QORTI CIVILI PRIM' AWLA

S.T.O. PRIM IMHALLEF
MARK CHETCUTI

Illum l-Erbgha, 17 ta' Gunju, 2020

Numru 8

Rikors Guramentat Nru. 253/2019

Av Antonio Ghio bhala mandatarju specjali
tas-socjeta estera International Tobacco plc

vs

P.L. Madeleine Firman
kuratur deputat sabiex tirraprezenta
lis-socjeta estera BR International Holdings Inc.
nominata b'digriet tat-2 ta' April 2019

Il-Qorti,

Rat ir-rikors guramentat tas-socjeta attrici tat-8 ta' Marzu, 2019 li jghid hekk:

1. Illi l-Avukat Dr Antonio Ghio jinsab debitament awtorizzat sabiex jirraprezenta lis-socjeta International Tobacco plc, socjeta estera b'indirizz ta' 102 Langdale House, 11 Marshalsea Road, London, England, SE1 1EN, fir-Renju Unit permezz ta' prokura ddatata it-2 ta' Jannar 2019, kopja ta' liema hija hawn annessa u mmarkata bhala "DOK. A";

2. Illi s-socjeta intimata ghandha registrata favur taghha mal-Kontrollur tal-Proprjeta Industrijali trademark bl-isem 'Business Royals Premium' u liema registrazzjoni ghandha n-numru TM52531, u liema trademark giet registrata fid-19 ta' Frar 2014, kif jirrizulta mid-dokument hawn anness u mmarkat bhala "DOK. B";

3. Illi jirrizulta li s-socjeta konvenuta BR International Holdings Inc., fil-perjodu ta' hames snin wara d-data tar-registrazzjoni, lanqas uzat u lanqas tat il-kunsens taghha

ghall-uzu tat-trademark numru TM52531 - "BUSINESS ROYALS PREMIUM" ghar-rigward tal-oggetti li dwarha tinsab registrata, u oltre dan illi ma hemmx ragunijiet xierqa ghalhiex mhux qed issir tali uzu u dan effetivament bi ksur tal-Artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta;

4. Illi ghalhekk ai termini tad-disposizzjonijiet tal-artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta it-trademark numru TM52531 - "BUSINESS ROYALS PREMIUM" ghandha tigi revokata u dan stante illi l-intimata naqset milli taghmel uzu mill-istess trademark;

5. Illi effetivament dan it-trademark kien gie registrar b'mod abbusiv u illegali ab initio stante illi l-intimata qatt ma kellha l-intenzjoni li taghmel uzu minnu gia la darba il-prodotti minnha suppliti ma humiex konformi mal-ligijiet vigenti kif ukoll mal- Tobocco Products Directive (2014/40/EU) u ghalhekk mhux talli qatt ma inbieghhu jew gew prodotti jew tqeghdu fuq is-suq gewwa Malta, talli kien ikun illegali kieku dan sar;

6. Illi s-socjeta intimata registrat dan it-trademark in kwistjoni minkejja li allacjat ma prodott illecitu u ghalhekk illegali, u ghaldaqstant dan it-trademark ghandu jigi revokat ghaliex qatt ma intuza;

7. Illi s-socjeta attrici ghandha interess li tistitwixxi dawn il-proceduri stante li r-registrazzjoni f'isem is-socjeta intimata tat-trademark numru TM52531 - "BUSINESS ROYALS PREMIUM" fuq ir-Registru tat-Trademarks ta' Malta, qeda tikkostitwixxi impediment milli s-socjeta attrici tottjeni r-registrazzjoni f'isimha tat-trademark ghall-isem figurattiv "BUSINESS ROYALS" kif jirrizulta mill-applikazzjoni ghar-registrazzjoni ta' l-istess trademark bin-numru TM58934 li estratt taghha qeghda tigi hawn annessa u mmarkata "DOK. C".

