

O-178-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2452317
BY INTERNATIONAL TOBACCO PLC TO REGISTER THE TRADE MARK**



Cigarettes

IN CLASS 34

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 95743
BY GALLAHER LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No. 2452317
by International Tobacco PLC to register the trade mark**



Cigarettes

in Class 34

and

**IN THE MATTER OF Opposition thereto under No. 95743
by Gallaher Limited**

BACKGROUND

1) On 12 April 2007, International Tobacco PLC (“International”), of 122-126 Tooley Street, London, SE1 2TU applied under the Trade Marks Act 1994 (“the Act”) for registration of the above trade mark in respect of the following goods in Class 34:

“Cigarettes and tobacco”.

2) The application was subsequently advertised in the Trade Mark Journal on 14 September 2007.

3) On 10 December 2007, Gallaher Limited (“Gallaher”) of Members Hill, Brooklands Road, Weybridge, Surrey, KT13 0QU filed notice of opposition to the application. The grounds of opposition are, in summary:

- a) International’s trade mark offends under Section 5(2) (b) of the Act in that it is similar to the following three earlier registrations and that the respective goods are identical or similar to the goods in respect of which use has been claimed, namely, cigarettes, cigars, smoking tobacco and smokers’ articles:

Earlier Registration	Filing and registration date	List of Goods
1419929 SOBRANIE	Filing date: 28 March 1990 Registration date: 18 October 1991	Tobacco, whether manufactured or unmanufactured, substances for smoking, sold separately or blended with tobacco, none being for medicinal or curative purposes, cigars, matches; smokers' articles; all included in Class 34.
925112 SOBRANIE	Filing date: 13 May 1968	Cigarettes and pipe tobacco.
Community Trade Mark (CTM) 85290 SOBRANIE	Filing date: 01 April 1996 Registration date: 01 December 1998	Tobacco, whether manufactured or unmanufactured; substances for smoking sold separately or blended with tobacco, none being for medicinal or curative purposes; snuff; smokers' articles included in Class 34; cigarette papers, cigarette tubes and matches.

- b) International's trade mark offends under Section 5(3) of the Act as it is sufficiently similar to all three of Gallaher's trade marks "to create a likelihood of confusion with the Opponent's extensive reputation in their SOBRANIE products."
- c) It offends under Section 5(4) (a) of the Act as Gallaher's trade marks have been extensively and continuously used for over eighty years on cigarettes and smoking tobacco and, as a result, has acquired a considerable reputation in the UK.

4) International subsequently filed a counterstatement stating that Gallaher's claims were without foundation. It did not request that Gallaher provide proof in respect of the scope of use claimed.

5) Only Gallaher filed evidence in these proceedings. Neither side requested to be heard but both filed written submissions in lieu of a hearing. Gallaher raised objections to the nature of International's submissions and I will deal with this as a preliminary point later in my decision. Both sides ask for an award of costs. After a careful study of the papers, I give my decision.

Opponent's Evidence

6) This takes the form of a witness statement by Alan David Goldring, Trade Mark Attorney with J E Evans-Jackson & Co., representatives for Gallaher in

these proceedings and is dated 21 October 2008. He states that Gallaher, through its predecessors in title, first adopted the name SOBRANIE in relation to tobacco products at least as early as 1879 and it was assigned to Gallaher in 1981. Exhibit Soprano 1 is a copy of the advertisement in the Trade Marks Journal of the earliest registration known of SOBRANIE in relation to cigarettes and is dated 29 August 1923. Mr Goldring states that this has since lapsed, but was replaced by many subsequent registrations.

7) Exhibit Soprano 2 provides copies of a selection of seventeen UK and CTM registrations all containing the word SOBRANIE that all relate to years subsequent to 1923. Mr Goldring explains that the three earlier trade marks relied upon by Gallaher in these proceedings are its principal registrations for SOBRANIE, at this time. However, it is also the proprietor of a further thirty five UK and CTM registrations featuring SOBRANIE and these are listed (together with the three relied upon in these proceedings) at Exhibit Soprano 4. All but eight of these are in respect of Class 34 goods.

