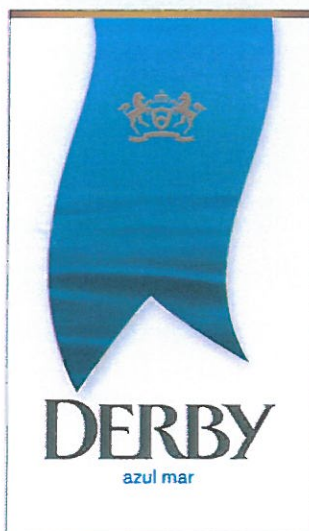


JIPO

Jamaica Intellectual Property Office

IN THE MATTER OF APPLICATION NO. 51,318
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED
TO REGISTER THE TRADE MARK



IN CLASS 34
AND IN THE MATTER OF OPPOSITION NO. 79/TM2008
BY PHILIP MORRIS PRODUCTS S.A.

**IN THE MATTER OF APPLICATION NO. 51,318
BY BRITISH AMERICAN TOBACCO (BRANDS) LIMITED
TO REGISTER A TRADE MARK IN CLASS 34
AND IN THE MATTER OF OPPOSITION NO. 79/TM2008
BY PHILIP MORRIS PRODUCTS S.A.**

DECISION AND REASONS FOR DECISION

The Application

1. On the 14th of December 2007, BRITISH AMERICAN TOBACCO (BRANDS) LIMITED, through its agents, Myers, Fletcher and Gordon, Attorneys-at-Law (hereinafter referred to as “the Applicant”) applied under the Trade Marks Act 1999 (hereinafter referred to as “the Act”) for registration of the following trade mark, which they call “DERBY azul mar”:



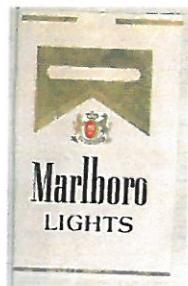
2. The Application relates to the following class and goods:
34 - Tobacco; smokers' articles; matches
3. On the 9th of June, 2008 the Trade Marks Registry accepted the mark for publication. The application was subsequently published in the Jamaica Gazette dated the 17th of December 2008.

Grounds of Opposition

4. A Form TM 4 - Notice of Opposition - accompanied by the Statement of Grounds of Opposition was filed on November 28, 2008 by Livingston, Alexander & Levy, Attorneys-at-Law on behalf of Phillip Morris Products S.A. (hereinafter referred to as "the Opponent").
5. According to the Statement of Grounds filed, the Opponent opposes the proposed registration of the trade mark on the following grounds:
 - (i) on the basis of the Opponent's four earlier trade marks which are entitled to protection pursuant to section 5 of the Act:
 - No. 7443 ("MARLBORO Label") registered in Jamaica as of April 12, 1958 in class 34 for cigarettes and other tobacco products:



- No. 20,484 ("MARLBORO LIGHTS Label") registered in Jamaica as of April 23, 1981 in class 34 for cigarettes only:



- No. 28,032 ("MARLBORO MEDIUM Label") registered in Jamaica as of June 19, 1992 in class 34 for tobacco, raw or manufactured; smokers' articles; matches:



- No. 48,542 (“MARLBORO Roof Device”) registered in Jamaica as of April 28, 2006 in class 34 for tobacco, raw or manufactured, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, tobacco substitutes (not for medical purposes); smokers’ articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays not of precious metals, their alloys or coated therewith; pipes, pocket apparatus for rolling cigarettes, lighters; matches:



- (ii) the device element of the Applicant’s mark is virtually identical to the Opponent’s earlier mark No. 48,542 (“MARLBORO Roof Device”) and in respect of identical goods which, pursuant to section 13(1) of the Act, precludes registration of the Applicant’s mark;
- (iii) the Applicant’s mark is similar to the Opponent’s earlier marks, in respect of identical or similar goods and there is a likelihood of confusion including likelihood of association which, pursuant to section 13(2)(b) of the Act, precludes registration of the Applicant’s mark;
- (iv) the Opponent’s earlier marks have a reputation in Jamaica and the use by the Applicant of its mark would take unfair advantage of and be detrimental to the distinctive character and reputation of the Opponent’s earlier marks which, pursuant to section 13(3) of the Act, precludes registration of the Applicant’s mark; and

- (v) the Applicant's use of its "DERBY Label" mark in Jamaica is liable to be prevented by the law of passing off and accordingly same is not registrable by virtue of s.13(4) of the Act.
6. Form TM 5 and Grounds in support of Counterstatement were filed on behalf of the Applicant on January 27, 2009.
7. The Applicant denied all the statements and allegations set out in the Opponent's Grounds of Opposition. In particular, the Grounds stated that:
- (i) The Applicant denies that its mark is identical or similar to the Opponent's mark as the Applicant's mark is distinctive in its own right;
 - (ii) The Applicant denies that there exists a likelihood of confusion between its mark and the Opponent's as the Applicant's mark does not bear such a resemblance that would result in or cause any confusion between the marks;
 - (iii) The Applicant's mark is inherently distinctive and has acquired distinctiveness through use and is therefore registrable;
 - (iv) The Applicant denies that its use of its mark takes unfair advantage of or is detrimental to the distinctive character of the Opponent's mark;
 - (v) The Applicant's Trade Mark Application No. 51,318, "DERBY azul mar" & design is capable of being graphically represented and capable of being graphically represented and distinguished from the Opponent and all other undertakings, as required by section 2 of the Act;
 - (vi) The Applicant's application is not disqualified from registration and does not fall within section 11 of the Act.

