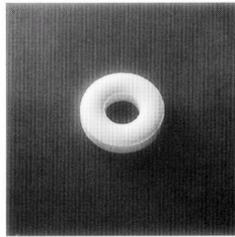


TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2006992
BY SOCIÉTÉ DES PRODUITS NESTLÉ S.A.
TO REGISTER THE TRADE MARK:**



IN CLASS 30

AND

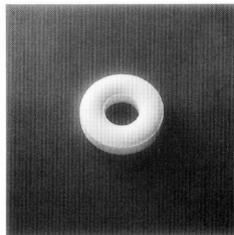
**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 47139 BY KRAFT FOOD HOLDINGS, INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2006992
by Société des Produits Nestlé S.A.
to register a trade mark in Class 30
IN THE MATTER OF Opposition thereto under No. 47139
by Kraft Food Holdings, Inc**

BACKGROUND

- 1) On 20 December 1994 Société des Produits Nestlé S.A. applied to register the following trade mark:



The application was examined and accepted and published on 2 April 1997 in respect of a specification in Class 30 which reads: *sugar confectionery*. It was published with the following description: “This mark consists of the three-dimensional shape represented above”.

- 2) On 2 July 1997 Nabisco, Inc filed notice of opposition to this application. Since this date the interests of Nabisco, Inc in this matter have been taken over by Kraft Food Holdings, Inc. The grounds of opposition ultimately relied upon were as follows:

- the trade mark in suit is not a trade mark within the meaning of Section 1 of the Act
- the trade mark in suit is devoid of distinctive character and so registration of the trade mark in suit would be contrary to section 3(1)(b) of the Act
- the trade mark in suit consists exclusively of a sign which has become customary in the trade and so registration of the trade mark in suit would be contrary to Section 3(1)(d) of the Act
- the trade mark in suit is similar to registration No. B442360, registration No.731732 and application No.2000622 and encompasses similar or identical goods and so there is a likelihood of confusion and registration of the trade mark in suit and would be contrary to Section 5(2)(b) of the Act.

- 3) The applicants filed a counterstatement in which they deny the grounds of opposition.

- 4) Both parties filed evidence and seek an award of costs.

- 5) The matter came to be heard on 29 and 30 May 2002 when the opponents were represented by Mr Peter Prescott of Her Majesty’s Counsel, instructed by The GSCP Partnership and the applicant was represented by Mr Geoffrey Hobbs of Her Majesty’s Counsel, instructed by Nestlé UK Limited Group Legal & Secretarial Department.

6) There are four sets of proceedings involving Nestlé, Kraft, Mars and Swizzels Matlow, all of which revolve around trade mark applications for representations of ‘sweets with holes’; these have been described in the various proceedings as annular sweets. The constant element in all the proceedings is the presence of Nestlé, either as applicants or opponents. Because of this and, for the most part, the common nature of the evidence I have summarised the evidence which encompasses all the proceedings. This summary is at annex A of this decision. The summary is segmented by reference to the evidence which was filed in each particular action. Consequently it is possible to identify the evidence which has been filed in each set of proceedings and it is only this evidence that is taken into account in my deliberations for each case. I have used an analysis of various of the common issues in each set of proceedings; keeping in mind at all times, where necessary, where there are any telling differences in the evidence.

HISTORY

7) The evidence filed by Nestlé Kraft (and Mars) has allowed me to draw a picture of the history and development of the annular mint.

8) In 1912 LIFESAVERS sweets were first sold in the United States by Clarence A Crane. To set himself apart from the competition he hired a pill maker to press his “new” mints into a circle with a hole in the middle. Since the new product looked like a miniature life preserver, life-belt in British English, he called them LIFE SAVERS and registered the trade mark. Initially the sweets had a very limited shelf life, they lost their mint flavour after about a month. Consequently the sales of the sweets plummeted and retailers did not want to restock them. The brand was then taken over by two advertising men in 1913, Edward J Noble and J Roy Allen who set about changing the reputation of the sweets. They discovered that the problem with the loss of the mint flavour did not lie with the mints themselves but with the packaging, which absorbed the flavour. Following a change of packaging the LIFE SAVER brand went from strength to strength. By 1921 sales of LIFE SAVERS annular mints had reached \$5 million and the product was distributed to some 84,000 outlets in the United States. LIFE SAVERS crossed the Atlantic in 1919 and were sold in the United Kingdom with the slogans “The Dainty Sweet With The Hole” and “The Candy Mint With The Hole”. Sales of the sweets reached a peak in the United Kingdom in 1931 when 2, 280, 000 packets were sold. Gradually sales in the United Kingdom lessened; the last figure for sales here is for 31, 500 packets in 1956. But the brand went from strength to strength in the United States where various other flavours and forms of the sweets were sold. The brand has been owned by various enterprises. Currently Kraft are the successors in title to the brand and the business developed by Clarence A Crane.

9) Around 1937 Navy Sweets Limited, an associated company of Swizzels Matlow, began to sell NAVY MINTS annular sweets in the United Kingdom. These were similar in shape to LIFE SAVERS. From 1955 NAVY NAVY was embossed on the sweet. Navy sold various flavours of sweets in the annular form, in addition to mints. The production and sale of NAVY sweets has not been continuous; there is no clear evidence as to when sales stopped and restarted. It would appear that there were sales in the 1950s and also at least in 1982, 1984 and continuous sales of NAVY MINTS from 1990 to 1994.

10) In 1948 Rowntree commenced the sale of POLO mints in the United Kingdom, which were in the same annular shape as LIFE SAVERS and NAVY MINTS. From the outset Rowntree, and their successors in title, have used the hole in the middle of the sweet as the

foundation for advertising and promotional purposes. There has been extensive television advertising in relation to POLO mints in which the hole is invariably featured both by the showing of the sweet and by verbal allusion..

CONSIDERATION OF EVIDENCE OF USE AND SURVEY EVIDENCE

11) Mr Hobbs stated that the application in suit contains a black and white photograph of the POLO sweet. Nestlé have put in evidence in relation to this shape. They rely upon the evidence to support their application in respect of acquired distinctiveness and in respect of reputation in respect of their grounds of opposition under Section 5(2)(b) and Section 5(4)(a) of the Act. In relation to Section 5(2)(b) they claim it is an earlier trade mark under the provisions of Article 6bis of the Paris Convention. I see no merit in dealing with each issue completely separately. They each have the same issue at heart, whether the shape of the blank sweet is distinctive of Nestlé. There are of course other matters which come into play such as the relevant date, whether in fact Nestlé can claim protection under Article 6bis, whether the blank sweet enjoys a protectable goodwill. But all relevant facts are contained in the evidence which Nestlé have submitted in relation to the blank sweet shape.

12) That the trade mark POLO is a well-known brand in the United Kingdom was not in issue. What was, was whether the shape of the product absent the word POLO was distinctive of the goods covered by the application and one which was a well-known trade mark that enjoys a protectable goodwill. In his submissions Mr Hobbs stated that Nestlé were prepared to limit the goods of their application to “mint flavoured compressed confectionery”. I find this helpful. The evidence of use only goes to such goods, thus I consider that in the consideration of the use made of the trade mark that this limit is appropriate in relation to the rights claimed under Article 6bis and passing off.

13) On the issue of distinctiveness of the shape of the product counsel for Kraft and Nestlé (as well as Mars) all made submissions on the decisions of the High Court and the Court of Appeal in relation to a passing off action that Nestlé launched against Trustin the Foodfinders Limited (the transcripts are exhibited at pages 113 – 136 of SH2 of the declaration of Mr Hartman (DEC16). This action was an ex-parte passing off case that did not go to full trial. Mars rely upon the comments of Walker J, as he then was, when he stated:

“But an annular configuration is so basic a shape, being used also in pasta, doughnuts, cocktail snacks and breakfast cereals, so far as foodstuffs are concerned, that the task of establishing the article itself as its own trade mark must impose an exceptionally high burden of proof.”

Nestlé, on the other hand, referred to the comments of Aldous in LJ in the Court of Appeal:

“Further, the plaintiffs have used, as a prominent part of their advertising, the words “the mint with the hole” and I have no doubt that the plaintiffs’ trademark is closely associated in the minds of the public with the shape of the product sold, namely a round sweet of just over ½" in diameter with a hole in the middle.”

14) Mr Hobbs submitted that the Court of Appeal had accepted that the evidence established that an annular sweet of POLO proportions was distinctive of Nestlé. He commented that the evidence before the Court of Appeal, and in particular the survey evidence, was the same as that filed in these proceedings. Counsel for Kraft (and Mars) did not consider that the

decision of the Court of Appeal acted as a validation of the survey evidence of Nestlé or that it established that the blank sweet was distinctive of them. The evidence filed by Nestlé into the Trustin Case was by way of an affidavit by Caroline Crowe which exhibited further evidence. Ms Crowe adduced no evidence directly into these proceedings, but her affidavit is exhibited at page 101 of SH2 of the declaration of Mr Hartman. Ms Crowe's affidavit acts as the vehicle for the admission of evidence by others. Therefore, I am satisfied that the evidence before the courts was also before me.

15) As stated, the Trustin's case was ex-parte and the defendant did not put in evidence. In these proceedings, distinctiveness of the shape of the product has to be considered in the light of the evidence that has been adduced by Kraft (Mars and Swizzels Matlow). There were lengthy submissions as to the nature of the survey evidence in the Trustin's case and the view of Aldous LJ in relation to this evidence. I consider that the appropriate course is for me to consider the evidence afresh and without my view being coloured one way or another by the decisions of either court. This is because the issue before the courts was one of passing off and not a trade mark issue in the terms of section 3 or section 5(2)(b) of the Trade Marks Act.

16) The distinctiveness, or otherwise, of the shape of the product is fundamental to these proceedings. For if the shape of the product is not capable of distinguishing the goods of Nestlé, and cannot act as a badge of origin, it cannot act as an earlier right in the terms of section 6(1) or in the terms of the law of passing off. Only if it can be held to be distinctive can it potentially act as a bar to other applications.

17) Before considering that issue I need to have regard to the relevant dates in the various proceedings. In relation to the oppositions against Kraft and Swizzels Matlow the relevant date for the Article 6bis claim by Nestlé is a date anterior to the date of the filing of the applications, 31 October 1994 and 28 June 1995 respectively. Consequently, I need to decide whether by 30 October 1994 and 27 June 1995 respectively Nestlé can claim protection under Article 6bis. If Nestlé establish that their application number 2006992 is registrable this in itself will represent an earlier right against Swizzels Matlow as it was filed on 20 December 1994. (Although I accept that until it is registered it cannot be finally determined to represent an earlier right – see Section 6(2)). In relation to the oppositions against Kraft and Swizzels Matlow the relevant date for passing off purposes is the date of the behaviour complained of, which in the case of an unused trade mark is the date of filing - *Cadbury-Schwepes Pty. Ltd. v. The Pub Squash Co. Ltd* [1981] R.P.C. 429. Both Kraft and Swizzels Matlow claim use of their trade marks prior to filing and so the relevant date could be prior to the dates of their filing. If anything hinges upon this I will come back to it when I deal with the passing off issue. In relation to the oppositions by Mars and Kraft the relevant date is the date of filing by Nestlé, 20 December 1994.

18) Mr Bloch (and Mr Prescott, acting in the opposition by Kraft,) made attacks upon the validity of the survey evidence of Nestlé. This was particularly aimed at the fact that in relation to the Millward Brown survey the original questionnaires of the interviewees were not adduced into the proceedings nor did they complete declarations to confirm any answers that they gave. Mr Hobbs argued that if the original questionnaires were considered important Mars and/or Nestlé should have requested them. This, I believe, does not fully address the issue. In reaching a decision I too have to consider what weight can be put on the survey evidence. Without the original questionnaires there is room for doubt as to how the answers to the questions were analysed and categorised. I note that declarations by Yvonne Cornwall, Janice Granger and Liliias Nimmo were adduced into the proceedings. These three

were interviewers in connection with the Millward Brown survey and they confirm that they conducted the survey in the manner directed by Millward Brown. This evidence has not been challenged. Nevertheless, this evidence, does not overcome the problems of the absence of the primary evidence without which it is difficult to analyse how the answers were interpreted when coded and whether there were degrees of ambiguity in the responses. Without the raw data it is not possible to assume that the results that have been presented truly represent the responses. For example, question 2a of the questionnaire, which is an important question as it tries to link the shape of the sweet with the name of the goods, allows for an unrestricted number of responses. I have no way of knowing what the exact nature of these responses was. Again questions 3a and 3b give the interviewee a free range of comments to make. In relation to question 2a a further problem arises from the coding instructions exhibited at RW5 of the declaration of Rosi Ware (DEC2). The instruction states that, "There are no (no detail) codes so you can code eg mints with Polo mints". It would appear from this that if someone responded with the answer "mints" to question 2a this could be recorded as a Polo mints response. The results indicate that this might not be the case, there is a separate category for "mints". Thus, the ambiguity and the doubt are there which in the absence of the raw data can not be diffused.

19) The standard tests applied to survey evidence are those set out in *Imperial Group plc & Another v. Philip Morris Limited & Another* [1984] RPC 293. For convenience I refer to the headnote which gives a clear synopsis of what is required:

"If a survey is to have validity (a) the interviewees must be selected so as to represent a relevant cross-section of the public, (b) the size must be statistically significant, (c) it must be conducted fairly, (d) all the surveys carried out must be disclosed including the number carried out, how they were conducted, and the totality of the persons involved, (e) the totality of the answers given must be disclosed and made available to the defendant, (f) the questions must not be leading nor should they lead the person answering into a field of speculation he would never have embarked upon had the question not been put, (h) the exact answers and not some abbreviated form must be recorded, (i) the instructions to the interviewers as to how to carry out the survey must be disclosed and (j) where the answers are coded for computer input, the coding instructions must be disclosed."

Certain of the criteria are satisfied by the Millward Brown survey. I do not consider that points d, e and h are satisfied.

20) There was some dispute as to whether the survey fell foul of point f. Mr Hobbs submitted that the interviewees were simply "guided" rather than led. It was argued on the other side that the questions led the interviewees into an area of speculation they would not have embarked upon normally. Question 2a brings the issue of shape and indicator of origin together; the aim of the survey. There is prompting to say what the goods are called. Would the consumer in the normal way of life make the association between shape and origin of goods? I do not know; in my view the research prompts the interviewee into a line of speculation that he/she might never have taken, I also note from the declaration of Ms Ware that the questionnaire was devised with Nestlé and with the purpose of supporting their application and oppositions. Research which is designed to prove a particular point, rather than arrive at a result without preconception, is always likely to be skewed by the purpose; whether consciously or unconsciously.

21) Taking these factors into account I take note of the Millward Brown survey but feel that I can accord it very little weight. I note that in an early stage of the proceedings Kraft sought disclosure of the raw data at an interlocutory hearing – *Lifesavers* [1997] RPC 563. I refused the request because it was made too early. However, my decision notes the following:

“At the outset, and by common consent, it was agreed between the parties that all relevant material relating to the survey undertaken by Nestlé, some details of which were filed in the opposition proceedings, would be made available to Nabisco, either directly, or by way of evidence filed in these proceedings. That material would include the questionnaires used, all the results of the questionnaire exercise, and the coding instructions in respect of the processing of the results. In reaching agreement on this point, it was agreed that the documents so made available will be treated as if they were produced on discovery.”

Consequently, Nestlé were fully aware of what was expected of them but still did not put into the proceedings the primary data. The onus was on them to do so and for whatever reason they chose not to do so.

22) Another survey, the ESA survey (see DEC3) deals with the trade. It does not tell me about the perception of the public at large. Again the survey, according to the declaration of Mr Palmer (DEC3) was devised with Nestlé and with the purpose of supporting their application and oppositions. The survey, therefore, engenders similar reservations in my mind as the Millward Brown survey; the aim of the survey skewing its nature and the consequent results. From the 109 retailers surveyed only three declarations with questionnaires have been adduced into the proceedings, (the declarations of Denise Journo, Joan Randle and Peter Suckling). The limited number of questionnaires adduced into the proceedings means I need to exercise a good deal of circumspection into my consideration of the survey. Also they tell me nothing about the perception of the public at large – a matter which is the subject of the Millward Brown survey.

23) I turn now to what can be described as the Llewelyn Zietman surveys. These were conducted by Tracey Irene Rose (DEC14) and Roy Priestley (DEC15). These surveys do not have any statistical validity by way of either sample size or cross section of the population. It is also quite possible that the results might have been contaminated by extraneous matter. It could have been the case, for instance, that Ms Rose and Mr Priestley were standing in proximity to advertisements for POLO. I do not consider that I can give any weight to the Llewelyn Zietman surveys.

24) The issue as to the distinctiveness of the blank sweet does not, of course, stand or fall only by reference to the surveys. There is the use to be considered both in terms of turnover and advertising. In relation to the advertising there is the nature of the advertising, in relation to the turnover there is the length of the use to be considered. The evidence of Nestlé shows use since 1948 in relation to the POLO mint. The turnover figures that have been furnished are substantial. They cover the years 1968 to 1994. In 1994 the turnover is £41, 086, 000. (I am not told if this is a wholesale or retail value, but either way it is clearly substantial for an item of confectionery of low cost.) The figures furnished by Mr Thomson (DEC1) for promotional expenditure cover a lengthy period and are for large sums of money.

25) The evidence before me shows that from the earliest days POLO was promoted by reference to being “the mint with the hole”. This appears both in the print media and in the

television advertising, which began in 1955. Nestlé have not given details of where the advertisements were broadcast and the period of the broadcasts. However, no party has alleged that they were sporadic and/or regional. I take it that the advertisements were broadcast nation-wide. All the television advertisements relate to mints, they invariably show the mint and for the most part refer to “the mint with the hole”. Mr Prescott did not consider that this advertising should be allowed to benefit the case of Nestlé as it was false. Mr Prescott claimed that it stated that POLO was the only mint with a hole when this was not in fact the case. Mr Prescott’s argument is based upon a very strict interpretation of the definite article. It also presumes that the public would read the statement in such a strict fashion. There is no evidence before me that they had and I do not see why they should. It is also the case that on many occasions the allusion is to POLO: the mint with the hole; a description of POLO rather than a claim to exclusivity. I see the phrase simply as a description of the product, not a claim to exclusivity. Even if the catch phrase had misled some members of the public I do not see why this evidence should be excluded; I have to try to decide whether in the real world, for whatever reasons, the blank sweet is distinctive of Nestlé.

26) I am struck by the later advertising, both print and television, which makes elliptical allusions to the POLO shape. Such advertising presumes that the public will be aware of the POLO shape and that an elliptical reference will strike a chord with them and bring to mind POLO mints. The type of elliptical advertising can be seen in the “burn out” advertisements shown at exhibit DJT6 to the declaration of Mr Thomson.

27) As stated earlier Mr Hobbs conceded his clients were prepared to limit the goods of the application to “mint flavoured compressed confectionery”. The evidence has a few allusions to some other goods but certainly can not, in my view, justify a claim in respect of any other goods. The evidence, however, I believe requires a more limited scope in relation to the trade mark for which registration is sought, if it can be accepted as showing distinctiveness, than that proposed by Mr Hobbs. Firstly the evidence supports use of the blank sweet in white. Mr Hobbs was most adamant in arguing against a colour limitation. He dealt with the issue on the basis of arguments over infringement rights. But the issue is what is the trade mark that the evidence, potentially, supports. The proviso says that a trade mark shall not be refused registration if before the date of application for registration *it* has in fact acquired a distinctive character. Therefore, if the shape of the product has become distinctive it must be limited to what the evidence supports; in this case a limitation by colour, to the colour white. There is also the issue of size. Mr Hobbs conceded at one stage that the shape could be limited by reference to proportion. I do not consider that this deals with the issue. A product could be produced in proportion to the blank sweet which is two or three inches in diameter. Does the evidence support the contention that such a variation in size would lead the public to identify such goods with Nestlé? In my view, it does not. The evidence relates to a fixed size. As already stated Nestlé are only entitled to have registered what the evidence shows is distinctive. They cannot expand on the basis of the evidence into other sizes, or other colours. If the shape of the product is distinctive of them in relation to mint flavoured compressed confectionery it is distinctive in white and in the size of the standard POLO mint.