8) At Exhibit Soprano 6, Mr Goldring provides copies from an undated “Brand Implementation Manual”, illustrating SOBRANIE cigarette packs. Mr Goldring states that these illustrations are of packs currently in use in the UK and Europe. Typically, the word SOBRANIE appears prominently on the packaging together with the word “London”. Other material differs from one packet to another. The representation below illustrates the common SOBRANIE LONDON element that appears on all the packets:



9) Mr Goldring also provides the following sales figures:

Year	UK Sales (No. of cigarettes)	UK Sales (£)
2003	1,609,000	322,000
2004	1,875,000	394,000
2005	5,240,000	1,153,000
2006	4,150,000	954,000
2007	3,490,000	872,000

10) Although tobacco advertising is not allowed in the UK, Mr Goldring explains that Gallaher use various means to promote and develop brand awareness and, at Exhibit Soprano 7, he produces pictures of various promotional items that are used where local laws allow. These include a pen, a carrier bag and some

promotional posters. He does not say whether the use of such items is allowable under UK law.

11) Mr Goldring provides a copy of the Wikipedia entry for SOBRANIE at Exhibit Soprano 8 to support his statement that it is extremely well known in the UK and around the world. This user-authored online encyclopaedia records that “Sobranie of London” was established in 1879, when cigarettes had just become fashionable in Europe. It refers to a number of premium SOBRANIE brands such as SOBRANIE COCKTAIL and SOBRANIE BLACK RUSSIAN as well as several styles of cigarettes specifically geared for ladies, some being slimmer than standard cigarettes and others brightly coloured.

12) Mr Goldring also makes numerous submissions regarding the level of similarity between the respective trade marks. I will not comment upon these here but I will refer to them, as appropriate, later in my decision.

DECISION

Preliminary Point

13) By letter, dated 15 April 2009, J E Evans-Jackson & Co (“Evans-Jackson”), attorneys for Gallaher in these proceedings, raised a number of objections to the nature of the submissions filed on 8 April 2009 by Potter Clarkson LLP (“Potter Clarkson”) on behalf of International. It contends that the contents of the letter, together with the exhibits/attachments, should not be admitted into the proceedings because they consist of evidence and are not submissions on the law or on the evidence already filed. Evans-Jackson contends that it is procedurally incorrect to accept evidence at this stage.

14) The Registrar’s tribunal procedures allow for sequential evidence rounds where the opponent is given an opportunity to file evidence in reply to evidence filed by the applicant. Any evidence submitted on behalf of International at this late stage would deny Gallaher the opportunity to file such evidence in reply. Having established this, I need to consider what, if anything, is evidence in these submissions. Evans-Jackson contends that none of the exhibits attached to the submission should be admitted. There are five exhibits, the contents of which are:

- 1 Extracts from Wikipedia, the online encyclopaedia referring to types of musical clefts;
- 2 Extracts from the Chambers and Websters online dictionaries;
- 3 A copy of the Registry examination report in respect of the application in suit;
- 4 Copies of two Registry decisions containing points that support International’s submissions;

- 5 An extract of a report issued by Yorkshire Bank relating to the cost of smoking tobacco products.

15) Clearly, the first and last of these are evidence of fact that may support International's contentions. In respect to the copy of the Registry examination report, this document is freely available to me in the papers of the case and therefore the admission of this exhibit does not impact upon the information before me. It is also appropriate for the hearing officer to enlighten himself through reference to dictionaries (see the comments of Geoffrey Hobbs QC sitting as the Appointed Person in *Forex*, BL O-100-09) and as such, Potter Clarkson's reliance upon a number of quoted dictionary extracts does not introduce any information that I am not free to ascertain myself. Further, it is legitimate that decisions and judgments supporting submissions can be referred to and for copies of such decisions to be provided for the convenience of the hearing officer and therefore the copies of the two Registry decisions may be taken into account as part of International's submissions.

