



MALTA

**QORTI TAL-APPELL**  
**(Sede Inferjuri)**

**ONOR. IMĦALLEF**  
**LAWRENCE MINTOFF**

Seduta tal-15 ta' Settembru, 2023

Appell Inferjuri Numru 152/2022 LM

**Av. Dottor Luigi A. Sansone (detentur tal-karta tal-identità ta' Malta bin-numru '0258269' ittra 'M') bħala mandatarju speċjali ta' Rothmans of Pall Mall Limited, kumpannija estera organizzata f'Companies House (Ingilterra u Wales) b'numru ta' registrazzjoni 00676565 u b'indirizz registrat ta' Globe House, 4 Temple Place, London WC2R 2PG fir-Renju Unit**  
*(l-appellanta')*

**vs.**

**Avukat Dottor Paul Micallef Grimaud bħala mandatarju speċjali ta' BR International Holdings Inc., kumpannija estera registrata fil-British Virgin Islands u b'indikazzjoni ta' indirizz ta' P.O. Box 261031, Jebel Ali, Dubai, United Arab Emirates**  
*(l-appellat')*

**Il-Qorti,**

**Preliminari**

1. Dan huwa appell magħmul mill-**Avukat Dottor Luigi A. Sansone (detentur tal-karta tal-identità ta' Malta bin-numru '0258269' ittra 'M')** bħala

**mandatarju speċjali ta' Rothmans of Pall Mall Limited**, [minn issa 'l quddiem 'l-appellant noe'], kumpanija estera organizzata f'*Companies House* (l-Ingilterra u Wales) b'numru ta' reġistrazzjoni 00676565 u b'indirizz reġistrat ta' *Globe House, 4 Temple Place, London WC2R 2PG* fir-Renju Unit, minn deċiżjoni [minn issa 'l quddiem 'id-deċiżjoni appellata'] tal-**Kontrollur tal-Proprietà Industrijali** [minn issa 'l quddiem 'il-Kontrollur'] datata 16 ta' Novembru, 2022, li permezz tagħha ddecieda billi ċaħad l-oppożizzjoni li l-appellant noe kien irreġistra miegħu fil-konfront tal-applikazzjoni nru. 59700 għar-reġistrazzjoni tat-*trademark* BUSINESS ROYALS OF LONDON 1844 taħt il-klassi 34 tal-Klassifikazzjoni Internazzjonali ta' Prodotti u Servizzi taħt in-*Nice Agreement* ipprezentata fl-10 ta' Ġunju, 2019 mis-soċjetà appellata **BR International Holdings Inc.**, kif debitament rappreżentata f'dawn il-proċeduri mill-mandatarju speċjali tagħha l-**Avukat Dottor Paul Micallef Grimaud** [minn issa 'l quddiem 'l-appellant noe'], kumpanija estera reġistrata fil-British Virgin Islands u b'indikazzjoni ta' indirizz ta' P.O. Box 261031, Jebel Ali, Dubai, United Arab Emirates, liema oppożizzjoni hija msejsa fuq il-para. (b) tas-subartikolu 6(1) tal-Kap. 597.

## **Fatti**

2. Il-fatti ta' dan l-appell jirrigwardaw l-applikazzjoni nru. 59700 tas-soċjetà appellata għar-reġistrazzjoni tat-*trademark* *Business Royals of London 1844* [minn issa 'l quddiem 'it-*trademark* opposta'] ipprezentata lill-Kontrollur fl-10 ta' Ġunju, 2019 fil-Klassi numru 34.

## **Mertu**

3. Fit-22 ta' Novembru, 2019, l-appellant noe pprezenta avviż ta' oppożizzjoni għall-applikazzjoni appena msemmija tal-appellat noe għar-raġunijiet fost oħrajn li (a) huwa kellu registrat *trademark* anteedenti bin-numru 10027 [minn issa 'l quddiem 'it-*trademark* anteedenti'], b'effett mis-17 ta' Mejju, 1969, fir-rigward ta' *tobacco raw or manufactured, smokers' articles, matches*, fejn kien applikabbli s-subartikolu 6(3)(a) tal-Kap. 597 dwar 'reputazzjoni' / 'vantagġ mhux ġust' / 'detriment għall-karattru distintiv u għar-reputazzjoni'; u (b) it-*trademark* anteedenti hija 'magħrufa sew' f'Malta, u hija *trademark* ta' 'reputazzjoni' anki f'Malta, u huma applikabbli l-para. (b) tas-subartikolu 6(1) flimkien mal-para. (d) tas-subartikolu 6(2), u l-para (a) tas-subartikolu 6(3) flimkien mal-para. (d) tas-subartikolu 6(2) tal-Kap. 597.

4. L-appellat noe pprezenta kontro-dikjarazzjoni fis-26 ta' Frar, 2020, u l-appellant noe fis-6 ta' April, 2020 ipprezenta Avviż dwar Manteniment tal-Oppożizzjoni.

