

O-459-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION
Nos. 2571608 & 2571609
BY ALLIED GLOBAL TOBACCO LIMITED
TO REGISTER THE TRADE MARKS
“WICKSON” and “WILTON”
IN CLASS 34**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS
THERE TO UNDER Nos. 102030 & 102031 BY
J T INTERNATIONAL S.A.**

BACKGROUND

1) On 9 February 2011 Allied Global Tobacco Limited (hereinafter the applicant), applied to register the following trade marks:

2571608	WICKSON	In Class 34: Tobacco, tobacco products, cigars, cigarillos, cigarettes, smoking tobacco, smokers' articles, ashtrays, lighters, matches, match boxes, cigarette rolling machines, cigarette papers, cigarette filters, matches.
2571609	WILTON	In Class 34: Tobacco, tobacco products, cigars, cigarillos, cigarettes, smoking tobacco, smokers' articles, ashtrays, lighters, matches, match boxes, cigarette rolling machines, cigarette papers, cigarette filters, matches.

2) The applications were examined and accepted, and subsequently published for opposition purposes on 4 March 2011 in Trade Marks Journal No.6877.

3) On 7 June 2011 J T International S.A. (hereinafter the opponent) filed notices of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Number	Mark	Filing and Registration Date	Class	Relevant Specification
1084827	W I N S T O N	10.10.1977 02.05.1978	34	Cigarettes.

b) The opponent contends that the marks in suit are similar to its mark. It also contends that the goods of the two parties are identical or similar. The marks in suit therefore offend against Section 5(2)(b) of the Act.

c) The opponent also contends that as a result of the extensive use of its mark in relation to cigarettes in the UK, beginning in 1977, it has gained a reputation and use of the marks in suit would, without due cause, take unfair advantage of, and be detrimental to, the distinctive character of its mark. The marks in suit therefore offend against Section 5(3) of the Act.

d) The opponent also claims that it is entitled to protection under Section 6(1)(c) under the Paris Convention on the basis that it is well known in the UK.

4) On 15 August 2011, the applicant filed a counterstatement. They accept that their specification for "cigarettes" and "tobacco" is identical or highly similar to the opponent's goods but deny that the other goods in the specification would be sold in the same outlets. They denied all the grounds and put the opponent to strict proof of use.

5) Both sides filed evidence and both sides request costs. Neither side wished to be heard in the matter although both provided written submissions.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 15 December 2011, by Alan Minto the Attorney-in-Fact of the opponent a position he has held since 2010. He states that the brand was launched by the opponent's predecessor in business in 1954 in the USA and that by the end of the 1990s WINSTON was available in over 60 countries. He states that by 2009 the cigarette was sold in over 107 countries and that the opponent has more than 3900 trademarks relating to the WINSTON brand worldwide. He states that the brand has been sold in the UK "for many years". He provides the following figures relating to sales of cigarettes and marketing:

Year	No. of cigarettes	Marketing £
2002	900,000	n/a
2003	500,000	n/a
2004	n/a	n/a
2005	n/a	n/a
2006	n/a	n/a
2007	n/a	n/a
2008	n/a	n/a
2009	2,090,000	818,794
2010	22,500,000	809,169

7) He states that the brand was launched in the UK in 2009 and that they are sold throughout the UK by Asda, Morrisons, Sainsbury and Tesco. He also provides the following exhibits:

- AM1: A copy of the Maxwell report for 2006 and 2007. This is said to be an independent annual report of the world's cigarette industry leaders. Winston was the fourth leading worldwide brand in 2000-2005 inclusive and the second leading brand in 2006.
- AM2: Copies of trade paper advertisements in 2009 and also photographs of the launch.
- AM3: Photographs of unidentified tobacco stands.
- AM4: Copies of four invoices. These are dated 25 January 2010, 17 March 2010, 1 October 2011 and 25 October 2011. The last two are after the relevant date. In the first invoice, addressed to a cash and carry in London, 3 of the 296 cartons of cigarettes are WINSTON brand. In the second invoice, addressed to a limited company in Kent, 14 out of 1227 cartons of cigarettes are WINSTON brand. The costs have been redacted.
- AM5: Photographs of a "smoking booth" in Heathrow from 2002 where the WINSTON brand is prominently displayed.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 28 February 2012, by Fiona Rodgers their Trade Mark Attorney. Most of the statement is in fact submissions which I shall refer to as and when required in my decision. She does however state :

“3.8 The applicant has informed me that it originally selected its trade marks after consultation with its designer, who suggested the words WILTON and WICKSON to identify the Applicant's products.”

9) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

10) The first ground of opposition is under section 5(2)(b) which reads:

“5.-(2) A trade mark shall not be registered if because -

(a)....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

11) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

12) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The opponent has been put to strict proof of use by the applicant as its mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004 paragraph six of which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

13) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of its mark has been made. In the instant case the publication date of the applications was 4 March 2011, therefore the relevant period for the proof of use is 5 March 2006 – 4 March 2011. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. The principles established in these judgments have been conveniently summarised by Ms Anna Carboni, sitting as the Appointed person O-371-09 *SANT AMBROEUS*:

“(a) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(b) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(c) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(d) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(i) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(ii) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(e) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(f) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

14) The mark is registered for “cigarettes”. The opponent has provided figures for cigarettes sold in the UK for the years 2009 and 2010. It has also provided a few invoices which show relatively small amounts of sales of cigarettes, but sales nonetheless. I also note that this evidence has not been challenged. Overall, I therefore find that there has been use of the mark in relation to cigarettes in the relevant period.

15) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the recent case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10) Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall

impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

16) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgments mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's marks and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods previously outlined.

17) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. (as he was then) sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that

distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v. Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become more distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

Distinctive character of the opponent’s earlier trade mark

18) To my mind, the opponent has singularly failed to show that it has a significant reputation in the mark at paragraph 3 above. The evidence provided is underwhelming at best. In the two years prior to the relevant date the opponent sold a total of approximately 24 million cigarettes in the UK. They do not put this figure into perspective in relation to the total number of cigarettes sold in the UK, market share or consumer awareness. They do state that they are the fourth largest global brand but fail to state how this equates to the UK. I am aware from my own knowledge that sales of tobacco in the developed world have reduced significantly in recent years and that sales in developing countries such as China, India and Brazil have increased significantly. In the absence of any contextual evidence I do not accept that the opponent can benefit from an enhanced reputation. Despite this I regard the opponent’s mark as having a high degree of inherent distinctiveness for the goods for which it is registered.

The average consumer and the nature of the purchasing process

19) I must now determine the average consumer for the goods of the parties. Both parties have specifications which cover tobacco in its many forms, and, broadly speaking, apparatus surrounding the act of smoking. To my mind the average consumer must be considered to be those members of the general public who smoke and businesses which trade in tobacco. However, I do not believe that there will be a difference between the member of the general public and businesses in terms of the level of attention paid during the purchasing process. It is well known that tobacco companies usually defend their advertising on the basis that it is encouraging brand loyalty, or to get smokers to switch brands rather than seeking to encourage new smokers. I accept the contention that tobacco products are the subject of brand loyalty and so they will not be purchased without a degree of care. Under current legislation

cigarettes are not the subject of self selection but must be requested. They are, currently, still visible and so the initial selection will be visual, but aural considerations will play a significant role. I am fortified in this view by the decision of the CJEU in *Plus v Blaz & Hiller* Case C-324/05.

Comparison of goods

20) The accepted test for comparing goods is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods;
- b) The respective users of the respective goods;
- c) The physical nature of the goods;
- d) The respective trade channels through which the goods reach the market;
- e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be found on the same or different shelves;
- f) The extent to which the respective goods are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods in the same or different sectors.

21) In *Gerard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC said:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM-Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the earlier trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM-Petit Liberto (Fifties)*[2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

22) The question of complementary goods/services has been considered by the CFI in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v*

OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685 , paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057 ; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757 , paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000 , paragraph 48).”