Evidence

Opponent's Evidence

8. On the 25th March, 2009 the Opponent filed an Affidavit of Irina Lucidi in support of the Opposition. Lucidi is Senior Counsel at Philip Morris International Management S.A., in charge of the Opponent's registered trademarks. She states therein *inter alia* that:
- (i) The Opponent's MARLBORO brand of cigarettes have been made and sold by the Opponent since 1924;
 - (ii) The Opponent's "MARLBORO ROOF Device" trademark was introduced in 1955 in the USA as a distinctive component of the package design of the MARLBORO Label trademark, which is registered in Class 34 in Jamaica (No. 7443) since April 12, 1958;
 - (iii) The Opponent also registered No. 20,484 ("MARLBORO LIGHTS Label") in Jamaica in class 34 as of April 23, 1981; No. 28,032 ("MARLBORO MEDIUM Label") registered in Jamaica in class 34 as of June 19, 1992; and No. 48,542 ("MARLBORO Roof Device") registered in Jamaica in class 34 as of April 28, 2006;
 - (iv) The Applicant's DERBY Label is confusingly similar to and takes unfair advantage of the Opponent's "MARLBORO Label" and "MARLBORO Roof Device";
 - (v) The similarities are readily apparent (as evidenced by comparative imagery), as a result of both marks containing: a five (5) sided device; with flat, perfectly horizontal top; two sides extending vertically; with constant width and two downward pointing peaks; used in the centre of the packaging label beginning at the very top of the label; and the word mark placed centrally directly underneath the two peaks approximately two-thirds down the label;
 - (vi) The Applicant's goods are identical to the Opponent's goods, making confusion extremely likely;
 - (vii) The Opponent's "MARLBORO Label" and "MARLBORO Roof Device" marks have been used and promoted extensively in Jamaica by the Opponent, evidenced by advertisements, sample packaging and photographs of promotional events in Jamaica, as well as by sales in Jamaica from 2004 to September 2008;

- (viii) The Opponent's "MARLBORO Label" and "MARLBORO Roof Device" marks are famous, significant and valuable in the Caribbean and worldwide, evidenced by sales throughout the Caribbean from 2004 to September 2008 and 345 trademark registrations worldwide in Class 34, as well as by an excerpt from the Maxwell Report listing Marlboro as the top world cigarette brand and an excerpt from the 2008 Brandz Top 100 Most Powerful Brands listing Marlboro as 10th most powerful brand, with an estimated value of US\$37,324 million;
- (ix) Since the introduction of the MARLBORO trade dress containing the "MARLBORO Roof Device" in 1955, estimated worldwide sales figures for the MARLBORO brand exceeded ten trillion cigarettes, the number one selling brand in the world for over a quarter of a century, which has therefore acquired global goodwill and reputation, necessitating a high level of protection including protection from dilution;
- (x) The Opponent's "MARLBORO Label" and "MARLBORO Roof Device" marks have become so famous worldwide and in Jamaica that they do not have to be used in conjunction with the word "MARLBORO" to signify the Opponent as the source. The Roof device is the distinctive accompaniment to the name and has been continuously used in conjunction with the name since 1955;
- (xi) If the Applicant is allowed to register and/or use its mark, it is likely that persons in the trade will infer that the DERBY brand is a trademark of or otherwise associated or affiliated with the Opponent.

9. Maximilien Yaouanc is the Senior Counsel Brand Integrity/Trademarks with Philip Morris Latin America & Canada Inc., a US corporation and affiliated company of the Opponent. In an Affidavit sworn to on the 24th of November, 2009 and filed on the 3rd of December 2009 in response to an Affidavit of Nicholas John Mercer filed on behalf of the Applicant, he states *inter alia* that:

- (i) The differences cited by the Applicant between the Applicant's mark and the Opponent's marks are either mischaracterized or minor or inapt to avoid likelihood of confusion;
- (ii) The Opponent uses the roof device in several width ratios to distinguish the Opponent's various products within the MARLBORO line of cigarettes;
- (iii) The alleged difference in length of the Applicant's device is artificial and would only subsist in the trademark registry, as the labeling laws in Jamaica require that a health warning be placed on tobacco products to cover 33.33% of the top or bottom margin of the pack, so if the Applicant were allowed to sell its product with trademark in Jamaica, it would likely reduce the length of its pentagonal figure as it has done in Chile where similar labeling requirements are in force;
- (iv) The Opponent denies the floating effect of the Applicant's mark claimed by the Applicant or any other marked differences in shape between its marks and the Applicant's. The conceptual difference claimed by the Applicant is denied as both devices are highly stylized and arbitrary and do not clearly symbolize any particular concept to consumers;
- (v) The Applicant has not claimed the colour blue and so that is not a material difference, but even if the Applicant had claimed blue, it is irrelevant to the issue of whether the devices are confusingly similar. Further the Opponent's mark is not limited by colour;
- (vi) Some Jamaican consumers are illiterate and therefore the devices/get up of cigarette packaging are the primary identifying features to these consumers;
- (vii) The MARLBORO cigarettes sold prior to 1955 were a very different and largely unsuccessful product and brand proposition and that the success of the reformulation of the brand is due to the Roof device rather than the word MARLBORO which remains unchanged;

- (viii) Any coexistence between Opponent's MARLBORO marks and the Applicant's DERBY mark in Chile is not peaceful as the Opponent has taken action against the Applicant's affiliated company in Chile;
- (ix) Any co-existence between the Opponent's MARLBORO marks and the Applicant's EMBASSY, MONTANA, WINFIELD and LOOK brands in distant jurisdictions such as France or Hong Kong is irrelevant to the issue of confusion in Jamaica. Further, the EMBASSY mark is used with a markedly different design in Andorra, Belgium, France, Ireland, Luxembourg, Pakistan, Portugal, Spain and the UK and the WINFIELD mark features a lozenge, which cannot be mistaken for a ribbon;
- (x) The Opponent is contesting the Applicant's marks, DERBY, EMBASSY and WINFIELD, in numerous jurisdictions.

