

QORTI TA' L-APPELL

IMHALLFIN

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Seduta ta' nhar it-Tnejn 19 ta' Novembru, 2001

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**Avukat Dottor Pio M. VALLETTA
bhala mandatarju specjali ghan-nom
u in rapprezentanza tas-socjeta'
Ferrero SpA**

vs

**Joseph Busuttil u Charles Busuttil
ghan-nom u in rapprezentanza tas-
socjeta' Foster Clark Products
Limited u Kontrollur tal-Proprjeta'
Industrijali**

L-Att tac-Citazzjoni

L-attur bhala mandatarju specjali tas-socjeta' estera Ferrero SpA
ipproceda kontra s-socjeta' lokali Foster Clark Products Limited u l-
Kontrollur tal-Proprjeta' Industrijali bis-segwenti att tac-citazzjoni:-

“Illi s-socjeta’ konvenuta Foster Clark Products Limited talbet ir-registrazzjoni f’Malta tat-‘trade mark’ konsistenti fil-kelma ‘NUTINA’ a rigward ta’ l-ogetti specifikati fl-applikazzjoni ta’ l-istess socjeta’ konvenuta; liema applikazzjoni ggib in-numru 19707, kollox kif jidher mill-Avviz fil-Gazzetta tal-Gvern tal-31 ta; Awissu, 1990, pagna 4060, hawn unita u mmarkata Dokument A;

Li s-socjeta’ attrici, fil-5 ta’ Dicembru, 1990, ghamlet oppozizzjoni ghat-talba fuq imsemmija b’att li vera kopja tieghu tinsab hawn annessa bhala Dokument B u dan, kif jidher mill-istess dokument, ghar-raguni li s-socjeta’ attrici hija proprjetarja tal-marka famuza u rinomata ‘NUTELLA’; liema marka hija registrata f’diversi pajjizi mad-dinja kollha u ilha hekk registrata ghal diversi snin u dan kif jigi ppruvat waqt it-trattazzjoni tal-kawza u peress illi l-konvenuti Busuttil nomine ghandhom bl-uzu tal-kelma ‘NUTINA’ l-intenzjoni li jibbenefikaw mill-“goodwill” gja ezistenti u li ghandha l-imsemmija marka ‘NUTELLA’; liema “goodwill” jestendi ruhu anke f’Malta; fuq kollox l-uzu tal-marka ‘NUTINA’ mill-konvenuti nomine jikkreja konfuzjoni fl-imhuh tal-konsumaturi in vista tas-sommiljanza bejn iz-zewg marki cioe’ ‘NUTINA’ u ‘NUTELLA’ f’dak li hu kitba u fonetika;

Li s-socjeta’ konvenuta Foster Clark Products Limited ghamlet kontro-dikjarazzjoni li biha ikkontestat l-opposizzjoni fuq imsemmija u dina l-kontro-dikjarazzjoni giet notifikata lis-socjeta’ attrici b’ittra tal-konvenut l-iehor il-Kontrollur tal-Proprijeta’ Industrijali tat-8 ta’ Jannar, 1991. (Dokumenti C u D);

Li s-socjeta’ attrici ghandha interess li tinsisti fl-opposizzjoni taghha stante li tirriteniha gusta stante illi altrimenti l-konvenuti Busuttil nomine, barra li jkunu qeghdin jikkrejaw konfuzjoni u jqarrqu bil-konsumatur bl-uzu tal-marka ‘NUTINA’, jkunu wkoll qed jaghmlu uzu a vantagg taghhom mill-“goodwill” tal-marka ‘NUTELLA’ li hu proprjeta’ tas-socjeta’ attrici; liema “goodwill” gie kkrejat wara snin kbar ta’ “marketing” mis-socjeta’ attrici u b’hekk johloq pregudizzju gravi lejn l-interessi tas-socejta’ attrici;

TALAB ghalhekk li l-konvenuti Foster Clark Products Limited u l-Kontrollur tal-Proprijeta’ Industrijali, ghar-ragunijiet premissi, jghidu ghaliex m’ghandhiex din il-Qorti tichad it-talba fuq imsemmija tas-socjeta’ konvenuta Foster Clark Products Limited gar-registrazzjoni tat-Trade Mark 19707 konsistenti fil-kelma ‘NUTINA’;

Ghall-finijiet ta' l-Artikolu 88 (3) TAL-Kap 29 tal-Ligijiet ta' Malta l-attur nomine qieghed jipproduci kontestwalment garanzija ghall-ispejjez tal-kawza (Dokument E);

Bl-ispejjez kollha kontra l-konvenuti”.