OBJECTIONS UNDER SECTION 3

28) In considering whether the blank sweet shape is distinctive of Nestlé it is necessary to consider the attacks which have been made against it under Sections 3(1) and 3(2) of the Act. Section 3(1) of the Act states:

“3.-(1) The following shall not be registered -

- (a) signs which do not satisfy the requirements of Section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 1(1) states:

“1.-(1) In this Act a “trade Mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings.

A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”

29) No argument of substance was put forward at the hearing to show how the application offended against section 3(1)(a). The basis of 3(1)(a) is that the sign could never act as a trade mark. I see nothing in the sign that would exclude it from acting as a trade mark or being accepted for registration in all potential circumstances. The ground of opposition based upon the Section 3(1)(a) is therefore dismissed.

30) Sections 3(1)(b) and (d) were the only absolute grounds which were supported and argued before me by both Kraft and Mars and I believe the only ones that can be considered to have any foundation under section 3(1). I turn to section 3(1)(d) first.

31) This sub-section of the Act creates a special problem for the shape of the goods for Nestlé. No one submitted that this shape does not represent the goods; Mr Hobbs stated that the Nestlé application was a photograph of the mint. If the goods are customary to the trade then I do not consider that evidence of use can overcome the objection. Being customary to the trade by its nature – where the trade mark is the goods – means that it would not be possible to discern from the trade mark from whom the goods originate. If the public are used to several sweets or confections of the same nature then there is nothing that can lead them to differentiate between them, other than additional matter such as the name POLO on the packaging or the shape itself. I can envisage situations under section 3(1)(d) where the proviso will come into play, where it is a sign, but where the subject of the application is the goods themselves I do not envisage evidence of use assisting the applicants. In this case I

will limit my deliberations to mint flavoured compressed confectionery. I have considered whether the ambit of my considerations should be wider than compressed mints, whether it should encompass all types of sweets. Nestlé at the hearing only laid claim to mint flavoured compressed confectionery. Different types of sweets have different customs and norms in their shapes, for instance the slab form of many chocolate bars. The type of sweet will quite often define the types of shape that it will normally be formed into, and in relation to this ground of oppositon I have to consider what is customary – not the unique or unusual: the Cadbury’s Dairy Milk bar for example rather than the Toblerone bar. Nestlé only lay claim to one particular form of sweet so I do not see why I should go wider than looking in that particular area of the confectionery market, for mint flavoured sweets.

32) What does customary in the trade mean? Mr Hobbs referred to the judgement of The European Court of Justice in *Merz & Krell GmbH & Co* [2002] ETMR 21 at page 231 in relation to the issues under section 3(1)(d). Unfortunately neither the judgement nor the proceeding opinion define what is meant by customary. I must rely upon my own interpretation based upon the language of the Directive. In relation to trade I consider that customary must mean a practice that is normal. The number of undertakings involved in the practice and the extent of the practice in terms of amount for it to be considered to be customary must be judged according to the trade. It would be unrealistic to establish fixed criteria which applied equally to the providers of particle accelerators and to sweet manufacturers. There are I suspect a relatively small number involved in the former, whilst there are a large number of enterprises involved in the production of sweets. There are a good number involved in the production of mint flavoured compressed confectionery; as demonstrated by the evidence furnished.

33) For the purposes of these cases I need to consider whether at the relevant date of Nestlé’s application (and their claim under Article 6bis) whether the production and sale of compressed mints in the POLO shape, and approximate dimensions, was customary in the trade within the United Kingdom. There has been evidence furnished by Kraft in relation to LIFESAVERS, primarily to support the claim to a residual reputation and/or goodwill. The evidence of Mr Hartman strikes me as being very full and also very frank. He has not tried to gild any lillies or camouflage facts that are not necessarily helpful to the Kraft case. His evidence shows the effective demise of the LIFESAVERS brand in the United Kingdom in 1956; even then the number of packets sold seems rather nugatory – 31, 500 packets. There is some indication of the importation of some LIFESAVERS into the United Kingdom by America Direct. However, there is no indication of the scale of this operation; there is certainly nothing to suggest that it was at a significant level or for a lengthy period of time. When the business was investigated by Mr Ian Smith it was in receivership. Taking all these factors into account I consider that the LIFESAVERS product within the United Kingdom can be discounted. Then there are the NAVY mints. The sales of these mints is certainly not large, indeed they could be categorised as a marginal product. Production also appears to have been intermittent.

34) Taking into account the number of manufacturers of mints, the variety of their products and the nature of the business, I reach the view that no case has been made out that the shape of the goods in this case is customary in the trade. There is, therefore, no bar to the registration of the blank sweet shape of Nestlé under Section 3(1)(d).

35) I turn now to the question of whether the blank sweet shape of Nestlé is devoid of distinctive character, whether it is objectionable under section 3(1)(b) of the Act. What does

devoid of any distinctive character mean? In *British Sugar Plc v. James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated that:

“Next, is "Treat" within Section 3(1)(b)? What does devoid of any distinctive character mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark? A meaningless word or a word inappropriate for the goods concerned ("North Pole" for bananas) can clearly do. But a common laudatory word such as "Treat" is, absent use and recognition as a trade mark, in itself (I hesitate to borrow the word from the old Act but the idea is much the same) devoid of any distinctive inherently character.”

Mr Hobbs, sitting as the appointed person, has referred to trade marks which are origin neutral and those which are origin specific; ie those signs which act as indicators of origin and those which do not. (See *Cycling Is ... Trade Mark Application* [2002] RPC 37.) The purpose of a trade mark is to act as an indicator of origin. To effect this it must be distinctive of an enterprise. If it does not effect this then it is not distinctive of the enterprise, and so is liable to fall foul of section 3(1)(b). With certain trade marks there is a presumption that they can act as an indicator of origin; for instance an invented word with no allusion to the goods in relation to which it is used. In other cases the presumption is that a sign can not act as an indicator of origin, without evidence of factual distinctiveness; this might be the case of a single letter mark. Sections 3(1)(c) and (d) define clear parameters as to the nature of the objection, section 3(1)(b) does not give any such definition; it is the section of the Act which gathers those trade marks which fall through the net of sections 3(1)(c) and (d) but still do not fulfil the function of a trade mark.

36) The Court of First Instance in *Henkel KgaA v OHIM* [2002] ETMR 25 held the following in relation to issue of signs which are devoid of distinctive character:

“Article 7(1)(b) of Regulation No 40/94 does not distinguish between different categories of trade marks. The criteria for assessing the distinctive character of three-dimensional trade marks consisting of the shape of the product itself are therefore no different from those applicable to other categories of trade marks.

Nevertheless, when those criteria are applied, account must be taken of the fact that the perception of the relevant section of the public is not necessarily the same in relation to a three-dimensional mark consisting of the shape and the colours of the product itself as it is in relation to a word mark, a figurative mark or a three-dimensional mark not consisting of the shape of the product. Whilst the public is used to recognising the latter marks instantly as signs identifying the product, this is not necessarily so where the sign is indistinguishable from the appearance of the product itself.”

Consequently, I must consider the matter here on the basis that the criteria for assessing whether the blank sweet shape is distinctive of Nestlé is no different from that applied to a word or device. However, the Court of First Instance immediately goes on to point out that the perception of the public is not necessarily the same in relation to shape trade marks. The public is not used to seeing shape marks as indicators of origin. So in considering the evidence of Nestlé I have to consider whether the public will see the shape of the goods as indicating that the mint originates from Nestlé. In *Yakult Honsha KK's Trade Mark*

Application [2001] RPC 39 Laddie J. said:

“The relevant question is not whether the container would be recognised on being seen a second time, that is to say, whether it is of memorable appearance, but whether by itself its appearance would convey trade mark significance to the average customer.”

37) It is unlikely that by its appearance the shape of a piece of confectionery prima facie would be seen as conveying trade mark significance. In this I take into account the broader interpretation of trade mark significance which Advocate General Colomer gives in *Arsenal Football Club plc v Matthew Reed* C-206/01:

“It seems to me to be simplistic reductionism to limit the function of the trade mark to an indication of trade origin. The Commission, moreover, took the same view in its oral submissions to the Court. Experience teaches that, in most cases, the user is unaware of who produces the goods he consumes. The trademark acquires a life of its own, making a statement, as I have suggested, about quality, reputation and even, in certain cases, a way of seeing life.

The messages it sends out are, moreover, autonomous. A distinctive sign can indicate at the same time trade origin, the reputation of its proprietor and the quality of the goods it represents, but there is nothing to prevent the consumer, unaware of who manufactures the goods or provides the services which bear the trade mark, from acquiring them because he perceives the mark as an emblem of prestige or a guarantee of quality. When I regard the current functioning of the market and the behaviour of the average consumer, I see no reason whatever not to protect those other functions of the trade mark and to safeguard only the function of indicating the trade origin of the goods and services.”

38) There has been much use of the POLO shape, many millions, probably billions have been eaten over nearly half a century. Use, however, does not of itself necessarily make a trade mark distinctive of an enterprise (see *British Sugar Plc v. James Robertson & Sons Ltd*). It depends on the nature of the use and it depends on the trade mark. As the Court of First Instance, as stated above, concluded, the public is not used to seeing the goods as the trade mark. The trade mark is normally used in connection with the goods. Where the trade mark is the goods the use of the trade mark also becomes problematic; the use represents the sales of the goods rather than a growing public awareness that it is a trade mark. It is thus difficult to extrapolate much from simple use and turnover where the goods and the trade mark are one and the same.

39) The evidence of Nestlé does not show that they have ever produced a mint for sale without POLO embossed twice on one side of the shape of the goods. The other side has been blank. The public in purchasing the mints will be confronted with the packet. The evidence also shows the goods being sold in a round packet with the words POLO prominently emblazoned upon it. I need to decide, nevertheless, whether Nestlé have established that the blank shape of the goods, without any writing or other feature upon it, is distinctive of them. As already indicated, I do not believe that I can give much weight to the survey evidence of Nestlé. If their case stands or falls upon the survey evidence then it would fall. In considering the evidence as a whole I also have to decide whether the shape of the goods is a mere association or acts as an indicator of origin. By mere association I mean that

the consumer might associate POLO with the blank sweet shape, and expect the mints to be in that form. However, that he/she might expect POLOS to be in that form does not mean that he expects all mints in that form to be POLOS. The problems with the survey evidence mean my consideration of this issue is particularly difficult. In considering the matter I take special notice of the following:

- the long and continuous advertising campaign
- the absence of evidence of anything on a similar scale by any other producer of annular mints
- the nature of the advertising - it has invariably and forcefully revolved around the annular shape, whether by direct reference or by the prominent display of the mint in the advertisement – with the words POLO embossed twice into it.

It is my view that I must weigh up all the evidence of Nestlé, including the survey evidence (defects and all), and decide upon the cumulative effect of that evidence.

40) The European Court of Justice in *Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots- und Segelzubehör Walter Huber and Franz Attenberger* [1999] ETMR 585 held the following:

“in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings;

if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied;”

41) I have carefully viewed the advertising. I have taken into account the scale of use, the length of use and the nature of use of Nestlé. The evidence as a whole, of Nestlé, Kraft and Mars, has led me to the conclusion that the mint buying public would see the blank sweet shape as being an indicator of origin of Nestlé. Objection under section 3(1)(b) is, therefore, overcome by the use of the trade mark. However, as I have indicated above, the evidence only convinces me that this acquired distinctiveness relates to the goods being white and of the size of the standard POLO mint. Consequently, for the Nestlé application to be registered it will be necessary for the following three requirements to be accepted:

1. As offered by Mr Hobbs the specification must be limited to “mint flavoured compressed confectionery”.
2. The sign will have to be limited to the colour white.
3. The sign will have to be limited by size, in terms of depth and diameter of both the mint and the hole, to that of the standard POLO mint.

OBJECTIONS UNDER SECTION 5(2)(b)

42) I go on to consider the ground of opposition under section 5(2)(b) which states:

“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 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) or Community trade mark 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,”

Section 6(2) of the Act states:

“References in this Act to an earlier trade mark include 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 subsection (1)(a) or (b), subject to its being so registered.”

43) In determining the question under section 5(2), 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 B.V.* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a

highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;

- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

SIMILARITY OF GOODS

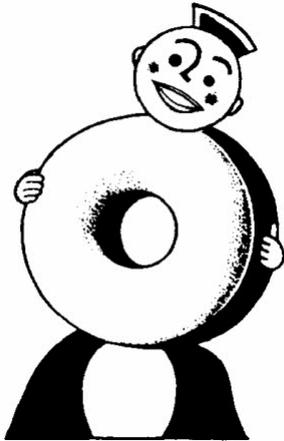
44) The opponents have claimed that there is a likelihood of confusion with the following United Kingdom trade marks: registration Nos. 442360 and 731732 and application No. 2000622. 442360 is registered in respect of *candy mint sweetmeats*, 731732 is registered in respect of *chocolate and non-medicated confectionery* and 2000622 has been applied for in respect of *non-medicated confectionery*. The applicants have agreed to limit his specification to *mint flavoured compressed confectionery*. The goods of the application in suit are encompassed by those of the earlier trade mark registrations. The respective goods are, therefore, in all cases identical.

SIMILARITY OF SIGNS

45) Registration 442360 is for the trade mark:



Registration No. 731732 is for the trade mark:



Application No. 2000622 is for the trade mark:



The above application has been published and has been opposed by Nestlé. It was published with the following description: “The mark consists of the three dimensional shape of the goods embossed with the words "Life Savers". The lining and/or stippling shown on the mark is for shading only.”

46) The respective trade marks must be compared in their entireties, the public do not normally analyse and dissect trade marks. However, weight must be given to the dominant and distinctive components. The device element of 442360, the annular shape with the words LIFE SAVER upon it, is a very small element in the trade mark. It is also not obviously a representation of the goods, I have even blown up the representation to gain a clear view of the device element. Even when magnified it does not take on the form of a sweet. It appears to be more like the form of a life belt. The trade mark also includes the words THE CANDY MINT WITH THE HOLE. It might be argued that this is a semantic representation of the shape mark that is the trade mark in suit. However, in my view the image and the word are not one and the same. Even if each have the same conceptual association this does not mean that the respective trade marks are similar. Considering the trade marks the subject of the application and trade mark registration No.442360 in their entireties I consider that the divergences are so great that they are not similar.

47) Registration 731732 would appear to be a stylised version of a sailor. The opponent argues that similarity arises from the annular shape that makes up the sailor's torso. Again the respective trade marks must be considered in their entirety. In this case the shape of a mint against a stylised sailor. I see no similarity. The annular shape in the registration would appear to be part of the cartoon figure. I do not consider that the trade mark in suit and trade mark registration No. 731732 are similar.

48) For there to be a likelihood of confusion the signs have to be similar. Without this similarity any objection under this ground must fail. Proximity of goods, reputation, distinctiveness of the earlier sign, the nature of the purchasing decision and all the other factors which are part of the global appreciation can not turn signs that are not similar into ones which are similar. Thus I find that in respect of registration Nos. 442360 and 731732 there is no likelihood of confusion and the requirements for refusal under Section 5(2)(b) are not met.

49) Application No. 2000622 has been the subject of parallel opposition proceedings. In those proceedings I have rejected all the grounds of opposition. Consequently, although 2000622 is not a registered trade mark I will deal with the issue of likelihood of confusion in relation to it.

50) The respective trade marks are both shape marks. I have no doubt that application No. 2000622, like the trade mark in suit is the goods, an annular sweet. Clearly they diverge in that application number 2000622 has the words LIFE SAVERS prominently placed upon it. The dominant and distinctive component is the word LIFE SAVERS. Although I must consider the trade mark in its entirety, I take into account that the words are the only aspect of the sign which make it more than the goods, in this case I have no evidence that the other aspects including the shape, contribute significantly to the badge of origin. The goods themselves are not distinctive of Kraft, based upon the evidence that they have filed. The indicator of origin is the wording LIFE SAVERS. Though both trade marks contain what is effectively the same shape, in the case of Kraft this shape is not distinctive, whilst the shape with no addition, in respect of the limited specification, as I have already decided, is distinctive of Nestlé.

51) In making a global appreciation of the issue I take into account the evidence in relation to the use of the trade mark in suit. That evidence tells me that without it bearing any writing it will be identified as being the product of Nestlé. From this perspective I believe that although the trade mark the subject of the earlier application reproduces the same shape as the trade mark in suit, the presence of the words LIFE SAVERS upon it will mean that it will be identified with the opponent's; the LIFE SAVERS shape, as a result of the use of the wording, will be seen as emanating from a source other than Nestlé. If there was or is any association it will be association in the strict sense, a momentary bringing to mind. There will not be the kind of association that will lead to confusion. Consequently, in relation to application No. 2000622 I do not consider that there will be a likelihood of confusion and thus the conditions for refusal under Section 5(2)(b) are not met here either.

52) I find that there is no likelihood of confusion in relation to any of the earlier trade marks and thus the ground of opposition based upon Section 5(2)(b) is dismissed entirely.

53) Taking my findings as a whole the application for registration may proceed to registration subject to the following:

1. The specification must be limited to “mint flavoured compressed confectionery”.
2. The sign must be limited to the colour white.
3. The sign must be limited by size, in terms of depth and diameter of both the mint and the hole, to that of the standard POLO mint.

54) The applicants should file within one month of the expiry of the appeal period from this decision a form TM21 to satisfy the above conditions. If no form TM21 is filed within the period set the application will be refused.

55) The applicants are entitled to a contribution towards their costs and I therefore order the opponents to pay to them the sum of £1600. This sum takes into account that the applicants’ have relied upon broadly similar evidence in parallel proceedings before the Office and in proceedings before the courts. 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 day of 2002

**M KNIGHT
For the Registrar
the Comptroller-General**

ANNEX A

CONSOLIDATED SUMMARY OF EVIDENCE IN RESPECT OF OPPOSITION NUMBERS 42897, 43718 , 47139, 47138 AND 45334

Consolidated opposition Nos. 42897 and 43718 by Société des produits Nestlé S.A. to application Nos. 2000625 and 2000622 in the name of Kraft Food Holdings, Inc. (application originally in the name of Nabisco Inc.)

Evidence of opponents

Statutory declaration of David John Thomson dated 15 July 1996 relating to opposition Nos. 42897 and 43718 and application no 2006992 (DEC1)

1) Mr Thomson is the managing director of the Nestlé Rowntree division of Nestlé UK Ltd. Mr Thomson has been employed by companies in the Nestlé S.A. Group since its acquisition of Rowntree PLC in 1988. Before then he had been employed by companies within the Rowntree group since joining John Mackintosh & Sons in 1968.

2) Mr Thomson states that, as can be seen from exhibit DJT1, the trade mark in suit consists of a three dimensional shape which is an essential feature of sugar confectionery manufactured and sold by the applicant by reference to the trade mark POLO. Mr Thomson exhibits at DJT2 examples of the product. These are two white sweets and a yellow and an orange sweet. They are in the form of the trade mark in suit and all bear the words POLO twice on one side of each sweet.

3) Mr Thomson states that the trade mark in suit has been used extensively and continuously throughout the United Kingdom in respect of confectionery since 1948. He goes on to give a history of the ownership of the trade mark.

4) Mr Thomson states that the first item sold bearing the trade mark in suit was a pressed mint and that original product has been sold continuously since. He states that from time to time other products have been added and the range of products currently sold bearing the trade mark in suit comprises original mints, spearmints, sugar free mints, extra strong mints and fruit sweets. Mr Thomson exhibits at DJT3 a sample pack. He states that it will be seen that the two letters “O” in the word POLO are emphasised to draw attention to the similarity of their shape with that of the sweet. He states that this representation of the “O”s has been a consistent feature since the launch of the brand in 1948.

5) Mr Thomson states that sales volumes in the United Kingdom for the period from 1948 to date have been very substantial. He states that information relating to sales in the years immediately following the launch of POLO confectionery is no longer available. He gives figures for sales for the years 1968 to 1994:

| Year | Sales (£000s) |
|-------------|----------------------|
| 1968 | 3440 |
| 1969 | 4100 |
| 1970 | 4860 |
| 1971 | 6160 |
| 1972 | 6670 |
| 1973 | 5890 |

| | |
|------|-------|
| 1974 | 6800 |
| 1975 | 9560 |
| 1976 | 11000 |
| 1977 | 12380 |
| 1978 | 13310 |
| 1979 | 15180 |
| 1980 | 18410 |
| 1981 | 19930 |
| 1982 | 21660 |
| 1983 | 21880 |
| 1984 | 22980 |
| 1985 | 25570 |
| 1986 | 29200 |
| 1987 | 29935 |
| 1988 | 32600 |
| 1989 | 32766 |
| 1990 | 31739 |
| 1991 | 32201 |
| 1992 | 33304 |
| 1993 | 31466 |
| 1994 | 41086 |

6) Mr Thomson does not state if these figures represent retail or wholesale prices.