Ghaldaqstant l-esponenti qieghed jitlob lill-din l-Onorabbli Qorti sabiex prevja kwalsijasi dikjarazzjoni li jidhrilha xierqa u opportuna taqta u tiddeciedi l-kawza billi;

(1) Tiddikjara illi s-socjeta BR International Holdings Inc. naqset milli taghmel uzu tat-trademark bin-numru ta' registrazzjoni TM52351 ghal oltre minn hames snin mid-data ta' registrazzjoni u sahansittra qatt ma ghamlet uzu mill-istess trademark.

(2) Konsegwentament tirrevoka r-registrazzjoni tat-trademark numru TM52531 - "BUSINESS ROYALS PREMIUM" u dana ai termini tal-artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta u/jew kull ligi ohra li din l-Onorabbli Qorti jidhrilha xierqa u opportuna.

(3) Tordna illi t-trademark numru TM52531 - "BUSINESS ROYALS PREMIUM" tigi mnehhija mir-registru ta' trademarks ta' Malta.

Bl-ispejjez kontra s-socjeta konvenuta, li minn issa ngunta ghas-subizzjoni,

Rat ir-risposta guramentata tal-kuratur deputat li tghid hekk:

1.Illi t-talbiet u l-asserzjonijiet tas-socjeta attrici huma nfondati fil-fatt u fid-dritt.

2. Illi s-socjeta konvenuta hija parti minn grupp ta' socjetajiet ta' produtturi ta' prodotti tat-tabakk rinomati f'diversi partijiet tad-dinja, mhux biss fl-Ewropa.

3. Illi is-socjeta konvenuta, u s-socjetajiet l-ohra li jiffurmaw parti mill-istess grupp ta' kumpanniji, ghandhom markji li jipprotegu l-brand rinomat ta' Business Royals, registrati ma' diversi pajjizi u kontinenti fid-dinja, inkluz f'Malta.

4. Illi l-attentat tas-socjeta attrici, anke f'din il-kawza, huwa wiehed abbuziv u jinbet biss mill-intenzjoni tas-socjeta attrici li tohloq konfuzjoni fis-suq biex hi tkun tista' tikkompeti b'mod zleali mas-socjeta konvenuta u tnaqqar u tibbenefika illegalment mill-avvjament tal-istess socjeta konvenuta.

5. Illi sahansitra, issa, is-socjeta attrici anke applikat hi stess biex f'Malta tirregistra f'isimha l-istess markju mertu tal-kawza odjerna, jew markji simili hafna.

6. Illi din il-kawza hija ritaljazzjoni tas-socjeta attrici ghall-kawza fl-ismijiet inversi (Rik. Gur. Nu. 1187/2018MCH) fejn is-socjeta konvenuta qed titlob lil din l-istess Qorti tordna d-distruzzjoni ta' prodotti falsifikati u/jew kontrafatti tas-socjeta attrici li jledu d-drittijiet tas-socjeta konvenuta.

7. Illi, ghall-kuntrarju ta' dak li ssostni s-socjeta attrici, mhuwiex minnu li ma sarx uzu tal-markju mertu tal-kawza.

8. Illi, bla hsara ghas-suespost, minkejja li sar użu tal-markju mertu tal-kawża odjerna, jekk dan l-użu seta' gie ftit jew wisq limitat f'xi żminijiet, ir-ragunijiet ta' dan jikkwalifikaw bhala ragunijiet xierqa ai termini tal-Artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta.

9. Illi, bla hsara ghas-suespost u ghall-użu tal-markju mertu tal-kawża f'Malta, altru minn registrazzjoni abbużiva, ir-registrazzjoni tal-markju gewwa Malta kienet parti minn skema ta' protezzjoni tal-markji appartenenti lis-socjeta konvenuta u s-socjetajiet l-ohra li jiffurmaw parti mill-istess grupp ta' kumpanniji madwar id-dinja, li permezz taghha gew protetti il-prodotti taghhom li kienu, u qed jigu reklamati u mibjugha, mad-dinja kollha.

10. Illi mhuwiex minnu illi l-prodotti tas-socjeta konvenuta huma illeciti u li r-registrazzjoni tal-markju ghandu ghalhekk jigi revokat.

