

O-175-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2364231  
BY GALLAHER LIMITED  
TO REGISTER THE TRADE MARKS (A SERIES OF 4):**



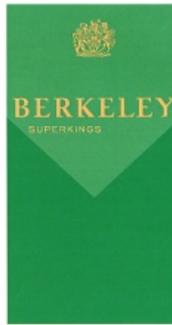
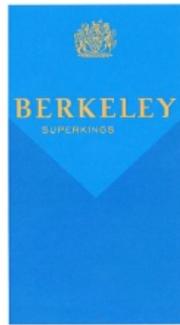
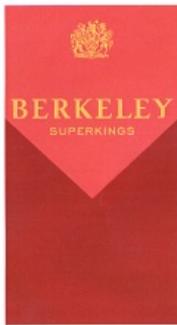
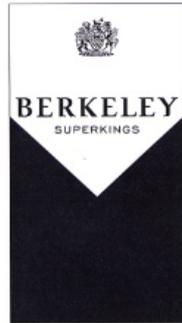
**IN CLASS 34**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92905  
BY  
PHILIP MORRIS PRODUCTS SA**

## Trade Marks Act 1994

**In the matter of application no 2364231  
by Gallaher Limited  
to register the trade marks (a series of 4):**



**in class 34  
and the opposition thereto  
under no 92905  
by Philip Morris Products SA**

### **BACKGROUND**

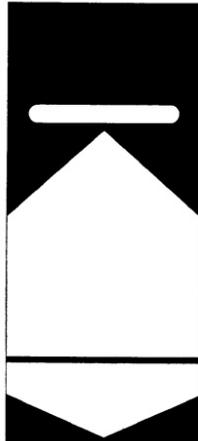
1) On 26 May 2004 Gallaher Limited, which I will refer to as Gallaher, applied to register the above trade marks (the trade marks). The application was published for opposition purposes in the *Trade Marks Journal* on 23 July 2004 with the following specification:

*tobacco, smoking substances; snuff; smokers' articles; cigarette papers; cigarette tubes; matches.*

The above goods are in class 34 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 25 October 2004 Philip Morris Products SA, which I will refer to as Philip Morris, filed a notice of opposition to the registration of the application. Philip Morris owns the three following United Kingdom trade mark registrations:

- No 1035182 for the trade mark:



The application for the trade mark was made on 10 September 1974. It is registered in respect of *cigarettes*. Philip Morris states that in the five years before the publication of Gallaher's application it has used the trade mark in relation to *cigarettes*.

- No 1046101 for the trade mark:



The application for the trade mark was made on 6 May 1975. It is registered in respect of *tobacco and smokers' articles included in class 34*. Philip Morris states that in the five years before the publication of Gallaher's application it has used the trade mark in relation to *tobacco and smokers' articles*. The trade mark is limited to the colour red as shown in the representation on the form of application.

- No 1027148 for the trade mark:



The application for the trade mark was made on 25 March 1974. It is registered in respect of *cigarettes*. Philip Morris states that in the five years before the publication of Gallaher's application it has used the trade mark in relation to *cigarettes*. The registration is subject to the effects of three clauses:

“The Trade Mark is limited to the colours red, white, gold and black as shown in the representation on the form of application.

Registration of this Mark shall give no right to the exclusive use of the letters, "PM INC".

In use in relation to goods covered by the specification other than filter cigarettes, the mark will be varied by the substitution of the name of such goods for the words "Filter Cigarettes".”

All of the goods of the registrations are in class 34 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

3) Philip Morris claims that the respective trade marks are similar and that the respective goods are either similar or identical. Consequently, there is a likelihood of confusion and registration of the trade marks of Gallaher would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) Philip Morris claims that it has used the trade marks, the subject of registration nos 1035182 and 1046101, in the United Kingdom since at least 1 January 1980 on cigarette packets in relation to cigarettes and tobacco. It claims that owing to this use, use of the trade marks of Gallaher for the goods of the application is liable to be prevented by the

law of passing-off. Consequently, registration of the trade marks would be contrary to section 5(4)(a) of the Act.