7) Mr Thomson goes on to give a list of other countries where products bearing the trade mark are sold: Czech Republic, Denmark, Ireland, Italy, Russia, Spain, South Korea, Brazil, China, Hong Kong, Malta, Oman, Singapore, Egypt, Taiwan, Mauritius, Ecuador, Tunisia, Bahrain, Cyprus, Israel, Dubai, Qatar, South Africa, Uruguay, Japan, Lebanon, Botswana, Kuwait, Abu Dhabi, Uganda, Venezuela, Colombia and the Caribbean Islands.

8) Mr Thomson goes on to give details of expenditure on advertising and promoting confectionery bearing the trade mark. He states that information relating to expenditure following the launch of POLO confectionery is no longer available. The figures for 1968 to 1994 are as follows:

| Year | Expenditure (£000s) |
|-------------|----------------------------|
| 1968 | 267 |
| 1969 | 233 |
| 1970 | 236 |
| 1971 | 214 |
| 1972 | 285 |
| 1973 | 325 |
| 1974 | 259 |
| 1975 | 340 |
| 1976 | 339 |
| 1977 | 503 |
| 1978 | 552 |
| 1979 | 503 |
| 1980 | 642 |

| | |
|------|------|
| 1981 | 741 |
| 1982 | 849 |
| 1983 | 891 |
| 1984 | 1138 |
| 1985 | 1278 |
| 1986 | 1782 |
| 1987 | 1885 |
| 1988 | 2012 |
| 1989 | 2036 |
| 1990 | 2600 |
| 1991 | 2045 |
| 1992 | 2147 |
| 1993 | 2431 |
| 1994 | 1935 |

9) Mr Thomson states that in the early years most of the expenditure on advertising and promotion of confectionery bearing the trade mark was in relation to press advertising and the provision of point-of-sale materials. He states that few of these early materials remain. He states that in 1955 television advertising was used for the first time. Since that time there has been an increasing use of television as the preferred medium, although advertising in other media has continued as has extensive use of point-of-sale materials and the like. Mr Thomson exhibits at DJT4 a schedule of television advertisements which have been screened in the period 1955 to date. Mr Thomson states that exhibited at DTJ5 are two video tapes upon which the advertisements listed at DJT4 are recorded. (In fact in relation to opposition No. 47131 only the first tape that covers the period 1955-1974 is exhibited.) The tapes all relate to mints, no other confectionery, they invariably show the mint and for the most part refer to the mint with the hole. In certain of the later advertisements – on tape two – the reference is sometimes elliptical. The schedule at DTJ4 gives the title of the advertisement, the catch phrase, the year, whether the advertisement is in black and white or colour, the format e.g. 35mm and a reference number. It does not give details of such matters as the number of broadcasts, the television companies which showed the advertisements, the period when the broadcasts were made.

10) Mr Thomson states that it will be seen from these advertisements that considerable emphasis is laid on the trade mark in suit as distinct from other branding properties associated with the product, such as the name POLO, both by visual means i.e. a representation of the product and by use of the slogan “The Mint with the Hole”. Mr Thomson states that half of the advertisements consist of vox populi style interviews with members of the public who were asked such things as to describe POLO or what they liked about POLO. He states that in many cases the reply included some comment on the shape of the product. Mr Thomson states that he cannot claim that this by itself represents independent evidence that the trade mark in suit is distinctive of the applicant’s products but that, at the very least, it demonstrates that the applicant and its predecessors in business have always regarded, and sought to promote, the trade mark in suit as a distinctive feature of products sold by reference to the trade mark POLO.

11) Mr Thomson states that there have been and continue to be advertisements for confectionery bearing the trade mark in suit in national and local newspapers, on the London underground and by way of posters and other public advertisements. He exhibits at DTJ6 a booklet prepared in 1995 by the applicant’s advertising agents, J Walter Thompson, giving

examples of press advertising campaigns for POLO confectionery over the preceding five years. He states that it can be seen from this booklet that the trade mark in suit is consistently promoted as a distinctive feature of the confectionery. He refers particularly to the “burn through” advertisements. Mr Thomas exhibits at DTJ7 to 17 further examples of press advertisements which have appeared in various publications over the last ten years. There is no indication of where and when the advertisements appeared. They generally reproduce the goods and make some reference, sometimes elliptically, to the hole.

12) Mr Thomson states that products bearing the trade mark are also the subject of promotional activity from time to time. He states that in recent years such activity has largely been price based, offering both consumers and the trade extra products for the same price. An instant win promotion took place in 1995. He exhibits at DJT18 promotional material from which it can be seen that the promotional mechanic was the appearance in some packs of a “gold” POLO, indicating that a prize had been won. Mr Thomson states that again this shows the emphasis that the applicant and its predecessors have consistently given to the shape of the product.

Statutory Declaration of Rosi Ware dated 25 July 1996 in respect of opposition Nos. 42897, 43718 and application No. 2006992 (DEC2)

13) Ms Ware is the managing director of Millward Brown Market Research Limited.

14) Ms Ware states that her company had been requested by Nestlé to devise and conduct a piece of market research to quantify the extent to which consumers of Nestlé’s POLO confectionery identify the shape of the confectionery with the POLO trade mark. Ms Ware exhibits at RW1 examples of the sweets. Ms Ware states that in conjunction with the market research department of Nestlé UK Ltd her company devised a questionnaire, a copy of which is exhibited at RW2. Ms Ware states that respondents were shown samples of sweets in a transparent plastic bag. They were unbranded in the sense that the word POLO did not appear upon any part of the sweet. She states that in all other respects the sweets used in the research were identical to the standard original mint product. She exhibits at RW3 samples of the sweets (or a picture of them).

15) Ms Ware states that the research was conducted during the period 15 April to 20 April 1996 by means of doorstep interviews and goes on to list the 38 locations where the research took place. The locations are in various areas of England, Scotland and Wales. Ms Ware states that the market research was conducted fully in accordance with the Code of Conduct of the Market Research Society, a copy of which is exhibited at RW4.

16) Ms Ware states that a total of 425 respondents aged over 16 and consisting as far as possible of a statistically representative sample of the adult population were interviewed. She exhibits at RW5 the results of the research. Ms Ware states that from the results it can be seen that 98% of the respondents identified the unbranded sweets by reference to the trade mark POLO. She states that 22% of the respondents thought that they knew of other sweets of the same shape but of these nearly three quarters were referring to other POLO products. She states that only six respondents mentioned the LIFE SAVERS product.

17) Ms Ware states that respondents were asked what was the first thing that came to mind when they thought of POLO mints; 47% spontaneously mentioned either the central hole or the shape as the first thing that came to mind and a further 8% mentioned these among other

things.

18) Ms Ware states that 99% of respondents were aware of at least one POLO product, 14% were aware of LIFE SAVERS and 9% were aware of NAVY MINTS. Ms Ware states that 89% had tried one of the POLO products, 6% had tried LIFE SAVERS and 4% had tried NAVY MINTS. She states that 24% said that they eat POLO products regularly; no respondent claimed to eat either LIFE SAVERS or NAVY MINTS regularly.

Statutory declaration of Guy Palmer dated 18 July 1996 in respect of opposition Nos. 42897 and 43718 and application No. 2006992 (DEC3)

19) Mr Palmer is a director of ESA Market Research Limited. Mr Palmer states that he had been requested by Nestlé to devise and conduct a piece of market research to quantify the extent to which trade customers for POLO confectionery identify the shape of the confectionery with the POLO trade mark. He exhibits at GP1 examples of sweets sold under the trade mark POLO. Mr Palmer states that in conjunction with the market research department of Nestlé his company devised a questionnaire for the research, a copy of which he exhibits at GP2. He states that from the questionnaire it can be seen that the respondents were shown samples of two types of sweets each in a transparent bag. Two types of sweets were used in order that it should not immediately be obvious to traders upon whose behalf the questions were being asked. The first type of sweet was specially produced to be identical to those exhibited at GP1 but without the word POLO embossed upon them. He exhibits at GP3 a sample (or picture) of the sweets. The second type of sweet is sold under the trade mark Tic Tac. He states that these latter sweets although an unusual shape do not individually carry any branding, he exhibits at GP4 a sample of the latter sweets.

20) Mr Palmer states that the research was conducted during the period 11 to 16 April 1996 by means of interviews with 109 retailers of whom 36 were in the north, 33 in the midlands and 40 in the south. He states that 55 of the retailers were confectioners, tobacconists and newsagents and 54 were independent grocery retailers. The retailers were selected without reference to the applicant. Mr Palmer states that the survey was conducted fully in accordance with the Code of Conduct of the Market Research Society, a copy of which is exhibited at GP5.

21) Mr Palmer states that the results of the survey are exhibited as part of GP2. He states that it can be seen that 99% of the respondents identified the unbranded sweets as POLO and only 12% (13 respondents) thought they knew of any other sweets with a similar shape. Of these 13 people 9 were thinking of other POLO products and the other 4 of completely different products. He states that neither LIFE SAVERS nor NAVY MINTS was mentioned spontaneously. Mr Palmer states that all the respondents had heard of POLO products, 11% had heard of LIFE SAVERS and 30% of NAVY MINTS.

Statutory declarations of Peter Wowra, Sylvia Dilley, Brenda Austin, Margaret Hartley, Yvonne Cornwall and Janice Granger, dated 29 July 1996, 31 July 1996, 2 August 1996, 24 July 1996 and 24 July 1996 respectively (DEC4, 5, 6, 7, 8 and 9)

22) Mr Wowra, Sylvia Dilley, Brenda Austin and Margaret Hartley were interviewers for ESA Market Research Limited. Ms Cornwall and Ms Granger were interviewers for Millward Brown Market Research Limited. All the declarations deal with how they conducted the surveys.

Statutory declarations of Denise Journo, Joan Randle and Peter Suckling dated 12 July 1996, 15 July 1996 and 18 July 1996 (DEC10, 11 and 12)

23) All these declarations are statements made by persons interviewed as part of the survey conducted by ESA Market Research Limited.

Statutory declaration of Liliias Nimmo dated 5 August 1996 (DEC13)

24) Ms Nimmo was an interviewer for Millward Brown Market Research Limited. Her declaration deals with how she conducted the survey.

Statutory declaration of Tracey Irene Rose dated 7 August 1996 (DEC14)

25) Ms Rose is an associate solicitor employed by Messrs Llewelyn Zietman, solicitors.

26) Ms Rose states that on 24 June 1996 she conducted consumer interviews in Hoxton Street, London N1. She states that she stopped a number of people and asked them questions as set out in a questionnaire. She exhibits at TIR1 copies of the completed questionnaires. The survey asked people about sweets that were shown to them. She exhibits at TIR2 the sweets. The sweets are in the form of the trade marks in suit. Ms Rose states that the sweets were loose and no packaging was displayed. Ms Rose states that she showed the interviewees the sweets and asked what they were. If they did not identify the sweets as LIFE SAVERS sweets she asked the interviewees to look at the writing on the sweets. Ms Rose states that most people identified the sweets as LIFE SAVERS having read the wording on the sweet. In a number of cases the interviewee did not read the wording correctly. In those cases she corrected them and told them the correct name of the sweets before asking them whether they had heard of LIFE SAVERS before. She then gave them an opportunity to make any other comment that they wished.

27) Ms Rose states that of the fourteen people stopped on 24 June eleven said that the sweets were POLOs or looked like POLOs. She states of those who did not refer to POLO by name, one person answered “the mint with the hole”, another “like a peppermint” and the third did not know what the sweets were.

28) Ms Rose states that when asked if they had heard of LIFE SAVERS before one person had heard of them in comic books, another had seen them in America and a third had thought that she had seen them in shops and had tried them a number of times over the last few years. The other eleven had not heard of them.

29) Ms Rose states that she repeated the exercise standing in Camden High Street, London NW1 on 25 June 1996. She exhibits at TIR3 completed questionnaires. Ms Rose states that fourteen people identified the sweets as POLOs. In addition one person answered that they looked like POLOs but that it said LIFE SAVERS on them and so he assumed that they were LIFE SAVERS. Ms Rose states that one person thought that she had seen advertisements for LIFE SAVERS. Another remembered the LIFE SAVERS sweets from the United States of America but believed that they were solid, without a hole. Another person stated that she had heard of LIFE SAVERS but could not remember where.

30) Ms Rose states that a number of people had difficulty reading the word LIFE SAVERS on the mint and had to look closely before answering the question concerning the writing on the sweets. She states that two of the people read the words as “Savers Life”.

31) Ms Rose exhibits at TIR4 a simplified analysis of the questionnaire results. She states that it can be seen that 46 of the 54 respondents said that the sweets were or looked like POLO. By contrast, only two respondents identified LIFE SAVERS without mentioning POLO. She states that four of the five respondents who identified LIFE SAVERS without prompting commented on the resemblance to POLO first. The fifth commented on the resemblance when asked if she associated LIFE SAVERS with any other sweets.

Statutory declaration of Roy Priestley dated 6 August 1996 (DEC15)

32) Mr Priestley is an associate solicitor employed by Messrs Llewelyn Zietman, solicitors.

33) Mr Priestley conducted the same surveys as Ms Rose and on the same dates. In Hoxton Street he interviewed persons walking along the street or entering or leaving a mini-market. He exhibits copies of the completed questionnaires at RP1.

34) When he conducted the survey in Camden as well as interviewing the public he entered shops and questioned the shop assistants or managers. He exhibits at RP2 copies of the completed questionnaires.

35) Mr Priestley states that on both occasions when he carried out the survey the great majority of people identified the sweets as POLOs. He states that only a couple of people immediately identified them as LIFE SAVERS. Of these people one was Australian and the other had seen the sweets in the United States of America.

36) Mr Priestley states that he noticed that a number of people had difficulty reading the writing on the sweets even when they were held very closely to their eyes. He states that a few people read the words as “Saverslife”. Mr Priestley states that two persons thought that the sweets were POLOs because of the writing on the sweets, even though the writing actually said LIFE SAVERS.

Applicants' evidence

Affidavit of Steven Hartman dated 2 May 1997 (DEC16)

37) Mr Hartman is the chief trade mark counsel of Nabisco, Inc.

38) Mr Hartman states that LIFE SAVERS is a range of sweets and is a household name and product in the USA. Mr Hartman states that the LIFE SAVERS product and brand name occupy a position in American lifestyle comparable to products such as COCA COLA, WRIGLEY'S and KODAK.

39) Mr Hartman states that the trade marks in suit fairly represent the product in the form in which it has been sold in the USA, as well as in the United Kingdom, from the early part of the twentieth century. Mr Hartman states that LIFE SAVERS sweets were first sold in the USA in or around 1912 and in the United Kingdom in or around 1916. He states that sales continued in the United Kingdom until at least 1956 and, thereafter, there were continuing sales (of largely unknown quantities) up to the present day. Mr Hartman states that the sales in the United Kingdom were continuous in US military installations and that there were at least intermittent sales through normal retail sales to consumers. Mr Hartman estimates that US military sales would have been in excess of \$100, 000 per annum at wholesale values. Mr Hartman states that retail sales would have been imports from a Nabisco marketing unit based in Switzerland and also private imports organised by independent businesses in the United Kingdom. Mr Hartman exhibits at page 141 of SH1 a selection of LIFE SAVERS sweets. The pack contains five packets of LIFE SAVERS in four flavours: butter rum, five flavor, tropical fruits and wild cherry. The packs do not show a representation of the sweets. The sweets are in the form of the applications in suit, although it is difficult to read the wording upon them. They would appear to be for the US market.

40) Mr Hartman then refers to the declaration of Adrian Spencer (see DEC119 paragraph 122 et seq).

41) Mr Hartman states that in 1948 when Nestlé claim that POLO was first introduced the annular shape had already been associated with LIFE SAVERS for more than thirty years and that NAVY annular mints had been on sale for ten years. Mr Hartman states that neither Nabisco nor its predecessors in title objected to the POLO annular mint in 1948, nor to the introduction of NAVY mints in 1937. He states that in the context of the United Kingdom market it appears strange to him that Nestlé should be objecting to LIFE SAVERS.

42) Mr Hartman states that he understands that Nestlé, by virtue of the following actions:

- Launch of passing off proceedings against Trustins the Foodfinders Limited in relation to the launch of LIFE SAVERS into the United Kingdom market in August 1996
- Opposition to the applications in suit
- Opposition to the registration of the representation of the NAVY sweet
- Application to register the representation of a plain annular sweet

seek to monopolise the use of annular sweets in the United Kingdom. As Rowntree was third comer with the annular shape in the United Kingdom Nabisco strongly contest that Nestlé are entitled to any such monopoly in the United Kingdom.

43) Mr Hartman states that he divides his evidence as follows:

- (i) The adoption and use of LIFE SAVERS brand in the United States and elsewhere;
- (ii) The adoption and use of LIFE SAVERS brand in the United Kingdom;
- (iii) Sales of NAVY brand sweets in the United Kingdom;
- (iv) Nestlé's other grounds of objection and other issues arising out of Nestlé's evidence.

Adoption and use of LIFE SAVERS brand in the United States and elsewhere

44) Mr Hartman exhibits at SH1 a bundle of historical advertising and publicity materials. He states that at page 1 of exhibit SH1 is a copy of an extract from the publication "North Western Confectioner" dated March 1921 which recounts the early history of the LIFE SAVERS brand. The article tells the story of LIFE SAVERS mints but does not refer to an annular shape. The article refers to "the Life-Saver shape" and the "attractive shape" but does not specify what this is. Mr Hartman states that, in short, Edward Noble and Roy Allen purchased, in 1913, the business of Cranes Life Saver Peppermints, and after initial problems established the ring shape LIFE SAVERS sweet as a brand leader. He states that by 1921 sales of LIFE SAVERS annular mints reached \$5 million and the product was distributed to a total of 84,000 outlets accounting for one retailer to every 125 people in the United States.

45) Mr Hartman states that exhibited at pages 2, 8 and 13 of SH1 are copies of publicity handouts dating from the years 1981 and 1988 together with a copy of an article reprinted from the December 1951 issue of "Modern Packaging Magazine". The material exhibited at pages 2 – 5 is sub-headed "The Candy with the Hole in the Middle". Page 6, which is dated 2 February 1981 gives a history of the various mints and candies which have been sold under the LIFE SAVERS brand from 1913 to 1981. Pages 8-10 is "The Story of Life Savers". Inter alia it states:

"At that time (1912) most mints were square, pillow shaped products imported from Europe. To set himself apart from the competition, Crane hired a pill maker to press his new mints into a circle and put a hole in the middle. Since the new product looked much like a miniature life preserver, he called it Life Savers and registered the trade mark."

The other material shows the annular shape of the sweets in various advertisements and in an article from "Modern Packaging Magazine". Many of the advertisements are for PEP-O-MINT LIFE SAVERS but other advertisements show other flavours. The article shows the original 1913 package which shows the goods to be in the annular shape the subject of the applications in suit.

46) Mr Hartman states that LIFE SAVERS brand annular sweets have been sold continuously and extensively in a large number of countries. He states that the total value for LIFE SAVERS sweets in the United States in 1996 was in excess of \$130,000,000 and that sales since 1985 were more than \$2,300,000, 000. He states that in 1967 LIFE SAVERS accounted for 78% of the total US market in hard roll candy.

47) Mr Hartman states that from the time of the earliest sales of LIFE SAVERS in the US Nabisco and its predecessors have laid great emphasis on the annular shape of the LIFE SAVERS sweets. He states that this is apparent from the materials exhibited at pages 1 to 21

of bundle SH1 as well as from the advertising exhibited at pages 26 to 91 and 116 to 124 of bundle SH1.

48) Mr Hartman exhibits at SH1 pages 22 to 91 copies of advertisements and statistics in relation to LIFE SAVERS advertising and promotion in publications originating in the USA over the period 1913-1996. At page 77 a video tape of US television advertising is exhibited. The advertisements are for various LIFE SAVERS products. These include the “hard candy” products in annular form for fruit flavoured sweets and mints and the soft fruit sweet GUMMI SAVERS, the latter sweets are also in annular forms.

