

O-162-09

TRADE MARKS ACT 1994

IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 904730
BY ALPI LIMITED

AND

IN THE MATTER OF OPPOSITION NO 71487 THERETO
BY BENSON & HEDGES LIMITED

TRADE MARKS ACT 1994

IN THE MATTER of
International Registration
No 904730 by ALPI Limited
and in the matter of
opposition No 71487 thereto
by Benson & Hedges Limited

Background

1. On 23 May 2006 ALPI Limited ("ALPI"), on the basis of a Bulgarian registration with a priority date of 20 December 2005, requested protection in the UK under the terms of the Madrid Protocol for the following mark:



2. The request was made in relation to the following goods in Class 34:

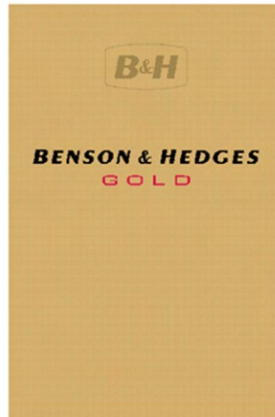
Tobacco; tobacco products, including cigarettes; smokers' articles; matches.

3. Following publication of the International Registration (which I will refer to as "the application") in the *Trade Marks Journal*, Notice of Opposition was filed by Benson & Hedges Limited ("B&H"). The opposition is based on section 3(6) of the Act on the grounds the application was made in bad faith and under sections 5(2)(b) and 5(4)(a) of the Act based on earlier rights. In support of its ground of opposition under section 5(2)(b) B&H rely on two earlier rights:

2364298



2364300



Each of the above marks is registered in respect of: *Tobacco, whether manufactured of unmanufactured; substances for smoking sold separately or blended with tobacco, none being for medicinal or curative purposes; smokers' articles and matches; cigarette papers; all included in Class 34; all for sale in the United Kingdom and for export to the Republic of Ireland.* The registration procedures for these marks were completed on 26 November 2004 and 1 April 2005 respectively, and therefore are not subject to the proof of use provisions of section 6A of the Act.

4. B&H claim that the respective marks are similar and that the respective goods are identical or similar such that there is a likelihood of confusion. Both the earlier rights are said to have been used in the UK in relation to cigarettes and to have acquired substantial reputations.

5. The objection under section 5(4)(a) of the Act is based on use since July 2003 of the following earlier rights:



6. ALPI filed a counterstatement which essentially denied each of the claims made. Both sides filed evidence and a hearing took place before me on 7 May 2009. ALPI did not attend nor was it represented although written submissions were filed in lieu of attendance. Ms Helene Whelbourn, of J.E. Evans-Jackson & Co Ltd, represented B&H.

Evidence

7. The following evidence was filed:

B&H

Statutory Declaration of Andrew Bingham with 9 exhibits: Mr Bingham has been the Company Secretary of B&H since November 2007.

ALPI

Witness statement of Nikolay Rusev Balushev with 4 exhibits: Mr Balushev is a Director of ALPI.

Mr Bingham also filed a witness statement in reply, as did Helene Whelbourn whose witness statement had 2 exhibits. Much of the evidence filed by both parties consists of submissions which I do not intend to summarise but do take into account as appropriate.

B&H's evidence

8. Mr Bingham states that cigarettes under the trade mark Benson & Hedges have been sold since as early as 1873 and in a gold-coloured packet since as early as 1955. Cigarettes under the BENSON & HEDGES trade mark were sold in a gold pack bearing the label "Special Filter" until July 2003. In September 2003 the words "Special Filter" were replaced by the word "Gold" to comply with regulations in force at the time. Between July and September of that year transitional packets were labelled with both "Special Filter" and "Gold". He exhibits copies of each of these packets at GS2, GS3A GS3B.