5) Gallaher filed a counterstatement. Gallaher accepts the statement of use in relation to the registered trade marks of Philip Morris. Gallaher denies that the respective trade marks/signs are similar and states that there is no likelihood of confusion or association between them. It accepts that the respective goods are the same or similar. It submits that its application should proceed to registration. Gallaher states that no attempt was made to approach it with a view to settlement, prior to the commencement of the proceedings, and that this should be taken into account in any award of costs. (The counterstatement also refers to the registrar exercising his discretion in favour of Gallaher. Under the Act I do not have any discretion as to whether to either refuse the application or to dismiss the opposition.)

6) Both sides have filed evidence.

7) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing, both sides filed written submissions.

## **EVIDENCE**

### **Evidence of Philip Morris**

8) This consists of a undated witness statement made jointly by Irina Lucidi and Célia Ullmann. Ms Lucidi and Ms Ullmann describe themselves as authorised representatives of Philip Morris.

9) They state that MARLBORO brand cigarettes have been made and sold by Philip Morris (and various predecessors) since 1883. Ms Lucidi and Ms Ullmann state that the modern history of the brand began in 1955 in the United States of America with the adoption of the MARLBORO roof design label, what they call the roof design, a five sided figure with a horizontal top and two vertical sides with two upwardly and inwardly sloping diagonals. They refer to *The Marlboro Story*, exhibit A; this story is told by an advertising executive. There is mention of the changes made to MARLBORO cigarettes and the way they were promoted; there is mention of the introduction of the flip top box but no reference to the roof design. The packaging was substantially redesigned in 1954 to be like that of registration no 1027148. Ms Lucidi and Ms Ullmann state that the roof design is featured upon all MARLBORO cigarette packets. They state that in its red form the roof design identifies full flavour MARLBORO cigarettes in both hard and soft packets. They state that other varieties of MARLBORO cigarettes include menthol and gold, which respectively bear green and gold roof designs. Copies of advertisements from the mid-fifties are shown, these show opened packets of MARLBORO, the apex of the roof disappearing with the opening of the packet.

10) Ms Lucidi and Ms Ullmann exhibit a list of worldwide trade mark registrations and applications for the MARLBORO label, MARLBORO and/or roof design and variants thereof. They state that between 1955 and 2005 worldwide sales figures for MARLBORO brand cigarettes bearing the roof design totalled more than 10 trillion cigarettes (sticks). Ms Lucidi and Ms Ullmann state that in the United Kingdom all MARLBORO cigarettes are sold in packets bearing the roof design, the packets contain at least 20 cigarettes. They give the following turnover figures for sales of MARLBORO cigarettes in the United Kingdom:

Year	Volumes (in million sticks)	Market share %
1996	3,319	n/k
1997	3,513	4.7
1998	3,452	4.9
1999	3,171	5.1
2000	3,099	5.6
2001	3,331	6.4
2002	3,674	6.8
2003	3,910	7.3
2004	3,871	7.4

11) Ms Lucidi and Ms Ullmann state that since the introduction of the brand in 1974, Philip Morris, and its predecessors, has intensively advertised the promoted MARLBORO brand cigarettes. They state that Philip Morris currently promotes its MARLBORO cigarettes through permitted promotional materials displayed at authorised retailers in the United Kingdom. In 2005, after the date of application, approximately 1,500 authorised retailers in the United Kingdom displayed promotional materials “in any significant way”. MARLBORO brand cigarettes in their gold variant are sold at more than 80% of all retailers of tobacco products within the United Kingdom. Copies of point of sales promotional materials for over a period of three years between 2002 and 2005 are exhibited at exhibit E. The first copy of an advertisement bears a proof date of 18 August 2004, after the date of application. A leaflet for a competition, bearing a date of 16 May 2002, shows the roof design in red under which MARLBORO appears. Three undated advertisements show pictures of packets of MARLBORO packets, the last two for MARLBORO lights menthol. An advertisement bearing the roof design has a proof date of 12 August 2004, after the date of application, as does an advertisement showing the roof design over the word MARLBORO, upon what appears to be bashed metal. A number of pictures of tobacco products sales cabinets are exhibited. The majority bear the roof design, next to which is MARLBORO, seven of them (with no indication of date) show a roof design, roughly drawn in black on a red back ground, several show representations of packets of MARLBORO gold, and one a representation of a MARLBORO (standard) packet. The display cabinets house various brands of cigarettes, including the three types of MARLBORO. A number of the pictures are not clear enough to make out details, a good number have suffered from pixilation, however, in six of the pictures green BERKELEY packets, as per the get-up of the application, can be seen, in two pictures blue BERKELEY packets, as per the get up of the application, can be seen