49) Mr Hartman states that hardly any visitors to the United States can fail to be exposed to the LIFE SAVERS brand and product. He states that there are currently about one million outlets situated in the United States where LIFE SAVERS can be purchased. There is also very extensive advertising and promotion. He states that expenditure on advertising LIFE SAVERS annular hard candy in the United States was in excess of \$60,000,000 over the period 1991-1996. He states that the major part of this expenditure is directed towards television advertising.

50) Mr Hartman states that in addition to sales of LIFE SAVERS Nabisco also markets a soft gum annular sweet under the name GUMMI SAVERS. A specimen is exhibited at page 142 of SH1. The goods would appear to be for US use. On the packet LIFE SAVERS appears as a house mark - the sweets are soft fruit flavoured sweets in the shape of a ring. The packet shows a partial representation of the sweet. Mr Hartman states that sales of GUMMI SAVERS in the US have totalled more than \$200,000,000 since 1991 and advertising expenditure for GUMMI SAVERS over the same period has totalled more than \$20,000,000.

51) Mr Hartman states that another LIFE SAVERS product launched in the United States as an extension of the LIFE SAVERS brand and equity is the product LIFE SAVERS HOLES. Exhibited at page 143 of SH1 is a box section and a label used in relation to the products – the label bears the legend © 1990 PLANTERS LIFESAVERS CO. Mr Hartman states that this new product comprised sugar confectionery in the form of pellets in mint and other flavours. The pellets were notionally the sections of the LIFE SAVERS sweets which were “removed” in order to create the traditional LIFE SAVERS annular shape.

52) Mr Hartman sets out a table of “non-immigrant” admissions to the United States from the United Kingdom over the period 1948-1994. He states that the figures were provided by the US Immigration and Naturalisation Service. Mr Hartman states that figures are quoted from 1948 because that is when POLO is claimed to have been introduced in the United Kingdom.

| YEAR | VISITORS FROM THE UK TO THE USA |
|------|------------------------------------|
| 1948 | 60, 189 |
| 1949 | 45, 599 |
| 1950 | 39, 919 |
| 1951 | 39, 270 |
| 1952 | 46, 628 |
| 1953 | 47, 484 |
| 1954 | 54, 424 |
| 1955 | 52, 447 |

| | |
|------|-------------|
| 1956 | 55, 141 |
| 1957 | 80, 622 |
| 1958 | 68, 637 |
| 1959 | 81, 285 |
| 1960 | 91, 339 |
| 1961 | 106, 141 |
| 1962 | 119, 322 |
| 1963 | 135, 971 |
| 1964 | 184, 544 |
| 1965 | 198, 900 |
| 1966 | 222, 443 |
| 1967 | 240, 485 |
| 1968 | 297, 914 |
| 1969 | 294, 461 |
| 1970 | 318, 354 |
| 1971 | 328, 287 |
| 1972 | 383, 287 |
| 1973 | 461, 864 |
| 1974 | 519, 537 |
| 1975 | 483, 345 |
| 1976 | 515, 473 |
| 1977 | 554, 182 |
| 1978 | 557, 000 |
| 1979 | |
| 1980 | |
| 1981 | 1, 388, 000 |
| 1982 | |
| 1983 | |
| 1984 | 692, 000 |
| 1985 | 598, 000 |
| 1986 | |
| 1987 | 1, 003, 000 |
| 1988 | 1, 397, 000 |
| 1989 | |
| 1990 | 2, 410, 785 |
| 1991 | 2, 614, 171 |
| 1992 | 2, 910, 993 |
| 1993 | 3, 067, 093 |
| 1994 | 3, 022, 399 |

53) Mr Hartman states that these figures are extracted from evidence given by Colette A Durst-Barkey (this has not been adduced into these proceedings). He states that the visitor figures for 1948–1994 include government officials, visitors for business and pleasure purposes, students and temporary workers, including spouses and children.

54) Mr Hartman states that it would appear that, for instance, in 1994 an appreciable portion of the population of the United Kingdom visited the USA.

The adoption and use of LIFE SAVERS brand in the United Kingdom

55) Mr Hartman states that the LIFE SAVERS trade marks were first registered in the United Kingdom by Life Savers Sweets Limited of 17, Victoria Street, Westminster. Thereafter the LIFE SAVERS business passed to Life Savers Limited of Ontario, Canada (1933), Life Savers Corporation of Port Chester, New York (1939), Beech-Nut Life Savers, Inc. (1956) and Squibb Enterprises, Inc (1968) which subsequently became Life Savers, Inc. In 1984 Life Savers, Inc was merged with and into Nabisco, Inc. Exhibited at page 1 of SH2 is an extract of the official register in respect of trade mark No. 442360. The trade mark, which is still valid, was filed on 6 November 1923 and was registered in respect of candy mint sweetmeats. The trade mark is reproduced below:



56) Mr Hartman states that from as early as 1923 Sweet Sales Limited distributed LIFE SAVERS in the United Kingdom with the slogan “The Dainty Sweet With The Hole” and this legend appeared on the packets of LIFE SAVERS sold in the United Kingdom. Mr Hartman exhibits at pages 116 – 123 of SH1 advertisements in support of this statement. Wrappers for LIFE SAVERS also bore the slogan “THE CANDY MINT WITH THE HOLE”. Mr Hartman states that with the introduction of additional flavours over the years this slogan was amended (in the USA) in 1931 to “THE CANDY WITH THE HOLE”. Mr Hartman states that this slogan, or closely similar phrases, is still used in the advertising and promotion of LIFE SAVERS sweets around the world.

Trade Mark Registrations

57) Mr Hartman states that Nabisco is the proprietor of four United Kingdom trade mark registrations for LIFE SAVERS. He exhibits at pages 9 –12 of SH2 “Trade Mark Journal” particulars for registration nos 406828, 442360, 600579 and 744838.

58) Mr Hartman goes on to note that the advertisement for registration No. 406828 carries the reference “user claimed from 1 October 1916”. He exhibits at page 13 of SH2 a copy of a statutory declaration relating to this. Exhibited at page 14 of SH2 is a letter from Life Savers Sweets Ltd, to The Patent Office dated 11 June 1923, the letter carries a picture of a tube of LIFE SAVERS bearing the slogan “THE CANDY MINT WITH THE HOLE”. Also represented are the sweets which are in annular form with the words LIFE SAVER upon them.

59) Mr Hartman refers to registration No. 442360, which is reproduced above. He also refers to the fact that the advertisement for registration No. 744838 carries the legend “advertised before acceptance. Section 18(1) (proviso)”. He states that he is advised that this indicates that the registrar required evidence of acquired distinctiveness before allowing the application to proceed.

Evidence filed in support of LIFE SAVERS trade mark applications

60) Mr Hartman refers to the statutory declaration of Charles Victor Booth, exhibited at pages 16 –18 of SH2. Mr Booth’s declaration, dated 20 December 1923, deals with sales of candy mints under the trade mark LIFE SAVERS from 29 November 1919. Mr Hartman refers to Mr Booth’s declaration that LIFE SAVERS were advertised by “vans in the shape of the packets, with the Trade Mark prominently displayed thereon”. Mr Hartman goes on to comment on advertising material exhibited at pages 116 –124 of SH1 in relation to use of LIFE SAVERS and reference by word and picture to the shape of the sweet. Where the advertisements are identified by date they emanate from 1923. All of the advertising material at pages 117 –123 displays the confection, the annular sweet with LIFE SAVERS written upon it, and reference is made to “The Candy Mint With The Hole” and “The Dainty Sweet With The Hole”. The advertisements on page 116 make multiple references to “The Dainty Sweet With The Hole” and show the annular sweet with LIFE SAVERS written upon it.

61) Mr Hartman exhibits at pages 19 – 23 of SH2 a copy of a statutory declaration made in relation to United Kingdom trade mark application No. 744838. This declaration is dated 14 December 1956. Included in the declaration are sales figures for LIIFE SAVER confectionery in the United Kingdom. The figures are as follows:

| YEAR | PACKETS SOLD |
|------|--------------|
| 1928 | 360, 000 |
| 1929 | 620, 000 |
| 1930 | 680, 000 |
| 1931 | 2, 280, 000 |
| 1932 | 240, 000 |
| 1933 | 20, 000 |
| 1934 | 106, 000 |
| 1935 | 60, 000 |
| 1936 | 106, 000 |
| 1937 | 114, 000 |
| 1938 | none |
| 1939 | 240, 000 |
| 1940 | no figure |
| 1941 | 72, 000 |
| 1942 | no figure |
| 1943 | no figure |
| 1944 | no figure |
| 1945 | no figure |
| 1946 | 20, 000 |
| 1947 | 400 |
| 1948 | none |
| 1949 | none |
| 1950 | none |
| 1951 | 20, 000 |
| 1952 | 21, 000 |
| 1953 | 21, 000 |
| 1954 | 21, 000 |

1955 none
 1956 31, 500

62) Mr Hartman states that the comparatively low sales in the period of the Second World War and afterwards, up to at least 1951, could be due substantially to the fact that confectionery was rationed in the United Kingdom in these years. He states that he believes it would have been difficult to ship quantities of confectionery from the United States to the United Kingdom over this period because the United Kingdom was concerned to arrange the import of more essential items.

63) Mr Hartman states that in the declaration of Mr Jordan the declarant testified to the advertising of LIFE SAVERS sweets in American magazines which circulate in the United Kingdom. There is also a schedule of the United Kingdom circulation for the magazines “Life”, “Look”, “Saturday Evening Post” and “Colliers” at page 23 of SH1. Exhibited at pages 26 to 35 of SH1 are copies of advertisements which appeared in US publications circulating in the United Kingdom between 1946 and 1995, these were exhibited as part of Mr Jordan’s declaration and appear at pages 26 to 35 of SH1. The circulation figures are as follows:

| | 1946 | 1947 | 1948 | 1949 | 1950 |
|-----------------------|----------|----------|----------|---------|----------|
| Life | 16, 918 | NA | NA | 8, 613 | NA |
| Look | - | 178, 761 | 103, 662 | NA | 88, 056 |
| Saturday Evening Post | 105, 960 | 141, 420 | NA | NA | 108, 714 |
| Colliers | 51, 216 | 52, 591 | NA | 10, 076 | - |

| | 1951 | 1952 | 1953 | 1954 | 1955 |
|-----------------------|----------|---------|----------|--------|----------|
| Life | 5, 920 | 4, 544 | 4, 880 | 5, 056 | 4, 752 |
| Look | 81, 066 | 73, 885 | 49, 884 | - | - |
| Saturday Evening Post | 123, 516 | NA | 106, 944 | NA | 113, 088 |
| Colliers | - | - | - | - | - |

NA – indicates no figures available.

64) Mr Hartman exhibits at page 24 of SH2 a copy of a statutory declaration made by Cyril Johnson on 25 January 1957 in support of registration No. 744838. Mr Johnson was the editor of “The Confectionery Journal” and had had forty years experience in the trade. Mr Johnson states that he has known LIFE SAVERS confectionery for at least twenty years.

65) Mr Hartman states that he is unable to determine from the records available to him whether shipments of LIFE SAVERS into the United Kingdom ceased completely in the period 1956 – 1988.

66) Mr Hartman refers to two companies bearing the name LIFE SAVERS, in some form, which were registered in the United Kingdom. He states that the two companies were effectively owned and controlled by Nabisco or its parent company. Mr Hartman exhibits various documentation relating to the companies at pages 25 to 78 of SH2. However, the

documentation does not indicate the nature or purposes of the companies. He refers to income statements for the years 1980 and 1981 for Life Savers European Trading Corporation, exhibited at pages 39 to 42 of SH1. However, these statements do not state what the nature of the business undertaken was. I consequently do not consider the evidence relating to the two companies can assist me in relation to these proceedings and so will say no more about it.

67) Mr Hartman states that he believes that since 1984 there have been intermittent sales of LIFE SAVERS sweets in the United Kingdom but for the most part these would have been through a European marketing facility of Nabisco's parent company based in Switzerland which is no longer in existence. Mr Hartman refers to page 79 of SH2 which is a schedule dated October 1988. Mr Hartman states that some of the sales listed in this schedule were in the United Kingdom, however he does not quantify them. He states that this sales record survived, as at around that time Nabisco's United Kingdom trade mark agent sought confirmation that the trade marks were not vulnerable to cancellation on grounds of non-use.

68) Mr Hartman states that he is aware that a number of businesses operating in the United Kingdom specialising in the import of American products have imported quantities of LIFE SAVERS. He exhibits at page 126 of SH1 a copy of an article which appeared in an addition of "You" magazine published with "The Mail on Sunday" on 2 March 1997. This advertises the availability of specially imported LIFE SAVERS by a company called American Direct.

69) Mr Hartman states that Nabisco has never intended to abandon its interest in the LIFE SAVERS brand in the United Kingdom. He refers to various LIFE SAVERS trade marks for which applications in the United Kingdom have been made. He states that with the exception of one trade mark all of the applications that have been registered have been renewed when appropriate. He exhibits at pages 80 – 89 advertisements from the Trade Marks Journal for the applications, not all of the applications incorporate the words LIFE SAVERS.

70) Mr Hartman states that Nabisco has always considered the United Kingdom a natural market for the expansion of the LIFE SAVERS business. He states that plans were developed to sell LIFE SAVERS in the United Kingdom but for reasons he has been unable to determine these plans were never realised. He states that in 1989 the ultimate parent company of Nabisco disposed of all its European manufacturing businesses and it became more difficult to re-launch LIFE SAVERS products on a realistically commercial scale.

71) Mr Hartman states that in 1991 there were detailed plans for RJ Reynolds Tobacco International S.A. in Geneva to re-establish substantial sales of LIFE SAVERS in the United Kingdom. These plans resulted in the preparation of the proof label exhibited at page 128 of SH1. In 1995 Nabisco re-acquired one of its former businesses, based in Spain – Nabisco Iberia - and as a result it became more viable to launch Nabisco products, including LIFE SAVERS, into the United Kingdom.

72) Mr Hartman states that in 1995 Nabisco Iberia appointed Trustins the Foodfinders Limited (Trustins) as its United Kingdom distributor for Nabisco products. He exhibits at pages 129 – 140 of SH1 extracts from "The Grocer" trade price list for January 1997 to illustrate the range of products handled by Trustins.

73) Mr Hartman states that in the summer of 1996 Nabisco Iberia arranged the import of the South African made LIFE SAVERS product into the United Kingdom for distribution and sale by Trustins.

74) Mr Hartman states that an announcement regarding the re-launch of LIFE SAVERS in the United Kingdom appeared in “The Grocer” of 10 August 1996. He states that this notice was seen by Nestlé who launched ex-parte passing off proceedings against Trustins. He exhibits at pages 90 – 136 of SH2 documentation relating to this passing off action. Walker J, as he then was, refused to grant any injunctive relief. He considered that the motion was premature and refused leave to appeal. The premature nature of the action arose from the fact that there was no evidence of how the defendant intended to use and promote the goods. Nestlé sought leave to appeal from the Court of Appeal, which was refused by the Court of Appeal. Mr Hartman makes special mention of Walker J’s comment:

“But an annular configuration is so basic a shape, being used also in pasta, doughnuts, cocktail snacks and breakfast cereals, so far as foodstuffs are concerned, that the task of establishing the article itself as its own trade mark must impose an exceptionally high burden of proof.”

75) Mr Hartman states that Nestlé, having been unsuccessful, have not taken any further action to determine the proceedings and have thus “allowed them to go to sleep”.

76) Mr Hartman refers to sales of NAVY brand sweets in the United Kingdom. He indicates that the primary evidence in relation to this is in evidence submitted by Adrian Spencer and so I will deal with this matter in relation to that evidence.

77) Mr Hartman turns to the issue of bad faith. He comments that in the light of the history of the LIFE SAVERS product that Nabisco take grave exception to the claim that use of the trade marks in suit would be calculated to deceive and cause confusion and therefore that no reasonable reputable trader would want to use them.

78) Mr Hartman states that POLO, NAVY and LIFE SAVERS have co-existed in the market place over the period 1948 – 1956 and beyond.

79) In relation to the claim that Nabisco has no bona fide intention to use the trade marks in suit Mr Hartman confirms that they have been waiting, for many years, for the opportunity to re-launch their LIFE SAVERS products in the United Kingdom.

Statutory declaration of Joanne Beth Green dated 7 May 1997 (DEC17)

80) Ms Green is a trainee solicitor . Ms Green states that she was instructed to carry out an exercise to gather evidence of the public’s recollection of LIFE SAVERS in the United Kingdom. The exercise was targeted at people who were children before World War II. Ms Green states that she does not suggest that from the results that a statistically significant prediction can be made of the population of the United Kingdom as a whole. However, she states that the results reflect the strong residual reputation of LIFE SAVERS in the United Kingdom. She exhibits at JBG1 a copy of the questionnaire.

81) Ms Green states that partners in her firm were contacted to arrange for assistant solicitors to carry out the exercise. Staff from the following offices of her firm conducted the exercise: Birmingham, Bristol, Cardiff, Leeds, Manchester, Middlesborough, Norwich and Nottingham. She exhibits at JBG2 a copy of the notes sent to the partners. The notes advised that people over the age of fifty should be interviewed and suggested that appropriate locations could be

bowling clubs, retirement clubs and other recreational clubs attended by the older generation. Retirement homes were not recommended. Exhibited at JGG3 are further notes as to how the exercise should be conducted. It includes the following, “the idea is to prompt the interviewees to say as much as possible about what they remember about LIFE SAVERS”.

82) Ms Green attended the Century Bowling and Sports Club in Wembley on 9 April 1997 to interview people. She exhibits at JBG4 those questionnaires where the interviewees could not recall LIFE SAVERS. Exhibited at JBG5 is a questionnaire by an interviewee who did not wish to be contacted again.

83) On 11 April 1997 an advertisement was published in “The Eastern Daily Press” which read: “Do you remember Life Savers Sweets. If so we could be very pleased to hear from you.” It then gave a freephone number to call. If someone phoned the number they would then be asked the questions in the questionnaire exhibited at JBG6. Advertisements were placed in a further seventeen local newspapers. Certain of the advertisements are exhibited at JBG7.

84) Ms Green states that on 11 April 1997 she took a number of the telephone calls that came in from the advertisements. She exhibits at JBG8 a copy of the questionnaire which she completed of a caller who would not agree to being contacted again about the survey. She exhibits at JBG9 two incomplete questionnaires.

85) Ms Green states that Jonathan Greenyer responded to the advertisement in “The Evening Standard”. Whilst completing the questionnaire he stated that he had a poster on his wall for LIFE SAVERS. A colour copy of this is exhibited at JBG10. Ms Green is unable to state from where the poster came originally. However, as it bears the price for the product as 5 cents it would not appear to emanate from or be for use in the United Kingdom. Ms Green exhibits at JBG11 and 12 copies of questionnaires which were not followed up with statutory declarations.

86) Ms Green states that after executed statutory declarations were received, with leading counsel’s approval, the interviewees were each sent six packets of LIFE SAVERS to acknowledge the time spent in answering questions and making the declarations. She states that no inducement was offered to the interviewees before they executed the statutory declarations.