Applicant's Evidence

10. On the 13th August, 2009 the Applicant filed Statutory Declaration of Nicholas John Mercer, Trade Mark Manager of the Applicant. In his Affidavit sworn to on the 11th of June, 2009 he states *inter alia* that:
 - (i) The Applicant has been part of the British American Tobacco (BAT) group which, through its affiliates, distributors, licenses and related companies, has been and is engaged in the manufacture, sale and distribution of cigarettes and tobacco products for over 100 years in over 180 countries.
 - (ii) There are significant differences between the Opponent's MARLBORO Roof device trade mark and the Applicant's DERBY and device trade mark. The following significant differences are apparent:
 - a. The length and the width of the device used in the DERBY trade mark are different from the MARLBORO Roof device trade mark, in that the Applicant's mark device covers approximately 70% of the entire representation whereas the

Opponent's device covers approximately 50% of the entire representation in some marks and is the entire 100% in Trade Mark No. 48,542.

- b. The shape of the device used in the DERBY trade mark is different from the MARLBORO Roof device trade mark.
 - c. However, the concept of the DERBY trade mark is that of a flag or ribbon flying in the wind or floating in water, represented also by the words "azul mar" (blue sea), while the concept of the MARLBORO trade mark is that of a roof or tent.
 - d. Also the DERBY trade mark is applied for with a claim to the colour blue, whereas the MARLBORO device has no colour claim.
 - e. The Applicant's trade mark along with some of the Opponent's trade marks contain heraldic crests which are commonly used in the cigarette industry. The Applicant's crest is gold with two horses on either side of a shield of irregular shape and a crown, above an empty scroll, whereas the Opponent's crest has two horses (one with crown) on either side of a crown and an oval shaped shield, above a scroll with the words "veni, vidi, vici".
- (iii) The Applicant's trade mark consists of a flying/floating flag or ribbon device and the words "DERBY Azul Mar" as opposed to the Opponent's MARLBORO trade marks which consist of a solid, compact shape with five sides, giving the effect of a rectangle with a triangular cut in the bottom areas, with no flying, floating or other fluid effect.
 - (iv) The marks are therefore substantially different given the differences in concepts and impression, use of curved and straight lines, colour, positioning, length, width, shape and texture.
 - (v) The majority of tobacco consumers in Jamaica have to orally identify their choice to the retailer in order to purchase the product of their

choice, as cigarettes are not sold in Jamaica as a self-serve item. Therefore, it is unlikely that the consumer will confuse the DERBY and MARLBORO brands.

- (vi) The Applicant cannot be held accountable for any changes to the appearance of the mark on the product as a result of health warning placement;
- (vii) The Opponent's cigarettes have been sold before the Opponent commenced using the roof device, so some of the goodwill vests in the word MARLBORO which is still the principal identifier used by consumers orally and textually. Confusion is therefore highly unlikely or virtually impossible.
- (viii) The Applicant is not aware of any confusion on the part of any of the Applicant's customers or members of the general public regarding the Applicant's and Opponent's mark, as the Opponent's mark is used in relation to entirely different goods, targeted at entirely different consumers.
- (ix) The Applicant has secured approximately 200 registrations for its DERBY trade marks in the current applied design and in previous designs which incorporated a straight vertical ribbon. The Applicant has also secured over 900 registrations for its DERBY, MONTANA, EMBASSY, WINFIELD and LOOK brands which contain a similar ribbon device and which were not contested by the Opponent and which peacefully co-exist with the Opponent's MARLBORO marks in many countries including Andorra, Australia, Belgium, Corsica, France, Germany, Ireland, Italy, Spain, Sweden, Denmark, Hong Kong, Brazil, Chile and Argentina.
- (x) The Applicant denies any deliberate attempt to trade off the goodwill of the Opponent's trademarks, affirms that the Opponent's allegations of deception or confusion remain unproven and calls upon them to introduce evidence to substantiate such claims.

The Opposition Hearing

11. The Opposition Hearing was held on the 30th November, 2012 before me acting for the Registrar of Industrial Property. Mrs. Andrea Scarlett-Lozer, Attorney-at-Law instructed by Myers, Fletcher & Gordon, appeared for the Applicant. Mrs. Kathryn Pearson, Attorney-at-Law instructed by Livingston, Alexander & Levy, appeared for the Opponent. At the hearing both parties presented written as well as oral submissions with authorities. Decision was reserved.
12. Based on the Notice and Statement of Grounds filed by the Opponent, the Applicant's mark was opposed on the following grounds:
 - (i) pursuant to s. 13(1) of the Act;
 - (ii) pursuant to s. 13(2)(b) of the Act;
 - (iii) pursuant to s. 13(3) of the Act; and
 - (iv) pursuant to s. 13(4) of the Act.

Analysis

s. 13(1) – identical marks for identical goods/services

13. In relation to the first ground of Opposition, s. 13(1) of the Act provides that:

*“A trade mark shall not be registered:
 (a) if it is identical with an earlier trade mark; and
 (b) the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”*

At the Opposition Hearing, the Opponent conceded that the marks are not identical for the purposes of s. 13(1) and therefore decided not to pursue this ground.

s. 13(2)(b) - similar marks for identical or similar goods + likelihood of confusion

14. In relation to the second ground of Opposition, s. 13(2)(b) of the Act provides that:

*"A trade mark shall not be registered if-
(b) it is similar to an earlier trade mark and the goods or services in relation to which application for registration is made are identical with or similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade mark."*

15. In order to assess the applicability of these subsections, it must first be considered whether the Opponent's marks are earlier marks as defined by the Act.