11. Illi huwa tal-ghageb kif is-socjeta attrici l-anqas tisthi tghid illi hija trid tkompli bl-agir illegali u abbużiv taghha u li johloq kompetizzjoni zleali fil-konfront tas-socjeta konvenuta. Huwa propju b'dan il-ghan illi ghamlet il-kawża odjerna u qed tittenta tirregistra markju identiku jew simili hafna ghall-markju mertu tal-kawża odjerna, gewwa Malta f'isimha. Is-socjeta attrici gja tbiegh prodotti taht l-istess isem ta' dak użat, u li ilu użat u protett, mis-socjeta konvenuta u issa trid b'xi mod jew iehor tissanzjona l-illegalita taghha — haga li ma titwemminx.

12. Illi dawn il-fatti l-esponenti nomine ma tafhomx personalment iżda gew mgharrfa lilha mir-rappreżentanti tas-socjeta intimata.

13. Salv eccezzjonijiet ulterjuri.

Ghaldaqstant it-talbiet tas-socjeta attrici ghandhom jigu michuda bl-ispejjez kontra taghha.

Rat il-verbal a fol. 44 li bih gie maqbul li l-provi f'dina l-kawza, sa fejn huma rilevanti, ghandhom jiffurmaw parti mill-atti tal-kawza numru 1287/2018MCH;

Rat l-atti u n-noti ta' sottomissjonijiet prezentati;

Rat li l-kawza thalliet ghas-sentenza.

Ikkunsidrat

Talba

Illi s-socjeta attrici qed titlob li ai termini tad-disposizzjonijiet tal-artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta, it-trademark numru TM52531 "BUSINESS ROYALS PREMIUM" ghandha tigi revokata u dan stante illi l-intimata naqset milli taghmel uzu mill-istess trademark.

Kontestatazzjoni

L-intimati wiegbu li "BR, and its affiliate company, The Independent Tobacco FZE, have shown a genuine and bona fide intention to make use of the BUSINESS ROYALS trademarks, including in particular TM 52331 in Malta, in connection with the goods and services for which TM 52331 is registered and this within the applicable five year period following the date of completion of the registration procedure, ie. 19th February 2014.

Provi

Ahmed Said Guedi, General Manager of BR International Holdings Inc., testified that BR is the lawful proprietor of BUSINESS ROYALS portfolio of trademarks in the tobacco market which are registered in over 100 countries since 2002, including Malta. The Malta trademark number TM 52531 has been registered since 2014 and is due for renewal in 2023 [Doc. ASG1 page 51]. Witness gave a list of distribution agreements signed with third parties for the marketing and distribution of its BUSINESS ROYALS tobacco products. BR has been present in tobacco related exhibitions in the UK to promote the trademark product. The Independent Tobacco

FZE, the manufacturer of the BUSINESS ROYALS products, is authorized by BR to use the trademark registered under its name and has entered into a non-exclusive Distributorship Agreement, dated 8th March 2018, with Azpet Group Ltd for the distribution of the BUSINESS ROYALS products in Malta [Doc. ASG3 page 86]. BUSINESS ROYALS products have passed health authorities tests in member states of the EU. BR has taken steps to put BUSINESS ROYALS products on the Maltese market and appointed a Maltese distributor for the marketing, distribution and sale of BR products. The last remaining hurdle to the launch of the product is the mandatory testing currently being held. BR is currently expanding it portfolio via the filing of the following national trade mark applications in Malta: TM 53902 filed 01/04/2019 Doc. ASG4A; TM 53904 filed 01/04/2019 Doc. ASG4B; TM 53905 filed 01/04/2019 Doc. ASG4C; TM 59700 filed 10/06/2019 Doc. ASG4D; TM 59701 filed 10/06/2019 Doc. ASG4E and TM 59708 filed 10/06/2019 Doc. ASG4F.