9. Sales figures as given as follows:

Year	1997	1998	1999	2000	2001	2002	2003	2004	2005	2006
Volume (Mills)	11068	9078	7116	6475	6082	5794	4961	4477	3848	3385
Revenue (£m)	1346.7	1187.3	1063.0	1041.7	1032.2	1015.9	896.1	837.4	749.6	987.6
Rate £ per M	122	131	149	161	170	175	181	187	195	212

10. Mr Bingham states that these figures relate to sales of Benson & Hedges Gold cigarettes however as these particular cigarettes were not introduced until 2003, I queried this with Ms Whelbourn at the hearing. She clarified the situation and stated that the figures relate to sales of cigarettes in Benson & Hedges gold-coloured packets bearing the words Special Filter or Gold (or both) depending on the date sold, in line with the information set out in the above paragraph.

11. Mr Bingham exhibits the following:

- GS4 internal documents said to date from around 2002 showing that the Benson & Hedges Special Filter cigarette then had an 18.5% market share (which Ms Whelbourn stated referred to its share in the “premium” cigarette market);
- GS5 advertising material dating from 1991 to 1997. Where cigarette packets are shown the packet is that of the Special Filter packet;
- GS6 point of sale material for use in retail and trade outlets. One of the documents bears a date of 2002 and appears to be an internal document from a design company. I cannot see clearly what it shows. Another two documents have a 2005 date within the text that appears on them, the rest is undated. These documents include pictures of Benson & Hedges Special Filter, Benson & Hedges Superkings and Benson & Hedges Superkings Lights cigarette packets.

12. Both GS5 and GS6 are said to show how emphasis is made of the gold colour of the packets. All of the different packets shown are gold-coloured.

- GS7 A photograph of a Gold Street premium cigarette packet;
- GS8 A printout from the Alibaba.com website showing a packet of Gold Street cigarettes as well as products described as related and from other suppliers. These include those described as Jackpot Mini Gold, Jackpot Slims Gold, Kiva Gold, Desert Gold and Conway Gold cigarettes as well as Gold B&H cigarettes, Benson and Hedges Gold cigarettes and Benson and Hedges Cigarettes (Gold).
- GS9 An extract from an edition of Tobacco Control Journal 2002 making reference to British American Tobacco’s (BAT) Gold Street cigarettes. The extract is accompanied by a picture which shows a packet of cigarettes but is

not clear enough for me to make out. At the hearing I queried the relevance of this material given the reference in the article to the cigarettes being those of BAT who are not a party to these proceedings. Ms Whelbourn confirmed the reference to them was thought to be an error within the text as BAT is not believed to be connected to ALPI.

13. Ms Whelbourn's evidence introduces two further exhibits:

- HMW1 advertising material of both parties dating from between 1963 and 1977:
- HMW2 pictures of point of sale displays showing how both parties' cigarette packets would be displayed. The quality of the reproduction is poor.

ALPI's evidence

14. Mr Balushev states that ALPI first sold its GOLD STREET cigarettes in 2005. They are sold through duty free outlets in Bulgaria from where he says UK visitors can buy them. The mark in suit is registered in a number of (specified) countries. At G1 Mr Balushev exhibits details of the international registration.

15. Mr Balushev states that B&H do not have exclusive rights either in the colour gold or in the word gold. He says that numerous cigarettes are sold under marks which include the word gold. At G3 he exhibits a list of cigarette brands as listed on the cigarettespedia website and which include the word in their name. At G4 he exhibits details of registrations on the UK trade marks register of marks which include the word.

16. Mr Balushev states that when buying cigarettes, purchasers refer to their name rather than the colour of the packet.

The objection under section 5(2)(b)

17. Whilst Ms Whelbourn submitted that this was probably her weakest ground, I intend to deal with the objection under Section 5(2)(b) first. Section 5(2)(b) of the Act reads:

(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.

18. In determining the question under Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000]

F.S.R 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) 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; *Sabel BV v Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29.

Similarity of goods

19. There is no dispute that identical goods are involved.

The relevant public and the purchasing act

20. It is very well known that cigarettes and related tobacco products are subject to legislative restrictions. Because of these restrictions, the relevant public are adult smokers and the purchaser will buy them by asking the assistant to provide them from displays located behind the counter. Alternatively, though to a lesser extent, the purchaser may select them himself from vending machines in a pub, club or similar venue. They are everyday goods which are widely available and likely to be bought regularly by the average consumer who, given the nature of the product, will take a fairly high degree of care with his purchase.