Second statutory declaration of Joanne Beth Green dated 7 May 1997 (DEC18)

87) Exhibited at JGB1 is a breakdown of the results of persons interviewed in person. The results tabulated at JBG1 are as follows:

| Area | Number questioned | Number who can recall Life Savers | Statutory declarations prepared | Number actually sworn |
|------------------------------|--------------------------|------------------------------------------|----------------------------------------|------------------------------|
| London | 83 | 21 | 14 | 12 |
| Birmingham | 7 | 1 | 1 | 1 |
| Manchester and Liverpool | 33 | 13 | 5 | 5 |
| Norwich | 2 | 2 | 1 | 1 |
| Nottingham | 22 | 4 | 2 | 2 |
| Leeds | 45 | 9 | 1 | 1 |
| Cardiff | 14 | 7 | 2 | 1 |
| South West | | | | |
| Middlesborough and Newcastle | 10 | 8 | 3 | 3 |

88) Exhibited at JBG2 is a summary of the results of the telephone calls received in response to the newspaper advertisements.

| Area | Number questioned | Number who can recall Life Savers | Statutory declarations prepared | Number actually sworn |
|------------------------------|--------------------------|------------------------------------------|----------------------------------------|------------------------------|
| London | 38 | 38 | 21 | 19 |
| Birmingham | 3 | 3 | 1 | 1 |
| Manchester and Liverpool | 15 | 15 | 11 | 11 |
| Norwich | 11 | 11 | 7 | 6 |
| Nottingham | 1 | 1 | 1 | 1 |
| Leeds | 3 | 3 | 3 | 3 |
| Cardiff | 11 | 11 | 11 | 10 |
| South West | 15 | 15 | 8 | 7 |
| Middlesborough and Newcastle | 2 | 2 | 2 | 2 |

Statutory declaration of Kristian Edward Grimes dated 7 May 1997 (DEC19)

89) Mr Grimes is a trainee solicitor with Eversheds. He states that on 10 April 1997 he went to interview people in Albany Road in Cardiff. He interviewed eleven people and exhibits at KEG1, KEG2 and KEG3 completed questionnaires arising from the interviews. He also exhibits at KEG4 a questionnaire arising out of an interview conducted following an advertisement in "The South Wales Echo". Of the questionnaires exhibited at KEG1 and KEG2 only one person, when prompted by "Have you ever heard of LIFE SAVERS sweets," had a vague recollection of them. In the interview exhibited at KEG3 the respondent seems to believe that they are cough lozenges. The respondent, whose questionnaire is exhibited at

KEG4, on prompting, recalls them looking like POLOs but being more lemony and recalls them being sold about fifty years ago.

Statutory declaration of Patricia Jean Hill dated 7 May 1997 (DEC20)

90) Ms Hill's declaration relates to her being interviewed in Cardiff and asked if she remembered LIFE SAVERS sweets. She states that she had a vague recollection of Americans bringing them over in the war and that they were like a POLO but fruit flavoured.

Statutory declaration of Iris Gratton dated 7 May 1999 (DEC21)

91) Ms Gratton was interviewed on 10 April 1997 in Albany Road, Cardiff, and declares to the truth of the questionnaire that is exhibited at IG1. When asked if she had heard of LIFE SAVERS sweets she states that they were a ball sweet that you could see through. She did not remember if they were round or square. She thought they were fruity and did not remember if "they had mints".

Statutory declarations of David Devine, Marina Hanrahan, Jennifer Langley, Barbara Acton and Lillian Lloyd dated 3 May 1997, 6 May 1997, 6 May 1997, 2 May 1997 and 2 May 1997 respectively (DEC22, 23, 24, 25 and 26 respectively).

92) All the above responded to advertisements in local papers. They telephoned the number in the advertisements and were asked what they knew about LIFE SAVERS sweets. Two of the declarants, Marina Hanrahan and Jennifer Langley remembered buying them in the 1950s. Barbara Acton remembered buying them in Manchester in the early 1960s. She describes them as being round with a hole in the middle and that some were mint and some were fruit. David Devine and Lillian Lloyd knew of them from purchases that were made in the United States.

Statutory declaration of Howard Jon Gill dated 7 May 1997 (DEC27)

93) Mr Gill is a trainee solicitor. Mr Gill conducted a similar exercise to that of Kristian Edward Grimes (DEC19).

94) On 15 April 1997 he went to Bridgewood Lodge in Greater Manchester, where he questioned twenty nine people. On the same date he went to a lunchtime tea dance at Manchester Town Hall where he questioned eleven people. Exhibited at HJG1 – 5 are copies of the questionnaires that were completed. Of those interviewed three had a recollection of LIFE SAVERS being sold as sweets, another three thought that they were cough sweets, like Fisherman's Friends or glucose sweets. None of those who stated that they remembered the sweets referred to the annular shape although some commented that they thought that the sweets were round. Exhibited at HJG6 is a questionnaire completed over the telephone as a result of a response to an advertisement in "The Manchester Evening News". The respondent was sent the sweets by an American pen friend in 1943 and bought them in the United Kingdom. He recalls them having a hole and a fruity taste.

Statutory declarations of Matthew Meyer dated 7 May 1997 (DEC28 and 29)

95) Mr Meyer is a trainee solicitor. His first declaration simply deals with an error he made in recording answers to a questionnaire by Patricia Martin. Mr Meyer conducted a survey

similar to those carried out by Messrs Grimes and Gill (DEC19 and 27). Mr Meyer went with Gregory Norton to the Civil Service Retirement Fellowship in Norwich on 15 April 1997. He states that they made an announcement asking for those people who remembered LIFE SAVERS to come forward. He states that he questioned one person. He exhibits at MM1 the questionnaire for Patricia Martin. She states that she was sent LIFE SAVERS by a pen friend after the war but was positive that they were on sale in the United Kingdom. Ms Martin states that they were shaped like POLOs. He refers to the statutory declaration of Joanne Beth Green.

Statutory declaration of Susan Belle Quinn dated 7 May 1997 (DEC30)

96) Ms Quinn is managing director of the consumer and business division of Martin Hamblin, which is an independent market research agency. Ms Quinn states that she has read the declaration of Rosi Ware (DEC2). Ms Quinn states that in her statutory declaration Ms Ware states that of the respondents interviewed 14% were aware of LIFE SAVERS and 9% were aware of NAVY MINTS. 6% had tried LIFE SAVERS and 4% had tried NAVY MINTS.

97) Ms Quinn states that she has been involved in market research for 31 years and is aware of brands which have a similar level of prompted awareness and positive responses to questions relating to whether the respondents had ever used the products. She states that in studies conducted by Martin Hamblin they have found that prompted awareness figures in the order of 15% are often attained by smaller more niche market brands which may well have been on the market for a reasonable amount of time, but which are used only by certain, sometimes specialist, groups. She states that with awareness levels of 15% one might expect “ever used” figures to be of the order of 3 – 9%.

98) Ms Quinn states that many a brand manager would like to have this degree of prompted awareness in relation to the brands for which they are responsible and the level of prompted awareness and use referred to in the declaration of Ms Ware indicates a degree of consumer recognition which clearly shows a substantial residual reputation in relation to LIFE SAVERS.

Statutory declaration of Andrew David Baker dated 7 May 1997 (DEC31)

99) Mr Baker is a trainee solicitor. Mr Baker was involved in carrying out the face to face and telephone surveys that have all been referred to above.

100) Mr Baker attended the Royal British Legion Club in South Harrow on 8 April 1997 where he questioned twenty three people. He exhibits at ADB1 copies of the questionnaires which he completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the latter case the names and addresses have been blocked out. He exhibits at ADB2 questionnaires which he completed where people did not recollect LIFE SAVERS. In only one questionnaire exhibited at ADB1 does the respondent identify LIFE SAVERS with a form of sweet. That person makes no reference to the annular shape but describes them as pastels.

101) On 9 April 1997 Mr Baker attended the Havering Shortmat Bowls Club in Hornchurch. There he questioned twenty five people. He exhibits at ADB3 copies of the questionnaires which he completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the latter case the

names and addresses have been blocked. He exhibits at ADB4 questionnaires which he completed where people did not recollect LIFE SAVERS. One of the responses exhibited at ADB3 refers to LIFE SAVERS as being like POLOs.

102) On 11 April 1997 Mr Baker answered some telephone calls in response to the press advertisements. He exhibits at ADB5 a copy of the questionnaire where the caller did not want the questionnaire to be used in legal proceedings and so the name and address of the person have been blanked out. Statutory declarations were prepared and made for all the interviewees who recalled LIFE SAVERS and agreed to be contacted again. He exhibits at ADB6 four questionnaires which did not give rise to a request for a declaration as he did not consider that it would have been appropriate. He exhibits at AB7 – 10 further questionnaires which, for various reasons, did not give rise to statutory declarations being completed.

Statutory declaration of Neil Michael Tindall dated 6 May 1997 (DEC32)

103) Mr Tindall is a trainee solicitor. Mr Tindall was involved in the surveys that have already been referred to. Mr Tindall in April 1997 went to Leeds City Station, Thongsbridge Cadet Centre and Dewsbury Town Centre to conduct interviews. He exhibits at NMT2 copies of the questionnaires which he completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the latter case the names and addresses have been blocked out. He states that he exhibits at NMT1 questionnaires which he completed where people did not recollect LIFE SAVERS. Two of the persons questioned seemed to have a clear idea of the sweets, one describing them as being like POLOs.

104) Mr Tindall states that he instructed Paul Tindall, an employee of Singleton Winn Solicitors, to assist in the evidence gathering exercise. Mr Tindall states that he received questionnaires which had been completed in the Ryton-on-Tyne and Newcastle-upon-Tyne areas. He exhibits at NM3 questionnaires by people whom he states had some recollection of LIFE SAVERS but were not invited to make statutory declarations. He exhibits at NMT4 twenty seven questionnaires by people who could not recall LIFE SAVERS. He states that statutory declarations were prepared and made for the interviewees who recalled LIFE SAVERS and agreed to be contacted again.

105) Mr Tindall goes on to deal with a questionnaire arising from the press advertisement and which did not give rise to a statutory declaration. The questionnaire is exhibited at NMT5.

Statutory declaration of Neil Michael Tindall dated 7 May 1997 (DEC33)

106) This declaration simply comments on two of the questionnaires adduced with Mr Tindall's declaration, which he exhibits at NMT1. He states that the two questionnaires of Messrs Hall and Bolton should not be taken into account.

Statutory declaration of Philip John Tompkins dated 1 May 1997 (DEC34)

107) Mr Tompkins is a trainee solicitor. He was involved in the surveys already referred to. On 11 April 1997 he stopped about fifteen or twenty people in Linthorpe Road, Middlesborough. Only four would answer his questions. He exhibits at PJT1 a completed questionnaire where the person did not wish to have the questionnaire adduced into legal proceedings and so his name and address were struck out. At PJT2 he exhibits the

questionnaires of those who could not recall LIFE SAVERS. On 14 April 1997 Mr Tompkins went to the Neighbourhood Centre in Middlesbrough. He exhibits at PJT3 the five questionnaires he completed, the respondents either did not wish to be contacted again or did not wish the questionnaire to be used in legal proceedings. All of the details of the respondents have been struck through. One of the respondents described LIFE SAVERS as being like POLOs and another that they were like POLOs in the packet shape. In all, four remembered LIFE SAVERS as being sweets.

Statutory declaration of Susan Ann Dowman dated 7 May 1997 (DEC35)

108) Ms Dowman is a secretary for the solicitors Eversheds. She answered some of the telephone calls from people who responded to the press advertisements. She exhibits at SAD1 copies of the questionnaires which she completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the letter case the names and addresses have been blocked out to protect confidentiality. She exhibits at SAD2 copies of questionnaires of people who telephoned in response to the advertisement but could not be contacted again or thought they were confusing LIFE SAVERS with another product. Several of the people compared them to POLOs whilst others said that they were in a tube like Refreshers.

Statutory declaration of Christopher Ian Jones dated 7 May 1997 (DEC36)

109) Mr Jones is a trainee solicitor. He was involved in the surveys already referred to. On 8 April 1997 he attended a Mothers' Union meeting in Clapham. He exhibits at CIJ1 copies of the questionnaires which he completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the latter case the names and addresses have been blocked out. Of these only one remembered LIFE SAVERS, from the wartime.

110) On 15 April 1997 Mr Jones attended the All Saints Hall at Hartley where he questioned nine interviewees. He exhibits at CIJ2 copies of the questionnaires where the interviewees could not recall LIFE SAVERS.

111) Mr Jones states that on 11 April 1997 he answered some of the telephone calls which arose as a response to the press advertisements. He exhibits at CIJ3 copies of the questionnaires which he completed where the interviewee did not agree to being contacted again and/or would not agree to the questionnaire being used in legal proceedings. In the latter case the names and addresses have been blocked out.

112) He goes on to give details of where a statutory declaration had been expected from the interviewees of either survey but did not eventually transpire. The relevant questionnaires are exhibited at CIJ5 and 6.

113) Mr Jones contacted Advertising Archive Limited for a copy of an advertisement they had for NAVY FRUITS in their archives. A colour copy of the advertisement is exhibited at CIJ6. Mr Jones states that the advertisement indicates that it is reproduced from "Picture Post" of 27 August 1955. The advertisement refers to "the sweet with the hole".

Statutory declarations of Kathy Taylor, Patrice Jane Cockburn, Ken Stewart, Eileen Carlsen, Ivy Doris Clark, Loraine Rossati, Roger Victor Flexman, Dorothea Poppy

Baker, Wynsum Emerton, Margaret Sasin, John Doyle, Hellena Stratton, Edward Charles Ward, James John Gordon, Valerie Willis, Jonathan Greenyer, Maurice Sheldon, Richard Griffiths, Susan Margaret Macpherson, John Joseph Morgan, Harvey Kendall, Anthony Willcocks, Patrick Keene, Sidney Arthur Jenkins, Jean Debeer, Robert John Jameson, Robert Richard Davies, Mark Foster, Brenda Lewis, John William Lewis, Maureen Patton Winn, Colin Diball, Stanley Langsman, Ronald Dobson Smith, Pamela Patricia Fahey, Ekaetex Assiak, Lynn Sharkey, Wilfred Musgrave, Esther Edwards, Malcolm Stuart Pettyt, Joanna Susan Yaffe, Margaret Scully, May Stuble, Margaret Bellenger, Cyril Frederick MacCartney, George David Grover, Alan Rickard, Rosemary Dulwich, David Roberts, Rodney Smith, Susan Jacques, Joan Eubank, David Thomas Young, Mary Ann Teasdale, Linda Graham, William Albert Smith, Geoffrey Kear Wiggins, John Leslie Brown, Maria Gladys Brown, Doreen Celia Moorcraft, Shirley Catherine Grainger, Ronald Henry West and Audrey Keane (DECS 37 – 97)

114) All these declarations are by persons who were interviewed in person or responded to the press advertisements. A large proportion of them describe LIFE SAVERS as being like POLOs. The majority remember them as being fruit flavoured although a few recall them as being mints. The majority remember them from around the period of the Second World War and a good number recall being given the sweets by American servicemen stationed in the United Kingdom at that time. A few of the respondents seem to be confusing LIFE SAVERS with some other sweet e.g. Linda Graham described them as being oval shaped but black and flat. Certain of the respondents from South Wales remember buying them recently, around 1997 when the declarations were completed, from Hypervalue stores i.e. Audrey Kean, Doreen Celia Moorcraft and Ronald Henry West.

Statutory Declaration of Isabel Milner Davies dated 30 April 1997 (DEC98)

115) Ms Davies is a partner in Eversheds, solicitors. Ms Davies exhibits at IMD1 to IMD4 examples of annular confectionery which she states has been purchased in England. She states that the first three exhibits were all purchased in 1997. Exhibit IMD1 consists of small sweets linked together to form a necklace. Exhibit IMD2 consists of Cadbury's Choc-o's which are annular chocolate confections. Exhibit IMD3 consists of NAVY Gums which are annular sweets in several colours, probably denoting fruit flavours. IMD4 are sweets embossed with the word NAVY twice. Except for the name embossed upon them they are almost identical in form to the trade marks in suit. She states that the NAVY mints came to her via the applicant's trade mark agent, from the trade mark agent for Swizzels Matlow Ltd.

116) Ms Davies exhibits at IMD5 some POLO GUMMIES in their packet. She also exhibits at IMD6 a copy of an extract from "Marketing" which indicates that these goods were introduced into the United Kingdom in June 1996. These sweets are in various "fruit colours" and in annular form. She exhibits at IMD7 a copy of an extract from "CTN" dated 25 October 1996. She states that this demonstrates the launch of POLO HOLES, circular mints which are the cores punched out of the traditional POLO. Ms Davies exhibits at IMD8 a copy of an extract from a pamphlet entitled "Sweet Memories – a selection of Confectionery Delights sampled by Robert Opie". Included in the extract is the following:

“...but in 1948 two brands appeared. One was Rowntree's Polo Mints – the mint with the hole. The idea had been captured from the American GIs a product called Lifesavers (the American for life belts).”

Statutory declaration of Josephine Manfredi dated 30 April 1997 (DEC99)

117) Ms Manfredi is a trainee solicitor. Ms Manfredi was involved in the surveys already referred to. On 9 April 1997 Ms Manfredi “tried the questionnaire out” on three employees of her firm, Eversheds, solicitors. She exhibits at JM1 copies of the questionnaires. One of the three – Alan Brown – had heard of LIFE SAVERS and described them as being like POLOS but being fruit. He knew of them from about the end of the war.

118) On 9 April 1997 Ms Manfredi attended the Rotary Club at Nottingham University campus and the Carlton Club in Nottingham. She questioned eleven and five people respectively. At JM2 and JM3 she exhibits the questionnaires of those who could not recall LIFE SAVERS, which represent all those interviewed.

Statutory declaration of Gregory Peter Norton dated 6 May 1997 (DEC100)

119) Mr Norton is a trainee solicitor. His declaration goes to his assisting Mr Meyer in conducting the survey already referred to. Mr Meyers declarations are summarised above – DEC37 and DEC38.

Statutory declaration of Samantha Jane Langley dated 6 May 1997 (DEC101)

120) Ms Langley is a trainee solicitor. She was involved in conducting the survey already referred to above. On 10 April 1997 Ms Langley went to Kings Heath Royal British Legion Club, Moor Green Leisure Gardens and Kings Norton Royal British Legion Club, all in Birmingham. She completed seven questionnaires. She exhibits at SL1 the questionnaires of those who did not recall LIFE SAVERS, six of the seven.

Statutory declarations of James Chettle, Keith Gadsden, Captain John Marsh, Philip Lunt, John Bryson Richardson, Philip Lots, Margaret Mildred Hinchcliffe, Dorothy Kersys, Frank Mullen, Gladys Ross, Ethel Healey, Ivor Glyn John, Rose Grant, Merrie Simes Longbottom, Maurice Sandell, Donald Osborne and Horace Charles Easey (DECS102 – 118)

121) All these declarations are by persons who were interviewed in person or responded to the press advertisements. (Also see DECS104 - 121). The responses are similar to those as for DECS 104 - 121. Ms Healey had recently purchased LIFE SAVERS in B&G stores in the Arndale Centre and in a shop in Ashton-under-Lyne, Mr John had purchased them in a local market in June/July 1996. Ms Longbottom stated that she had eaten LIFE SAVERS all her life and that they are American. Mr Easey had purchased them in London, in Mount Pleasant Post Office canteen around 1960/1955.

Statutory declaration of Adrian Younger Spencer dated 1 May 1997 (DEC119)

122) Mr Spencer was a registered trade mark agent. He states that in October 1995 he came across the fact that Swizzels Matlow Limited (Swizzels) had applied to register the representation of an annular sweet. He exhibits at AYS1 details of the application. Mr Spencer checked the current “Grocer” trade price list for Swizzels and found NAVY mints listed for “roll lines – compressed”. He also checked back numbers of the price list and found

reference to NAVY mints from as early as November 1991. Mr Spencer exhibits at AYS2 extracts from the price list for 2 November 1991 and 2 September 1995.

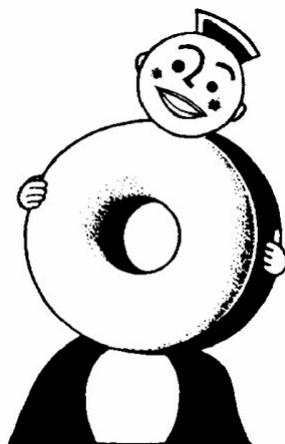
123) Mr Spencer wrote to the agents for Swizzels and also arranged to procure Swizzels' sales literature. He exhibits at AYS3 copies of the correspondence and a Swizzels' leaflet. Included in AYS3 are price lists from Swizzels dated November 1982 and August 1994. Both price lists refer to "Navy Rolls in seal tight food box" and "Navy Refreshers" or "Navy Refresher Rings" in a jar.

124) Mr Spencer states that the Swizzels leaflet does not illustrate the NAVY mints. He states that it does illustrate products designated as "dolly beads" and "dolly watches". He states that these products either are, or are of the same nature as, the products exhibited at IMD1 of the declaration of Isabel Davies (DEC98).

125) Mr Spencer exhibits at AYS4 a copy of the statutory declaration and exhibits of Trevor Matlow in relation to the application by Swizzels for the NAVY trade mark (a summary of this can be found in DEC138). Mr Spencer states that he subsequently discovered that Swizzels can probably establish use of their trade mark and of the annular configuration from 1937, rather than 1955 as per the declaration of Mr Matlow.