Eccezzjonijiet

Is-socjeta' konvenuta eccepjet illi t-talbiet tas-socjeta' attrici kienu nfondati fil-fatt u fid-dritt stante li l-marka “Nutina” m’hi bl-ebda mod konfliggenti jew somiljanti mal-marka “Nutella” proprjeta' tas-socjeta' attrici.

Il-konvenut, Kontrollur tal-Proprijeta' Industrijali eccepixxa hekk ghat-talbiet attrici:-

1. Illi, fit-30 ta' Mejju, 1990, is-socjeta' konvenuta Foster Clark Products Limited applikat ghar-registrazzjoni tat-trade mark NUTINA ghall-oggetti li jikkwalifikaw taht il-Klassi Internazzjonali tletin (30);
2. Illi peress illi l-applikazzjoni ghar-registrazzjoni tat-trade mark fuq citata kienet konformi mar-rekwiziti imposti mill-Ordinanza dwar il-Protezzjoni tal-Proprijeta' Industrijali (Kapitolu 29), it-talba ghar-registrazzjoni ta' l-istess trade mark giet imxandra mill-Kontrollur ai termini ta' l-artikolu 87 ta' l-imsemmija Ordinanza (Kapitolu 29);
3. Illi, fil-5 ta' Dicembru, 1990, l-eccipjent ircieva ittra ta' dikjarazzjoni ta' oppozizzjoni ghar-registrazzjoni in kwistjoni minghand id-dirra attrici Ferrero SpA; liema oppozizzjoni giet komunikata lid-ditta konvenuta Foster Clark Products Limited fit-3 ta' Jannar, 1991;

4. Illi d-ditta konvenuta Foster Clark Products Limited issottomettiet lill-eccipjenti l-kontro-dikjarazzjoni taghha fit-3 ta' Jannar, 1991; liema kontro-dikjarazzjoni giet mibghuta lid-ditta attrici fit-8 ta' Jannar, 1991;

5. Illi d-dikjarazzjoni ta' oppozizzjoni u l-kontro-dikjarazzjoni fuq citati saru fit-terminu rikjest mill-artikolu 88 ta' l-Ordinanza dwar il-Protezzjoni tal-Proprieta' Industrijali (Kapitolu 29);

6. Illi, stante n-natura ta' l-azzjoni attrici, l-esponenti jirrimetti ruhu ghall-provi u ghad-decizjoni ta' dina l-Onorabbli Qorti ghar-rigward tat-talba attrici salv li, fi kwalunkwe kaz, l-eccipjenti m'ghadux ibati spejjez".

Decide

B'sentenza tad-29 ta' Novembru, 1996, il-Prim'Awla tal-Qorti Civili ddecidiet il-kawza billi prevja r-rigett tar-rapport peritali, laqghet it-talba attrici u hekk ordnat lill-konvenut Kontrollur tal-Proprieta' Industrijali sabiex ma jilqax ir-registrazzjoni tat-trade mark "Nutina", liema registrazzjoni ntalbet bl-applikazzjoni li ggib in-numru 19707. L-ispejjez kellhom jithallsu in kwantu ghal zewg terzi (2/3) mill-konvenuti nomine u in kwantu ghar-rimanenti terz (1/3) mill-attur nomine.

Motivazzjoni tas-sentenza appellata

L-ewwel Qorti hekk immotivat is-sentenza taghha:-

“M’hemm ebda dubbju li l-azzjoni ezercitata mill-attur nomine hija dik kontemplata fl-artikolu 88 ta’ l-Ordinanza Dwar il-Protezzjoni tal-Propjeta’ Industrijali (Kap 29);

Din l-azzjoni tista’ tigi esperita minn kull persuna, pero’, kif sewwa jirrileva l-attur nomine fin-nota tieghu a fol. 81 tal-process, fil-maggoranza tal-kazi, l-interess ta’ dawk li jopponu talba ghar-registrazzjoni ta’ marka jkun motivat minn dak li jistabilixxi l-istess Ordinanza meta fl-artikolu 81 tghid illi:

“(1) Il-marki u l-kelmiet imsemmijin fl-ahhar artikolu qabel dan ghandhom ikun differenti minn dawk gia wzati legalment minn ohrajn”.