16) Evans-Jackson also complains that the content of some of the submissions themselves constitutes evidence and should be excluded from the proceedings. In particular it refers to Potter Clarkson's comments regarding the respective pronunciations of the trade marks. These comments are in the form of expressing a view and are not supported by any evidence of fact. As such, I find no reason as to why such comments are excluded from the proceedings. I observe that Evans-Jackson itself makes comments on the same subject in its submissions.

17) Potter Clarkson do not seek leave to submit additional evidence and the information referred to above has not been provided in a format that accords with Rule 55 of the Trade Mark Rules 2001. Further, it should be observed that even if this evidence was admitted, the conclusions that follow later in this decision would not be disturbed. Therefore, I do not intend to refer further to the evidence of fact identified above and I will proceed by taking account only the relevant submissions as identified.

Section 5(2) (b)

18) Section 5(2) (b) 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.”

19) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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.”

20) Gallaher’s trade marks are all registered and have filing dates in 1968, 1991 and 1998 respectively. Gallaher’s trade marks are, therefore, earlier marks as defined by Section 6 of the Act. All three were registered more than five years before the publication of International’s trade mark. As such, Gallaher’s trade marks would normally be subject to the proof of use provisions, however, International have chosen not to exercise its right to request that Gallaher provide proof of use. Therefore I shall continue my analysis based on the goods in which use is claimed, namely cigarettes, cigars, smoking tobacco and smokers’ articles.

21) 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] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 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). 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*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

(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 Kaisha v Metro-Goldwyn-Mayer Inc*,

(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*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(j) 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*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

Comparison of goods

22) For ease of reference, the respective goods are:

International's specification	Scope of use claimed by Gallaher
Cigarettes and tobacco	Cigarettes, cigars, smoking tobacco and smokers' articles


23) The term "cigarettes" is present in both the application and in Gallaher's list of goods where use is claimed and therefore the goods are clearly identical. "Tobacco" is present in the application and "smoking tobacco" is in Gallaher's list of goods. The latter is the same or at least a subset of the former term and as such, the goods covered by these terms are also identical. I therefore conclude that both terms present in International's application are identical to terms covered by one or more of Gallaher's earlier registrations.

The average consumer

24) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. The average consumer of cigarettes and tobacco is that section of the general public who are also smokers of tobacco products. Due to legal restrictions in the UK, these average consumers will be adults only. International, in its submissions, argues that these users are likely to be fairly brand loyal and will usually carefully consider products before making a purchase. Further, it contends that most purchases are made "over the counter" at, for example, supermarkets, grocery stores or tobacconists. It does, however, acknowledge that sales also take place from vending machines. There is an absence of evidence on this issue but I concur with the views expressed by International. It is my experience that tobacco products tend to inspire a certain degree of brand loyalty and, as a result, the purchase of such goods involves more than the average level of attention that is associated with normal consumer products.

Comparison of trade marks

25) For ease of reference, the respective trade marks are:

Gallaher's trade marks	International's trade mark
SOBRANIE	

26) When assessing the extent of similarity between the respective trade marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). In this context, I acknowledge that International's trade mark consists not only of the word SOPRANO, but also a stylisation including a swirl element incorporated into the letter "S" and also the word "cigarettes". Due to its size, position in the trade mark and its descriptive nature, I view the word "cigarettes" to be negligible within the meaning attributed in *Shaker di L. Laudato & C. Sas v OHIM* and I will keep this in mind when considering the similarity between the respective trade marks.

27) Firstly, I turn to consider the visual similarity of the respective trade marks. International's trade mark consists of the word SOPRANO in a stylised form with the word CIGARETTES appearing underneath it in an ordinary typeface. The "S" in SOPRANO is stylised by the addition of a number of swirls reminiscent of musical notation and, International contend, is similar to the "G clef" musical symbol. Gallaher's trade marks are all in respect of the word SOBRANIE in an ordinary typeface and, therefore, the stylisation of International's trade mark is a point of difference between the respective trade marks. Mr Goldring, in his witness statement, contends that they are extremely similar with both trade marks sharing five of the first six letters. He also draws attention to the fact that the letter that is different is "B" in SOBRANIE and "P" in SOPRANO and that these two letters are visually similar. He also argues that the stylised nature of International's trade mark further diminish the differences between these letters. On the other hand, International points to the stylisation of the first letter in its trade mark.