Ammar El-Saadi, on behalf of Azpet Group Ltd, confirmed the agreement concluded with The Independent Tobacco FZE on 8th March 2018 [at page 107] to act as non-exclusive distributors of BUSINESS ROYALS products in Malta. Following this the company entered into a number of negotiations with Maltese retailers including the Franchise, ‘The Convenience Shop’, and retailer Vegimania in San Gwann for the sale and promotion of BUSINESS ROYALS products in Malta. They are at the final stages of concluding these agreements. If things go according to plan, the products will be sold in Malta with the next six months to one year [October 2020].

Marco Abela, direttur ta’ Vegimania, kkonferma illi ppartecipa f’negozjati ma’ The Independent Tobacco FZE sabiex is-sigaretti taghha jibdew jinbieghu mis-supermarket taghhom. Dawn in-negozjati ghadhom ghaddejin.

Sergio Calleja, rapprezentant ta’ International Tobacco PLC, xehed li t-Trademark 52531 qatt ma intuzat Malta u qatt ma ra Malta prodotti b’dik it-trademark fis-suq Malti. Kien recentement, fil-2019, li s-socjeta konvenuta applikat ghal trademarks ohra f’Malta.

Konsiderazzjonijiet

Din l-azzjoni hi wahda bbazata fuq l-artikolu 42(1)(a) tal-Kap. 416 li tghid hekk:

> Ir-registrazzjoni ta' trademark tista' tigi revokata għal xi wahda minn dawn ir-ragunijiet li gejjin –
> (a) li fil-perjodu ta' hames snin wara d-data tat-temm tal-procedura ta' registrazzjoni din ma tkunx tqieghdet f'uzu genwin f'Malta, mill-proprjetarju jew bil-kunsens tieghu, ghar-rigward tal-oggetti jew is-servizzi li dwarhom tkun registrata, u ma jkunx hemm ragunijiet xierqa ghaliex ma tkunx qeghda hekk tintuza.

Din il-kawza hi intiza sabiex l-Qorti tirrevoka r-registrazzjoni tat-trademark BUSINESS ROYALS f'isem is-socjeta intimata minhabba r-raguni ta' non uzu.

Dan l-artikolu jitfa' prova negattiva ta' non uzu ghal tali revoka li stante n-natura taghha din il-prova tissusisti bil-fatt stess tat-talba sakemm ma tigix opposta u sta ghas-socjeta' intimata bhala proprjetarja li tipprova hi li fil-fatt l-uzu sar jew qed isir fit-terminu tal-istess artikolu.

Ghalhekk l-oneru tal-prova hu spostat mis-socjeta attrici ghal dik intimata. Dan hu konfermat mill-artikolu 87 tal-Kap. 416 li jghid hekk:

> Jekk fi procedimenti civili taht dan l-Att tqum xi kwistjoni dwar l-uzu li trademark registrata seta' sar minnha, l-oneru tal-prova li jkun sar xi uzu partikolari minnha jaqa' fuq il-proprjetarju.

Min hu proprjetarju ta' marka jrid jaghraf li dan mhux biss privilegg ghalih, izda wkoll li bhala detentur ta' monopolju fuq dik il-marka ghandu obbligu li jinqeda biha fil-limiti tal-poteri koncessi lilu bil-ligi, u l-ligi ma tridx li dak il-proprjetarju jibqa' jgawdi b'dak il-monopolju meta jkun naqas, ghar-ragunijiet tieghu, milli jinqeda bih ghal tul ta' hames snin [ara sentenza **Avukat Dr Luigi Sansone vs Marsovin Ltd**, App 24/02/2012]

Fil-kaz in ezami Ahmed Said Guedi, General Manager tas-socjeta intimata xehed li t-TM 52531 giet registrata Malta fit-2014 u r-renewal taghha hija fit-2023. Independent Tobacco FZE, li tipproduci l-BUSINESS ROYALS dahlet f'non-exclusive Distributorship Agreement, datat 8 ta' Marzu 2018, ma' Azpet Group Ltd ghad-distribuzzjoni ta' BUSINESS ROYALS products f'Malta [ara Doc. ASG3 a fol. 86]. Hemm agreements ohra li ghad iridu jigu negozjati u konkluzi. Ighid li huma qed

jaghmlu marketing ghad-distribuzzjoni tal-prodotti BR. Li jonqos huwa li jsiru l-mandatory testing. BR qed izzid l-portfolio taghha billi fil-2019 dahhlet applikazzjonijiet ohra ghal trademarks f'Malta. Bhal issa qed taghmel marketing fl-Ewropa kollha imma s-sigaretti BUSINESS ROYALS ghadhom ma gewx distribwiti Malta. Jahsbu li jkunu jisghtu jidhlu fis-suq fil-2020.