Are the Opponent's marks earlier trade marks as defined by the Act?

16. Section 14 of the Act defines an "earlier trade mark" as:

*"(a) a registered trade mark; or
(b) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application was entitled to protection under the Paris Convention as a well known trade mark; or
(c) a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of paragraph (b), subject to its being so registered."*

17. As the section outlines, three categories of earlier marks are protected, namely (i) trade marks registered in Jamaica, (ii) well-known trade marks; and (iii) unregistered trade marks for which an earlier application for registration was filed.
18. By virtue of the "MARLBORO" trade mark of the Opponent having its first date of application for registration in Jamaica on April 12, 1958 (TM Registration No. TM 7443), earlier than the Applicant's mark which was applied for in Jamaica on December 14, 2007 (DERBY AZUL MAR - TM Application No. 51,318), then unless there is some relevant priority date properly claimed, which there is not in this case, the Opponent's mark qualifies as an earlier trade mark under the Act (Kerly's 13th, para. 8-91). This

is without the need to consider at this stage whether the Opponent's marks are well-known.

Similarity of the parties' marks

19. Having found that the Opponent's marks are earlier marks, as defined by the Act, in relation to the Applicant's mark, it is necessary to consider for the purposes of s. 13(2)(b) and 13(3), the following three issues:
 - (i) The similarity of the parties' marks;
 - (ii) The identical or similar nature of the goods; and
 - (iii) The likelihood of confusion.
20. Counsel for the Opponent and Applicant agreed that an analysis of whether the Applicant's mark is similar to the Opponent's earlier marks should be conducted on the basis of the 'global appreciation' approach outlined by the European Court of Justice (ECJ) in *Sabel B.V. v. Puma AG, Bently & Sherman-Intellectual Property Law-3rd ED.p.863-867*. By virtue of that approach, the tribunal should compare the marks as a whole based on the overall impression given by the marks, including the degree of aural, visual or conceptual similarity, as the average consumer would normally perceive them, particularly the dominant and distinctive components of the marks. The ECJ noted that it is not permissible to isolate one element of a graphic ensemble and to restrict examination to that element alone. The two signs must be compared in their entirety and the comparison must not be confined to their individual (characterizing) elements. The ECJ also noted that consideration must be given to the imperfect recollection of consumers who may not remember a mark perfectly in the absence of direct comparison of the marks.
21. The degree of distinctiveness of the earlier mark is also relevant because the less distinctive the earlier mark, the less literal or visual alteration is necessary to prove dissimilarity, whereas if the earlier mark is highly distinctive, the

later mark although substantially modified may still be similar. Each case must be considered on its own facts.

22. The main considerations for the tribunal in determining similarity of the marks are:
 - (i) Are the marks visually similar?
 - (ii) Are the marks aurally similar?
 - (iii) Are the marks conceptually similar?
 - (iv) What level of distinctiveness attaches to the Opponent's earlier mark?
23. The Opponent submitted that the Applicant's mark, in essence, contains the Opponent's MARLBORO Roof device trademark in its entirety and that, in those circumstances, one may deviate from the global appreciation approach. For that proposition, the Opponent relied on an extract from *Bently & Sherman* and a decision of the ECJ in *Medion AG v Thomson Multimedia Sales et al* [2006] ETMR 13. *Bently & Sherman* use an example of an earlier mark SENSATIONS being compared with WALKERS SENSATIONS and comment that using the global appreciation approach would likely result in a finding that the marks are not similar.
24. In *Medion AG v Thomson Multimedia Sales et al*, the earlier mark of LIFE was compared with THOMSON LIFE and the ECJ said that where the goods or services are identical, there may be likelihood of confusion where the contested sign is composed of the company name of another party juxtaposed with a registered mark which has normal distinctiveness and which still has an independent distinctive role, without determining the overall impression conveyed by the composite sign. The Court held that a finding of likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark. That is applicable where the earlier mark still has an independent distinctive role.

25. The Opponent therefore submitted that the Opponent's Roof Device is highly distinctive both on account of its arbitrariness and its acquired distinctiveness and reputation and that as a result of the Applicant's device being virtually identical to the Opponent's device, then at the very least the device is playing an independent distinctive role within the Applicant's composite mark.
26. The Applicant submitted that the marks are not similar because the Applicant's DERBY trade mark is stylized with several visual differences (thus visually dissimilar), and with a concept of horse-racing and or sport (thus conceptually dissimilar). The Applicant submitted that overall, the marks were distinguishable, particularly having regard to the definition of "derby" in the Concise Oxford English Dictionary as":
- (i) Annual horse-race run on the flat at Epsom;
 - (ii) A similar race elsewhere (Kentucky Derby);
 - (iii) Any important sporting contest;
 - (iv) A US bowler hat.
27. I think it is clear that both marks are not aurally similar nor are they conceptually similar (the concept of the DERBY trade mark is that of a flag or ribbon flying in the wind or floating in water, represented also by the words "azul mar" (blue sea), while the concept of the MARLBORO trade mark is that of a roof). Indeed, the Opponent argued that similarity should be determined based on the dominant and distinctive elements of the mark, without examining the mark in too much detail, and in light of the level of distinctiveness that attaches to the Opponent's earlier marks and the fact that the Applicant's device is virtually identical to the Opponent's Roof device, which is playing an independent distinctive role in the Applicant's mark.
28. However, as a result of the Applicant's "vertical ribbon" extending downwards with curved lines of differing degrees which gives the impression of a flag flying in the wind or floating in water, which is also elongated in