## **Id-deċizzjoni appellata**

5. Fis-16 ta' Novembru, 2022 l-Kontrollur wasal sabiex ċaħad l-oppożizzjoni tal-appellant noe, wara li għamel is-segweni konsiderazzjonijiet rilevanti għal dan l-appell:

“

**2) *Opposition to the applicant's mark based on Trademark 10027 on the grounds of Article 6(3)(a) Trademarks Act Cap 597.***

*The office notes that:*

a) *For a trademark not to be registered under Article 6(3)(a) of the Trademarks Act, Cap 597, all of the following must apply:*

- i) the trademark must be identical with, or similar to, an earlier trademark (irrespective of whether the goods or services for which the trademark is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is protected)
- ii) the earlier trademark must have a reputation in Malta
- iii) the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark

b) *The first requirement is fulfilled as:*

- *the Opponents goods relating to National Registered Trademark Application No: 10027 are identical or similar to goods in respect of which applicant is applying for with National Trademark Application No: 59700*
- *there is an average visual, aural and conceptual similarity between the marks in question;*

c) *Trademark 10027 was registered with effect 17th May 1969.*

d) *The opponent states that:*

6. during the period 1969 to 1972 the brand was introduced to/consolidated in various other markets across Europe including Malta, and was advertised in accordance with applicable local laws of the time...

11. evidence of matters indicated in paragraph numbers 2-10 (inclusive) and 12 of this Part, as well as evidence of a list of all the current trademark registrations worldwide for – or including – the expression ROYALS, in the name of the Opponent or any other company forming a part of BAT, is attached to an affidavit of Stuart Paul Aitchison a certified copy of which is attached hereto and marked as document “I” ...

12. sales of Rothmans ROYALS have been constant throughout the European Union and Malta since 1969, and details of sales in Malta over approximately 10 years (period 2008-2018) are annexed to the affidavit of Stuart Paul Aitchison as document “Annex XXIV” thereto

13. there can be no doubt that as a result of massive effort from the part of BAT, all of the Opponent’s Malta-registered trademarks indicated herein at

paragraph 8, enjoy reputation in Malta. Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent's part or from the part of any other person (corporate or unincorporated) connected therewith

*e) Neither the opponent nor the affidavit of Stuart Paul Aitchison provides any evidence of any advertising campaign involving Trademark 10027 taking place close to the date when the applicant filed his application. Indeed, the opponent states that:*

*"...Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent's part or from the part of any other person (corporate or unincorporated) connected therewith..."*

*f) The statistics referred to by the opponent do not provide any breakdown of the sales taken place in Malta in packets or packaging bearing Trademark 10027.*

*g) The opponent have not provided any documentation indicating to the satisfaction of the Office that Trademark 10027 has a reputation in Malta.*

*Given the above the Office does not consider that any proof has been provided showing that Trademark 10027 has a reputation in Malta. Thus, the second requirement of Article 6(3)(a) of the Trademarks Act, Cap 597 is not fulfilled.*

*The opposition to the applicant's mark based on the opponent's mark, Trademark 10027, on the grounds of Article 6(3)(a) of the Trademarks Act, Cap 597 is rejected.*

**3) Opposition to the applicant's mark based on claim of "ROYALS" as a "WELL KNOWN TRADEMARK" in Malta in respect of cigarettes as per Art. 6(1)(b)**

*The Office notes that:*

*a) Article 6(1) b states:*

6(1) A trademark shall not be registered or, if registered, shall be liable to be declared invalid where ....

b) because of its identity with, or similarity to, an earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public, including the likelihood of association by the public with the earlier trademark

*b) Since in this instance the opponent when citing grounds for opposition 6(1)(b) he does so on the claim that Royals is an earlier trademark which is a well-known*

*mark in Malta, the opponent must submit evidence of the mark being well known.*

*c) The opponent states that:*

6. during the period 1969 to 1972 the brand was introduced to/consolidated in various other markets across Europe including Malta, and was advertised in accordance with applicable local laws of the time...

11. evidence of matters indicted in paragraph numbers 2-10 (inclusive) and 12 of this Part, as well as evidence of a list of all the current trademark registrations worldwide for – or including – the expression ROYALS, in the name of the Opponent or any other company forming a part of BAT, is attached to an affidavit of Stuart Paul Aitchison a certified copy of which is attached hereto and marked as document “I” ...

12. sales of Rothmans ROYALS have been constant throughout the European Union and Malta since 1969, and details of sales in Malta over approximately 10 years (period 2008-2018) are annexed to the affidavit of Stuart Paul Aitchison as document “Annex XXIV” thereto

...

