

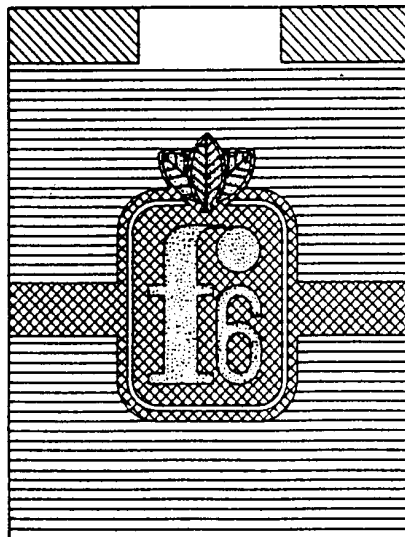
**TRADE MARKS ACT 1938(AS AMENDED)
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION by
Vereinigte Zigarettenfabriken Dresden GmbH
to register a trade mark in Class 34**

AND IN THE MATTER OF

**OPPOSITION THERETO by Reetsma
Cigarettenfabrik GmbH**

1. On 2 October 1990, Vereinigte Zigarettenfabriken Dresden GmbH of Germany made an application under Section 17 of the Trade Marks Act 1938 for the registration of a trade mark consisting of the label shown below.



2. The specification of goods of the application is as follows:-

Raw tobacco; tobacco products; smokers articles; holders, cases, packets and boxes all

for cigars, tobacco and cigarettes; ash trays (not precious metal or plated therewith); pipe racks, pipe cleaners, pipe cleaning sets, cigar cutters; tobacco pipes, tobacco pouches, lighters, apparatus for rolling cigarettes, cigarette paper, cigarette filters, cigarette tubes, humidifiers for tobacco goods; matches; all included in Class 34.

3. The application contains the following disclaimer:-

“Registration of this mark shall give no right to the exclusive use of the letter and numeral f6.”

4. The application form also contains the following limitation as to colour under Section 16 of the Trade Marks Act 1938:-

“The mark, here depicted in heraldic shading, is limited to the colours brown, green and yellow as shown in the representation on the form of application.”

5. On 8 May 1994, Reetsma Cigarettenfabrik GmbH of Hamburg, Germany filed notice of opposition. The grounds of opposition are primarily based upon Sections 11 and 12(1) of the Trade Marks Act 1938. In particular, that the opponent is the proprietor of an earlier registered trade mark in Class 34 consisting of the label shown below.



6. The effective date of this registration is 25 August 1988, which is prior to the date of the application under opposition. The registration is subject to a disclaimer to any exclusive right arising therefrom to the use of the letter and numeral "R6", the word "International" and the device of tobacco leaves.

7. The specification of goods for which the earlier trade mark is registered is:-

"Tobacco, raw or manufactured."

8. The mark is registered in black and white with no limit as to colour.

9. The opponent also asks for the application to be refused in the exercise of the Registrar's general discretion under Section 17 of the 1938 Act.

10. The applicant denies the grounds of opposition.

11. The matter came to be heard on 28 June 1999 when the applicant was represented by Mr C Morcom Queen's Counsel, instructed by Abel & Imray, and the opponent was represented by Ms D McFarland of Counsel, instructed by Walther Wolf & Co.

12. By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, in the light of the transitional provisions set out in Schedule 3 to the Trade Marks Act 1994, I am required to continue to apply the provisions of the old law to these proceedings. Accordingly, all further references in this decision to the Act are references to the Trade Marks Act of 1938.

13. Despite requesting a number of extensions of time to file evidence, the opponent failed to do so. In consequence there is no evidence before me which could support the opponent's ground of opposition under Section 11 of the Act. This ground of opposition therefore fails.

14. It is common ground that the matter falls to be determined primarily by reference to Section 12(1) of the Act, which is as follows:-

“12(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with a trade mark belonging to a different proprietor and already on the register in respect of the same goods, or that so nearly resembles such a trade mark as to be likely to deceive or cause confusion.

15. It is also common ground that the appropriate test under Section 12 is that set out in *Smith Hayden's Application* [1946] 63 RPC 97 at page 101, which requires me to consider all normal and fair use of the respective marks and then to decide whether I am satisfied that there will be no reasonable likelihood of confusion amongst a substantial number of persons. Mr Morcom also referred me to the well known test set out by Parker J in *Pianotist* [1906] 23 RPC 774 at page 777, which is set out below:-

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

16. It is well settled that the onus is on the applicant to satisfy me that there is no reasonable likelihood of confusion.