shape and different from that of the Opponent, both devices do not appear to be virtually identical. Even though there is some similarity between the Opponent's Roof device and the Applicant's ribbon device, in terms of both containing five-sided figures with flat, horizontal tops and two vertical sides and a cut-out triangle pointing upwards, overall the marks do not have a high degree of similarity and in fact, there appears to be more dissimilarity overall than similarity. It therefore could not be said, as asserted by the Opponent, that the Applicant's mark, in essence, contains the Opponent's MARLBORO Roof device trademark in its entirety and that, in those circumstances, one may deviate from the global appreciation approach.

29. The circumstances were different in *Medion AG v Thomson Multimedia Sales et al*, where the contested sign was composed by juxtaposing the company name of another party and a registered mark which had normal distinctiveness and which still had an independent distinctive role. In the case before us, the MARLBORO company name is not used in the Applicant's mark and therefore does not play an independent distinctive role in the Applicant's mark. Similarly, although I accept that there is some similarity between the Opponent's Roof Device and the Applicant's ribbon device, I find that the Opponent's Roof Device is not used in the Applicant's mark and therefore does not play an independent distinctive role in the Applicant's mark.
30. Therefore from a global appreciation and overall impression approach, the marks are not similar. However, if we look at the distinctive components of the mark, as the Opponent has invited us to do, there is some similarity between the marks, based on there being some degree of similarity between the Opponent's Roof Device and the Applicant's ribbon device.
31. The Opponent submits that their Roof device mark is highly distinctive on account of its arbitrariness and its acquired distinctiveness and reputation. However I am not in a position to accept that, as although the device is arbitrary, it does not appear to be highly creative, colourful or fanciful.

Unlike Trade Marks No. 7443 ("MARLBORO Label"), No. 20,484 ("MARLBORO LIGHTS Label") and No. 28,032 ("MARLBORO MEDIUM Label") which include the name 'MARLBORO', which is undoubtedly a highly distinctive name, Trade Mark No. 48,542 ("MARLBORO Roof Device") does not include the name 'MARLBORO'. I also consider that Trade Mark No. 48,542 ("MARLBORO Roof Device") was only registered in Jamaica as of April 28, 2006.

32. The evidence presented by the Opponent does not convince me that the Roof device is highly distinctive in Jamaica alone without being juxtaposed with the house mark MARLBORO. The Affidavit of Irina Lucida speaks to use of the Roof device by itself but the attached Exhibit C shows the Roof device on a Marlboro cigarette box with the distinctive MARLBORO sign. Similarly, Exhibit D shows a sample of MARLBORO packaging used in Jamaica which shows the Roof device on a Marlboro cigarette box with the distinctive MARLBORO sign. Exhibit E shows photographs taken at promotional events in Jamaica, all of which show that the Roof device is mostly used with the MARLBORO mark. The evidence presented does not support the assertions made in the Affidavit that the MARLBORO Roof device can be seen in constant use by itself in Jamaica and that it has become so famous in Jamaica that it does not have to be used in conjunction with the MARLBORO mark or any other mark to signify the Opponent as the source.
33. In that respect, the volume of sales of MARLBORO branded cigarettes in Jamaica is not reliable to ascertain the extent of distinctiveness and reputation of the MARLBORO Roof device by itself in Jamaica. When I consider the large number of cigarette brands in the industry which use a similar, varied or inverted ribbon and/or five-sided design, I seriously doubt that the Roof device by itself is highly distinctive or as famous as the Opponent asserts.

34. Nevertheless, in light of the fact that the marks have some albeit minimal degree of visual similarity, I must consider the similarity of the goods and the likelihood of confusion.

Identical or similar nature of the goods

35. For the purposes of comparison, the goods in respect of Classes 34 as contained in the Applicant's application No. 51,318 are to be compared with the goods in the Applications prior registrations.
36. The Opponent's prior registrations are:
- Trade Mark No. 7443 ("MARLBORO Label") in class 34 for cigarettes and other tobacco products;
 - Trade Mark No. 20,484 ("MARLBORO LIGHTS Label") in class 34 for cigarettes only;
 - Trade Mark No. 28,032 ("MARLBORO MEDIUM Label") in class 34 for tobacco, raw or manufactured; smokers' articles; matches;
 - Trade Mark No. 48,542 ("MARLBORO Roof Device") in class 34 for tobacco, raw or manufactured, including cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, tobacco substitutes (not for medical purposes); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco tins, cigarette cases and ashtrays not of precious metals, their alloys or coated therewith; pipes, pocket apparatus for rolling cigarettes, lighters; matches.
37. The goods covered by the Applicant's application No. 51,318 in Class 34 are for the full class headings:
- *Tobacco; smokers' articles; matches*

38. The Opponent's Trade Mark No. 28,032 ("MARLBORO MEDIUM Label") and Trade Mark No. 48,542 ("MARLBORO Roof Device") are registered to cover the full class headings in class 34. According to *Bently & Sherman, Intellectual Property Law, 3rd Ed.*, page 861-862:

"If the category of goods or services protected by an earlier trade mark is broader than, but includes, the category of goods or services to which the application relates, then the applicant's goods are identical with those of the earlier mark... Equally, if the specifications of the trade mark applicant overlap with those of the earlier trade mark owner/opponent, those goods within the overlap will be regarded as identical."