23) As both the applicant’s specifications are identical in the comparison test I shall simply refer to one specification. For ease of reference the competing goods are reproduced below:

Applicant’s goods	Opponent’s goods
In Class 34: Tobacco, tobacco products, cigars, cigarillos, cigarettes, smoking tobacco, smokers' articles, ashtrays, lighters, matches, match boxes, cigarette rolling machines, cigarette papers, cigarette filters, matches.	In Class 34: Cigarettes

24) Clearly, the term “cigarettes” appears in both specifications and this is therefore identical. To my mind “tobacco, tobacco products, cigars, cigarillos and smoking tobacco” are very similar to cigarettes in the sense that the users, uses, physical nature and trade channels are all likely to be the same as those for cigarettes. I accept that some items such as cigars may be sold in highly specialised outlets as expensive cigars tend to be stored in humidors, however, cheaper cigars are available in packets in garages and general stores.

25) Moving onto “cigarette rolling machines, cigarette papers, cigarette filters” it seems to me that the sole purpose of these items is to create a cigarette. They may not be manufactured by the same company but are clearly in competition. It is my experience that cigarette papers and filters are sold in the same outlets as cigarettes. I am therefore willing to accept that there is a high degree of similarity between these goods.

25) Turning to consider the remainder of the specification, namely, “smokers' articles, ashtrays, lighters, matches, match boxes, matches”. These are physically different to cigarettes and have different uses. The users, particularly for items such as matches are not necessarily likely to be the same as those for cigarettes. The opponent has not filed any evidence to show that such items are usually manufactured by the same companies as those that manufacture cigarettes, or that they are sold in the same outlets. Indeed, speaking personally it is my experience that items such as lighters and ashtrays are manufactured by jewellers and not by manufacturers of cigarettes and are sold in totally different outlets. Nor are they in competition with each other. I do not accept that they are complementary as these items are not indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking. They have a number of uses and the average consumer will not expect them to originate from the same source. These goods are dissimilar.

Comparison of trade marks

26) The trade marks to be compared are as follows:

Applicant's marks	Opponent's mark
2571608: WICKSON	W I N S T O N
2571609: WILTON	

27) It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

28) In my opinion, there are no dominant or distinctive elements in either party's trade marks. The distinctiveness lies in their totality, which in the case of the opponent's mark is, as far as I am aware (and there is no evidence or submissions to the contrary), distinctive for the cigarettes. I shall first compare the opponent's mark to application number 2571608 for the mark WICKSON.

Visual similarity

29) The opponent contends that the marks share the first two letters WI and the last two letters "ON". They state that the differences being in the middle of the mark will have less impact upon the average consumer, especially compared to the similarities at the beginning of the mark. I agree that there are similarities but do not accept that the significant differences can be so easily glossed over or that they would be so ignored by the average consumer. Overall there is a degree of visual similarity.

Aural similarity

30) The opponent again relies upon the sharing of the first and last two letters; also pointing out that both marks consist of two syllables. Again I accept these views but again I do not accept that the very different overall sound of each mark can be so readily overlooked whilst grasping at minor similarities within the whole. Overall there is a degree of aural similarity.

Conceptual similarity

31) The opponent submits that neither party's mark has a particular meaning in relation to the goods in question and contends that conceptual similarities or differences will not be relevant in the instant case. Again, I accept that neither mark has a meaning when used on the goods in question. However, I do not accept that the fact that the opponent's mark is a very well known first name in the UK can be overlooked. Nor should the fact that the applicant's mark has the appearance of being a surname be ignored. I take into account the CJEU comments in *The Picasso Estate v OHIM* - case C361/04P. To my mind there is a considerable conceptual difference between the marks even when used on tobacco products.

32) I now turn to compare the opponent's mark to application number 2571609 for the mark WILTON.