13. there can be no doubt that as a result of massive effort from the part of BAT, all of the Opponent’s Malta-registered trademarks indicated herein at paragraph 8, enjoy reputation in Malta. Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent’s part or from the part of any other person (corporate or unincorporated) connected therewith

*d) Neither the opponent nor the affidavit of Stuart Paul Aitchison provides any evidence of any advertising campaign involving Trademark ROYALS taking place close to the date when the applicant filed his application. Indeed, the opponent states that:*

*“...Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent’s part or from the part of any other person (corporate or unincorporated) connected therewith...”*

*e) The statistics referred to by the opponent do not provide any breakdown of the sales taken place in Malta in packets or packaging bearing the Trademark ROYALS.*

f) *The opponent has not provided any documentation indicating to the satisfaction of the Office that Trademark ROYALS is well known in Malta.*

*Given the above, the Office does not consider that any proof has been provided that the Trademark ROYALS is well known in Malta.*

*The opposition to the applicant's mark based on claim of "ROYALS" as a "WELL KNOWN TRADEMARK" in Malta in respect of cigarettes as per Article 6(1)(b) of the Trademarks Act (Cap 597) is rejected.*

**4) *Opposition to the applicant's mark based on claim of "ROYALS" being as a "TRADEMARK OF REPUTATION in Malta ... in respect of cigarettes as per Art 6(3)(a) the Trademarks Act, Cap. 597***

*The Office notes that:*

a) *in opposing the applicant's mark based on claim of "ROYALS" being as a TRADEMARK OF REPUTATION, the opponent states in the opposition Section (B) CLEAR IDENTIFICATION OF THE EARLIER MARK(S) OR RIGHT(S) ON WHICH THE OPPOSITION IS BASED..."*

*"Opposition is based on the following:*

*...*

- (B)(2) EARLIER MALTA TRADEMARK "ROYALS", in respect of cigarettes ... both as:*

*...*

*(b) a trademark "OF REPUTATION" in Malta under applicable provisions contained in Cap. 597, in particular art. 6(3)(a) thereof and its related provision art. 6(2)(d)."*

b) *The opponent basing his claim on the definition of earlier mark as provided in 6(2)(d) namely:*

*(d) trademarks which, on the date of application for registration of the trademark or, where appropriate, of the priority claimed in respect of the application for registration of the trademark, are well known in Malta, in the sense in which the words "well-known" are used in Article 6bis of the Paris Convention.*

c) *since in this instance the opponent when citing grounds for opposition 6(3)(a) he does so on the claim that Royals is an earlier trademark which is as a well-known mark in Malta, the opponent must submit evidence of the mark being well known.*

*d) The opponent states that:*

6. during the period 1969 to 1972 the brand was introduced to/consolidated in various other markets across Europe including Malta, and was advertised in accordance with applicable local laws of the time ...

...

11. evidence of matters indicated in paragraph numbers 2-10 (inclusive) and 12 of this Part, as well as evidence of a list of all the current trademark registrations worldwide for – or – including – the expression ROYALS in the name of the Opponent or any other company forming a part of BAT, is attached to an affidavit of Stuart Paul Aitchison a certified copy of which is attached hereto and marked as document “I” ...

12. sales of Rothmans ROYALS have been constant throughout the European Union and Malta since 1969, and details of sales in Malta over approximately 10 years (period 2008-2018) are annexed to the affidavit of Stuart Paul Aitchison as document “Annex XXIV” thereto

...

13. there can be no doubt that as a result of massive effort from the part of BAT, all of the Opponent’s Malta-registered trademarks indicated herein at paragraph 8, enjoy reputation in Malta. Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent’s part or from the part of any other person (corporate or unincorporated) connected therewith

*e) Neither the opponent nor the affidavit of Stuart Paul Aitchison provides any evidence of any advertising campaign involving trademark ROYALS taking place close to the date when applicant filed his application. Indeed, the opponent states that:*

“...Since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since then there is no evidence of advertising activities from the Opponent’s part or from the part of any other person (corporate or unincorporated) connected therewith...”

*f) The statistics referred to by the opponent do not provide any breakdown of the sales taken place in Malta in packets or packaging bearing the trademark ROYAL.*

*g) The opponent has not provided any documentation indicating to the satisfaction of the Office that Trademark ROYALS is well known in Malta.*



*Given the above the Office does not consider that any proof has been provided that the Trademark ROYALS is well known in Malta and hence cannot be used as earlier mark on the basis of which to claim that it is a trademark of reputation.*

*Consequently, the opposition to the applicant's mark based on claim of "ROYALS" being a "TRADEMARK OF REPUTATION in Malta in respect of cigarettes as per Art. 6(3)(a) of the Trademarks Act, Cap. 597 is rejected.*

#### **5) Regarding the trademarks subject to invalidity proceedings**

*In regards to the grounds for opposition citing the trademarks which are subject to invalidity proceedings these will be considered:*

- a) If there is an appeal and the Court does not rule in favour of the acceptance of the opposition and rules that the opposition should be rejected and*
- b) The Office is presented with official documentation by the opponent showing that all pending actions in their regard are decided in a final manner. Provided that consideration will be only in case of those in respect of which the action of invalidity fails.*

*The trademark applicant will be informed of this decision and can institute an appeal against this decision before the Court of Appeal in terms of Article 100 of the Trademark Act, Cap 597.*

*If an appeal is not instituted within the timeframe provided in Article 100, this office will record this application as refused in our records."*

