19948, respectively, in respect of cigarettes, in class 34. 10

The applicants are a company of limited liability, registered in the United Kingdom and on the 20th August, 1979, they applied to the respondent for the registration in class 34 of Part A of the Register of Trade Marks, of the trade marks attached to their said applications. The proposed trade mark in Case No. 78/81 is a maroon coloured rectangular, rounded by a gold coloured frame and bears No. 19947. The proposed mark in Case No 79/81 is a bigger rectangular, of the same shape and colours and bears No. 19948. There is no inscription whatsoever on the two marks and as stated in paragraph (στ) of the applications, they were intended to be limited to the colours shown on the applications (maroon and gold). 15 20 25

By identical letters dated the 11th September, 1979, the respondent informed the applicants that their applications could not be accepted because the proposed marks lacked any distinctive character and there were, also, objections under section 13 of the Trade Marks Law, Cap. 268. Section 13 of Cap. 268 provides:- 30

«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.» 35

By the said letters of the respondent, the applicants were further informed that the proposed marks could not be registered unless evidence was produced that their use in Cyprus or other circumstances would give them distinctiveness. The attention of the applicants was also drawn to the provisions of section 19(3) of Cap. 268 which provides that their applications could be examined with a scope of registration under Part B of the Register and Regulation 32, in accordance with which they could ask for a hearing, or supply the Registrar with a written reply.

10 As a result, the applicants requested a hearing, which took place on the 11th November, 1980 and the respondent, by letter dated the 13th December, 1980 informed them that his objections could not be waived and that the proposed marks could not be registered either in Part A or in Part B of the Register.

15 On the 22nd January, 1981, the respondent gave the reasons of his decision, which were communicated to the applicants by letter dated the 23rd January, 1981, hence the present recourses, which are based on the following grounds of law:

1. The sub judge decision is not duly reasoned.
- 20 2. The respondent acted under a misconception of law and/or fact.
3. The respondent misdirected himself and/or proceeded on wrong principles in arriving at his decision.
4. The respondent exercised this discretion wrongly and/or the sub judge decision was not reasonably open to him.

Counsel for the applicants argued that the Registrar did not give any reason why he found the proposed marks not to be distinctive and, also, why they were not registrable in Part B of the Register. Counsel also submitted that the Registrar misconceived the evidence which was before him and which was to the effect that there is no other packet of cigarettes in the market with the same colours and that he wrongly found that the evidence adduced at the hearing before him did not amount to evidence of use of the marks propounded for registration, but was use of the marks in another form. He also contended that the Registrar did not direct his mind

to the fact that the proposed registrations were limited to certain colours which, by themselves, make the marks more distinctive and that, in the light of the above, the sub-judice decision was not reasonably open to him.

Counsel for the respondent maintained that the sub-judice decision was reasonably open to the Registrar in the light of the evidence adduced and that such evidence was not evidence of use of the marks in their proposed form but together with other material. She, also, contended that even if the allegation of the applicants that there is no other packet of cigarettes in the market with similar colours was correct, it would not change the situation since colour is not by itself a ground for registration of a trade mark. 5 10

The question that has to be decided in these recourses is whether the discretion of the Registrar was reasonably exercised, in other words, whether the sub-judice decision was reasonably open to him. 15

The reason that the Registrar gave for not accepting registration of the marks in question is, as it emanates from his judgment, that he did not find them to be distinctive, as is required by section 11(1)(e) of the Trade Marks Law, Cap. 268. This section reads, in this respect, as follows: 20

«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:

..... 25

(e) any other distinctive mark, but a name, signature, or word or words, ..... shall not be registrable under the provisions of this paragraph except upon evidence of its distinctiveness.»

In paragraph 4 of the reasons of the Registrar's decision it is stated that the marks are not distinctive in that the colours comprising them «are common to the trade for the goods concerned». This is one of the elements that led him to arrive at the conclusion that the marks were not distinctive. 30

The applicants, however, adduced evidence before him to the effect that no other cigarettes are sold in packets of the same 35

colours. This evidence emanates from (a) the affidavits of Michael Fred Barford, the editor of the «World Tobacco» magazine, an issue of which magazine was exhibited with the affidavit and in which all known and new brands of cigarettes appear, together  
5 with a description of the colours of their packages; (b) the affidavit of Andreas Charilaou Palazides, sales manager of the representatives of the applicants in Cyprus, in which he states that no other packet of cigarettes, with the same colours, has appeared in the Cyprus market during the last 10 years; and (c) the affidavits  
10 of two retailers of cigarettes in Cyprus.

This evidence, which was before the respondent, contradicts his aforesaid finding. There is nothing in the reasons he gave showing that the above mentioned evidence was either contradicted or not true, nor there appears that any inquiry was carried out on the  
15 respondent's part to ascertain the correctness of this evidence. His failure to conduct an inquiry into the truthfulness or not of the evidence he had before him leads me to the conclusion that the respondent, in taking the sub judge decision, may have been labouring under a misconception of fact.

20 In *Foumia Ltd. v. The Republic*, (1983) 3 C.L.R. 262, 279, it was decided that a mere possibility of a misconception of fact is enough to vitiate the sub judge decision. In the circumstances of the present case and in the light of the *Foumia* case, supra, I find that the sub judge decision has to be annulled. In view of this finding,  
25 I do not propose to consider the other grounds raised, but I would like to stress the importance of a limitation as to colour in deciding the question of distinctiveness for a proposed trade mark. (See section 18 of the Law, and, also, Kerly's text book on the Law of Trade Marks, 10th Edition, p.22, paragraphs 2-14, and p. 160,  
30 paragraphs 8-76).

In the result, these recourses succeed and the sub judge decision is hereby annulled with order for costs against the respondent.

35 *Sub judge decision  
annulled with costs  
against the respondent.*