126) Mr Spencer exhibits at AYS5 a copy of an advertisement for NAVY sweets which appeared in "Picture Post" on 27 August 1955.

127) Mr Spencer states that in February 1997 he visited the 10th International Food and Drink Exhibition held at Earls Court Exhibition Centre. He states that he met Mr Matlow there and that the latter had told him that he had come across evidence in the company archives of sales of NAVY mints as long ago as 1937. Mr Spencer exhibits at AYS6 correspondence from the trade mark agent for Swizzels. Included in this is a copy of a photograph which it is stated was taken at a confectionery exhibition in 1936/37. "Blow-ups" of the picture show what appear to be annular sweets and clearly visible is a sign referring to NAVY mints. Exhibited at AYS7 is a copy of trade mark registration No. 731732 which was filed on 1 July 1954. Mr Spencer states that this trade mark features prominently a plain annular sweet. The actual trade mark is reproduced below:



128) The registration is in the name of Navy Sweets Limited. Mr Spencer states that Mr Matlow stated that Navy Sweets Limited is an associated company of Swizzels. Exhibited at

AYS9 are extracts of the company file showing Mr Matlow as a director of Navy Sweets Limited.

129) Mr Spencer goes on to give details of conversations with Mr Matlow. However, no exhibits nor declaration has been adduced in support of the statements that Mr Matlow is said to have made to Mr Spencer. I will, therefore, say no more about this part of the evidence of Mr Spencer. Mr Matlow has, however, completed a declaration in relation to these matters (DEC133).

Opponents evidence in reply

Statutory Declaration of Felicity Ann Cox dated 22 January 1998 in relation to opposition Nos. 42897, 43718 and 45334 adopted into the proceedings for opposition no 47138. (DEC120)

130) Ms Cox is a trade marks assistant working for Nestlé UK Ltd.

131) Ms Cox states that she has read the declaration of Adrian Spencer in relation to opposition Nos. 42897 and 43718. She states that this declaration includes the declaration of Trevor Matlow in relation to opposition No. 45334. She states that she understands from these declarations that Swizzels Matlow Limited have used the trade mark the subject of application No. 2025205 since 1955 and that particular reference is made to sales between 1990 and 1995. Ms Cox states that she was asked to quantify as far as possible the sales of NAVY mints from 1955 to date.

132) Ms Cox states that she first conducted an Internet search and located the web site of Swizzels Matlow Limited. She exhibits at FAC1 a copy of the company history downloaded from the Internet on 7 October 1997. Ms Cox states that she notes that the history contains three references to the trade mark NAVY. (Two of the references are to NAVY Mints and one to NAVY Sweets.) Ms Cox states that there is reference to the trade mark NAVY in the document which forms exhibit AYS8 to the declaration of Mr Spencer. Ms Cox states that she consulted the 1994 edition of "The Grocer Guide to the UK's Top Food & Drink Suppliers" and exhibits at FAC2 a copy of the entry relating to Swizzels Matlow Limited. She notes that the list of brands does not include NAVY. Ms Cox states that she knows, because her department is responsible for checking Nestlé's entry in this publication, that the list of brands is supplied by the company itself.

133) Ms Cox goes on to state that she visited the offices of William Reed Publishing Limited, publishers of the weekly magazine "The Grocer", on 24 September 1997. She states that on the first Saturday of each month a price list giving the manufacturers' wholesale prices for a wide range of food products is published with "The Grocer". She exhibits at FAC3 by way of example a copy of the price list dated 6 June 1997. (I note that the part dealing with Swizzels Matlow includes a reference to Giant NAVY Mints and Giant NAVY Fizzy Fruits.) Ms Cox states that she believes that these price lists are based upon information supplied by the manufacturers of the products listed. Ms Cox states that at the offices of William Reed she asked to see old price lists. She states that the oldest price list that they were able to show her dated from 4 January 1986 and included a reference to NAVY Refresher Rings under the heading Swizzels Matlow Limited, Countlines. Ms Cox states that the price of this product was shown as 2 for 1p which suggests to her that these products were sold loose. She states that there was no other indication as to what the goods might have been. Ms Cox states that she then examined the price lists for the next three months. She states that NAVY Refresher Rings were listed in the price lists for February and March 1996 but did not appear in the list for April 1986. Ms Cox then looked at the price lists for 6 September 1986, 7 March 1987, 2 January 1988, 2 December 1989 and 5 January 1991. She states that in none of the aforesaid price lists was there any reference to the trade mark NAVY. Ms Cox states that in the price list dated 2 February 1991 there is a listing for NAVY mints under the heading Swizzels Matlow Limited, Roll Lines Compressed.

134) Ms Cox goes on to state that she was informed by William Reed Publishing Limited that they had a searchable database of all articles that appeared in “The Grocer” from 27 April 1985 onwards. She states that she obtained a printout of all the articles on the database that had mentioned Swizzels Matlow Limited and she exhibits at FAC4 a copy of this printout. Ms Cox states that the printout lists 31 references to Swizzels Matlow, none of which appears to relate to NAVY mints. In fact the printout appears to list only the headings of articles so it is not possible to know what was in the body of the articles.

135) Ms Cox states that she visited the offices of Emap Limited, publishers of the weekly magazine “CTN” on 19 November 1997. She states that “CTN” publishes a price guide approximately monthly based upon information supplied by individual manufacturers. She states that she was informed by the deputy editor of “CTN” that the magazine was previously known as “Confectionery and Tobacco News” and has been published weekly for 110 years. Ms Cox states that she was provided with the following price lists:

1980 – January, February, March, June

1981 – July, August, September, October, November, December

1985 – August, September, October, November

1988 – April, September, November, December

1989 – January, March, April, June, July, August, September, October, December

1990 – March, April, June, July, August, September, October, November, December

1991 – January, February, March, April, June, July, August, September, October, November, December

1993 – January, February, March, April, June, July, September, October, November, December

136) Ms Cox states that in these price lists she found references to NAVY confectionery as follows:

NAVY Rolls August to October 1985

NAVY Refresher Rings August to November 1985

NAVY Mints 1991 from February 1993 (I am not certain what she means by this last reference.)

137) Ms Cox states that the first recent entry for NAVY mints was in the price guide for February 1991. She exhibits at FAC5 a copy of this reference which has a black rectangle next to the entry. Ms Cox states that she was informed by Mr Lee that this symbol is used to denote a new product.

138) Ms Cox states that Mr Lee suggested that she should consult “Shaw’s Price Guide”. She states that he explained that, as far as he was aware, this was the first guide to be produced in the United Kingdom and that it first appeared during or shortly after the Second World War to publish the prices of rationed foods. Mr Lee was able to show her copies dating from January 1963 at which stage the guide did not cover confectionery. In May 1993, confectionery was included in the list for the first time. Ms Cox states that the goods are listed by the manufacturer. She states that there was no entry for Swizzels Matlow Limited in 1963 and that the first entry she could find dated from 1 August 1980.

139) Ms Cox states that she found that the technical library at the Nestlé research and development centre in York keeps back copies of “CTN” price guides and “Shaw’s Price

Guides". She asked to be faxed copies of the Swizzels Matlow entries in the "CTN" price guides at five year intervals from 1976 to 1991. She was sent appropriate pages from the price lists dated 2 April 1976, 3 April 1981, 4 April 1986 and 5 April 1991. Ms Cox exhibits at FAC6 copies of the pages. She states that the only reference to NAVY mints is in the price list dated 5 April 1991. Ms Cox was also sent a copy of a Swizzels Matlow Ltd price list dated 1974 which she exhibits at FAC7. She states that it will be seen from this that there is no reference to any product under the trade mark NAVY.

140) Ms Cox states that as noted in respect of her visit to Emap, as far as "CTN" was concerned, NAVY mints appeared to be a new product in February 1991. She, therefore, checked every price list for the preceding twelve months. Copies of the relevant pages are exhibited at FAC8. She states that it can be seen from these pages that there were no entries for NAVY mints during 1990.

141) Ms Cox states that she was also sent copies of the entries for Swizzels Matlow Limited in the following "Shaw's Price Guides": August 1980, October 1984, January 1992 and February 1994. She states that there is no entry for any product under the trade mark NAVY in the 1980 guide. In the 1984 guide there is a listing for NAVY Refresher Rings and NAVY Rolls and in 1992 and 1994 NAVY mints are listed under the heading "roll lines compressed". Ms Cox does not exhibit these documents.

142) Ms Cox also refers to the annual report produced by Mintel on the market in the United Kingdom for sugar confectionery. She states that part of this report is a table listing the main companies operating in the sugar confectionery market and their brands. She obtained copies of the reports for 1993, 1995 and 1996 and copies of the tables from each of these years is exhibited at FAC9. She states that Swizzels Matlow is listed in each report as a major manufacturer of sugar confectionery but that there is no mention of NAVY mints in the list of brands attributed to them.

143) Ms Cox states that she contacted the Leatherhead Food Research Organisation and was informed that they own a searchable computerised database of articles which have appeared in the trade press including "The Grocer" and "CTN" from 1986 onwards. She states that she asked for the database to be searched using both Swizzels Matlow and NAVY mints as key words. She exhibits at FAC19 a copy of the printout she received. She states that none of the fifty seven articles about Swizzels Matlow retrieved refer to NAVY mints. She exhibits at FAC10 a copy of the printout.

144) Ms Cox states that she then contacted Fast Facts Limited which specialises in making abstracts of articles that appear in the trade press and compiled a database of these abstracts. She states that the database covers the period from October 1985 to date. Ms Cox states that Fast Facts searched their database for references to Swizzels Matlow and produced one reference to an article which appeared on 6 February 1991 describing the launch of NAVY mints. She exhibits a copy of the abstract at FAC11 but states that she could not trace the article to which it relates.

145) Ms Cox states that she also enquired of Nestlé's marketing research department whether they had any records of sales of NAVY mints over the years or had access to such records. She obtained a printout, a copy of which is exhibited at FAC12. She states that this is extracted from the database of A C Nielsen Limited, the research organisation. She states that, according to Nielsen's records, sales of NAVY mints were first recorded in March 1991. She

states that the cumulative totals recorded by Nielsen for the years 1991 to 1995 were as follows:

| | |
|------|----------|
| 1991 | £81, 000 |
| 1992 | £75, 700 |
| 1993 | £21, 500 |
| 1994 | £6, 600 |
| 1995 | £4, 500 |

146) Ms Cox states that a Mr Randall explained to her that Nielsen obtained their data from outlets such as multiple grocers, confectioners' shops and petrol stations; they do not receive data from outlets such as kiosks and tuck shops. Consequently, the sales figures that they record probably account for about 60% of all sales for a sugar confectionery product such as NAVY mints. She states that no sales of NAVY mints were recorded by Nielsen for the years 1990 and 1996.

147) Ms Cox states that when going through the "CTN" price guides looking for references to NAVY mints her eye was caught by a listing for LIFE SAVERS which appeared in several issues between 1980 and 1981. She exhibits at FAC13 copies of the relevant two pages. She states that the sole product listed is Bubble Yum bubble gum. She states that a packet of Bubble Yum recently purchased in the United States is exhibited at FAC14. Ms Cox states that from this exhibit it may be seen that the product consists of a number of rectangular tablets of gum. The packet indicates that the goods emanate from Nabisco, Inc but there is no reference on the packet to Lifesavers. Ms Cox exhibits at FAC 14 an article from "Super Marketing" magazine dated 13 January 1978. She states that from this article it appears that the product available in the United Kingdom in the late 1970s and 1980s had that same configuration as that now sold in the United States. The article exhibited at FAC 14 refers to Bubble Yum being a product of Life Savers Inc.

Statutory declaration of Sarah Dixon dated 22 January 1998 (DEC121)

148) Ms Dixon states that she has read the affidavit of Steven Hartman and the declaration of Adrian Spencer in these proceedings. Ms Dixon states that in paragraphs 6, 48 and 51 of his affidavit Mr Hartman refers to sales of NAVY mints having commenced at least as early as 1937. She states that the sole evidence for this assertion is the photograph which is exhibited at AYS6 to the declaration of Mr Spencer. Ms Dixon states that she has made or instructed others to make investigations into the history of NAVY mints.

149) Ms Dixon states that she interviewed three ex-employees of Rowntree and Company Limited: Raymond Clifford – formerly the marketing manager, Albert Norton – formerly the production director and William Porteous – formerly the director of advertising. Ms Dixon states that for reasons of age the aforesaid three men did not wish to give evidence themselves; they are all over eighty years of age. She states that Mr Clifford and Mr Norton were working for Rowntree and Company Limited in 1937. Mr Norton stated to her that he would have remembered extensive sales of NAVY mints as he was working on a prototype of POLO at the time.

150) Ms Dixon states that Mr Porteous had a clear recollection of the period leading up to the launch of POLO in 1948. She states that Porteous told her that Rowntree had relied heavily

upon the input of its advertising agency, J Walter Thompson Company Limited (JWT), in the matter of selection of brand names. She states that Mr Porteous recalled that the name POLO had been chosen by Rowntree and JWT because of the possibilities it offered having regard to the shape of the product upon which it was to be used. Mr Porteous clearly remembered what he believed to be the launch of NAVY mints in 1954. He told Ms Dixon that he and his colleagues were concerned that NAVY mints were being passed off as and for POLO mints and that he had mentioned this concern to JWT.

151) Ms Dixon states that Mr Hartman states in his affidavit that NAVY mints, LIFE SAVERS and POLO mints “co-existed in the market place over the period 1948-1956 and beyond”. She states that the results of her researches do not accord with this statement. She states that as detailed in the declarations of Helen Smith and Felicity Cox ACNielsen have no record of sales of NAVY mints until 1954 and no record of sales of NAVY mints after 1956 until 1991. Ms Dixon states that the only evidence of sale of LIFE SAVERS confectionery in the United Kingdom after the Second World War is as set out in the declaration of Mr Jordan which, with its exhibits, forms pages 19 to 23 of bundle SH2 exhibited to the affidavit of Mr Hartman. Ms Dixon states that according to Mr Jordan in no year after the Second World War did sales of LIFE SAVERS confectionery in the United Kingdom exceed 32, 000 packets with the highest figure of 31, 500 being recorded in 1956 after no sales in 1955. She states that to put this into context she has been advised that in the same year Rowntree sold over 92 million packets of POLO confectionery.

152) Ms Dixon states that in paragraph 7 of Mr Hartman’s affidavit he claims that “In 1948...the annular shape had already been associated with Lifesavers for more than thirty years” and in paragraph 8 he refers to “Nabisco’s claim to be entitled to the registration of the LIFE SAVERS product/configuration trade mark”. Ms Dixon states that it is self-evident that Nestlé do not agree with Mr Hartman in these respects. Ms Dixon states that Nestlé regularly receive enquiries from third parties or their advertising agencies wishing to run advertising campaigns for unrelated products that in some way play on the shape of POLO confectionery. She exhibits at SD1 copies of two such approaches. She states that typically Nestlé receive one or two approaches each year and that they do indicate to her that those who make such approaches associate the annular shape exclusively with POLO.

Statutory declaration of Helen Smith dated 26 January 1998 in relation to opposition Nos. 42897, 43718 and 45334 (DEC122)

153) Ms Smith is an account director of ACNielsen Limited. Ms Smith states that Nielsen was founded in the United States in 1923 and opened its first office in the United Kingdom in 1939. From that time Nielsen has provided the retail measurement service that has remained the cornerstone of its business. She states that periodically sales of specific items in a range of shops are audited. The shops are selected to be representative of the outlets through which items are typically sold. She states that over the years, particularly since the introduction of electronic scanning, the collection of data and the uses to which the data may be put have become more sophisticated. Ms Smith states that today Nielsen collects data from supermarkets, hypermarkets, petrol stations, convenience stores, pharmacies, supercentres, independent food stores, mass merchandisers and warehouse clubs. She exhibits at HS1 a copy of the brochure “Your Competitive Advantage”.

154) Ms Smith states that Nielsen’s earliest records go back to 1945. She states that she visited Nielsen’s archives in Oxford to look for references to NAVY mints and Swizzels

Matlow Limited with particular reference to the period between 1950 and 1975. Ms Smith states that a large part of the work of Nielsen is the preparation of individual reports tailored to the specific interests of a client. Ms Smith explains the methodology that Nielsen follow in collecting data.

155) Ms Smith states that she decided that a suitable place to start her searches for references to NAVY mints was amongst reports of the confectionery sector produced by Nielsen for various clients, including Rowntree & Company Limited. She states that from 1945 to 1954 she found no references to this product. The first reference that she found was in a report dated May 1954 prepared for Rowntree & Company Limited. It covered the period mid-March to mid-May 1954. The items audited were POLO mints, Trebor peppermints and NAVY mints. She states that it is likely that the list of products was specified by Rowntree.

156) Ms Smith states that the average weekly sales of the products audited were 51.5 tons of which figure POLO mints accounted for 66.6%, Trebor peppermints 29.9% and NAVY mints 3.5%. During the period covered POLO mints were distributed to 87% of stores in the sample whilst NAVY mints were distributed to 19%. Ms Smith does not exhibit the report.

157) Ms Smith states that the above was the first of a series of reports submitted to Rowntree at two monthly intervals and the next report was dated July 1954. She states that at that stage POLO still held a two thirds market share, the market share of Trebor Peppermints had increased to 30% and that of NAVY mints had declined to 3.3%. The stock outlets for NAVY mints had increased to 25%. Ms Smith states that the commentary to the report for September 1954 states that the market share for POLO had risen to 68.2% and that “most of this gain was effected at the expense of NAVY mints whose volume was well down”. She states that there was no mention of NAVY mints in the commentary to the report dated November 1954 and by January 1955 the commentary stated that “The share of POLO peppermint continued at the same level as in our previous report. Trebor peppermints made a further slight gain in share to 33.4% at the expense of NAVY mints, the latter brand selling at less than 1 ton per week during the period reviewed”. Ms Smith states that the March 1955 report did not mention NAVY mints in the commentary and in May 1955 the commentary states that “NAVY mints, in common with other NAVY lines we have covered, have suffered a marked fall in distribution.” Ms Smith states that in July 1955 the commentary recorded that “NAVY mints share fell to less than half that recorded a year ago”. She states that at this stage the average weekly sales of NAVY mints during the two months in question was 0.5 tons compared to 29.8 tons for POLO mints.

158) Ms Smith states that from September 1955 onwards the bimonthly reports contained no data for NAVY mints although a space to enter such data persisted until May 1956 when it was replaced by Murray mints. Ms Smith states that the failure to include data after July 1955 could have been due either to NAVY mints having disappeared altogether or at the request of Rowntree because they no longer saw NAVY mints as a significant competitor to POLO.

159) Ms Smith goes on to state that she also consulted reports prepared for another client. She does not consider it appropriate to identify the other client. She states that the reports for the period March to July 1955 included data relating to the sale not only on NAVY mints but also NAVY fruit and scotch sweets. Ms Smith states that the period covered by the reports falls within that covered by the Rowntree reports and that she did not find any mention of NAVY sweets of any description either before March 1955 or after May 1956. Ms Smith states that Nielsen has submitted reports to Rowntree and their successors continuously since

1956, at first every two months, then every month and currently every four weeks. She states that she has not looked at every report but concentrated on those from the 1950s and 1960s. She states that she did look at the 1959 and 1960 reports and at the reports made during the latter half of 1964, there was no mention of NAVY mints in any of them.

160) Ms Smith ends by stating that she asked ACNielsen MEAL to check their computerised database of annual advertising expenditure in the fmcg sector (no explanation of this term is given) to see whether there was an entry for NAVY mints. She states that this database records advertising expenditure by brand and year from 1986 to date. Ms Smith states that only one entry was found, in 1991. This recorded an advertising expenditure of £1,700.

161) None of the reports to which Ms Smith refers in her declaration are exhibited.

Statutory declaration of Martin James dated 15 January 1998 (DEC123)

162) Mr James is the managing director of Millward Brown Market Research Limited, a position he has held since taking over from Rosi Ware.