39. It is obvious therefore that the goods in the Applicant's application No. 51,318 are identical to the goods covered by the Opponent's Trade Mark No. 28,032 ("MARLBORO MEDIUM Label") and Trade Mark No. 48,542 ("MARLBORO Roof Device"). Additionally, there is overlap between the Applicant's goods and the Opponent's goods covered by Trade Mark No. 7443 ("MARLBORO Label") for cigarettes and other tobacco products and Trade Mark No. 20,484 ("MARLBORO LIGHTS Label") for cigarettes only.
40. I therefore find that the goods related to the Applicant's application are identical to the goods related to the Opponent's registered marks for the purposes of section 13 of the Act.

Likelihood of confusion

41. Having found that the Applicant's mark is similar to the Opponent's earlier marks and that the goods covered by the Applicant's application are identical to the goods in the Opponent's registrations for the purposes of section 13 of the Act, I now consider whether there is likelihood of confusion on the part of the public, including the likelihood of association with the earlier mark, as required to fall foul of section 13(2)(b).
42. It is trite law that the confusion must be as to origin. It is therefore not enough that upon seeing the mark, the earlier mark is called to mind, if there is no possibility of the consumer being under any misapprehension as to the

origin of the goods. It follows that the likelihood of association, although required by the section, is not sufficient alone to fall within section 13(2)(b). There must be likelihood of confusion (see *Wagamama v. City Centre Restaurants* [1995] FSR 713 and *Sabel v. Puma* [1997] ECR I-1691).

43. As explained in *Kerly's on Trade Marks and Trade Names*, the likelihood of confusion must be found on the evidence. It should be caused by the identity or similarity of the marks and the goods or services and not merely external factors such as advertising or packaging. The likelihood of confusion is to be assessed globally, taking into account all factors relevant to the marks and goods in issue and the circumstances of the case (*Sabel v. Puma*; *Lloyd Schuhfabrik Meyer v Adidas* (2000) ETMR 723; *Canon Kabushiki Kaisha v MGM*; *In the Matter of Application No. 44756 (JIPO Opposition Decision 2007)*). According to *Kerly's on Trade Marks and Trade Names*, a global assessment requires a consideration of:

- (i) the similarity of the marks;
- (ii) the similarity of the goods;
- (iii) the likely perception of the marks in the mind of the average consumer of the goods in question; and
- (iv) the degree of distinctiveness of the earlier mark.

Having already assessed the similarity of the marks, the similarity of the goods and the degree of distinctiveness of the earlier marks, I will now consider the likely perception of the marks in the mind of the average consumer of the goods in question.

44. A global assessment of the likelihood of confusion implies interdependence between the various factors. It is recognized therefore that a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks and vice versa (*Kerly's*, 13th ed, para. 8-33).
45. As assessed earlier, the marks have a minimal degree of visual similarity. However, the goods are identical. In assessing the likely perception of the marks in the mind of the average consumer of the goods in question, the

evidence presented by the Opponent included that of Irina Lucidi, who stated that the "MARLBORO Label" and "MARLBORO ROOF Device" marks have a tremendous reputation in Jamaica and throughout the world and that if the Applicant is permitted to register and/or use its mark it is extremely likely that persons in the trade will infer that same is another trade mark of the Opponent or that same is associated or affiliated with the Opponent.

46. As stated above, although the Opponent's Roof device is arbitrary, it does not appear to be highly creative, colourful or fanciful. Further the evidence presented does not support the assertions that the MARLBORO Roof device can be seen in constant use by itself in Jamaica and that it has become so famous in Jamaica that it does not have to be used in conjunction with the MARLBORO mark or any other mark to signify the Opponent as the source. Additionally, considering the large number of cigarette brands in the industry which use a similar, varied or inverted ribbon and/or five-sided design, I have serious doubts that the Roof device by itself is highly distinctive or as famous as the Opponent asserts.
47. Considering that the average consumer of the category of goods is reasonably well informed and reasonably observant and circumspect, and as deposed by Nicholas Mercer for the Applicant, the average consumer of cigarettes in Jamaica has to orally identify their choice of product to a retailer because cigarettes in Jamaica are not usually sold by self-service, and applying the global appreciation approach, acknowledging that the Opponent's Roof device is not highly distinctive in Jamaica, I find that the Applicant's mark is not sufficiently similar to the Opponent's marks to warrant a likelihood of confusion (following *Sabel v Puma* where the prior mark was not imaginative enough to be similar enough to result in likelihood of confusion). I find that upon an assessment of the overall impression created by both marks, there is no likelihood of confusion in the minds of the public that the goods produced under the Applicant's mark are goods originating from the Opponent or that there is some economic connection between the parties.

s. 13(3) - identical or similar marks in relation to dissimilar goods + the earlier mark has a reputation in Jamaica and use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.

48. In relation to the third ground of Opposition, s. 13(3) of the Act provides that:

A trade mark which is identical with or similar to an earlier trade mark and is to be registered in relation to goods or services that are not similar to those for which the earlier trade mark is protected, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in Jamaica and the use of the later mark, without due cause, would take unfair advantage of, or be detrimental to, the distinctive character or the reputation of the earlier trade mark.