and in on picture red BERKLEY packets, as per the get up of the application, can be seen. In all of these pictures packets of MARLBORO can also be seen.

12) Ms Lucidi and Ms Ullmann state that in 2005 the MARLBORO brand was ranked at no 10 on the list of the top 100 global brands in the world, as decided by Interbrand; it was valued at US\$ 21,189 billions and significantly outranked Nike and Sony. At exhibit F there are copies of Interbrand's list as published in the August 2002 and July 2005 issues of *Business Week*. The 2002 list shows MARLBORO at number 9, between McDonald's and Mercedes.

### **Evidence of Gallaher**

13) This consists of a witness statement by Suzanne Elizabeth Wise. Ms Wise is the group head of legal of Gallaher.

14) Ms Wise states that products bearing the trade mark BERKELEY have been made and sold in the United Kingdom by Gallaher, or its predecessor, since at least 1981. In 2003 it was decided that a new packet design would be adopted and that packet design was launched in July 2003. Ms Wise exhibits sample packets at G1. These packets are essentially the same as the red, blue and green trade marks of the application. There are some differences:

- On the packets underneath the coat of arms the words, in small print, "GALLAHER LIMITED SUPPLIERS OF FINE CIGARETTES" appear.
- On the blue packet after superkings, the word blue appears.
- On the green packet after the word superkings, the word menthol appears.
- The bottom 40% of the packets is taken up with a health warning.

15) Ms Wise states that since the launch in 2003 sales of products in the new packet designs have been as follows:

2004	£231.4 million
2005	£197.0 million
2006	£164.8 million

She states that to the best of her knowledge there have been no instances of confusion that have been brought to the attention of Gallaher.

16) Ms Wise states that significant amounts were spent of the launch of the new packet design. Trade promotion and point of sales promotion for the £3.99 superkings price reposition amounted to £250,000. The cost of the king size launch was £500,000.

17) Ms Wise exhibits at G2 a memo from 2003 setting out the proposed implementation of the packet re-design.

## **Evidence in reply**

18) This consists of a witness statement by Georg Punkenhofer, who is the senior counsel, trade marks, in the law department of Philip Morris. A large part of Mr Punkenhofer's statement consists of submissions rather than evidence of fact. I bear in mind these submissions in reaching my decision but it is not appropriate to summarise them as evidence in reply. Mr Punkenhofer goes on to give details of three cases brought by Philip Morris in the United States, Spain and Portugal. These relate to different trade marks in other jurisdictions and so I cannot see how they are relevant to the decision that I have to make in this case; which must be based on the evidence in relation to the United Kingdom and the trade marks the subject of the application. Mr Punkenhofer then exhibits pictures of Gallaher's trade marks with the wording and the crest removed, in juxtaposition with Philip Morris's roof design. I have to consider the trade marks as filed, Mr Punkenhofer is asking me to consider trade marks which have not been filed.