### **L-Appell**

6. L-appellant noe ipprezenta r-rikors tal-appell tiegħu fl-1 ta' Dicembru, 2022 fejn qiegħed jitlob lil din il-Qorti sabiex:

*"...jogħgobha tilqa' dan l-appell u tvarja d-Deciżjoni tal-Kontrollur tal-Proprietà Industrijali datata 16 ta' Novembru 2022 (opposizzjoni numru 25), fis-sens li tħassar u tirrevoka l-kontenut kollu tal-kapi numri 2, 3 u 4 tal-istess Deciżjoni, u tipprovdi minflok billi:*

- (a) fl-ewwel lok, tiddikjara li l-applikazzjoni tat-trademark numru ta' applikazzjoni 59700 *Business Royals of London 1844* ma hijiex registrabbli ai termini tal-*

*artikolu 6(3)(a) tal-Att dwar it-Trademarks (Kap. 597 tal-Ligijiet ta' Malta), in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-trademark ta' Malta registrata bin-numru 10027*



*(b) fit-tieni lok, tiddikjara li l-applikazzjoni tat-trademark numru ta' applikazzjoni 59700 Business Royals of London 1844 ma hijjex registrabbli ai termini tal-artikolu 6(1)(b) tal-Att dwar it-Trademarks (Kap. 597 tal-Ligijiet ta' Malta), in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-trademark ROYALS qua trademark "magħrufa sew" ai termini tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi għall-Protezzjoni tal-Proprietà Industrijali tal-20 ta' Marzu 1883 (kif riveduta jew emendata minn żmien għal żmien); u*

*(c) fit-tielet lok, tiddikjara li l-applikazzjoni tat-trademark numru ta' applikazzjoni 59700 Business Royals of London 1844 ma hijjex registrabbli ai termini tal-artikolu 6(3)(a) tal-Att dwar it-Trademarks (Kap. 597 tal-Ligijiet ta' Malta) in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-trademark ROYALS qua trademark "magħrufa sew" dwar oġġetti identici u ċjoé sigaretti, ai termini tal-Artikolu 6 bis tal-Konvenzjoni ta' Pariġi għall-Protezzjoni tal-Proprietà Industrijali tal-20 ta' Marzu 1883 (kif riveduta jew emendata minn żmien għal żmien).*

*Bl-ispejjeż ta' din il-proċedura li għandhom jiġu sopportati nterament mill-kumpannija appellata."*

Jissottometti li "**... limitatament dwar il-kontenut tal-kapijiet enumerati 2, 3 u 4 rispettivament tad-Deciżjoni...**), l-aggravji tiegħu huma dawn:

*"1. fir-rigward tal-kontenut tal-kap numru 2 tad-Deciżjoni appellata u partikolarment il-paragrafi d) sa g) u ż-żewġ paragrafi li jsegwu l-para. g), il-*

*kumpannija appellanta ssostni li fiċ-ċirkostanzi hija ressqet evidenza ampjament suffiċjenti sabiex tipprova li t-trademark numru 10027*



*għandha reputazzjoni f'Malta dwar "Tobacco raw or manufactured, smokers' articles", bil-konsegwenza li l-opposizzjoni tagħha bbażata fuq l-art 6(3)(a) tal-Kap. 597 kellha assolutament tintlaqa' u mhux tiġi riġettata;*

- 2. fir-rigward tal-kontenut tal-kap numru 3 tad-Deċiżjoni appellata, u partikolarment il-paragrafi ċ) sa f) u ż-żewġ paragrafi li jsegwu l-par. f), il-kumpannija appellanta ssostni li fiċ-ċirkostanzi hija ressqet evidenza ampjament suffiċjenti sabiex tipprova li t-trademark ROYALS hija "magħrufa sew" f'Malta dwar sigaretti u għalhekk protetta skont l-Artikolu 6bis tal-Konvenzjoni ta' Pariġi fuq trademarks "magħrufin sew", bil-konsegwenza li l-opposizzjoni tagħha bbażata fuq l-art. 6(1)(b) [flimkien ma' dik relatata 6(2)(d)] tal-Kap. 597, kellha assolutament tintlaqa' u mhux tiġi riġettata;*
- 3. fir-rigward tal-kontenut tal-kap numru 4 tad-Deċiżjoni appellata u partikolarment il-paragrafi d) sa g) u ż-żewġ paragrafi li jsegwu l-par. g), il-kumpannija appellanta ssostni li fiċ-ċirkostanzi hija ressqet evidenza ampjament suffiċjenti sabiex tipprova li t-trademark ROYALS hija "magħrufa sew" f'Malta dwar sigaretti u għalhekk protetta skont l-Artikolu 6bis tal-Konvenzjoni ta' Pariġi fuq trademarks "magħrufin sew", bil-konsegwenza li l-opposizzjoni tagħha bbażata fuq l-art. 6(3)(a) [flimkien ma' dik relatata 6(2)(d)] tal-Kap. 597, kellha assolutament tintlaqa' u mhux tiġi riġettata;"*

7. L-appellat noe għażel li ma jwegibx.

### **Konsiderazzjonijiet ta' din il-Qorti**

8. Din il-Qorti ser tgħaddi sabiex tikkunsidra l-aggravji rispettivi tal-appellant noe, u dan fid-dawl ta' dak kollu li qal il-Kontrollur fid-deċiżjoni appellata.