49. In light of my finding that the goods are identical, would section 13(3) of the Act apply? At the Opposition Hearing the Applicant made a preliminary submission that as the goods are similar or identical, section 13(3) is inapplicable.
50. However UK and European law is now clear that the relevant subsection of the Act (section 13(3) in the Jamaican Act) is to be interpreted as being equally applicable to identical and similar goods as it is to dissimilar goods (see the decision of the ECJ in *Davidoff v Gofkid* [2003] 1 WLR 1714 and *Adidas-Salomon AG v Fitnessworld Trading Ltd* [2004] Ch 120). This is based on (1) the overall scheme and purpose of the Act to provide greater protection for marks with a reputation and (2) to avoid the absurdity that is caused by the literal interpretation of the subsection which would result in marks with a reputation having less protection where a sign is used for identical or similar goods or services than where a sign is used for dissimilar goods or services. I therefore find that section 13(3) is applicable.
51. The Opponent argued that the MARLBORO Roof Device and the MARLBORO Label marks qualify for protection in Jamaica under section

13(3) of the Act as marks with a reputation. The Opponent cited *Bently & Sherman, Intellectual Property Law*, 3rd Ed., 878 and the case of *General Motors Corporation v Yplon* [1999] ETMR 950 which held that a mark has a reputation where it is known by a significant part of the public concerned by the products covered by the mark and that it is only where there is a sufficient degree of knowledge of the mark by a significant part of the relevant public, that the public, when confronted with the later mark, may possibly make an association between the two marks. Relevant factors include the market share held by the mark, the intensity, geographical extent and duration of its use and the size of the investment made in promoting it. A mark with a reputation need not be as well-known as a well-known mark.

52. There is no evidence of the market share held by the Opponent's earlier marks in Jamaica, nor of the intensity, geographical extent and duration of their use in Jamaica, or the size of the investment made in promoting them in Jamaica. We know from when the marks were registered in Jamaica but not the extent and duration of their use in Jamaica. The evidence of promotional events in Jamaica does not speak to the intensity, geographical extent and duration of promotions in Jamaica, or the size of the investment made in promoting them in Jamaica.
53. However the Affidavit of Irina Lucidi gives the volume of sales of the Opponent's MARLBORO Label branded cigarettes in Jamaica and the Caribbean from 2004 to September 2008 and cites the Maxwell Report and the 2008 Brandz Top 100 Most Powerful Brands, which both rank MARLBORO as the top world brand for tobacco products. Based on that and the fact that the threshold for reputation is a relatively low one (*Bently & Sherman, Intellectual Property Law*, 3rd Ed., 879), I accept that the Opponent's earlier marks, save for the Roof device mark which was registered in 2006, are known by a significant part of the relevant public and therefore have a reputation among the relevant public in Jamaica.

54. However, while I find that a significant part of the relevant public knows the MARLBORO Label marks, as a result of the sales of MARLBORO brand cigarettes in Jamaica and the worldwide repute, there is insufficient evidence to establish that there is a sufficient degree of knowledge of the Roof Device by a significant part of the relevant public, that the public, when confronted with the Applicant's mark, may possibly make an association between the two marks. In other words, the reputation in Jamaica of the Opponent's Roof Device per se, which was just registered as a trade mark in Jamaica in 2006, has not been established. On a global appreciation, taking into account all factors relevant to the circumstances of the case, I do not find that there is sufficient similarity between the marks for there to exist a link between the registered marks and the mark applied for in the minds of the relevant public (*Kerly's 15th Ed.*, para. 9-119).
55. However, a link may be a mere calling to mind (*Intel v CPM* (C-252/07)) and so I am prepared to accept that there might be a calling to mind of the Opponent's marks, although unlikely and if so limited, but that is not sufficient without more. In *Mastercard International v Hitachi Credit (UK) Plc* [2005] RPC 21 Smith J held that there "must be real possibilities as opposed to theoretical possibilities" of disadvantage or detriment. In *Electrocoin Automatics Limited v Coinworld Limited and others* [2004] EWHC 1498 (Ch) Mr. Geoffrey Hobbs QC (sitting as a deputy judge) stated that "in order to be productive of advantage or detriment of the kind proscribed, 'the link' established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose."
56. Therefore, I ask myself, even if there is a link in the minds of some members of the public, are there "real possibilities as opposed to theoretical possibilities" of disadvantage or detriment? As recognized by the decision of the ECJ in *Adidas-Salomon AG v Fitnessworld Trading Ltd* (para. 36) the relevant section of the Act covers four types of uses:

- (i) Use which takes unfair advantage of the mark's distinctive character;
- (ii) Use which takes unfair advantage of the mark's reputation;
- (iii) Use which is detrimental to the mark's distinctive character; and
- (iv) Use which is detrimental to the mark's reputation.

57. The ECJ explained at para. 37 that the concept of detriment to the distinctive character of a mark generally refers to what is called 'dilution' of a mark in the USA and that the concept of detriment to the reputation of a mark generally refers to what is called degradation or tarnishment of a mark. However, whereas the essence of dilution is the blurring of distinctiveness of the mark, in that the mark "is no longer capable of arousing immediate association with the goods for which it is registered and used", the concept of detriment to the reputation of the mark describes cases where "the goods for which the infringing sign is used appeal to the public's senses in such a way that the trade mark's power of attraction is affected."
58. In the opinion of the ECJ in *Adidas-Salomon AG v Fitnessworld Trading* [2004] 2 WLR 1095 and followed in *Crunch Fitness International Inc v Societe des Produits Nestle SA* [2008] ETMR 18, unfair advantage of the distinctive character or repute of another would include evidence of "clear exploitation and free-riding on the coattails of a famous mark or an attempt to trade upon its reputation." The Opponent also relied on *Hachel International Foundation v Excelsior Publications* and *Mango Sport System v Diknah* [2005] ETMR 5 to argue that unfair advantage occurs when another undertaking exploits the distinctive character or repute of the earlier mark to benefit its own marketing efforts, using the renowned mark as a vehicle for generating consumer interest while saving on investment in promotion and that the stronger the similarity of the marks the greater the risk of unfair advantage. However in both of those cases, the marks were identical.

