

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2136261
BY CITA TABACOS DE CANARIS SA
TO REGISTER THE MARK
HELIOS
IN CLASS 34

AND IN THE MATTER OF OPPOSITION THERETO
BY REEMTSMA CIGARETTENFABRIKEN GMBH

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10 BACKGROUND

On 18 June 1997, Cita Tabacos De Canarias SA address c/o Juan Ravina Mendez, s/a Barrio Chamberi, Fabrica, CITA, 38009 Santa Cruz de Tenerife, Spain applied under the Trade Marks Act 1994 for registration of the trade mark **HELIOS** in respect of the following goods in Class 34:

15 “Tobacco, cigars, cigarettes and cigarillos; articles for smokers, pipes for smoking, cigar cutters, cigar cases, tobacco tins not in precious metals, humidors for tobacco, lighters not of precious metals; matches.”

20 On the 22 December 1997, Reemtsma Cigarettenfabriken GmbH, of Parkstrasse 51, D-22605, Hamburg, Germany filed notice of opposition to the application. The grounds of opposition are in summary:

25 i) that the opponents are the registered proprietors of the International Trade Mark HELIOS, number 674308, dated 19 April 1997, for goods in class 34.

ii) that registration of the applicants’ mark would offend against Section 5(1) and 5(2) of the Trade Marks Act 1994.

30 The applicants subsequently filed a counterstatement denying all of the grounds of opposition, and claiming that the opponents’ mark has not been accepted by the Registry as the applicants are the proprietors of an earlier mark (Helios Capote and device, number 1065721). Both sides ask for an award of costs. The applicants did not file any evidence other than their counterstatement. Neither party wished to be heard in the matter. My decision will therefore be based on the pleadings and the
35 evidence filed.

OPPONENTS’ EVIDENCE

This takes the form of a statutory declaration is by Mr David Neville Peters, dated 10 June 1998, who is a Chartered Patent Agent and the registered trade mark agent for the opponents.

40 Mr Peters acknowledges that at the date of his declaration the UK Registry had not accepted his clients’ International Trade Mark (No 674308). This was due to a conflict under Section 5(2) of the Trade Marks Act 1994 with UK Trade Mark No 1065721. However, an application for revocation of this mark had been filed by his clients, and the decision of the Registry would determine the issue.

45 Mr Peters also points out that the mark applied for HELIOS is exactly the same as his clients international mark, “and the respective goods are in part identical and in part at least similar.”

That concludes my review of the evidence. I now turn to the decision.

DECISION

Before considering the grounds of opposition the situation regarding the conflicting claims of earlier registrations by both parties needs to be resolved.

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The applicants' registered the mark HELIOS CAPOTE and DEVICE (no 1065721) on 14 July 1976. However, this mark was revoked with effect from 17 December 1997. The revocation of Trade Mark Registration 1065721 allowed the opponents' International Trade Mark 674308 to be registered with a date of protection in the UK of 19 April 1997.

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Therefore, on the date that application 2136261 was filed by the applicants (18 June 1997) the opponents were the registered proprietors of trade mark number 674308 HELIOS for the following goods:

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“ Tobacco, tobacco products, especially cigarettes; smokers' requisites, included in this class, matches.”

I now consider the grounds of opposition based on Section 5(1) & (2) which is as follows:

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“5.- (1) A trade mark shall not be registered if it is identical with an earlier trade mark and 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

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*(2) A trade mark shall not be registered if because -
(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 mark is protected,*

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there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

The marks are identical, both being the word HELIOS. I therefore need to consider whether the goods are identical or similar.

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Clearly the applicants' goods, “Tobacco, cigarettes and matches”, are identical to the goods for which the opponents' mark is registered. The opposition under Section 5(1) therefore succeeds in relation to those goods.

I must therefore consider whether the applicants other goods:

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“Cigars and cigarillos; articles for smokers, pipes for smoking, cigar cutters, cigar cases, tobacco tins not in precious metals, humidors for tobacco and lighters not of precious metals”

are similar to those of the opponents:

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“Tobacco, tobacco products, especially cigarettes; smokers' requisites, included in this class, matches”.

In this I rely on the decision by Jacob.J. in the British Sugar plc v James Robertson & Sons [“TREAT” 1996 RPC 281]. In that case the court stated that:

“The following factors must be relevant in considering whether there is or is not similarity:

a) The respective uses of the respective goods or services;

b) The respective users of the respective goods or services;

c) The physical nature of the goods or acts of service;

d) The respective trade channels through which the goods or services reach the market;

e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors”.

Whilst I acknowledge that in view of the CANON - MGM judgement by the European Court of Justice (C-39/97) the TREAT case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions, which are the factors listed in TREAT, are still relevant.

In utilising the same test and applying it to this case it is clear that the opponents’ goods “cigars and cigarillos” are similar to the applicants’ goods “Tobacco, tobacco products” as the respective uses, users, and physical nature are broadly similar. Also, the trade channels are likely to be the same, and the goods are likely to be found on the same shelves, and they could be said to compete.

The remainder of the applicants’ goods can be said to be covered by the term “smokers’ requisites” in the opponents registration.

I therefore have to determine whether, bearing in mind the identical nature of the marks, the goods are so similar that there exists a likelihood of confusion on the part of the relevant public.

It is my view that the degree of similarity of the goods is such that it would create a likelihood of confusion at 18 June 1997, the material date. The opposition under Section 5(2) therefore succeeds.

The opposition having succeeded the opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £335

Dated this 3 day of March 1999

George W Salthouse
For the Registrar
The Comptroller General