9. Dwar l-ewwel aggravju tiegħu, l-appellant noe jipprezenta s-segventi sottomissjonijiet: (a) f'para. 2(e) tad-deċiżjoni appellata, huwa kien qed jiġi kkritikat li ma pproduċa l-ebda evidenza "*of any advertising campaign involving Trademark 10027 close to the date when the applicant filed his application*", u saħansitra kkastigatha fejn "*since at least ten years all forms of advertising of tobacco products are illegal in Malta hence since there is no evidence of advertising activities from the Opponent's part or from the part of any other person (corporate or unincorporated) connected therewith...*"; (b) din il-pożizzjoni hija skorretta u saħansitra inkredibbli fid-dawl tad-dispożizzjonijiet tas-subartikolu 4(1) tal-Kap. 315 li ġew fis-seħħ stante d-Direttiva tal-UE 2003/33/KE, sabiex b'hekk il-perijodu tal-projbizzjoni kien ta' madwar erbatax-il sena u xahrejn qabel ma sar l-Avviż tal-Oppożizzjoni, u dan fejn il-*brand look* evolva ruħu f'dawk il-ħamsin sena fejn ġew registrati t-*trademarks* 18478 u 35235 fl-1988 u fl-2001 rispettivament, u aktar tard it-*trademarks* 44324 u 52121 fl-2005 u fl-2013 rispettivament, mingħajr ma ġie mittiefes l-element dominanti jew l-isem tal-prodott ROYALS li jinsab registrat bħala *trademark* 37183; (ċ) hija kienet irrilevat il-volum ta' bejgħ ta' sigaretti ROYALS bejn l-2008 u l-2018, u donnu l-Kontrollur kien aċċetta in principju l-ammont għoli ta' bejgħ; (d) madankollu din l-evidenza twarrbet għaliex allegatament ma kienx hemm evidenza li setgħet turi li l-bejgħ kien proprju ta' sigaretti bil-marka



(e) it-*trademark* antecendenti hija registra sogġetta li *“The right to the exclusive use of the letter R; the lions and the crown which is common to the trade is disclaimed”*, sabiex b’hekk ma jista’ jkun hemm l-ebda dubju li l-konsumatur li jara dik it-*trademark* ser jidentifikaha bħala ‘ROYALS’ ta’ Rothmans jew marka tal-appellant noe, fejn l-element verbali ‘ROYALS’ huwa predominanti; (f) il-para. (a) tas-subartikolu 26(4) tal-Kap. 597 jipprovdi b’mod inekwivoku li użu validu ta’ *trademark* reġistrata tfigisser ukoll *“l-użu tat-*trademark* f’forma li hija differenti fir-rigward tal-elementi li ma jbidlux ix-xorta distintiva tat-*trademark* fil-forma li fiha tkun giet reġistrata”*; (g) hija kienet ippruvat li l-element ‘ROYALS’ li huwa dak li l-iktar li jispikka fit-*trademark* 10027, huwa wżat skont il-liġi u skont id-disposizzjonijiet tal-para. (a) tas-subartikolu 26(4) tal-Kap. 597 permezz ta’ użu kummerċjali kontinwu sa mill-1969 fir-rigward ta’ prodotti ta’ tabakk manifatturat (sigaretti)/artikli ta’ tipjip magħrufin bħala ‘ROYALS’ fejn saħansitra l-prodott huwa popolari sew hawn Malta kif jidher mill-bejgħ qawwi li ntwera għall-perijodu bejn l-2008 u l-2018; (g) għalhekk il-Kontrollur kellu jkun sodisfatt li gie ppruvat li ‘ROYALS’, kemm bħala kelma u wkoll f’sfumatura jew f’sfumaturi figurattivi stilizzati, hija rinomata f’Malta, u għalhekk għandha reputazzjoni fost il-pubbliku; (għ) iċ-ċifri ta’ bejgħ huma tassew inkredibbli; (ħ) huwa kien esebixxa prova tar-rikliamar għall-perijodu qabel ma hawn Malta kienet giet imposta projbizzjoni tar-reklamar ta’ prodotti tat-tabakk; (h) kuntrarjament għal dak li ngħad fil-para. 2(g) tad-deċiżjoni appellata, hija kienet

esebiet dokumentazzjoni li kellha turi a sodisfazzjoni ta' min kellu jiġġudika, li t-*trademark* anteedenti hija rinomata hawn Malta u għandha 'reputazzjoni' skont id-disposizzjonijiet tal-para. (a) tas-subartikolu 6(3) tal-Kap. 597; (i) il-Kontrollur jidher li injora għal kollox is-sentenzi *res judicata* mogħtija mill-Qorti Ċivili, Prim'Awla, fit-22 ta' April, 2010 u tal-10 ta' Diċembru, 2013, fejn giet ittrattata t-tema ta' reputazzjoni hawn Malta tat-*trademark* anteedenti b'mod ġenerali; (ie) għalhekk jirrizulta li hija kienet ippruvat li t-*trademark* anteedenti hija magħrufa fost il-pubbliku rilevanti hawn Malta, u b'hekk tikkostitwixxi *trademark* ta' 'reputazzjoni f'Malta' *ai termini* tal-para. (a) tas-subartikolu 6(3) tal-Kap. 597; (j) b'hekk kellha tiġi akkolta l-oppożizzjoni tagħha.