Similarity of marks and their dominant and distinctive elements

21. When assessing the similarity of the marks, I must do so with reference to the visual, aural and conceptual similarities between them, bearing in mind their dominant and distinctive components (*Sabel BV v Puma AG*, para 23). Given that the predominant method of purchasing these goods will take place in shops or other venues where one would have to ask the assistant for them, the oral/aural aspect is likely to be paramount though the visual aspect may predominate where the goods are selected from a vending machine. However they are selected, I have to consider the likelihood of confusion based on a global assessment of all relevant matters.

22. ALPI's mark consists of the words GOLD STREET in capital letters presented in an italicised but unremarkable font. Whilst these are both everyday words with clear meanings they hang together and are suggestive of a place name. Above these words, and in a central position, is a device of what I take to be a tobacco leaf presented in a square border. Such a leaf would not be distinctive in relation to the goods in issue. Below the words, and again in a central position, is what I take to be a letter G stylised in such a way as to provide itself with a crescent-shaped border. It is a long established principle that words speak louder than devices and, whilst the G device has a fair degree of distinctiveness, in my view the words GOLD STREET constitute the dominant element within the mark.

23. Whilst much is made in the evidence and submission of B&H's Special Filter cigarette packet this is not, as Ms Whelbourn accepted at the hearing, a mark which B&H has pleaded in its Notice of Opposition. As set out in paragraph 3 above, B&H rely under this ground on two earlier registered trade marks.

24. The first of the two marks relied upon, No. 2364298, consists of the words and ampersand BENSON & HEDGES. These words are said to be in italicised font but in my view the degree of italicisation is so slight as to be negligible. On anything other than a forensic examination they appear to be in plain block capitals. Above these words, and in a central position, are the letters "B&H" presented in a lozenge shaped border. The whole is contained within a rectangular border.

25. Earlier registration No. 2364300 is a series of two marks. These differ from the 2364298 mark only in that they also have the word GOLD underneath the words BENSON & HEDGES and, in the second mark in the series, the word gold appears in red, the other words in black, the rectangular background is a solid gold colour with the lozenge containing the letters B&H in a slightly deeper gold colour.

26. At the hearing Ms Whelbourn stated that she could not deny that other cigarette manufacturers use the word GOLD for premium cigarettes. On that basis it is not a distinctive element within the earlier marks. Both Benson and Hedges are surnames but the combination, joined by the ampersand are distinctive and are the dominant element within each of the earlier marks, with these names being emphasised to an extent by the letters B&H in the lozenge device.

27. I intend to consider B&H's earlier series of two marks under No. 2364300 only, as if B&H cannot succeed in relation to these marks which contain the word GOLD, it will be in no better position in relation to No. 2364298 which does not. To the extent that the respective marks contain the word GOLD there is some point of similarity from a visual and aural perspective. But this similarity is at a very low level when comparing the marks as wholes, as I am required to do, given the relevant positions of the word GOLD and the presence of other elements in the marks. Conceptually, GOLD STREET brings to mind a place whereas BENSON & HEDGES has surnominal meaning. The inclusion of the word GOLD within the earlier marks brings to mind a premium product supplied by persons (or company) with these names and as suggested by B&H's own submissions in relation to the evidence at Exhibit GS4. There is no conceptual similarity between the respective marks.

28. Ms Whelbourn referred me to Mr Bingham's evidence in reply where he submitted that if ALPI were to use its mark in a gold colour "it would increase even further [-] the similarities between the Alpi's trade marks and the packaging used by my Company and as shown in Exhibits GS2, GS3A and GS3B...". As for the marks shown in the first two named exhibits, neither of them has been pleaded and cannot therefore be taken into account.