59. In another case cited by the Opponent, *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] FSR 767, the UK High Court held that despite the similarity of the claimant's mark and the defendant's sign and the inherent distinctiveness of the claimant's mark, the average customer for kitchenware would not confuse the TYPHOON sign used by the defendant's for kitchenware, with the claimant's TY.PHOO mark used for teas. Indeed the Court held that the relevant section equivalent to our section 13(3) was "not intended to have the sweeping effect of preventing the use of any sign which was the same as, or similar to, a registered trade mark with a reputation. Nor was it intended to enable the proprietor of a well known registered trade mark to be able to object, as a matter of course, to the use of a sign which might remind people of his mark."
60. Based on my findings that there is only minimal visual similarity and no likelihood of confusion, I do not believe that the Applicant's use of its mark would take unfair advantage of or be detrimental to the distinctive character or reputation of the Opponent's marks. I do not believe that the Applicant's mark if registered would render the Opponent's marks as no longer capable of arousing immediate association with the goods for which it is registered and used, or that the goods for which the Applicant's sign is used appeal to the public's senses in such a way that the power of attraction of the Opponent's trade marks is or would be affected. I am not persuaded that use of the Applicant's mark would cause tarnishing or blurring of the Opponent's marks.
61. Based on the apparent common use of the type of five-sided device in the cigarette industry (the five-sided device being the only aspect of similarity, albeit minimal), the minimal visual similarity, the lack of evidence of reputation in Jamaica and the limited level of association between the marks, I find that the Applicant's adoption and use of its mark is not without due cause. Although it cannot be said that the Applicant 'is under such a compulsion to use this very mark that he cannot honestly be asked to refrain

from doing so' (see *Lucas Bols v Colgate-Palmolive* (1976) 7 IIC 420 at 425), it appears to me that that is more applicable where the marks are identical or at least very similar. In the case before us however, where the marks are only minimally similar but not very similar, based on a five-sided device whose reputation as a trade mark per se in Jamaica has not been sufficiently or satisfactorily proven, and there is no likelihood of confusion, the Applicant is entitled to use its mark in its own right and does not have to yield this right to the Opponent.

62. As was said in the *Premier Brands* case, although there is a limited degree of association between the two marks, such association was likely to occur in comparatively few cases and the degree of association would not be particularly strong, resulting in only a few members of the public, if any, associating the marks. Thus the actual commercial effect on the distinctiveness of the Opponent's marks would be so small as to be inconsequential. The Opposition therefore fails under section 13(3) of the Act.

s. 13(4) - Passing Off

63. In relation to the fourth ground of Opposition, s. 13(4) of the Act provides that:

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

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

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) of this subsection, in particular, by virtue of the law relating to copyright or rights in designs

64. The Opponent argues that the use of the Applicant's mark is liable to be prevented by the law of passing off. The Opponent relied on the five characteristics of the tort of passing off as outlined in *Warnink v Townsend*

(the *Advocaat* case) [1979] AC 731. Although very similar, the modern test for passing off is the classical trinity test as outlined in *Reckitt & Coleman Products v Borden* (the *Jif Lemon* case) [1990] 1 WLR 491 which requires (1) goodwill or reputation attached to the goods bearing the mark or get-up of the plaintiff, (2) misrepresentation by the defendant to the public that the goods offered by the defendant are those of the plaintiff, and (3) damage or likelihood of damage caused by the misrepresentation. I accept as the Opponent submitted that there need not be intention to pass off or deceive.

65. The Opponent does have goodwill and reputation in Jamaica under its marks. I accept as the Opponent submitted that the correct approach is to consider a normal and fair use of the mark the subject of the application in respect of the goods the subject of the application and whether this would result in passing off.
66. Based on the absence of aural and conceptual similarity between the marks, the minimal degree of visual similarity of the marks, the nature of the average consumer of cigarettes in Jamaica being reasonably observant and circumspect, the nature of the cigarette industry in Jamaica where cigarettes are requested orally and not generally available through self-serve, and the finding that there is no likelihood of confusion (all discussed earlier), I cannot find that the Applicant's mark, used normally and fairly by the Applicant, would result in passing off. The similarity of the Applicant's mark to the Opponent's mark is not such that misrepresentation can be imputed and no other evidence has been led upon which to ground a finding of misrepresentation.
67. As there is no misrepresentation, there can be no damage to goodwill and thus no passing off.

Conclusion

68. The Opposition is therefore refused, on the basis that:
- i. the Applicant's mark is not identical to the Opponent's marks and therefore does not fall foul of section 13(1) of the Act;
 - ii. although similar to the Opponent's earlier marks, in relation to identical goods, the Applicant's mark is not likely to cause confusion in the minds of the public and therefore does not fall foul of section 13(2)(b) of the Act;
 - iii. although the Opponent's earlier marks have a reputation in Jamaica, it has not been proven that use of the Applicant's mark, without due cause, would take unfair advantage of or be detrimental to the distinctive character or reputation of the Opponent's earlier marks, and therefore the Applicant's mark does not fall foul of section 13(3) of the Act;
 - iv. it has not been proven that use of the Applicant's mark is liable to be prevented by the law of passing off, and therefore the Applicant's mark does not fall foul of section 13(4) of the Act;
69. The Applicant's mark shall proceed to registration.
70. There is no Order as to costs.

Marcus Goffe
for Registrar of Industrial Property
May 2, 2014