

1988 February 8

{KOURRIS, J.}

IN THE MATTER OF ARTICLE 146 OF THE CONSTITUTION

SOCIETE D/HYGIENE DERMATOLOGIQUE DE VICHY

"S.H.D.V.",

*Applicants,*

v.

THE REPUBLIC OF CYPRUS, THROUGH

1. THE MINISTER OF COMMERCE AND INDUSTRY AND/OR

2. THE REGISTRAR OF TRADE MARKS,

*Respondents.*

(Cases No. 337/86).

5 *Trade marks—The Trade Marks Law, Cap. 268—Registration in Part B governed by section 12—Difference between Registration in Part A and Registration in Part B—In the case of Part B it is enough, if the mark is inherently capable of distinguishing—Burden of satisfying Registrar lies on applicant—In the circumstances of this case (PICK OUT for products against the pricking of mosquitoes) evidence was necessary to show that the words were capable of distinguishing.*

10 *Trade marks—The Trade Marks Law, Cap. 268, section 13—Deception or confusion—Likelihood of—PICK OUT for products against the pricking of mosquitoes.*

*Trade marks—Registrability—Foreign registration—Significance of.*

*Judicial control—Trade marks—Registrability—Principles applicable.*

15 The Registrar raised objections to the registration of the words "PICK OUT" in Part A, Class 9 of the Register of Trade Marks in respect of products against the pricking of mosquitoes. The objections were raised under sections 11(1) (d) and (e) and 13 of Cap.268.

The applicants elected to answer by way of a considered reply, whereby they suggested acceptance of the mark in Part B of the Register with a

disclaimer of the words PICK and OUT separately.

The Registrar examined afresh the matter, but concluded that his objections could not be waived.

Hence this recourse.

Applicants complained, inter alia, that the Registrar completely ignored their suggestion for registration in Part B of the Register. 5

Held, dismissing the recourse: (1) Bearing in mind the decision of the Registrar that he has reconsidered carefully the case in the light of applicants' considered reply, the conclusion is that the Registrar considered the mark propounded for registration in Part B of the register with a disclaimer of the words "PICK" and "OUT" separately. 10

(2) The relevant section governing registrations of trade marks in part B of the register is s. 12 of Cap. 268.

The difference between the two registrations is that in the case of Part A registration the mark should be inherently adapted to distinguish the goods, whereas in the case of Part B registration, the mark should be inherently capable of distinguishing such goods. 15

The onus is on the applicant to satisfy the Registrar that the mark is capable of distinguishing the goods. In the present case no evidence was called before the Registrar in support of the applicants' case. In the circumstances of this case it was not possible without evidence to satisfy the Registrar that the mark is capable of distinguishing the goods. 20

(3) The mark also contravenes the provisions of s. 13 of the law because it suggests that the goods concerned possess qualities (i.e. they pick out the mosquito pricking) which have not been proved, something which may cause confusion and deception to members of the public who may buy these products believing them to be able to pick out mosquito pricking whereas they may not. 25

(4) Applicants' allegation that the Registrar failed to give reasons for his objections for registration in Part B with a disclaimer of the words "PICK" and "OUT" separately in Part B of the Register cannot stand, because they failed to invoke the procedure under s. 19(4) and ask for reasons of such decision. 30

(5) The fact of registration of the words in question in other countries,

is, in the absence of sufficient particulars to illuminate the background to the foreign registrations, inconsequential.

(6) The sub judice decision was reasonably open to the Registrar.

*Recourse dismissed. Costs against applicants.*

5 *Cases referred to:*

*Smitsvonk N.V's application* [1955] 72 R.P.C. 117;

*Beecham Group v. Republic* (1982) 3 C.L.R. 622;

*Plough Inc. v. Republic* (1985) 3 C.L.R. 1687;

10 *White Horse Distillers Ltd. v. El Greco Distillers Ltd. and Others* (1987) 3 C.L.R. 531;

*Plough Inc. v. Republic* (1988) 3 C.L.R. 145.

**Recourse.**

15 Recourse against the decision of the respondents whereby applicant's application for the registration in Part B, Clause 5 of the Register of Trade Marks of the words "PICK OUT" as a trade mark in respect of products used against the pricking of mosquitoes was refused.

*G. Platritis*, for the applicants.

*L. Koursoumba (Mrs.)* for the respondents.

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*Cur. adv. vult.*

25 KOURRIS J. read the following judgment. The present recourse is directed against the decision of the Registrar of Trade Marks, dated 13th March, 1986, whereby he refused applicants' application No. 26758 for registration in part B, class 5 of the words "PICK OUT" as a trade mark in respect of products used

against the pricking of mosquitoes.