Dwar it-tieni aggravju rigwardanti l-kap. 3 tad-deċiżjoni appellata, partikolarment il-paragrafi (ċ) sa (f), u ż-żewġ paragrafi li jsegwu l-para. (f), tissottometti: (a) hija kienet ressqet prova tassew biżżejjed sabiex turi li t-*trademark* anteedenti hija 'magħrufa sew' hawn Malta fir-rigward ta' sigaretti, u għalhekk tinstab protetta *ai termini* tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi fuq *trademarks* 'magħrufin sew', u għalhekk l-oppożizzjoni tagħha msejsa fuq il-para. (b) tas-subartikolu 6(1) flimkien ma' dik marbuta mal-para. (d) tas-subartikolu 6(2) tal-Kap. 597, kellha tintlaqa' u mhux tiġi riġettata; (b) bl-istess mod kif ċaħad is-sottomissjonijiet tiegħu dwar 'reputazzjoni' hawn Malta tat-*trademark* anteedenti, il-Kontrollur ċaħad is-sottomissjonijiet tiegħu dwar *status* ta' '*well-known trademark*' hawn Malta fir-rigward ta' sigaretti; (ċ) dawk l-argumenti pprezentati fir-rigward tal-ewwel aggravju għandhom jgħoddu hawnhekk ukoll; (d) għandu jiġi osservat li fil-kap. 1 tad-deċiżjoni appellata, li minnu huwa mhuwiex qed jappella, il-Kontrollur sab li hemm '*likelihood of confusion*' *ai termini* tal-para. (b) tas-subartikolu 6(1) tal-Kap. 597; (e) għaladarba

stabbilit li 'ROYALS' huwa protett hawn Malta bħala '*well-known trademark*' ai termini tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi, id-deċiżjoni appellata kellha ssib li hemm ukoll '*likelihood of confusion*' skont il-para. (b) tas-subartikolu 6(1), flimkien mal-para. (d) tas-subartikolu 6(2), tal-Kap. 597; (f) b'hekk kellha tiġi milqugħa din ir-raġuni ta' oppożizzjoni sabiex b'hekk il-Kontrollur jiddeċiedi li jirrifjuta li jirregistra t-*trademark* opposta.

Dwar it-tielet aggravju, is-socjetà appellanta qegħda tissottometi dan li ġej fir-rigward tal-kap. 4 tad-deċiżjoni appellata, partikolarment għal dak li jingħad fil-paragrafi (d) sa (g), u ż-żewġ paragrafi li jsegwu dan tal-aħħar: (a) hija kienet ressqet prova tassew suffiċjenti sabiex turi li t-*trademark* anteedenti hija 'magħrufa sew' hawn Malta fir-rigward ta' sigaretti, u b'hekk tinstab protetta mill-Artikolu 6bis tal-Konvenzjoni ta' Pariġi, u għalhekk l-oppożizzjoni tagħha msejsa fuq il-para. (a) tas-subartikolu 6(3) u dak relatat para. (d) tas-subartikolu 6(2) tal-Kap. 597, kellha tintlaqa'; (b) il-Kontrollur kien ċaħad bl-istess mod is-sottomissjonijiet tagħha dwar *status* ta' '*well-known trademark*' / *trademark* 'magħruf hawn Malta' tal-marka 'ROYALS' fir-rigward ta' sigaretti; (c) is-sottomissjonijiet tagħha fir-rigward tal-ewwel aggravju jgħoddu hawnhekk ukoll; (d) għaladarba stabbilit li t-*trademark* anteedenti hija protetta hawn Malta bħala '*well known trademark*' ai termini tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi, kellu jiġi deċiż li l-użu fil-kummerċ ta' *Business Royals of London 1844* kien ser ikun ta' preġudizzju għax-xorta distintiva u/jew għar-reputazzjoni f'Malta tat-*trademark* anteedenti skont dak li jiddisponi għalih il-para. (a) tas-subartikolu 6(3) u l-para. (d) tas-subartikolu 6(2) tal-istess Kap. 597; (e) għalhekk l-oppożizzjoni tagħha hawn ukoll għall-istess raġuni ta' oppożizzjoni kellha tintlaqa'. Is-socjetà appellanta rrilevat ukoll is-segwentanti dwar il-Konvenzjoni ta'