163) Mr James states that he has read the declarations of Rosi Ware and Susan Belle Quinn in these proceedings. He states that Ms Quinn draws a particular conclusion from the results of research as evidenced in Ms Ware's declaration. This conclusion is based upon the answers to question 4 in the survey. Mr James states that in question 4 respondents were given the following list of confectionery products and asked which they had heard of, or eaten or eaten regularly:

- POLO
- Fruit POLO
- Trebor Mints
- Trebor Extra Strong Mints
- XXX Extra Strong Mints
- Trebor Softmints
- NAVY Mints
- Lifesavers

164) Mr James states that in her declaration Ms Ware states that the answers to question 4 demonstrated that 14% of respondents had heard of LIFE SAVERS and 6% had tried them. In her declaration, Ms Quinn comments that she is aware of other niche brands which have been on the market for a reasonable amount of time but which are used only by a certain section of the population which have a similar level of prompted awareness and trial. She states that 14-15% prompted awareness could be viewed as a desirable level for a niche brand market.

165) Mr James states that he does not differ from Ms Quinn's conclusions. However, it is his understanding that the current proceedings relate principally to the shape of the respective products, not to the brand names under which they are sold. The responses to question 4 do indeed demonstrate that the prompted awareness of the name LIFE SAVERS was 14% at the time the survey was carried out. Mr James states that this did not necessarily mean that the respondents knew anything else about LIFE SAVERS, simply that they had heard of the name. He states that in his view there is no justification for assuming that because the respondents recognised the name that they had any knowledge of the shape of the confectionery sold under that name.

166) Mr James states the results of the survey suggest that the awareness of the shape of LIFE SAVERS was very much lower, to the point where it cannot be regarded as statistically significant. Mr James refers to question 2(b) of the survey in which, after being shown the unbranded POLO mints and asked to identify them, the respondents were asked if they were aware of any other sweet with the same shape. Mr James states that only 6 of the 482 respondents – 1% - mentioned LIFE SAVERS in response to this question. Mr James states that it is interesting to note that this figure is appreciably lower than the 6% who stated that they had tried LIFE SAVERS.

Declaration of Trevor Copley dated 23 January 1998 (DEC124)

167) Mr Copley joined Rowntree & Company Limited as company solicitor in 1967. In 1973 he was appointed to the board of Rowntree Mackintosh Limited and in 1979 was appointed chairman of the overseas division, which position he held until retirement in 1989.

168) Mr Copley refers to paragraphs 35 to 39 of the declaration of Mr Hartman (DEC16). He states that in 1967 Beech Nut International was a subsidiary of Squibb Corporation, the company which at that time owned the LIFE SAVERS trade mark and business.

169) Mr Copley states that in 1971 Rowntree Mackintosh Limited wished to increase the manufacturing capacity for POLO mints. The economic merits favoured the establishment of manufacturing capacity in Paris. However, Rowntree were aware that Beech Nut had registered the shape of their LIFE SAVERS confectionery in France and they were advised that the manufacture of POLO mints in France might infringe that registration. He exhibits at TC1 a representation of the trade mark which was the subject of the registration. Mr Copley states that at the time Rowntree sold BEECH NUT chewing gum under licence from Beech Nut International. He states that it so happened that at that time Beech Nut were keen to enter the stick chewing gum market in the United Kingdom and Europe. To do this they needed to come to an arrangement with Rowntree concerning the latter's licence to manufacture and sell tablet chewing gum under the trade mark BEECH NUT.

170) Consequently on 22 March 1972 a meeting between the parties took place to discuss the above issues. Mr Copley exhibits at TC2 a copy of a note he made of the discussions. Mr Copley states that he does not have a perfect recollection of everything that was said at the meeting but that he had the impression that Beech Nut was not interested in what was going on in Europe other than where it had a specific objective in mind, as with the chewing gum. He states that as far as he can recall the proposal to manufacture POLO in France gave Beech Nut little cause for concern. Mr Copley states that he was left with the impression that Beech Nut accepted that the POLO business was so well established in the United Kingdom that it was not worth bothering with the United Kingdom as a market for LIFE SAVERS. He states that he could not go so far as to state that Beech Nut had abandoned the United Kingdom as a potential market for LIFE SAVERS. He states that he had the impression that Mr Hoenicke, of Beech Nut, considered that in Europe Rowntree and Beech Nut had monopolised the shape of POLO/LIFE SAVERS and that he accepted POLO because it was a well established product but that he would not have been happy to see any third party produce a product of that shape.

171) Mr Copley states that in March 1972 Mr Dixon, of Rowntree, wrote to confirm the arrangements under which POLO would be manufactured in France and he exhibits at TC3 a

copy of the letter together with the response of Mr Hoenicke. These arrangements were later formalised by written agreements, copies of which are exhibited at TC4. These agreements encompass France, the Benelux and Italy. The agreements all ran to 1 January 2000.

172) Mr Copley states that he has never been aware of LIFE SAVERS products in the United Kingdom. He also states that he has never heard of NAVY mints.

Declaration of Bonita Fleur Backhouse dated 30 September 1997 (DEC125)

173) Ms Backhouse is a trainee solicitor. She states that on 23 and 24 September 1997 she conducted enquiries into the audited circulation figures for a number of publications. She exhibits at BFB1 audited circulation figures for these publications which were provided in respect of the period January to June 1997. The publications are those in which the applicant advertised for people who knew of LIFE SAVERS (DEC17 paragraph 12):

| | |
|-----------------------------------------------|-----------------------------------------|
| “The Evening Standard” | 430, 967 per day |
| “Evening Chronicle” | 113, 841 per day |
| “Manchester Evening News” | 181, 313 per day |
| “Yorkshire Post” | 78, 282 per day |
| “South Wales Echo” | 78, 434 per day (87, 702 Saturday) |
| “Nottingham Evening Post” | 96, 641 per day |
| “Thurrock Recorder” | |
| “Romford, Hornchurch and Upminster Recorder” | |
| “Brentwood, Billericay and Havering Recorder” | |
| “Harold Recorder” | 23, 611 per week (all audited together) |
| “Barking and Dagenham Recorder” | |
| “Ilford Recorder” | 22, 800 per week (all audited together) |
| “Docklands Recorder” | |
| “Newham and Docklands Recorder” | 23, 650 per week (all audited together) |
| “Express & Star” | 197, 030 per day |
| “Liverpool Daily Post” | 72, 917 per day |
| “Western Morning News” | 51, 559 per day |
| “Eastern Daily Press” | 81, 025 per day |

Statutory declaration of Sarah Dixon dated 6 April 1998 (DEC126)

174) Ms Dixon has already been referred to in relation to other declarations.

175) Ms Dixon adopts into the proceedings the declaration of Mr Opie.

Statutory Declaration of Robert Opie dated 2 March 1998 (DEC127)

176) Mr Opie is Director of the Museum of Advertising and Packaging in Gloucester which opened in 1984. Mr Opie has a collection of examples of packaging, advertising and promotional materials amounting to over 300,000 items, including the displays at the museum. His collection covers the 19th and 20th centuries. Mr Opie previously worked in the field of market research. He has created special displays for the Victoria and Albert Museum and has often given lectures and media interviews on the history of packaging. He is the author of a number of books on the packaging and advertising of consumer goods including "Sweet Memories" which provides an overview of the development of the market for chocolate and confectionery in the United Kingdom.

177) Mr Opie states that he was contacted by Caroline Crowe of Nestlé. She told him that Nestlé's attention had been drawn to two other confectionery products of similar configuration to POLO called LIFE SAVERS and NAVY Mints. Nestlé had been given to understand that these products had been on sale in the United Kingdom more or less continuously since before the Second World War in the case of LIFE SAVERS and since the mid-1950s in the case of NAVY Mints. According to Ms Crowe this did not entirely accord with Nestlé's perception of these products and Nestlé, therefore, wished to investigate the history of LIFE SAVERS and NAVY Mints from the launch of Polo in 1948 to about 1970, as this was a period in respect of which Nestlé had not been able to find much market information.

178) Mr Opie states that he informed Ms Crowe that he had heard of the LIFE SAVERS brand and indeed had made reference to it in the book "Sweet Memories". He was not, however, familiar with NAVY Mints. He was commissioned to examine his collection of packaging material to examine it for any material relating to either NAVY Mints or LIFE SAVERS.

179) Mr Opie states that he looked through his collection. This includes not only examples of packaging but also point of sale material, vending machines and many advertisements. In respect of LIFE SAVERS the only post-war items he found were a vending machine which he believes dates from the 1950s and five labels which he believes are from the same period. He exhibits at RO1 a photograph of the vending machine. The vending machine is decorated with pictures of tubes of LIFE SAVERS and representations of the sweets, which are in the shape of rings with the name LIFE SAVER on the top surface of the sweet. Mr Opie states that he is familiar with LIFE SAVERS as an American brand and is aware that the LIFE SAVERS confectionery was sold in the United Kingdom in the 1930s. He states that he only has one exhibit in his collection dating from this period.

180) Mr Opie states that the only material in his collection relating to NAVY Mints is two advertisements which appeared in "The Eagle" comic and "Everybody's" magazine in 1954 and two advertisements which appeared in "Picture Post" in 1954 and 1955. He exhibits copies of these advertisements at RO2. These advertisements show NAVY Mints NAVY Butterscotch and NAVY Fruits. They show the packets and the goods which are in a similar

form to the application in suit, except that only the mints are white and the words NAVY Mints, NAVY Fruits and NAVY Scotch appear upon them. Three of the advertisements refer to the “sweet with the hole” and the other advertises that “it’s the hole that makes NAVY SWEETS so much tastier”. Mr Opie found further advertisements for NAVY confectionery in issues of “Everybody’s” and “Picture Post” dating from 1955. These advertisements are for NAVY Fruits, NAVY Lemon Drops, NAVY Orange Drops, NAVY Acid Drops and NAVY Brazils. The NAVY Brazils advertisement states “another NAVY favourite to go with NAVY MINTS, NAVY FRUITS, NAVY SCOTCH. The sweets are in the same form as referred to above and the advertising strap line “the sweet with the hole” again appears on both advertisements. Mr Opie states that he also found a label for a product called NAVY Brazils which is exhibited at RO4.

181) Mr Opie states that he has a selection of women’s and other magazines dating from the period 1948 to 1970 which he looked through and the only relevant advertisements that he came across are the ones referred to above.

Opponents’ additional evidence

Declaration of Sarah Dixon dated 9 December 1999 (DEC128)

182) Ms Dixon adopts into the proceedings the declarations of Janine Everett and Gary Swift.

Declaration of Janine Everett dated 18 August 1999 (DEC129)

183) Ms Everett states that she is employed by First Choice Cards to commission artwork for greetings cards. She states that she contacted Nestlé in May 1999 to request their permission to use a design for a greetings card. This shows a stone age man standing by a wheel with the caption “The First Polo”. She exhibits at JE1 a copy of this design, which is the work of Gary Swift (see DEC130).

184) Ms Everett was asked by a member of Nestlé’s legal department why she had decided to accept the design for a greetings card. Ms Everett told her that as soon as she saw that illustration she thought that it would make an excellent greetings card, as the gag was “right there” and no other explanation of the drawing was necessary. The drawing looks like a huge stone POLO sweet and the card does not actually have to say “The First POLO” for it to be obvious what it is. Ms Everett states that this illustration would appeal to both genders and all ages. She states that the POLO card will be displayed in the humorous card section of shops and will appeal to all consumers who will recognise the illustration as being the mint with the hole, POLO.

Declaration of Gary Swift dated 18 August 1999 (DEC130)

185) Mr Swift is a freelance graphic designer. He exhibits at GS1 his design for a card that he submitted to First Choice Cards – the design which is referred to by Ms Everett in DEC129. He too was contacted by a member of Nestlé’s legal department and was asked to describe how and why he had decided to draw the illustration.

186) Mr Swift states that he was looking for a humorous concept surrounding the invention of the wheel. The illustration of a neolithic man with the first wheel is well known but not humorous. He states that he started with a cliché, and then to make it different and instantly recognisable to the general public, he added the caption “The First POLO”. He states that in his opinion the brand image of POLO mints is very strong, as being the mint with the hole. He states that the humour in the illustration relies upon the general public recognising POLO as being the mint with the hole, which he believes they do.

Applicants' additional evidence

Declarations of Jacqueline Helen Simpson dated 30 June 1999 (DEC131 and 132)

187) Both declarations are the same, being for each of the oppositions that are now consolidated.

188) Ms Simpson is a registered trade mark attorney. She exhibits at JHS2 a copy of a declaration by Trevor Jack Leslie William Matlow.

Declaration of Trevor Jack Leslie William Matlow dated 8 December 1998 (DEC133)

189) Mr Matlow is the joint managing director of Swizzels Matlow Ltd (SM).

190) Mr Matlow makes the declaration in support of the applications in suit and further to his conversations with Mr Spencer – see DEC 119. He exhibits at TJLWM1 a copy of Mr Spencer's declaration.

191) Mr Matlow states that Swizzels Ltd (Swizzels) and Matlow Bros Ltd (Matlow) were two separate companies until their amalgamation in 1975. Mr Matlow states that he has worked in the SM business since 1952 and during this time has dealt mostly with the production of confectionery and has attended many exhibitions and meetings of the confectionery industry. Mr Matlow goes on to give a brief history of the company. He states that Navy Sweets Limited is an associated company of which he is a director and that it is the proprietor of United Kingdom trade mark registration no 731732 – see DEC 119. He exhibits at TJLWM3 a page from SM's web site. He states that he exhibits at TJLWM4 a sample of NAVY mints but this has not been adduced into the proceedings.

192) Mr Matlow states that LIFE SAVERS were featured in films during the Second World War and that US soldiers based in the United Kingdom during the Second World War had LIFE SAVERS. He states that he remembers that there was a large range of flavours and in particular a rhubarb version of LIFE SAVERS.

193) Mr Matlow states that NAVY MINTS annular sweets were sold by Swizzels from approximately 1937. In 1955 Swizzels started to emboss the words NAVY NAVY on the products. Mr Matlow refers to SM's trade mark application No. 2025205 and the declaration that he made in respect of it. He states that in that declaration (see DEC138) he stated that SM and its predecessors first commenced use of the trade mark in 1955. However, new evidence shows that it first commenced in 1937. Mr Matlow exhibits at TJLWM5 a further copy of the picture that was exhibited at AYS6 in DEC119. He believes that the photograph emanates from 1937 owing to the address that is displayed. This is a London address and SM moved to Derbyshire in 1940. Mr Matlow exhibits at TJLWM6 a copy of packaging for NAVY MINTS and NAVY FRUITS. He states that as the wrapping refers to Swizzels Ltd, London it must emanate before the move to Derbyshire. The packaging does not bear a representation of the goods.

194) Mr Matlow states that the range of NAVY sweets produced by SM from the 1950s onwards was extensive and not just for mints. He states that the entire range consisted of annular sweets in a variety of flavours. He exhibits at TJLWM7 copies of examples of packaging for the range of NAVY sweets. These demonstrate a variety of flavours and the

majority include some representation of an annular sweet. Mr Matlow goes on to state that SM sold the following products:

NAVY ACID DROP, NAVY ALMONDS, NAVY BARLEY, NAVY BARLEY SUGAR, NAVY BRAZILS, NAVY BRAZIL NUT CRUNCH, NAVY BULLSEYES, NAVY BUTTER MINTS, NAVY BUTTERSCOTCH, NAVY BUTTERED BRAZIL CRUNCH, NAVY CRYSTAL MINTS, NAVY FRUITS, NAVY LEMON DROPS, NAVY MINTS, NAVY MINT HUMBUGS, NAVY ORANGE DROPS, NAVY SWEETS, NAVY PEANUTS, NAVY QUENCHERS, NAVY REFRESHERS, NAVY SAMBA, NAVY SCOTCH, NAVY SHERBERT.

195) Mr Matlow exhibits at TJLWM8 examples of packaging for gift boxes of NAVY sweets in the 1950s. Of the examples three include a representation of an annular sweet. Mr Matlow states that SM has not retained any information as to sales figures of NAVY sweets in the 1950s. He is not able to say when there were gaps in production. Mr Matlow states that he does recall that during the 1950s there were thirteen roll wrapping machines for the sweets which were working twenty four hours a day. He estimates that SM were producing 100 tonnes per week of NAVY products, which in these days would equate to approximately 2, 500, 000 rolls per week.

196) Mr Matlow exhibits at TJLWM9 copies of price lists from 1982, 1984 and 1991 showing prices for NAVY MINTS, NAVY ROLLS and NAVY REFRESHERS.

197) Mr Matlow states that during the 1950s SM advertised NAVY products nationally. He states that SM did not spend large amounts on advertising. He states that during the 1950s a poster for NAVY products appeared in carriages of underground trains and buses. SM also advertised in "The Radio Times" and "Picture Post". He refers to the declaration of Mr Opie (DEC127) in relation to advertising and exhibits this at TJLWM10. Mr Matlow states that at RO3 of DEC127, at the bottom of one of the advertisements, there is a reference to NAVY MINTS, NAVY FRUITS and NAVY SCOTCH.

198) Mr Matlow exhibits at TJLWM11 a copy of a letter dated 1 October 1958 from the British Technion Committee which refers to an advertisement which was placed in their 1957 brochure. Also exhibited is a copy of the advertisement which is for NAVY mints and shows a representation of an annular sweet and the rubric "the sweet with the hole". The advertisement also refers to other NAVY sweets. Exhibited at TJLWM12 is a copy of a document which shows the number of NAVY labels SM had in stock at 22 June 1971, the numbers run into several millions. Exhibited at TJLWM13 are copies of promotional materials used for NAVY sweets and boxes in which products were displayed. These display prices in both decimal and pre-decimal currency. The annular nature of the sweets can be seen in the material.

199) Mr Matlow states that the figures for the annual retail value of NAVY MINTS from 1990 to 1994 are as follows:

| Year | Value | Quantity (packs) |
|-------------|--------------|-------------------------|
| 1990 | £1, 000, 000 | 10, 000, 000 |
| 1991 | £250, 000 | 2, 500, 000 |
| 1992 | £125, 000 | 1, 250, 000 |
| 1993 | £125, 000 | 1, 250, 000 |
| 1994 | £150, 000 | 1, 500, 000 |

200) Mr Matlow exhibits at TJLWM14 copies of magazine advertisements. He notes from the first exhibit at TJLWM14 that NAVY MINTS are advertised in the magazines but do not appear in the price lists.

201) Mr Matlow states that he first became aware of POLOs in the 1950s. He refers to the declaration of Helen Smith (DEC122) and Sarah Dixon (DEC121), both of which are exhibited – TJLWM15 and 16, to show that Rowntree had known of NAVY MINTS in the 1950s. He also notes that Mr Porteous is stated, in the declaration of Ms Dixon, to have said that he clearly remembered the launch of NAVY mints in 1954. However, Mr Matlow states that NAVY mints were launched prior to 1954.

202) Mr Matlow states that the two products have peacefully co-existed since the 1950s and until now neither Rowntree nor its successors have complained about the NAVY products.

203) Mr Matlow states that during his career in the confectionery industry he has come across annular sweets other than LIFE SAVERS, POLO and NAVY sweets.

204) Mr Matlow states that he has read the declaration of Isabel Milner Davies (DEC98), which he exhibits at TJLWM17. He states that the sweets exhibited at IMD1 are known as Dolly Beads and Dolly Watches. SM have sold 970, 000 boxes, containing approximately 50 units, of these sweets since 1990.

205) Mr Matlow states that he recalls how Halls, now Warner Lambert, sold a fruit sweet with a hole in it and that Mars sold SPANGLES with a hole in the middle of the sweet, albeit with a square sweet with a round hole.

206) Mr Matlow exhibits at TJLWM18 a brochure from 1988 of FRESHIOS showing an annular sweet manufactured and sold by Swizzels. This sweet appears to be a “fizzy” fruit flavoured sweet. He also exhibits details of sales figures taken from computer records. He states that production was approximately 70,000 boxes of 40. He also refers to TJLWM9 and the price list for 1991 which shows FRESHIOS in the price list. Mr Matlow exhibits at TJLWM19 copies of the wrapping for FRESHIOS and the box in which the packets were displayed.

Opposition No. 47139 by Nabisco Inc to application No. 2006992 in the name of Société des produits Nestlé S.A.

Opponents' evidence

Statutory declaration of Alice Margaret Mastrovito dated 10 July 1998 (DEC134)

207) Ms Mastrovito is a registered trade mark agent. Ms Mastrovito adopts into the proceedings all the evidence previously filed in support of trade mark applications Nos. 2000625 and 2000622 (DECS16 – 119 and 133)

Declaration of Trevor Jack Leslie William Matlow (DEC133)

208) This declaration includes at TJLWM4 the packet of NAVY MINTS referred to in the declaration.