The salient facts of the present recourse are briefly as follows:-

The applicant is a company incorporated in France and on 27.11.85 submitted application No.26758 for registration of the words "PICK OUT" written in plain capital letters as a trade mark in part A, class 9 of the register of trade marks in respect of products against the pricking of mosquitoes (Red 6 in exhibit 1). 5

On 12.12.85 the application, having been considered by the respondent was objected to on the ground that the proposed mark contravened the provisions of s.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 also lacked distinctiveness contrary to the provisions of s. 5 (ii) (i) (e) and also that it contravened the provisions of s.13 as it was likely to deceive or cause confusion. 10

Applicants' attention was drawn to Regulation 32 of the Trade Marks Rules 1951 - 1971 by virtue of which they could either apply for a hearing or make a considered reply to these objections within 2 months (Red 7 in exhibit 1). 15

On 7th February, 1986, applicants filed a Considered Reply in accordance with s.19(3) of the Trade Marks Law, Cap. 268 and they requested the respondent to have their application transferred for consideration from Part A to Part B. The Considered Reply reads as follows:- 20

"The Registrar by his letter dated 12.12.85 raised objections to the registration of the above trade mark under s.11(1) (d) and (e) and s.13 of the Trade Marks Law. 25

The applicants to whom these objections were communicated allege that the trade mark is good for registration in Part B of the Register and they state that it was accepted for registration in France, O.A.P.I, Bureau International and Benelux. 30

Ourselves looking at the case we would suggest the acceptance of the mark in Part B of the Register with a disclaimer of the words PICK and OUT separately."

5 It appears from the considered reply of the applicants that they have abandoned their claim for registration in Part A of the register and they requested the Registrar of Trade Marks to examine the case for registration in Part B of the register with a disclaimer of the words "PICK" and "OUT" separately. The Registrar examined afresh the matter in the light of the considered  
10 reply and he concluded that his objections to the Registration of the mark could not be waived and consequently the application was refused, and on 13.3.86 the Registrar's refusal was communicated to applicants' counsel (Red 8 &9 in exhibit 1).

15 As a result, the applicants filed the present recourse challenging the sub judice decision and praying for its annulment on the ground that the request of the applicants for registration in Part B of the Register of the mark was completely ignored by the Registrar and also that the discretion of the Registrar of Trade Marks was exercised wrongly.

20 With regard to the first question, counsel for the applicants suggested that there is no reference in the decision of the Registrar either that the mark was considered for registration in Part B of the register or that an objection is made for such registration or the grounds of such objection. He went on to say  
25 that the decision of the Registrar clearly refers to his objections for Part A registration and nothing is mentioned of his consideration of whether the mark could be registered in Part B of the Register and he does not mention if he considered the mark for registration in Part B with a disclaimer of the words "PICK" and "OUT" separately.  
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Counsel for the respondent contended that the applicants' allegation that the Registrar ignored the applicants' request that the mark be examined with a view to its being registered in Part B of the register is not correct. She contended that the Registrar in

all cases of applications for registration of a trade mark invariably considers whether the mark proposed for can be accepted for registration in Part B of the register under the provisions of s.12 of Cap.268 and afortiori in a case like the present, where this was suggested in the considered reply of the applicants and he had a duty to do so imposed on him by s.19(3) of the law. She contended that in the present case he had given careful consideration to such a request before reaching the sub judice decision.

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I have considered carefully the arguments of counsel on this point and bearing in mind the decision of the Registrar (red 9 in exhibit 1) that he has reconsidered carefully the case in the light of applicant's considered reply, I am satisfied that the Registrar considered the mark propounded for registration in Part B of the register with a disclaimer of the words "PICK" and "OUT" separately.

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I now propose to consider the matter carefully whether the Registrar was correct in refusing the registration of the mark. The relevant section governing registrations of trade marks in part B of the register is s.12 of the Trade Marks Law, Cap. 268 which reads as follows:-

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"12.(1) In order for a trade mark to be registrable in part B of the register, it must be capable, in relation to the goods in respect of which it is registered or proposed to be registered, of distinguishing 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, either generally, or where the trade mark is registered or proposed to be registered subject to limitations in relation to use within the extent of the registration.

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(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

5 (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."

10 It appears that the difference between the two registrations is that in the case of part A registration the mark should be inherently adapted to distinguish the goods, whereas in the case of Part B registration, the mark should be inherently capable of distinguishing such goods.

15 Counsel for the applicant suggested that it is not necessary for an applicant to prove at the time of registration in Part B the distinctiveness of the mark, and he went on to say that distinctiveness is not required to exist at the date of the application if the mark is used long enough, may thereafter become distinctive of the goods of the proprietor of the mark, and he cited a passage from Kerly on Trade Marks, 10th edn., para. 8 - 73 giving the meaning of the words "capable of distinguishing".