Parigi: (a) huwa paċifiku li l-Artikolu 6*bis* huwa rikonoxxut fil-liġi tagħna u anki enforzabbli permezz tal-istess; (b) stante li hija għiet imċaħħda mill-*protezzjoni ai termini* tal-Artikolu 6*bis* u anki li l-Kontrollur interpreta l-provi b' mod żbaljat, din il-Qorti għandha teżamina l-mertu wara li tikkunsidra l-Avviż ta' Oppożizzjoni, il-Kontro-dikjarazzjoni, l-Avviż dwar Manteniment tal-Oppożizzjoni, il-provi relatati u d-deċiżjoni appellata stess. Dan kollu rilevat għandu jwassal sabiex din il-Qorti tiddikjara li l-applikazzjoni tat-*trademark* opposta mhijiex reġistrabbli *ai termini* tal-para. (b) tas-subartikolu 6(1) u tal-para. (a) tas-subartikolu 6(3) tal-Kap. 597, u dan ukoll fid-dawl tal-jeddijiet tagħha msemmija taħt il-kapi 2, 3, u 4 tad-deċiżjoni appellata.

10. Il-Qorti tibda billi tikkunsidra dak li jiddisponu għalih il-para. (b) tas-subartikolu 6(1), il-para. (d) tas-subartikolu 6(2) u l-para. (a) tas-subartikolu 6(3) tal-Kap. 597:

“(1) Trademark m'għandhiex tiġi reġistrata jew, jekk tkun reġistrata, tista' tiġi dikjarata invalida meta

...

(b) minħabba l-identità jew similarità tagħha ma' trademark preċedenti u l-identità jew is-similarità tal-oġġetti jew is-servizzi koperti mit-trademarks, teżisti l-probabbiltà ta' konfużjoni min-naħa tal-pubbliku, inkluża l-probabbiltà ta' assoċjazzjoni mill-pubbliku mat-trademark preċedenti;

...

(2) “Trademarks preċedenti” fil-kuntest tat-tifsira tas-subartikolu (1) tfisser:

...

(d) trademarks li, meta ssir l-applikazzjoni għar-reġistrazzjoni tat-trademark li, meta ssir l-applikazzjoni għar-reġistrazzjoni tat-trademark jew, meta jkun xieraq, tal-prijorita' pretiża fir-rigward tal-applikazzjoni għar-reġistrazzjoni tat-trademark, ikunu



magħrufa sew f' Malta, fis-sens li fih il-kliem "magħrufa sew"  
jintużaw fl-Artikolu 6bis tal-Konvenzjoni ta' Pariġi;

...

(3) Aktar minn hekk, trademark m'għandhiex tigi registrata jew, jekk tigi  
registrata, din tkun tista' tigi dikjarata invalida meta:

- (a) din tkun identika, jew simili, għal trademark preċedenti  
irrispettivament minn jekk l-oġġetti jew is-servizzi li għalihom  
tigi applikata jew registrata trademark ikunux identiċi, jew  
simili jew mhux ma' dawk li dwarhom it-trademark  
preċedenti tkun protetta, meta t-trademark preċedenti jkollha  
reputazzjoni f' Malta jew, fil-każ ta' trademark tal-UE, għandha  
reputazzjoni fl-Unjoni u l-użu tat-trademark sussegwenti,  
mingħajr raġuni valida, jieħu vantaġġ ingust mit-trademark  
preċedenti jew huwa detrimental għax-xorta distintiva jew għar-  
reputazzjoni tat-trademark preċedenti;"

11. Il-Kontrollur għaraf li fil-każ odjern jinsab sodisfatt l-ewwel rekwizit li  
jitlob dan il-provvediment, jgħid li *"...the trademark must be identical with, or  
similar to, an earlier trademark (irrespective of whether the goods or services  
for which the trademark is applied or registered are identical with, similar to or  
not similar to those for which the earlier trademark is protected)"*. Iżda rrileva  
li *"[n]either the opponent nor the affidavit of Stuart Paul Aitchison provides any  
evidence of any advertising campaign involving Trademark 10027 taking place  
close to the date when the applicant filed his application"*, u kkunsidra dak li  
saħansitra stqarr l-appellant noe stess li *"[s]ince at least ten years all forms of  
advertising of tobacco products are illegal in Malta hence since then there is no  
evidence of advertising activities from the Opponent's part or from the part of  
any other person (corporate or unincorporated) connected therewith..."*, u li  
*"[t]he statistics referred to by the opponent do not provide any breakdown of*