Applicants' evidence

Statutory declaration of Sarah Dixon dated 31 March 1999 (DEC135)

209) Ms Dixon is a legal adviser in the legal department of Nestlé UK Ltd. Ms Dixon adopts into the proceedings the declarations of Thomson, Ware, Palmer, Wowra, Cornwall, Granger, Journo, Randle, Hartley, Dilley, Austin and Suckling (DECS1 –12) which were adduced into the proceedings in relation to the opposition to application numbers 2000622 and 2000625.

210) Ms Dixon refers specifically to paragraph 7 of Mr Thompson's declaration which relates to the advertisement of confectionery bearing the trade mark in suit and comments that in the early years most of the advertising for confectionery bearing the trade mark was press advertising and that few examples of these early materials remain. Ms Dixon states that since Mr Thomson made his declaration copies of press advertisements used during the period 1948 – 1952 have come to hand and these are exhibited at SD2 – see DEC143 re these advertisements. Ms Dixon also refers to a more recent advertisement which she exhibits at SD3 – see DEC143 re this advertisement.

211) Ms Dixon also adopts into the proceedings the declarations of Backhouse, Copley, James and Ian Smith which were filed in relation to application numbers 2000622 and 2000625 (DECS125, 124, 123 and 139 respectively).

212) Ms Dixon also adopts into the proceedings the declarations of Cox, Dixon, Opie and Helen Smith (DECS120, 121, 127 and 122 respectively).

213) Ms Dixon states that in August 1998 the applicant with other companies in the Nestlé group took action in the High Court in an attempt to restrain a third party selling ring-shaped sweets. She states that the action, for passing off, failed in the High Court and the Court of Appeal. Ms Dixon states that in giving judgement in the Court of Appeal Aldous LJ made a number of statements to the effect that, on the evidence before the court, he was satisfied that the word POLO was associated with a particular shape of sweet. She exhibits a transcript of the judgement at SD6 and refers specifically to pages 5, 8 and 10 of the judgement.

Statutory declaration of Gary Swift dated 18 August 1999 (DEC130)

Statutory declaration of Janine Everett dated 18 August 1999 (DEC129)

Opposition No. 47138 by Mars UK Limited to application No. 2006992 in the name of Société des produits Nestlé S.A.

Opponents' evidence

Statutory declaration of Fiona Jane Lawlor dated 20 October 1997 (DEC136)

214) Ms Lawlor is the marketing property manager for companies within the Mars group in Europe of which Mars UK Limited is one.

215) Ms Lawlor states that in her rôle as marketing property manager that she has been exposed to the confectionery market in the United Kingdom for a period of five years. During this period 90% of her work has related to confectionery or snack products. She states that, in her opinion, the circular shape sought to be registered under the application in suit is not distinctive in the absence of some other distinguishing feature, such as the embossed word POLO which appears on the sugar confectionery products sold in the shape by the applicant.

216) Ms Lawlor states that on her instructions an investigator was instructed to conduct enquiries and find confectionery products in the shape of the trade mark in suit which are available on the United Kingdom market. She states that the investigator has furnished a declaration in relation to his purchases.

217) Ms Lawlor states that she is aware that applications to register the shape of the application in suit have been filed by Swizzle Matlow Ltd under No. 2025205 and Nabisco under No. 2000622. She states that both applications were accepted by the registrar and published. She exhibits at FJL1 copies of the Journal notices relating to the applications. She states that the opponent is obtaining the official files in relation to these applications. She states that she believes that evidence of use was filed in relation to the application for No. 2025205 and evidence of use was filed in relation to the opposition against No. 2000622. She states that it is clear that the applicant does not have exclusivity in the shape, the subject of the application in suit.

Statutory declaration of Julian Hill dated 20 October 1997 (DEC137)

218) Mr Hill states that he was instructed to identify and purchase confectionery or snack products available on the market in the United Kingdom in the shape of a ring similar to the shape encompassed by the application in suit. He exhibits at JH1 a copy of his reporting letter listing the products found during his first enquiries. The letter lists the following products which were obtained from five shops in London and two shops in the Brighton area:

- New York Bagel Company Blueberry Bagels
- Fox's Party Rings
- Sainsbury's Chocolate Chip All Butter Highland Shortbread Rings
- Four Assorted Fondant Potted Ring Doughnuts
- Lolly Watch
- Lolly Necklace
- Three Packets Of Different Flavoured Hula Hoops
- Onion Rings

Kids Pick And Mix Jelly Rings
 Peach Rings
 Safeway Iced Party Rings
 Safeway Chocolate Party Rings
 Ginni's Jelly Rings

219) Mr Hill exhibits at JH2 examples of the sugar confectionery products which he purchased, namely Ginni's Jelly Rings, Sweet Factory Jelly Rings, Woolworths Jelly Rings and a necklace and bracelet made up of small circular sugar confectionery rings. Mr Hill states that he also noticed for sale in J Sainsbury Haribo, Friendship Rings. He exhibits these at JH3. These goods are not a simple circle or oval but include at the top a square element similar to a jewel setting. Mr Hill states that he purchased from a mail order company in London called America Direct Limited, LIFE SAVERS Sunshine Fruits. He exhibits at JH4 a copy of the bag showing the date of purchase as 7 April 1997. Also exhibited is a tube of these sweets. The sweets are circular in shape with a hole through the centre.

220) Mr Hill concludes by stating that his enquiries were limited to a handful of shops and he had no difficulty in making the purchases for which he had been instructed.

Statutory declaration of Claire Christina Hutchinson dated 18 November 1997 (DEC138)

221) Ms Hutchinson is a trade mark agent. She states that she has been involved with the Mars group of companies in one capacity or another since 1982, except for the period between 1990 and 1994.

222) Ms Hutchinson exhibits at CCH1 a copy of the official file for application No. 2025205 which she states relates to a three-dimensional sweet identical to the trade mark in suit except that it bears the words NAVY NAVY. Ms Hutchinson states that the file includes a statutory declaration filed by Trevor Jack Leslie William Matlow giving evidence of use of the exact shape of the trade mark in suit since 1955, albeit embossed with the words NAVY NAVY.

223) Mr Matlow states in his declaration that Swizzels Matlow Ltd commenced use of its trade mark in 1955 and has continually used it until January 1996 apart from one or two short breaks. He states that the trade mark has been used throughout the United Kingdom. He gives details of the annual retail value of sales and the number of packets sold from 1990 to 1994 as follows:

| YEAR | VALUE | AMOUNT (PACKS) |
|-------------|--------------|-----------------------|
| 1990 | £1, 000, 000 | 10, 000, 000 |
| 1991 | £250, 000 | 2, 500, 000 |
| 1992 | £125, 000 | 1, 250, 000 |
| 1993 | £125, 000 | 1, 250, 000 |
| 1994 | £150, 000 | 1, 500, 000 |

224) Mr Matlow goes on to exhibit examples of labels and counter display material.

225) Mr Matlow states that his company's trade mark has been the subject of considerable advertising and promotion and has featured, for example, in the following publications: Retail Newsagent Tobacconist Confectioner, Progressive Newsagent, Asian Business Magazine,

CTN Magazine, Convenience Store. Mr Matlow states that the brand has featured and been promoted at exhibitions and trade shows, in particular: The ISM Exhibition for confectionery manufacturers held each year in Cologne, Palmer & Harvey, NISA, SUGRO UK, FORECOURT SHOW NEC, Wholesale Confectionery & Tobacco Alliance.

226) Mr Matlow exhibits photographs of displays at various exhibitions and photocopies of specimen advertisements. Included in the exhibits is a photograph of posters which it is indicated emanate from approximately 1955, the posters show prices in pre-decimal currency. Mr Matlow also exhibits extracts from his company's price lists and examples of his company's prices as published in magazines.

227) Mr Matlow states that he cannot give precise figures as to promotion/advertising of his company's trade mark but that the following represents the minimum amounts spent:

| | |
|------|---------|
| 1990 | £80,000 |
| 1991 | £20,000 |
| 1992 | £7,500 |
| 1993 | £7,500 |
| 1994 | £9,000 |

228) Ms Hutchison states that the evidence adduced into the proceedings by the opponent demonstrates that the shape the subject of the application in suit is common to the bona-fide and established practices of the trade and that the trade mark in suit is not capable of distinguishing the goods of one undertaking from those of another.

Applicants' evidence

Statutory declaration of Ian Smith dated 17 March 1998 (DEC139)

229) Mr Smith is an enquiry agent employed by The Duncan Mee and IPI Partnership.

230) Mr Smith's declaration is made in respect of the instant proceedings and opposition Nos. 42897 and 43718.

231) Mr Smith states that he has read the declaration of Steven Hartman in respect of opposition Nos. 42897 and 43718 and the declaration of Julian Hill in respect of opposition No. 47138. He states that he understands from these declarations and their exhibits that, in March 1997 at least, it was possible to purchase LIFE SAVERS confectionery in the United Kingdom from an organisation called America Direct.

232) Mr Smith states that on 9 December 1997 he was instructed by Felicity Cox, a trade marks assistant working for Nestlé UK Ltd, to find out from America Direct how long they had been selling LIFE SAVERS confectionery in the United Kingdom. He states that he made numerous attempts to contact America Direct by telephone on 10 and 11 December but each call was answered by a recorded message. He states that on 12 December the telephone was answered by a man who gave his name as Doug Friedman.

233) Mr Smith states that he explained that he had seen an advertisement for LIFE SAVERS sweets in an old magazine and was interested in buying some. Mr Friedman replied "You must have seen it in the "You" magazine produced by "The Mail on Sunday". He went on to explain that he did still have the Pep-o-mint and Spear-o-mint flavours in stock but that his company America Direct was in receivership. Mr Smith states that he was told that America Direct did not import food products themselves but purchased them from a company called Trustin the Foodfinders. Mr Smith states that Mr Friedman told him that he had been in business for two years dealing in American items such as LIFE SAVERS and Hershey bars but he did not state how long he had been selling LIFE SAVERS in the United Kingdom. Mr Smith states, however, that he notes from paragraph 45 of Mr Hartman's declaration (DEC16) that Nabisco only arranged for Trustin to import LIFE SAVERS into the United Kingdom "in the early summer of 1996".

234) Mr Smith goes on to state that he subsequently spoke to the advertising department of the Daily Mail Group of Newspapers and was told that neither Mr Friedman nor America Direct had placed any advertising in any of their publications since at least as early as January 1994. The entry in the shopping feature in "You" magazine was not placed through normal advertising channels since this feature includes a best buys section in which suppliers are invited to display their goods or services without charge.

Statutory Declaration of Sarah Dixon dated 4 February 1998 (DEC140)

235) Ms Dixon is a legal adviser in the legal department of Nestlé UK Ltd.

236) Ms Dixon in her declaration adopts into the proceedings evidence filed in respect of opposition No. 45334; declarations by Felicity Ann Cox and Helen Smith.

Statutory Declaration of Felicity Ann Cox dated 22 January 1998 in relation to opposition Nos. 42897, 43718 and 45334 adopted into the proceedings for opposition No. 47138 (DEC120)

Statutory declaration of Helen Smith dated 26 January 1998 in relation to opposition Nos. 42897, 43718 and 45334 (DEC122)

Statutory Declaration of Sarah Dixon dated 6 April 1998 (DEC141)

237) This declaration adopts into the proceedings the declaration of Robert Opie.

Statutory Declaration of Robert Opie dated 2 March 1998 (DEC127)

Statutory declaration of Sarah Dixon dated 30 June 1998 (DEC142)

238) Ms Dixon's declaration adopts into the proceedings declarations by David John Thomson, Rosi Ware, Guy Palmer, Peter Wowra, Margaret Hartley, Sylvia Dilley, Brenda Austin, Yvonne Cornwall, Janice Grainger, Denise Journo, Joan Randle and Peter Suckling.

Statutory declaration of David John Thomson dated 15 July 1996 relating to opposition Nos. 42897 and 43718 and application No. 2006992 (DEC1)

Statutory Declaration of Rosi Ware dated 25 July 1996 in respect of opposition Nos. 42897, 43718 and application No. 2006992 (DEC2)

Statutory declaration of Guy Palmer dated 18 July 1996 in respect of opposition Nos. 42897 and 43718 and application No. 2006992 (DEC3)

Statutory declarations of Peter Wowra, Margaret Hartley, Sylvia Dilley, Brenda Austin, Yvonne Cornwall and Janice Granger, dated 29 July 1996, 31 July 1996, 2 August 1996, 24 July 1996 and 24 July 1996 respectively (DECS4 -9)

Statutory declarations of Denise Journo, Joan Randle and Peter Suckling dated 12 July 1996, 15 July 1996 and 18 July 1996 (DECS10 -12)

Statutory Declaration of Sarah Dixon dated 11 March 1998 (DEC 143)

239) Ms Dixon refers to paragraph 7 of the declaration of David John Thomson. She states that in that paragraph Mr Thomson stated that most of the advertising in respect of confectionery bearing the trade mark in suit was press advertising and that few examples of these early materials remain. Ms Dixon states that since Mr Thomson made his declaration copies of a number of press advertisements used between 1948 and 1952 have come to hand and she exhibits at SD1 copies of these advertisements. The advertisements are all for POLO mints and included in the advertisements is a picture of a mint with a hole in it. All the advertisements bar one refer either to a “peppermint made with a hole in it” or “the mint with the hole”, the latter phrase being used in relation to the later advertisements. The sole exception to this is an advertisement from May 1949 which refers to “the peppermint ring made wholly by Rowntrees”.

240) Ms Dixon also exhibits at SD2 an advertisement which she states is for confectionery bearing the trade mark in suit. She states that she believes that the advertisement emanates from the early 1990s. The actual advertisement does not indicate what goods are being advertised, although the advertiser is identified as being Rowntree Mackintosh. The advertisement shows a suitcase in the form of a ring with the rubric “A Hole New Package”.

241) Ms Dixon exhibits at SD3 a letter from the agents for the opponent. Ms Dixon notes that the agent uses the designation “Blank POLO Shape” to refer to the trade mark in suit. Ms Dixon contends that this indicates that the agent for the opponent, at least, identifies the trade mark in suit exclusively with the goods of one manufacturer.

Opposition No. 45334 by Société de Produits Nestlé to application No. 2025205 in the name of Swizzels Matlow Limited

Opponents' evidence

Statutory declaration of Lisa Jane Nathan dated 6 March 1997 (DEC144)

242) Ms Nathan is a trainee solicitor. Ms Nathan states that on 5 February 1997 she conducted consumer interviews in Marylebone High Street, London. She stopped a number of people, eleven of whom were prepared to answer certain questions, the answers to which she recorded in questionnaire form. She exhibits at LJN1 copies of the completed questionnaire forms. Ms Nathan showed the interviewees a clear plastic bag containing nine loose NAVY MINTS, which she exhibits at LJN2. She asked the interviewees what the sweets were and the reason for their answers. If they did not identify the sweets as NAVY MINTS she then asked them to look at the writing upon the sweets. She states that most people, on closer inspection, identified the sweets as NAVY by reading the writing. Nobody said NAVY MINTS. She told them that the sweets were called NAVY MINTS and gave the interviewees an opportunity to make any comment that they wished. Ms Nathan states that of the eleven people she interviewed ten said that they were POLOs or looked like POLOs. One person could not identify the brand. She states that none of the interviewees had heard of NAVY MINTS before. She states that comments given by the interviewees varied: one said they looked like POLOs, another thought that they were stealing the POLO idea, one asked if they were new and another asked if they tasted like POLOs.

243) Ms Nathan states that she then conducted another set of fifteen interviews with the same questions in the Petticoat Lane area on 3 March 1997. She exhibits the completed questionnaires at LJN3. However, in this instance she showed the subjects a small packet of NAVY MINTS, which had apparently been specifically made for the Norton Grange Hotel. She exhibits photographs of the packet at LJN4. The packet does not appear to have any reference to NAVY MINTS, the wording that can be seen on the packet is Norton Grange. The sweets inside the packet can be seen and would appear to be annular mints bearing the wording NAVY NAVY. Ms Nathan states that the packet contained five mints and was open at one end with the wrapper torn as if the packet had been opened for consumption. The very top sweet had been removed and she held the packet at the bottom between her finger and thumb with a mint embossed with the word NAVY clearly facing the subject.

244) Ms Nathan states that of the fifteen people questioned all of them responded that they thought that the sweets were POLOs or looked like POLOs. None of the interviewees identified the sweets as NAVY MINTS even after examining the writing and seven people could not make out the writing on the sweets even when given to them for closer inspection. She states that none of the subjects had ever heard of NAVY MINTS.

Statutory declaration of Janet Lucy Gibson dated 6 March 1997 (DEC145)

245) Ms Gibson is a trainee solicitor. On 5 February 1997 Ms Gibson conducted a survey in Marylebone High Street, London, on the same basis as the first survey of Ms Nathan – DEC144. She exhibits the completed questionnaires at JLG1 and the NAVY MINTS at JLG2.

246) Ms Gibson states that of the nineteen people she interviewed sixteen said that the sweets were POLO mints or looked like POLO mints. Of the three other interviewees, one immediately said that the sweets were POLO mints but quickly corrected his response upon looking more closely at the sweets. Another, a representative for Trebor, looked at the logo before answering and correctly identified the mints as NAVY MINTS. The third, a professor from the USA, at first said he thought that the sweets were LIFE SAVERS. However, he said that because he was in the United Kingdom that he would normally have expected that the sweets were POLO mints.

247) Ms Gibson states that on discovering that the sweets were NAVY MINTS and being asked whether they had heard of them before only two interviewees thought that they had heard of them, neither was certain. One of these was the professor from the USA and the other was a foreign student.

248) Ms Gibson states that of the six people who made any comment at the end of the interview, five made a remark as to the similarity between the sweets shown to them and POLO mints.

Statutory declaration of W Jones dated 11 March 1997 (DEC146)

249) Mr Jones is a dispatch rider. He is one of the persons interviewed by Ms Nathan – see DEC144 – and his questionnaire is exhibited at LJN3 of that declaration.

250) Mr Jones states that he was stopped near Paul Street on 3 March 1997 to take part in an interview. He was shown a small packet of sweets and asked to identify them. He immediately said that they were POLOs. He was then asked to read the writing on the sweets and read the word NAVY. He was informed that the sweets were called NAVY MINTS. He had never seen or heard of NAVY MINTS before.

Statutory declaration of Stanley Silver dated 5 March 1997 (DEC147)

251) Mr Silver is a credit control consultant. He is one of the persons interviewed by Ms Nathan – see DEC144 – and his questionnaire is exhibited at LJN3 of that declaration.

252) Mr Silver states that he was stopped in Middlesex Street, London on 3 March 1997 to take part in an interview. He was shown a small packet of sweets and asked to identify them. He immediately said that they looked like POLOs. He was then asked to read the writing on the sweets and read the word NAVY. He was informed that the sweets were called NAVY MINTS. He had never seen or heard of NAVY MINTS before. He states that they look like POLOs because they are the same shape.

Statutory declaration of Paul Miriam Nelson dated 11 March 1997 (DEC148)

253) Ms Nelson is the company secretary of Nestlé UK Ltd. Ms Nelson adopts into the proceedings declarations adduced into the opposition proceedings in relation to application numbers 2000622 and 2000625, namely those of Thomson (except paragraph 8), Ware, Palmer, Hartley, Dilley, Wowra, Granger, Cornwell, Nimmo and Austin (DECS1 – 9 and 13).

Applicants' evidence

Statutory declaration of Trevor Jack Leslie William Matlow dated 21 August 1997 (DEC149)

254) This declaration adopts into the proceedings the evidence he furnished in relation to the application at ex parte stage – this evidence is summarised as part of DEC138, where it is exhibited at CCH1.

Opponents' evidence in reply

Statutory declaration of Sarah Dixon dated 4 February 1998 (DEC150)

255) Ms Dixon is a legal adviser in the legal department of Nestlé UK Ltd. Ms Dixon adopts into the proceedings declarations adduced into the opposition proceedings in relation to application Nos. 2000622 and 2000625, namely those of Cox, Dixon and Smith (DECS120 - 122 respectively)

Statutory declaration of Robert Opie of 2 March 1998 (DEC127)