28) In addition to these similarities and differences identified by the parties, a further point of difference is the ending of the respective trade marks with Gallaher's trade mark ending in "IE" and International's in "O". Taking all these factors into account, I conclude that the respective trade marks share a reasonable level of visual similarity.

29) From an aural perspective, Gallaher's trade mark is pronounced SO-BRAN-EE, SOB-RAN-EE or SO-BRA-NEE and International's trade mark is pronounced

SO-PRAN-O, SOP-RAN-O or SO-PRA-NO. International contend that Gallaher's trade mark will be pronounced SO-BRAY-NEE, but I do not see how the BRAN (or BRA) element of the trade mark will be pronounced BRAY and International provide no reasoning for this assertion. The first syllable SO is identical in both trade marks and the second syllables BRAN and PRAN are very similar with the letters "B" and "P" having similar sounds. The third syllables "IE" and "O" are a point of difference between the respective trade marks. Gallaher contends that word endings are lost in pronunciation and that word beginnings are far more significant. I accept that, generally, the end of words tend to be enunciated with less clarity but the hard sound of the "IE" in Gallaher's trade mark compared to the soft sound of the "O" in International's trade mark is sufficient to provide a difference in the pronunciation of the respective trade marks. Taking all these factors into account, I conclude that the respective trade marks share a reasonably high level of aural similarity.

30) From a conceptual perspective, International submit that SOPRANO has a very well known meaning, namely a singing voice or a musical instrument which has the highest or very high pitch. Dictionary definitions to support this view are brought to my attention. It further submits that this conceptual meaning is reinforced by the "G clef" symbol formed by the first letter of the trade mark. By contrast, it submits that SOBRANIE has no meaning and, as a result, the trade marks are distinguishable. Gallaher makes no comment regarding the conceptual comparison. I concur with International's view in so far that the word SOPRANO will be understood by the relevant consumer as being a musical term, even if it is not known what exactly, in the field of music, the term means. I believe my view here is consistent with the approach advocated by Ms. Anna Carboni sitting as the Appointed Person in *Cherokee*, BL O-048-08. I also concur that the word SOBRANIE appears to be a made up word with no meaning. The impact of the "G clef" symbol incorporated into the letter "S", may to some consumers reinforce the musical connection, but as the word SOPRANO is already synonymous with music, I do not believe that the symbol plays any great part in defining the conceptual meaning of the trade mark. Taking all these points into account, I find there is no conceptual similarity between the respective trade marks.

31) In summary, the respective trade marks share a reasonable level of visual similarity, a reasonably high level of aural similarity. However, these similarities are offset by the lack of any conceptual similarity and, as a result, these factors combine so that there is an overall low level of similarity between the trade marks.

Distinctive character of the earlier trade mark

32) Gallaher's trade mark consists of the made-up word SOBRANIE. As a made-up word it benefits from a high level of inherent distinctive character. I must also consider the effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act. This was considered by David Kitchen

Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchen 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 distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

33) Mr Goldring states that SOBRANIE cigarettes have been sold in the UK for some considerable time and International, in its submissions, states that it does not dispute that Gallaher has over eighty years use of the SOBRANIE trade mark. However, even if I accept this point, there is a lack of evidence that goes to the manner of use, its geographic spread or the nature of outlets making the goods available to the consumer. No information has been provided as to the size of the cigarette market in the UK and as such, I am unable to place into context, the sales figures provided by Gallaher. Therefore, there is insufficient information for me to draw any conclusions regarding the market share for SOBRANIE goods and I am unable to conclude that the already high level of distinctive character that resides in the word SOBRANIE is further enhanced through use.

Likelihood of confusion

34) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). Mr Goldring makes much of what he sees as close visual and aural similarities. I note these, but I am

mindful that I must also consider the impact of conceptual differences and I refer to the following guidance provided by the ECJ on the weight to be given to conceptual differences in *Claude ruiz-Picasso et al v OHIM (PICASSO)* C-361/04 P:

“20. ...where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them...