*the sales taken place in Malta in packets or packaging bearing Trademark 10027*". Il-Kontrollur irrileva wkoll li l-appellant noe ma kienx esebixxa dokumentazzjoni li setgħet turi a sodisfazzjoni tiegħu li t-*trademark* anteedenti għandha reputazzjoni hawn Malta. Il-Qorti tgħid fl-ewwel lok li fid-dawl ta' dak li jipprovdli għalih is-subartikolu 4(1) tal-Kap. 315, l-appellant noe għandu raġun jilmenta minn kif il-Kontrollur wasal sabiex ċaħad l-oppożizzjoni tiegħu *ai termini* tal-para. (a) tas-subartikolu 6(3) tal-Kap. 597. Il-projbizzjoni fil-liġi ta' kull xorta ta' reklamar hija ċara, u ma jistax jinftiehem kif l-ottemperanza tal-appellant noe mal-istess liġi setgħet ittiegħdet bħala raġuni għaċ-ċaħda tal-oppożizzjoni tiegħu. Il-Qorti tgħid li jirriżulta mill-provi esebiti quddiem din il-Qorti konsistenti f'Dok. LAS01 u Dok. LAS02, li huma MISCO *survey reports* li t-*trademark* anteedenti registrata f'isem l-appellant noe għandha reputazzjoni sostanzjalment qawwija hawn Malta kuntrarjament għat-*trademark* opposta, li tirriżulta saħansitra mhux magħrufa. Għalhekk il-Qorti hija konvinta li jekk l-applikazzjoni għar-registrazzjoni ta' din tal-aħħar tigi milqugħa, m'hemm l-ebda dubju li ser tgawdi u ser tigi aġevolata mir-reputazzjoni tat-*trademark* anteedenti fl-istess suq ta' bejgħ ta' sigaretti, sabiex b'hekk sidha ser jagħmel ingustament gwadann finanzjarju ta' kwalunkwe xorta bis-saħħa tar-reputazzjoni tat-*trademark* anteedenti, li sidha ċertament ħadem għalih bis-sħiħ matul dawn is-snin kollha. Dan huwa biżżejjed sabiex jirnexxi l-ilment tal-appellant noe taħt is-subartikolu 6(3) tal-Kap. 416. Iżżid tgħid li meta l-Kontrollur ikkunsidra li ma kinitx giet esebita informazzjoni dwar il-bejgħ hawn Malta ta' pakketti jew ippakkjar bit-*trademark* anteedenti fuqhom, dan kien qed ikun restrittiv wisq fl-interpretazzjoni li kien qed jagħti lil-liġi. Kif sewwa jirrileva l-appellant noe, l-iktar element li jispikka huwa l-element verbali

‘ROYALS’, u saħansitra l-Kontrollur stess wara li għaraf li bħala prinċipju l-element l-iktar distintiv huwa dak verbali, qal li fil-każ odjern dan kien jikkonsisti fil-kliem ‘Rothmans’ u ‘ROYALS’. Għalhekk il-Qorti tikkunsidra li l-bejgħ elevat tal-prodott marbut mal-isem ‘ROYALS’, kellu jkun prova suffiċjenti tar-reputazzjoni tat-*trademark* anteedenti.

12. Għaldaqstant il-Qorti tqis li l-aggravji tal-appellant noe huma ġustifikati, u tilqagħhom.

### **Decide**

**Għar-raġunijiet premessi l-Qorti tiddeċiedi dwar l-appell tal-appellant noe billi tilqgħu u b’hekk tbiddel id-deċiżjoni appellata billi tħassar il-kapi numri 2, 3 u 4 tagħha billi minflok:**

- (a) fl-ewwel lok, tiddikjara li l-applikazzjoni tat-*trademark* numru ta’ applikazzjoni 59700 *Business Royals of London 1844* ma hijiex reġistrabbli *ai termini* tal-artikolu 6(3)(a) tal-Att dwar it-*Trademarks* (Kap. 597 tal-Liġijiet ta’ Malta), in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-*trademark* ta’ Malta



reġistrata bin-numru 10027 ;

- (b) fit-tieni lok, tiddikjara li l-applikazzjoni tat-*trademark* numru ta' applikazzjoni 59700 *Business Royals of London 1844* ma hijiex registrabbli *ai termini* tal-artikolu 6(1)(b) tal-Att dwar it-*Trademarks* (Kap. 597 tal-Liġijiet ta' Malta), in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-*trademark* ROYALS *qua trademark 'magħrufa sew' ai termini* tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi għall-Protezzjoni tal-Proprietà Industrijali tal-20 ta' Marzu 1883 (kif riveduta jew emendata minn żmien għal żmien); u
- (c) fit-tielet lok, tiddikjara li l-applikazzjoni tat-*trademark* numru ta' applikazzjoni 59700 *Business Royals of London 1844* ma hijiex registrabbli *ai termini* tal-artikolu 6(3)(a) tal-Att dwar it-*Trademarks* (Kap. 597 tal-Liġijiet ta' Malta), in vista tal-jeddijiet tal-kumpannija appellanta naxxenti mit-*trademark* ROYALS *qua trademark 'magħrufa sew' ai termini* tal-Artikolu 6bis tal-Konvenzjoni ta' Pariġi għall-Protezzjoni tal-Proprietà Industrijali tal-20 ta' Marzu 1883 (kif riveduta jew emendata minn żmien għal żmien).

**Bl-ispejjeż tal-appell odjern a karigu tal-appellat noe.**

Moqrija.

**Onor. Dr Lawrence Mintoff LL.D.  
Imħallef**

**Rosemarie Calleja  
Deputat Registratur**