## **DECISION**

### **The roof design and cigarette packet get-up - reputation**

19) There is no doubt that MARLBORO is a famous trade mark in relation to cigarettes, it is a fact so notorious that it can be taken upon the basis of judicial notice. However, Philip Morris is not relying upon its reputation in MARLBORO or trade marks including the word MARLBORO but on the claimed reputation of the roof design and the get-up of the front of MARLBORO. There is an absence of evidence to show that prior to the date of application that the roof design had been used on its own. There is no indication that the get-up has ever been used on its own. However, acquisition of a distinctive character may be as the result of use as part of a registered trade mark or in conjunction of a registered trade mark<sup>1</sup>; to acquire such distinctive character will mean that a reputation has been developed. It is a question of fact and evidence as to whether Philip Morris has acquired a reputation in relation to these two elements on their own. I am of the view that of themselves these trade marks, taking into account the nature of the goods and the nature of the use, are not particularly distinctive; in use with MARLBORO they can easily be swamped. The primary use of the roof design is as part of the get-up of the packet. Some of the use shown in exhibit E to the witness statement of Ms Lucidi and Ms Ullmann is in a very different form eg the burning brand of black on red. I cannot see how this use can be seen as use of roof design as identified in the pleadings, it is a very different sign, even if it keeps the same geometric shape. The only material in exhibit E which can be identified as being from prior to the date of application is the copy of the "Stake Your Claim" leaflet. This does not show the roof design on its own but above the word MARLBORO and, as with the standard packet, on a white background. I cannot see why Philip Morris could not give the date that the various photographs, copies of which are included in the exhibit, were taken. In my view in order to establish a reputation in respect of these trade marks separate from their use with MARLBORO, in respect of either section 5(2)(b) or section 5(4)(a) of the Act, it would be necessary to supply survey evidence emanating from the relevant public, cigarette smokers. In the absence of such evidence, I cannot see how Philip Morris can establish what it has

claimed. It is mere assertion. (I would also note that the use of these trade marks has been in particular colours but the claims to reputation have not been limited to colour, although the section 5(2)(b) rights in the roof design are limited by the claim to colour.)

### **Respective goods**

20) The specification of the application encompasses cigarettes. There is no dispute between the parties that this case is about cigarettes and that the respective goods are identical, for the purposes of both section 5(2)(b) and section 5(4)(a) of the Act.

### **Likelihood of confusion – section 5(2)(b) of the Act**

21) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

The registered trade marks are earlier trade marks within the meaning of the Act.

22) 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 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 BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM) C-106/03 P*.

### **Average consumer and nature of purchasing decision**

23) The average consumer for the goods in question is the smoker of tobacco products. In my experience the smoker has a good deal of brand knowledge and loyalty, he or she does not go to the tobacconist or the tobacco counter of a supermarket and choose a brand on the spot. Tobacco companies long argued that tobacco advertising was not about encouraging people to smoke but to get smokers to switch brands or stay loyal to a particular brand. I am aware that in public houses that there are cigarette machines, cigarettes can also be picked up from the shelf in duty free shops, however, in the normal

course of events cigarettes are purchased over the counter and have to be asked for. The primary means of identification is verbal. On cigarette machines and in duty free shops the name of the brand is still prominent. I am of the view that the purchasing decision is careful and very much based on the name of the product.

### Comparison of trade marks

24) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). 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*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 and he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

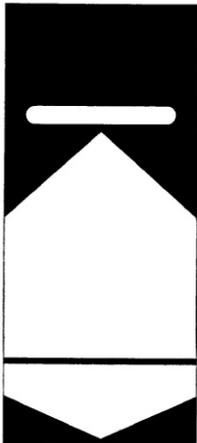
25) The trade marks to be compared are:

#### Philip Morris’s trade marks:



#### Gallaher’s trade marks:





In making the comparison it is necessary to take into account that the upper two trade marks are limited to colour. Applying the findings of Jacob LJ in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5<sup>ii</sup> in relation to infringement, these two registrations could only have an effect in relation to trade marks in the same colour(s).