Minn naha l-ohra, Sergio Calleja, rapprezentant tas-socjeta' attrici xehed li t-Trademark 52531 qatt ma intuzat Malta u qatt ma ra Malta prodotti b'dik it-trademark fis-suq Malti. Kien recentement, fil-2019, li s-socjeta attrici applikat ghal trademarks ohra f'Malta.

George Agius, rapprezentant tal-Kontrollur tad-Dwana, xehed li ma jidhirlux li l-konvenuti qatt importaw cigaretti b'dan il-markju, ghax mhumiex registrati mal-ligi Ewropeja. Hu jghid li t-trademark 52531 mhijiex registrata mal-EUIPO skond l-Artikolu 2 subsection 2(A)(B)(C) tal-EC Regolament 608/2013 jew artikolu 2 subsection (a)(i) tal-Kap. 414 biex tircievi protezzjoni ghal ksur.

Illi kif gie deciz fis-sentenza c.f. **Hermes** [1982] R.C.P. 425:

> It is suggested that, to constitute genuine use, the use relied upon must be use in the course of trade. In this context, the proviso to section 46(3) draws a clear distinction between use and preparation for use. Preparations for use do not constitute use, although it might be quite difficult to fix the line between the two. It is suggested that trade in the goods or services in question must have commenced ... In all cases the decision is whether genuine use has been established.

Fil-fehma tal-Qorti l-prova li kellha taghmel is-socjeta intimata ma saritx u fil-fatt ma tressqet ebda prova mis-socjeta intimata illi qatt uzat jew tat il-kunsens ghall-uzu tal-imsemmija trademark f'Malta tul il-hames snin mindu giet registrata fil- 2014. Hemm provi li dina trademark qatt ma giet uzata Malta; li l-prodott BUSINESS ROYALS qatt ma gie distribwit fis-suq Malti; li prodott ghad irid jigi ttestjat qabel jidhol fis-suq u l-agreements li semmiet is-socjeta intimata ghadhom biss qed jigu negozjati u jridu jigu konkluzi. Preparation for use mhux use of trade.

Darba jirrizulta li, bhala fatt, is-socjeta intimata naqset milli taghmel uzu mill-marka "Business Royals" ghal aktar minn hames snin, u ma kienux jezistu ragunijiet li ghal

din il-Qorti jistghu jitqiesu “xierqa” ghaliex ma tkunx qeghdha hekk tintuza, allura, fit-termini tal-Artikolu 42(1)(b), il-Qorti tista’ tipprovdi ghar-revoka tal-istess registrazzjoni.

Decide

Ghal dawn il-motivi, il-Qorti tiddeciedi billi

Tiddikjara illi s-socjeta BR International Holdings Inc. naqset milli taghmel uzu tat-trademark bin-numru ta' registrazzjoni TM52351 ghal oltre minn hames snin mid-data ta' registrazzjoni u sahansittra qatt ma ghamlet uzu mill-istess trademark;

Konsegwentament tirrevoka r-registrazzjoni tat-trademark numru TM52531 "BUSINESS ROYALS PREMIUM" u dana ai termini tal-artikolu 42(1)(a) tal-Kap. 416 tal-Ligijiet ta' Malta;

Tordna illi t-trademark numru TM52531 "BUSINESS ROYALS PREMIUM" tigi mnehhija mir-registru ta' trademarks ta' Malta.

Bl-ispejjez kontra s-socjeta intimata.

Mark Chetcuti
Prim Imhallef

Anne Xuereb
Deputat Registratur