

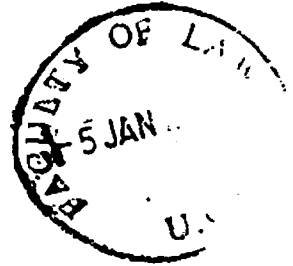
PLAYER

1983 No. 6196p A

PLAYER AND WILLS (IRELAND) LIMITED

.v.

GALLAHER (DUBLIN) LIMITED



Judgment of Mr. Justice Barron delivered the 26th day of September 1983.

The Plaintiff has brought these proceedings to protect the sales of its medium tar king size cigarettes. It maintains that these sales are threatened by the manner in which the Defendant is marketing its club size cigarettes.

The Plaintiff's cigarettes are sold in a distinctive blue wrapping and on the evidence adduced are essentially sold either as John Player Blues or simply as Blues. The Defendant's cigarettes are sold in a similar distinctive blue wrapping although the colour blue is not identical.

The Plaintiff's case is that confusion will arise in the minds of the public if the two brands are allowed to be sold side by side.

The essence of passing off is the adoption by the Defendant of some element of the manner in which the Plaintiff's goods are marketed in a manner calculated to deceive persons intending to buy the Plaintiff's product into thinking that they have bought it when in fact they have bought the Defendant's product. This element so adopted must be one for which the Plaintiff can establish a reputation in the sense that those

purchasing goods involving such element do so because of their awareness of the connection between that element and the Plaintiff. The element may inter alia be the name, the particular mark or design attached to the goods or its get up. In each case, it indicates a badge of origin.

In the present case, the Plaintiff contends that the colour of the packaging of its product is such that it is connected in the minds of the purchasing public as being its product. The Defendant maintains the contrary and denies that any confusion can arise.

The Plaintiff has to establish that there is a fair issue of fact to be tried, which, if determined in its favour, will establish the tort. In my view, there is such an issue to be tried. The evidence suggests that the all blue packaging is such as to amount to a badge of origin and that those asking for blues could be deceived into thinking that they had received the Plaintiff's product when in fact they had received that of the Defendant. Even after discovering that they had received a packet of club size rather than king size they could still assume that the product was a new product of the Plaintiffs.

In support of his argument Counsel for the Defendant relies upon Cadbury Schweppes .v. Pub Squash Co., 1981, 1 All E.R. 213. However in that case, the issue had already been determined against the Plaintiff.

It is not for decision on the present application. Adapting the quotation from the speech of Lord Fraser in Ewen Warninck B.V. v. J. Townend and Sons (Hull) Limited, 1979, 2 All E.R. 927 at page 943 cited by Lord Scarman, what the Plaintiff in the present case is seeking to do is to protect what it says is its established right of property in the goodwill attached to the colour which is distinctive of a product or class of products sold by it in the course of its business. On this application I do not have to decide if he has this right, but am required only to determine whether there is a fair question to be tried as to its existence. As I have already indicated, I accept that there is.

The Defendant has urged strongly that in any event the balance of convenience lies in its favour. Normally the balance of convenience lies in retaining the status quo. In passing off, the convenience lies usually with the Plaintiff because of the difficulty in assessing the damage to its trading, if it ultimately succeeds. There is nothing in my view in the present case to disturb this approach. The Plaintiff is selling king size cigarettes. The Defendant is introducing club size cigarettes. The confusion arises from the packaging not from any other promotional aspect of the Defendant's product which concentrates on club size. Very little alteration in the colouring of the packaging and its printing will

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avoid the present problem. In my view the balance of convenience lies with the Plaintiff.

The Plaintiff is entitled to the relief it seeks. Having regard to the views I have expressed this will apply to the sales of 20's as well as 10's even though the packet shape is different, and will apply also to promotional material.

Henry Birrell

28/7/83