26) Taking into account the nature of the goods and the average consumer I consider that the dominant and distinctive components of Gallaher's trade marks is the word BERKELEY. Coats of arms are, in my experience, commonplace on cigarette packets, superkings is very much subsidiary to BERKELEY and appears to be reference to the size of the cigarette rather than as indication of origin. (Although in the absence of evidence in relation to this point I cannot be certain of this.) The get-up of all the trade marks of Gallaher consists of two colour which are demarcated by a v shape. In the coloured trade marks, the upper colour is a different shade of the lower colour. The dominant and distinctive element of the first trade mark of Philip Morris is the word MARLBORO, a coat of arms is present and the white and red elements of the trade mark are demarcated by what Philip Morris call the roof design. The second trade mark is limited to a particular shade of red. Philip Morris call it a roof design, it appears to be a square with a triangle removed from the bottom. So the trade mark consists of two components, a particular shade of red and a geometric shape. The third trade mark appears to be the get-up of the flattened pack of MARLBORO, displaying the bottom and the top of the pack. However, it seems to me that I have to consider the trade mark as it is filed and not to bring the bag and baggage of knowledge of the owner's use to my

consideration. There is no indication in relation to the registration that it represents a packet in any shape or form. It is recorded simply as a device, although this is a mere administrative action and does not define the rights or form of the trade mark. It is not like the device of a three headed shaver that speaks of being a two-dimensional representation of a three-dimensional trade mark. The trade mark consists of a rectangle in black and white, towards the top is a thin lozenge, in the centre is a shape which is like the side view of a house, at the bottom there is a rectangle with two touching triangles. I cannot see that any one part is the dominant or distinctive component, that the average consumer seeing the trade mark would give more importance to one element than another.

27) There is now a tranche of case law in relation to the considerations to be made in considering complex or composite trade marks<sup>iii</sup>. The fundamental principle is that one cannot consider just one element of a complex trade mark and compare it with another trade mark. “[T]he 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<sup>iv</sup>.”

28) In relation to registration nos 1027148 and 1046101 (regardless of the colour limitations) it is difficult to see similarities. Registration no 1027148 and the trade marks of Gallaher all represent cigarette packets, but that can hardly be a basis for similarity. This just represents the basic, standard packaging of the goods. To find a geometrical similarity one would have to turn the trade marks of Gallaher upside down, by doing so one is no longer considering the trade marks as applied for. The nature of the trade marks of Gallaher, with the name present, means that the trade mark will normally be used in one direction so that the name can be read. Even if one inverted the trade marks the similarity is limited to all the trade marks including a triangular shape. The colour of trade mark registration no 1046101 is similar to the darker shade of the colour of the red trade mark of Gallaher. The dominant element of trade mark registration no 1027148 is the name MARLBORO, this is totally alien and different to the trade marks of Gallaher. It is also to be born in mind that the purchase of the goods is largely effected by word rather than eye. Registration no 1035182 consists of several geometric shapes, but no clear v shape as in the applications.

## **Conclusion**

29) According to the interdependence principle a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). The respective goods are identical. There is no doubt, I believe, that MARLBORO through use is highly distinctive for cigarettes. I consider that the packet, as a whole, as per 1027148 is highly distinctive owing to reputation. The more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). However, reputation cannot create similarity nor can it, of itself give rise to confusion<sup>v</sup>. I cannot see how the average consumer will confuse the trade mark, the subject of

1027148, with the trade marks of Gallaher. As I have stated above, I do not consider that Philip Morris has established a reputation in respect of the other two trade marks upon which it relies. My own impression is that, for tobacco products, these trade marks are not particularly distinctive. Of themselves they have nothing that hooks onto the mind and memory readily; this position is increased by the nature of the goods, which will be primarily purchased orally rather than by the eye. Gallaher has sold its goods for several years using essentially the same get up as represented in the trade marks; the goods have had substantial turnover. Philip Morris has referred to no instance of confusion. The courts have warned against assuming that because there has not been confusion that there is not a likelihood of confusion<sup>vi</sup>. The absence of confusion could relate to matters that are extraneous to the trade marks in question, the goods might not have been exposed in the same market, one set of products might never have been put upon the market. In this case both sets of goods have been put on the market. There is evidence from Philip Morris of them being sold side by side; there has been plenty of opportunity for confusion to have arisen, there has been no evidence of it having occurred. I consider, therefore, that this is a matter that has to be taken into account<sup>vii</sup>. In its submissions Philip Morris tries to circumvent the absence of confusion by putting forward that the average consumer will consider that the goods emanate from the same undertaking or an economically linked undertaking. Philip Morris submits:

“The presence of other wording such as the names MARLBORO and BERKLEY SUPERKINGS only give rise to the impression that the marks belong to the same stable of brands.”

This is certainly not the impression that I have. For this to be the case there would have to be some key common identifier or similarity, I can see no such common identifier or similarity. I do not consider that there is any effective similarity between the trade marks of Philip Morris and those of Gallaher, indeed, I would state that they are dissimilar. (I consider this is the case even if one does not take into account the colour limitations of two of Philip Morris’s trade marks.)

**30) The grounds of opposition under section 5(2)(b) of the Act are dismissed.**

**Passing-off – section 5(4)(a) of the Act**

31) Section 5(4)(a) of the Act states:

“4) 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;”

32) To succeed under the law of passing-off Philip Morris has to establish a goodwill/reputation in the signs upon which it arises, that there would be deception or confusion and damage. I have already decided that Philip Morris has not established a

reputation in the signs upon which it relies. Even if it had, the absence of similarity between these signs and the trade marks of Gallaher would mean that there could be no deception or confusion. Consequently, the ground of opposition under section 5(4)(a) must fall. I would also note that the basis of the ground of opposition is that Philip Morris could prevent use of the trade marks of Gallaher. Gallaher has effectively been using these trade marks since July 2003 and there does not appear to have been any passing-off action launched against it. If Philip Morris could prevent the use of the trade marks it would be reasonable to assume that it would have taken action so to do. It is also to be noted, again, that there have been no reported instances of confusion.

**33) The grounds of opposition under section 5(4)(a) of the Act are dismissed.**

**COSTS**

34) Gallaher having been successful is entitled to a contribution towards its costs. Gallaher in its counterstatement submits that the fact that Philip Morris did not give notice that it intended to file an opposition should be taken into account in the award of costs. The costs regime of the registrar takes this into account where the applicant withdraws its application, following the filing of the opposition, and does not join the proceedings. It is not taken into account where the proceedings have been joined and I can see no reason as to why it should be. I award costs on the following basis:

Considering notice of opposition	£200
Statement of case in reply	£300
Preparing and filing of evidence	£300
Considering evidence of opponent	£150
Written submissions	£200
<b>TOTAL</b>	<b>£1,150</b>

35) I order Philip Morris Products SA to pay Gallaher Limited the sum of £1,150. 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 20th day of June 2007**

**David Landau  
For the Registrar  
the Comptroller-General**

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<sup>i</sup> Société des produits Nestlé SA v Mars UK Ltd Case C-353/03 [2005] ETMR 96

<sup>ii</sup> 57 Mr Miller submits that if we were to hold that this form of words did amount to a limitation of rights (as the registrar thinks they do) then that would not "retain the confidence of industry. It would be a pirate's charter." Strong stuff with which I do not agree. If a man chooses to apply for his mark in colour to overcome an objection of non-distinctiveness, I do not see why he should not be stuck with a corresponding limitation of rights. It is true that he will have more limited rights than if there had been no limitation--but that is because he was not entitled to more at the time of his application. If, after use and proof that the non-distinctive part of his mark has become distinctive he can register a mark with wider rights, well and good. That is what a prudent trade mark owner would do.

68 I have concluded that Miss Lane is right. My first reason is simply conventional--one does not normally hold that language (here the whole sentence) is redundant if there is a permissible alternative meaning. And there is another, Miss Lane's.