29. There is no evidence, and indeed ALPI makes no claim, that the mark applied for has been used in the UK. ALPI submits that I should not consider anything other than the mark as applied for. B&H submit that the use ALPI has made elsewhere of its mark has been in gold and that this means it is probable it will be used in gold in the UK. This raises the question of what would be considered "normal and fair use" of the applied for mark.

30. In *Direct Line Insurance plc v esure Insurance Limited* BL O-363-06 the registrar's Hearing Officer stated:

"115. It is common ground that in assessing the likely effects of a mark applied for I must consider normal and fair use of the marks. However, there is some disagreement about what this means in practice. Counsel for esure submitted that as esure's mark has been used in the colours of blue and orange, I should consider the paradigm use of esure's mark to be in those colours. Mr Hobbs submitted that in the absence of a proposal for the mark to be registered in any particular colour, I should consider normal and fair use of esure's mark in all colours.

116. In my view, Mr Hobbs is correct. Otherwise esure would be able to ask for the assessments of any damage that its mark may cause to be assessed on the basis that it is used in orange and blue, and yet still be free to make further "normal and fair" use of it in other colours, including red.

117. I am aware of authority in *Premier Brands UK v Typhoon Europe* [2000] FSR 767 to the effect that, prima facie, and in the absence of evidence or argument, the way that a mark has been used can be taken as a paradigm example of normal and fair use. I do not read this as meaning that a tribunal should not consider other examples of normal and fair use. I proposed to approach the matter accordingly. This requires me to contemplate the effect of the use of the mark applied for in any colour, including red.”

31. The Hearing Officer’s decision was subject to an appeal before Lindsay J. In his decision, reported at [2007] EXHC 1557 (Ch) he said:

“ Colour

128 Before the Hearing Officer, Direct Line, by Mr Hobbs, had submitted that in the absence of a proposal by esure for the mouse on wheels to be registered in any particular colour the Hearing Officer was required to consider normal and fair use of the mark in all colours. The Hearing Officer held Mr Hobbs’ argument on the point to be correct and he concluded that he was thus required to contemplate the effect of the use of the mouse on wheels mark “in any colour, including red.” In Direct Line’s Respondent’s Notice there is a heading which leads to a suggested conclusion, namely that the claim for protection by registration by esure was accordingly for the shape graphically represented, inter alia, in the colour red. In practical terms there is, as it seems to me, no difference between the contention in the Respondent’s Notice and the finding, which I have cited, by the Hearing Officer on the issue. However, Mr Silverleaf did in argument raise that the Hearing Officer erred in principle in relation to colour. He had paid too much regard to the possibility of esure using a red mouse with black wheels. But esure never foreswore the use of red and black, as they so easily could have done had that represented their intent and, all in all as to colour, I have failed to find any material error of principle in this respect on the Hearing Officer’s part.

Black and white

129 In its Respondent’s Notice Direct Line seeks to build upon the Hearing Officer’s finding at his paragraph 127 that the phone on wheels mark had acquired a huge reputation in the financial services market and “was extremely distinctive, even in black and white. When seen in its customary red livery the mark was even more distinctive of the services of Direct Line”. Yet, when the Hearing Officer came to his conclusion on likelihood of indirect confusion, he relied to a material degree upon Direct Line’s use of red. At his paragraph 143 he said:

“In this case the colour red serves to reinforce the association of the earlier trade mark with DL. The use of the mark applied for in that colour would plainly serve as a further pointer to DL. Taking all of the above into account, I find that at the date of the application, the use of the mark applied for in the colour red would have been likely to cause indirect confusion with DL’s earlier mark. As the use of the mark in that colour is an example of normal and fair use of the trade mark, I find that the objection under s.5(2)(b) succeeds.”

The complaint raised in the Respondent's Notice is, in effect, that the Hearing Officer should specifically have held esure's mouse on wheels would give rise to the existence of a likelihood of confusion even when it was used in black and white. But the point only becomes material to the overall outcome if the Hearing Officer could be said to have erred in principle in his view that, given that esure had not limited the colours which it applied to use but had sought registration in black and white form, the conventional interpretation of such an application was that, if registration were to be granted, registration in any colour (including black and white) would have been protected. As I have not understood Mr Silverleaf to argue that the Hearing Officer erred in principle in that respect, the argument raised under this heading in the Respondent's Notice adds nothing of substance and, as I am not only loath to tinker but obliged not to tinker with the Hearing Officer's conclusions, short of a demonstrated material error of principle, I would prefer to leave his paragraph 143 and its reference to colour exactly as it is."