Visual similarity

33) The opponent contends that the marks share the first two letters WI and the last three letters "TON". They state that the differences being in the middle of the mark will have less impact upon the average consumer, especially compared to the similarities at the beginning of the mark. I agree that there are similarities but do not accept that the significant differences can be so easily glossed over or that they would be so ignored by the average consumer.

Aural similarity

34) The opponent again relies upon the sharing of the first two and last three letters; also pointing out that both marks consist of two syllables. Again I accept these views but again I do not accept that the very different overall sound of each mark can be so readily overlooked whilst grasping at minor similarities within the whole.

Conceptual similarity

35) The opponent submits that neither party's mark has a particular meaning in relation to the goods in question and contends that conceptual similarities or differences will not be relevant in the instant case. Again, I accept that neither mark has a meaning when used on the goods in question. However, I do not accept that the fact that the opponent's mark is a very well known first name in the UK can be overlooked. Nor should the fact that the applicant's mark is the name of a well known town in Wiltshire which is famous for its carpets be ignored. Also the applicant's mark has the appearance of being a surname. I take into account the CJEU comments in *The Picasso Estate v OHIM* - case C361/04P. To my mind there is a considerable conceptual difference between the marks even when used on tobacco products.

Likelihood of confusion

36) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade

marks may be offset by a greater degree of similarity between goods and services and vice versa. Firstly, considering the opponent's mark with application number 2571608, to my mind, whilst there are minor similarities in the marks these are far outweighed by the differences, such that even when used on identical goods (cigarettes) there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. Next, considering the opponent's mark with application number 2571609, to my mind, whilst there are minor similarities in the marks these are far outweighed by the differences, such that even when used on identical goods (cigarettes) there is no likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them.

The opposition under Section 5(2) (b) therefore fails in relation to both application number 2571608 and application number 2571609.

37) I shall now turn to consider the ground of opposition under Section 5(3) of the Act which states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in 3 the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

38) The relevant principles can be gleaned from the case law of the Court of Justice of the European Union. In particular, cases *General Motors Corp v Yplon SA* [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 and *L'Oreal SA and others v Bellure NV and others* - Case C-487/07. These cases show that:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal*, paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41.

39) The onus is upon an opponent to prove that its earlier trade mark enjoys a significant reputation or public recognition and it needs to furnish the evidence to support this claim. In the instant case the opponent filed evidence which it contended showed that it had reputation in the term "WINSTON" for cigarettes. At paragraph 18 above I set out my issues with the evidence provided and came to the conclusion that the opponent had not shown reputation in its mark for cigarettes in the UK. Thus the opponent fails at the first hurdle. **The ground of opposition based upon**

Section 5(3) fails in relation to both application number 2571608 and application number 2571609.

40) However, in case I am wrong regarding the matter of reputation, the opponent must also show how the earlier trade marks would be affected by the registration of the later trade mark. It is clear from *Inlima S.L.*'s application [2000] RPC 61; *L'Oréal v. Bellure*, Case C-487/07 and the decision of Mr Daniel Alexander sitting as the Appointed Person in B/L O/307/10 that a likelihood of the average consumer linking the products of both parties is a pre-requisite under this ground and in view of my earlier findings in relation to the marks at issue, the opponent is in no stronger position on this ground. **The opposition with regard to Section 5 (3) in respect of both applications fails.**

41) Lastly, I turn to the ground of opposition based upon Section 56 of the Act which reads:

"56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section."

42) A likelihood of confusion is a pre-requisite under this ground and in view of my earlier findings in relation to the marks at issue, the opponent is in no stronger position

on this ground. **The opposition with regard to Section 56 of the Act also fails in relation to both applications.**

CONCLUSION

43) The opponent has failed under all the grounds of opposition.

COSTS

44) As the applicant has been successful in defending both applications it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement x2	£400
Preparing evidence and considering and commenting on the other side's evidence	£600
Submissions	£400
TOTAL	£1400

45) I order J T International S.A. to pay Allied Global Tobacco Limited the sum of £1400. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of November 2012

**George W Salthouse
For the Registrar,
the Comptroller-General**