69 Secondly, the word "limitation" or its verb "limit" is found in the Act in the context of s.13. It is also in Art.6 of the Directive and s.11. In these contexts it means a restriction on rights or effects. There is no statutory context of use of "limit" or "limitation" as defining a mark. So it is likely that in a post-1994 registration the words have the same meaning in an actual registration as they do in the governing legislation.

70 Thirdly, the informed reader would know the context provided by the Act and Rules. So he would know that the register is to contain any particulars of a limitation of rights. On seeing the word "limited" he would be alert for a limitation of rights. If he had any doubt as to whether there was one he would have cause to go to the pre-registration correspondence--was there, he would ask, a s.13(1) agreement? If he went, he would find that the mark was applied for (without evidence of distinctiveness through use) as a series of two marks, the logo in colour, and in black and white (meaning all colours). The Office objected to the black and white version saying it was "insufficiently distinctive" but in a telephone conversation confirmed by letter (April 15, 1999) offered acceptance on the basis of a colour limitation. In a letter of confirmation agents said the decision was accepted with reluctance and asked for the colour version to proceed. In the circumstances it is clear that Caudwell were accepting a limitation within the meaning of s.13. This is perhaps emphasised by the fact that in relation to another mark referred to in the same Office letter, the Office clearly drew a contrast between "a colour claim (as opposed to a colour limitation)."

71 As to the permissibility of using the correspondence with the Office, it is the general rule that one does not go to the prosecution history of a monopoly to determine its extent. Thus in the context of patents Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] R.P.C. 9 at [35] said:

"The courts of the UK, the Netherlands and Germany certainly discourage, if they do not actually prohibit, use of the patent office file in aid of construction. There are good reasons: the meaning of the patent should not change according to whether or not the person skilled in the art has access to the file and in any case life is too short for the limited assistance which it can provide."

72 But the position is different in the case of a limitation under s.13. For there one asks whether the trade mark owner has agreed to a limitation. Clearly what is contemplated is some sort of agreement with the Office--which I think could result either from an original agreement in the application at the outset or as the result of a limitation proposed during prosecution. So in that narrow context one can reasonably expect to look at the prosecution history to see whether there was an agreement.

76 For the present, therefore, I not only need not but cannot decide the position as regards old Act registrations. Mr James' view is that such wording did indeed create a limitation. Certainly the logic I have applied here--that if one knows the mark was registered in colour then the words must add something and that something can only be a limitation--would apply. As I have said I do not shrink from that conclusion. People who relied on colour to get their registration are apt to find that their rights are limited accordingly.

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80 But one is not starting trade mark law now. One has to go by the existing legislation. Once a mark has got on the register, the rights given are those conferred by Art.5 as enacted in s.10 of the UK Act. The only question here is that posed by Art.5(1)(b)--confusing similarity. That involves an overall (global) comparison of the registered mark with the alleged infringement. If one undertakes that here, a clear, prominent and memorable part of the registered mark is the words as such. It seems inevitable that taking those words as such (or a trivial variant such as phone4u) will cause confusion. So those words would have infringed but for the limitation.

iii *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-3/03P

*Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P

*Inex SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-153/03

*Camper, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-43/05

*GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04

*Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-3/04 *Société des produits Nestlé SA v Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case T-74/04 *The Royal County of Berkshire Polo Club Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-214/04

*Athinaiki Oikogeniaki Artopoiia AVEE v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-35/04

*Chum Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-359/02

*Miles Handelsgesellschaft International mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-385/03

iv *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P

v *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723

*Grether AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-167/05

vi *The European Ltd v. The Economist Newspaper Ltd* [1998] FSR 283 at p 291, *Compass Publishing BV v. Compass Logistics Ltd* [2004] RPC 41 at p 809 and *Phones 4U Ltd v. Phone 4u. co. uk Internet Ltd* [2007] RPC 5 at paragraphs 42 to 45.)

vii As per *Fiorelli Trade Mark* [2007] RPC 18.