32. None of the respective marks are subject to any limitation as to colour. Normal and fair use of marks not limited to colour could therefore extend to each parties' marks being used in the same colour and I will consider the position with this in mind.

Distinctiveness of the earlier trade mark

33. A further factor to be taken into consideration is that of the distinctiveness of the earlier trade mark based either on its inherent qualities or on any enhanced distinctiveness because of the use made of it. The more distinctive the earlier mark, the greater the likelihood of confusion (*Sabel BV v Puma AG*, paragraph 24).

34. B&H's mark is said to have been used since September 2003. The volume and revenue figures given and which relate to the period since this time appear extensive but I have no information as to what market share they may represent. Whilst, in his evidence, Mr Bingham states that "considerable efforts have been made to promote and advertise (where permitted under tobacco advertising legislation)" I have not been provided with any evidence that would support this. Although some point of sale material has been filed within Exhibit GS6, I have no indication of whether, and if so where and when it was used. Smokers will no doubt be aware of BENSON & HEDGES per se and I accept that the earlier mark has a reasonable degree of inherent distinctiveness. But I am unable to find on the evidence that the earlier mark relied upon has any enhanced level of distinctiveness through use.

Likelihood of confusion

35. I need to consider both direct and indirect confusion. In relation to direct confusion, where the average consumer, who rarely has the chance to make direct comparisons between marks but must instead rely upon the imperfect picture of them he has kept in his mind, mistakes one mark for another, the clear visual, aural and conceptual differences between the marks mitigates strongly against any such likelihood. This is the case even taking into account that identical goods are involved and the distinctiveness in the earlier mark even if both marks were to be presented in the same colour. Ms Whelbourn accepted, and the evidence shows, that other cigarette manufacturers use the word Gold and did not dispute that others use the

colour gold on their packaging. Indeed Exhibit GS6 shows B&H to have used gold colouring on a number of different packets itself. The use of the word Gold and/or packaging of that colour cannot be distinctive of B&H nor indeed of any particular trader. It seems to me that the consumer will be aware of this circumstance of trade and, consequently, no confusion will arise.

36. In relation to indirect confusion, where the similarities between the marks lead the consumer to believe the goods or services sold under them are from the same or an economically linked undertaking, I have already found that the only point of similarity is the fact that each of the respective marks shares the word Gold and it is not disputed that this is a word that is not distinctive of a particular trader. Taking all matters into account, and applying the global appreciation as I am required to do, including normal and fair use where both marks may be used in the same colour, I find there is no likelihood of indirect confusion.

37. The ground of objection under section 5(2)(b) based on earlier mark No 2364300 fails. That being the case, and as I have already indicated, it can be in no stronger position in relation to its objection based on 2364298. The objection under section 5(2)(b) therefore fails in its entirety.

The objection under section 5(4)(a)

38. Section 5(4) (a) reads:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

39. B&H’s objection under this ground is based on its claim that it enjoys extensive common law rights in the UK in the colour and get-up of two of its packets of cigarettes. In its pleadings, B&H claim to have used each of the marks since July 2003 although the representations provided appear to me to be those which appear in the evidence as the transitional pack said to have been used between July and September 2003 only and the pack used from September 2003 onwards. No further explanation of its objection is provided on the Notice of Opposition, however, in her submissions Ms Whelbourn says that “ the GOLD STREET pack, as actually used, is so nearly resembling the Benson & Hedges pack that there is an argument consumers would be mislead (sic) into thinking that the packs are related to one another leading to misrepresentation and damage to the Opponent’s sales.” I therefore take the objection under this section to be based on the law of passing off.

40. It is well established that the elements necessary for passing off are threefold: there must be goodwill, misrepresentation and damage. (See *Erven Warnick BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31).