21. ...such a finding is, in this case, entirely part of the process designed to ascertain the overall impression given by those signs and to make a global assessment of the likelihood of confusion between them”

35) The word SOPRANO, the dominant component of International’s trade mark, has a clear conceptual meaning whereas, as a made-up word, SOBRANIE has no meaning. Taking account of the considered nature of the purchasing act inspired by the brand loyalty associated with such goods, this conceptual difference will strike the relevant consumer immediately and I believe this is an example of where conceptual differences will indeed counteract the visual and phonetic similarities that exist. I find that International’s trade mark may bring the earlier trade mark to mind, but no more than this and there will be no direct or indirect confusion. The opposition based upon Section 5(2) (b) of the Act therefore fails.

Section 5(4) (a)

36) Gallaher’s case under Section 5(4) (a) is no stronger than under Section 5(2) (b) and in light of these findings above, there is no need for me to consider the opponent’s further objection under Section 5(4) (a).

Section 5(3)

37) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(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 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 scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42.

39) The applicable legal principles arising from these cases are as follows:

a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA* (CHEVY) [1999] ETMR 122).

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in CHEVY, paragraph 30).

d) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

40) To these, I would also add the following legal principles that have arisen from the recent ECJ judgement in *Intel Corporation Inc. v CPM United Kingdom Ltd* (INTEL) C-252/07:

a) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

b) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting trade marks, within the meaning of *Adidas-Salomon and Adidas Benelux*.

c) Whether use of the later trade mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

d) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

Reputation

41) International submits that the evidence fails to support Gallaher's claim to a substantial reputation and comments that the scale of sales is not significant in the context of the UK cigarette market as a whole. I have already commented that based on the evidence before me, I am unable to come to a conclusion regarding the significance of the scale of sales. There is an undisputed claim of more than 80 years use in the UK, but there is no evidence to illustrate the nature of this use. The exhibits illustrating the numerous trade mark registrations for SORBRANIE do not equate to evidence of use, but rather only evidence of an intention to use. No invoices are provided to illustrate the scope of use or the type or geographic spread of traders selling SOBRANIE products. Neither is there any evidence of the trade mark in use. Extracts from an undated "Brand Implementation Manual" showing the get-up of the packaging is the only evidence showing the trade mark on cigarette packaging. There is nothing in these extracts to show that the manual relates to implementing the brand in the UK. There are no press articles and whilst I note the legal limitations placed upon promotion of tobacco products, I would expect a brand with a reputation as claimed by Gallaher to have been featured in trade publications.

42) I should also comment on the extract from Wikipedia online encyclopaedia. This is a user generated body of information and therefore, it must carry a caveat in terms of the accuracy and veracity of its content. As such, I am unable to conclude that this exhibit provides the required evidence of use.

43) Finally, I will say that when this body of evidence is taken together it hints at the existence of a reputation. However, such hints cannot be taken as a substitute for sound evidence of fact and are insufficient for the purposes of these proceedings. Therefore, I am unable to come to the conclusion that SOBRANIE is known by a significant part of the public concerned with cigarettes. As such, I find that the necessary reputation has not been shown and therefore I do not need to go on to consider if the necessary link exists.

44) As a consequence of the above findings, the grounds based upon Section 5(3) of the Act fails.

COSTS

45) The opposition having failed, International Tobacco PLC is entitled to a contribution towards its costs. I take account of the fact that no hearing has taken place but that it did file written submissions in lieu of attendance. I also take account that its written submissions attracted criticism from Gallaher, some of which I found to be justified, and the additional unnecessary cost implications for Gallaher. The award in respect to preparing these submissions is therefore reduced to reflect this. I award costs on the following basis:

Considering Notice of Opposition and statement	£200
Statement of case in reply	£300
Considering evidence	£300
Filing written submissions	£150
TOTAL	£950

46) I order Gallaher Limited to pay International Tobacco PLC the sum of £950. This sum is 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 24th day of June 2009

**Mark Bryant
For the Registrar,
the Comptroller-General**