17. The applicant's evidence consists of a Statutory Declaration dated 19 March 1997 by Mrs Annette Miller-Pawlischek, who is a Manager in the Legal Department of Phillip Morris GmbH, which is the parent company of the applicant. Mrs Miller-Pawlischek states:-

1. The applicant is the proprietor of United Kingdom trade mark registration number 1443410, which is in respect of a trade mark which is substantially identical to the trade mark in suit and has been registered since 1993 with an effective date of registration of 19 April 1990, in respect of cigarettes in Class 34. Mrs Miller-Pawlischek notes that no opposition was filed to this earlier application.
2. The parties goods have been on sale side by side in the former East Germany since 1977 under substantially the same marks at issue in these proceedings. Mrs Miller-Pawlischek states that the applicant is unaware of any confusion having arisen in that market.
3. The opponent has filed opposition to, or applications for cancellation of, the applicant's mark in a number of other jurisdictions. These opposition and cancellation actions have been based upon the same, or substantially the same, marks at issue in these proceedings. These opposition and/or cancellations have, to date, been resolved in the applicant's favour or are on-going or subject to appeal.
4. The opponent launched cancellation proceedings in respect of a corresponding trade mark in the former East Germany. These proceedings were also based upon the existence of an earlier trade mark which substantially corresponds with the opponent's mark in these proceedings. The application for cancellation was rejected by the Dresden District Court, the District Supreme Court and eventually the Federal Supreme Court in Germany.
5. A copy of the Supreme Court decision with an English translation is exhibited

to Mrs Miller Pawlischek's declaration. It appears from this that the Supreme Court refused to accept the appeal because:-

“Even if the two constituents of the marks “R6" and “f6" are considered to have a significance which dominates the respective marks as a whole, there is for the purposes of trade mark law no risk of confusion.”

18. Mr Morcom accepted that the existence of the applicant's earlier registration of substantially the same mark in Class 34 did not in any way debar this opposition. He argued that the absence of any opposition to the earlier registration supported the applicant's contention that there was no likelihood of confusion between the respective trade marks. There can, of course, be many reasons why an opposition is not filed. It may simply be, as Ms MacFarland submitted, that the opponent simply missed the earlier publication. I do not think the existence of the earlier registered trade mark has any significant bearing on the outcome of this opposition, not least because the application before me has a wider specification of goods than that contained within the applicant's earlier registration.

19. I find little assistance from the absence of any evidence of confusion arising from the concurrent use of the respective marks in East Germany. The trading conditions in the former East Germany may be very different to those in the United Kingdom.

20. Similarly, I get little assistance from the list of countries where the opponent has failed in oppositions and/or cancellation proceedings on similar grounds. With one exception, which I shall come to in a moment, the applicant has not provided copies of the decisions of the courts or tribunals concerned and I therefore have no idea of the reasoning that was adopted and which resulted in their decisions. I also bear in mind that, even with label-type trade marks such as those before me, differences in the pronunciation of letters and numerals can occur from one country to another. In determining the likelihood of confusion I must apply the case law established under Section 12 of the Act.

21. The decision of the German Federal Supreme Court is of interest but is not binding upon me. In the end I must make my own decision.

22. The first matter to be considered is whether the goods are the same or of the same description. A comparison of the respective specifications reveals that the application under opposition contains goods which are the same as those for which the earlier trade mark is registered. I therefore intend to consider the matter first on the basis that the respective marks are to be used on the same goods.

23. Before I move on to consider the similarity of the marks it is necessary for me to clarify the relevance of the disclaimers of exclusive rights to the combinations "f6" and "R6", which are features of the application and registration before me. A similar point arose in a decision of 24 December 1998 by Mr Geoffrey Hobbs QC, sitting as the Appointed Person in the case of Fountain Technologies Inc's Application, which as far as I am aware, has not yet been reported. He described the significance of a disclaimer in relation to an objection under Section 12(1) of the Act as follows:-

"..... similarities attributable to nothing more than the presence of a disclaimed feature could not support an action for infringement of the registered trade mark under the 1938 Act. The position appears to be no different under the Trade Marks Act 1994: *The European Limited, The Economist Newspaper Limited* (1998) FSR 283 (CA).