41. I have already found that the marks themselves are not similar enough to cause the consumer to be confused about the economic origin of the goods in question even if ALPI uses its mark in gold. There is no evidence that B&H have any goodwill or reputation in either the word GOLD or in the colour of that name, quite the reverse. That being the case I fail to see how B&H can be in any better position to argue that goods sold under ALPI's mark would be taken by the relevant consumer to be those of B&H. The opposition under section 5(4)(a) therefore also fails.

The objection under section 3(6)

42. Section 3(6) of the Act reads:

“3.-(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

43. In relation to the objection under section 3(6) of the Act, B&H say that ALPI:

“adopted the trade mark the subject of International Registration No. 904730 GOLD STREET (label) in bad faith and consequently registration of GOLD STREET (label) would offend against the provisions of S.3(6) of the Trade Marks Act 1994. The font in which the words GOLD STREET appear in the Applicant's trade mark is identical to the font which was used for a long number of years in respect of cigarettes sold in the UK under the Opponent's trade mark BENSON & HEDGES, and a visual illustrating use of that font is shown in “Exhibit 1” hereto. The use of this particular font was discontinued in the UK in 2003 but the font continues to be used in relation to cigarettes sold under the trade mark BENSON & HEDGES in a large number of territories outside the UK. While the Applicant's GOLD STREET (label) trade mark is not registered in a specific colour, the trade mark is used in other territories in respect of cigarettes sold in packaging whose colour and get-up is virtually identical to the colour, get-up and packaging of the Opponent's cigarettes. “Exhibit 2” illustrates how the Applicant uses its GOLD STREET (label) trade mark. “Exhibits 3 and 4” are further illustrations of variations of the Opponent's cigarette packaging. It is submitted that the Applicant's actions in other countries signal an intention to use the GOLD STREET (label) trade mark in the UK in a manner calculated to pass off the Applicant's cigarettes as those of the Opponent.”

44. At the hearing, I questioned Ms Whelbourn as to whether the objection under this ground was, in essence, an attempt to re-run the ground of objection already made under section 5(4)(a). She denied this was the case and stated that this was a standalone objection based on the totality of evidence as to ALPI's conduct in making its application.

45. In *Gromax Plasticulture Ltd v. Don & Low Nonwovens Ltd* [1999] RPC 367, Lindsay J. considered the meaning of “bad faith” in Section 3(6) of the Act and stated (at page 379):

“I shall not attempt to define bad faith in this context. Plainly it includes

dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined. Parliament has wisely not attempted to explain in detail what is or is not bad faith in this context; how far a dealing must so fall-short in order to amount to bad faith is a matter best left to be adjudged not by some paraphrase by the courts (which leads to the danger of the courts then construing not the Act but the paraphrase) but by reference to the words of the Act and upon a regard to all material surrounding circumstances.”

46. Despite a careful reading of the claim and the evidence I can find nothing that persuades me that ALPI cannot honestly claim to be the proprietor of the GOLD STREET mark and, on the face of it, it is entitled to use the word Gold and that colour for the packaging should it choose so to do. Similarly, I can find no evidence to support any claim that the application was made in bad faith because it intended to use the mark in such a way as to be an instrument of deception in terms of passing off (or contribute to it in any way) and I have already found in my consideration under sections 5(2) and 5(4), that the marks are not similar. The objection based on section 3(6) of the Act also fails.

Costs

47. The opposition has failed in its entirety and ALPI is entitled to an award of costs in its favour. ALPI did not attend the hearing nor was it represented but written submissions were filed on its behalf.

48. I make the award on the following basis:

Considering application	£200
Filing counterstatement	£300
Filing evidence	£500
Considering B&H's evidence	£250
Preparation of written submissions	£400
Total:	£1650

49. I order Benson & Hedges Limited to pay ALPI Limited the sum of £1650 as a contribution towards the costs of these proceedings. Such sum should 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 12th day of June 2009

**Ann Corbett
For the Registrar
The Comptroller-General**