20 Counsel for the respondent suggested that section 12 of our Trade Marks Law is an exact replica of s.13 of the English Trade Marks Act, 1938 and she referred to Kerly's (supra) paragraph 8 -72 at p. 153, where it is stated the difference between the registrability of the trade mark in part A and Part B in the register; and in relation to applications for registration of new  
25 marks as in the present case, the same book, at p. 154 emphasises that the language of s.10 calls for further consideration and in this respect paragraph 8 -73 at p. 155 reads as follows:-

30 "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 behind the mere possibility of the mark's some day becoming distinctive and there are degrees of inherent capacity.....

.....Thus a descriptive word was refused registration in Part B, on the ground that its descriptive character made it 'not appropriate to distinguish the goods of one..... trader from the goods of another, even though there was evidence suggesting that the mark had since the application to register become distinctive in fact, of which the court said 'it is evidence that indicates that it may turn out in the future that use will show that this word has acquired a distinctive capacity to distinguish the applicants' goods.'

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However, counsel for the respondent very fairly conceded that it is not an easy task for the Registrar to say that by use the mark will in future become distinctive and he went on the say that Kerly on Trade Marks, 8th edn. at p. 139 stated as follows:-

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".....while for the part B, such evidence is not required if it is possible without evidence to satisfy the tribunal that the mark is capable of distinguishing the goods".

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The onus is on the applicant to satisfy the Registrar that the mark is capable of distinguishing the goods. In the present case no evidence was called before the Registrar in support of the applicants' case and I do not think it was possible without evidence to satisfy the Registrar that the mark is capable of distinguishing the goods; afortiori in the case in hand, where the mark propounded for registration is directly descriptive of the goods, and it is a new mark and no trade has been established in it (*In the Matter of Smitsvonk N.V.'s* application for a trade mark [1955] 72 R.P.C. 117 at p. 120). Thus, applicants failed to discharge the onus cast upon them to satisfy the respondent either by evidence or otherwise that their proposed mark is capable of distinguishing their goods within the meaning of s.12 of the law and, therefore, registrable in Part B of the Register of Trade Marks with a disclaimer of the words "PICK" and "OUT"

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separately.

The Registrar in his letter of 12.12.85 objected to the registration of the trade mark on the additional ground that it contravened the provisions of s.13.

5 Section 13 of the Trade Marks Law, Cap. 268 reads:-

10 "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".

15 I am of the opinion that the Registrar was correct in that finding because it is evident that the mark also contravenes the provisions of s.13 of the law because it suggests that the goods concerned possess qualities (i.e they pick out the mosquito pricking) which have not been proved, something which may cause confusion and deception to members of the public who may buy these products believing them to be able to pick out mosquito pricking whereas they may not.

20 Applicants' allegation that the Registrar failed to give reasons for his objections for registration in Part B with a disclaimer of the words "PICK" and "OUT" separately in part B of the Register cannot stand, because they failed to invoke the procedure under s.19(4) and ask for reasons of such decision (See *Beecham Group v. The Republic*, (1982) 3 C.L.R. 622).

25 With regard to the point that the mark was accepted for registration in France and Benelux, it does not carry the case for the applicants any further. The law does not in terms make registration in any other country a consideration relevant to registration in Cyprus. The value of foreign registration lies in large measure in the persuasiveness and the reasoning behind such registration provided always that similar circumstances apply for registration in the two countries. In the absence of sufficient particulars to illuminate the background to the foreign registrations is applicants' mark, the effect of such registrations is inconsequential. (*Plough Inc. v. The Republic*, (1985) 3 C.L.R.

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1687, upheld on appeal (1988) 3 C.L.R. 145.

The approach of our Supreme Court as to when the Court should interfere with an administrative decision regarding the registrability of a trade mark has been recently reviewed by the Full Bench in Revisional Appeal No. 505, *White Horse Distillers Ltd. v. El Greco Distillers Ltd. and others*, (1987)3 C.L.R. 531. Triantafyllides, P. said the following, at p. 534:-

"It is the well-established approach of our Supreme Court, on the basis of the principles governing the exercise of its jurisdiction as an administrative Court in the first instance and on appeal that it does not interfere with an administrative decision regarding the registrability of a trade mark if such decision was reasonably open to the Registrar of Trade Marks and does not substitute its own evaluation in the place of the Registrar."

This decision was followed by the decision of the Full Bench in the case of *Plough Inc. v. The Republic*, (1988) 3 C.L.R. 145.

In the present case on the material before me which was also before the Registrar of Trade Marks, and having carefully considered the contents of the decision of the Registrar and the reason 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 s.12 of the law.

Bearing in mind the well established principles that the trial Court does not interfere with decisions of an administrative organ, nor does it substitute its own discretion for 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 good cause for interference with the Registrar's decision.

In the result, the recourse fails and is hereby dismissed with costs in favour of the respondent. Costs to be assessed by the Registrar.

*Recourse dismissed with costs.*