It will be easy to suppose that the same consideration should apply for the purpose of determining whether registration is prevented by Section 12(1) on the ground that a mark so nearly resembles a previously registered mark as to be likely to deceive or cause confusion. However, the prohibition in Section 12(1) has been carried forward (with modifications) from Section 6 of the Trade Mark Registration Act 1875 and it has long been recognised that it renders marks ineligible for registration on a somewhat broader basis than that upon which their use would be regarded as actionable in proceedings for infringement. This has led to the prevailing view that objections under

Section 12(1) are not, in point of law, restricted to the residue that is left after disclaimers (applicable either to the mark offered for registration or the mark previously registered) have been taken into account. According to the prevailing view a disclaimed element must neither be ignored nor given less significance than it deserves when due allowance has been made for the degree to which it is not distinctive of the relevant goods or services. On this approach to the matter, similarities attributable to nothing more than the presence of a disclaimed feature may be sufficient to sustain an objection under Section 12(1): GRANADA TM [1979] RPC 303.”

24. The correctness of that approach was not argued before Mr Hobbs, and I understood Mr Morcom to accept this interpretation of the law. I therefore intend to proceed on the basis that the respective disclaimers of exclusive rights to the combinations “R6” and “f6” do not, of themselves, prevent the opposition under Section 12(1) from succeeding. However, in making my comparison of the respective trade marks I must take into account the distinctiveness or otherwise of the various elements which make up the two trade marks. In this connection I observe that a single letter and numeral combination, whilst not describing the goods, has little imaginative content. This is no doubt the reason why the parties agreed to enter a disclaimer of exclusive rights to these elements of their marks.

25. The visual similarities and differences between the respective trade marks are self evident. Ms McFarland submitted that, in respect of the goods at issue, the visual comparison of the marks was the most important. I do not entirely accept that submission. In my experience tobacco products are commonly ordered by word of mouth. I therefore consider the phonetic similarity or otherwise to be equally important. Indeed one of the examples of confusion envisaged by Ms McFarland involved aural confusion arising from the respective trade marks both being shortened in use and described simply as “6” marks. There is no evidence to support this argument and I reject it as unlikely.

26. Ms McFarland also suggested that there could be direct visual confusion between the respective trade marks. There is, in my view, very little prospect of confusion if the marks are

seen side by side on a shelf. However, it is well established that the enquiry should go further than this. See *De Cordova and Others v Vick Chemical Company* (1951) 68 RPC 103.

Allowance must be made for imperfect recollection of the earlier trade mark. This appears to me to be the opponent's best point.

27. In considering the possibility of confusion through imperfect recollection it is important, as Mr Justice Parker's words in the *Pianotist* case makes clear, to consider the nature of the goods involved and the kind of customers for those goods. Ms McFarland suggested that the goods at issue were of the "bag of sweets" variety which would tend to be purchased with little care or attention. Again there is no evidence to guide me on this point. I am therefore left to rely upon my own experience. In my experience tobacco products are not normally casual purchases. Indeed users of such products are, I believe, well known for their allegiance to their favoured brand or brands. In my view they are a group of consumers who are amongst the least likely to have an imperfect recollection of the brand of products they desire. Accordingly, even making allowance for imperfect recollection, I see no real tangible likelihood of confusion between the respective trade marks.

28. In the light of my finding in respect of identical goods, there is no need for me to go further and consider the opposition in respect of the other goods in the applicant's specification. Not all of the applicant's goods are necessarily "of the same description" as the goods covered by the opponent's registration. For example, "ash trays", "pipe racks", "pipe cleaners", "pipe cleaning sets", "cigar cutters", "tobacco pouches", "lighters" and "matches". In the light of my earlier finding it is not necessary for me express a final view about this, and as the matter was not argued before me, I prefer not to do so. I simply draw attention to the matter in the event that my primary finding is found to be wrong on appeal.

29. For the reasons given above, the opposition under Section 12(1) of the Act fails.

30. I see no reason to exercise the Registrar's discretion under Section 17(2) of the Act adversely to the applicant and I decline to do so.

31. The opposition having failed the applicant is entitled to a contribution towards its costs. I therefore order the opponent to pay the applicant the sum of £800.

Dated this 13 Day of July 1999

ALLAN JAMES

For the Registrar

The Comptroller General