Minn dan jitnizzel li l-perit legali ma kienx korrett meta wasal ghall-konkluzzjoni li l-azzjoni taht l-artikolu 88 tispetta biss lill-proprietarju tal-marka, disinn jew mudell li jkun gie debitament registrat mal-Kontrollur tal-Propjeta’ Industrijali. Kien proprju dan l-izball inizjali li, fil-fehma tal-Qorti, gieghel lill-istess perit li jidentifika l-azzjoni odjerna bhala dik kontemplata fl-artikolu 32 tal-Kodici tal-Kummerc li, kif jirrileva huwa stess fuq l-iskorta tas-sentenza tal-Qorti ta’ l-Appell (Sede Kummercjali) fil-kawza fl-ismijiet “Avukat Dottor Stefan Meilak noe vs. Albert W. Salomone noe” (dec. 9.01.1995), ghandha kriterji aktar ampji minn dawk tal-Kap 29 fejn l-uniku kriterju li jistabilixxi l-artikolu 81 precitat huwa li l-marki u l-kelmiet, imsemmijin fl-artikolu precedenti, ghandhom ikunu differenti minn dawk ga uzati legalment minn ohrajn.

Dan l-izball inizjali tal-perit legali, kif sewwa jissottometti l-attur nomine, necessarjament wasslu biex jikkonsidera t-talba tieghu in bazi ghall-kriterji li huma aktar ampji, kif inghad, u l-konsegwenza kienet li rrelata kontra t-talba tieghu ghaliex fl-ottika tieghu kellu l-konsiderazzjoni jekk il-marka ‘Nutina’ setghetx iggib “tahwid” f’mohh il-konsumatur mal-marka ‘Nutella’; mentri dak li kellu jiddeciedi kien jekk il-marka ‘Nutina’ kienetx sufficjentement differenti mill-marka ‘Nutella’ biex tkun tista’ tigi registrata minkejja l-oppozizzjoni ta’ l-attur nomine.

L-attur nomine, fuq l-awtorita’ ta’ l-awtur Kerly, jsostni li x-xebh bejn il-marka ‘Nutella’ u l-marka ‘Nutina’ ma jippermettix li din ta’ l-ahhar tkun registrata bhala “Trade Mark”. Huwa jibda biex jikkwota mill-ktieb ta’ dan l-awtur bl-isem “Laws of Trademarks and Tradenames” (12th Edition), pagna 438, fejn jnghad hekk:

“What degree of resemblance is necessaryis from the nature of things incapable of definition a prioriIn comparing marks, the Registrar and the Court, as the case may be, must, as appears from the authorities referred to below, take into account all the circumstances of the case, and must consider whether, as a whole, the applicant’s mark is substantially different from the opponent’s.

L-istes awtur, f’dan il-kuntest, jagħmel riferenza għas-sentenza mogħtija fil-kawza Ngliza magħrufa bħala “Pianotist” fejn l-Imħallef qal dan:-

“You must take the two words. You must judge them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy these goods. In fact you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trademark for the goods of the respective owners of the marks”.

Kwotazzjoni ohra ta’ l-awtur Kerly, li tinsab riprodotta wkoll fin-nota ta’ l-attur nomine, hija dik senjalata minn dan l-awtur fil-pagna 447 (op. Cit.) u li tirriferi għal dak li ntqal fis-sentenza magħrufa bħala l-kaz “Sadow” fis-sens li:

“The question is not whether if a person is looking at two trademarks side by side there would be a possibility of confusion: the question is whether the person who sees the proposed trademark in the absence of the other trademark and in view only of this general recollection of what the nature of the other trademark was, would be liable to be deceived and to think that the trademark before him is the same as the other, of which he has a general recollection”.

Skond l-istess Kerly, f’paragrafu 17, 13, pagina 445 (op. Cit.):-

“It has been accepted in several reported cases that the first syllable of a word mark is generally the most important. It has been observed in many cases that there is a tendency of persons using the English language to slur the termination of words”.

Imbagħad, in sostenn ta’ dan huwa jgħaddi biex isemmi kazi quddiem il-Qrati Nglizi fejn il-kelma “Tablones” ma gietx accettata għax tixbah il-kelma “Tabloids”, fejn il-kelma

“Accutron” ma gietx accettata ghax tixbah il-kelma “Accutrist” u fejn il-kelma “Buler” ma gietx accettata ghax tixbah il-kelm “Bulova” u, dippiu’, jsemmi li sentenzi Nglizi stabbilew illi f’kazijiet fejn jezistu marki bl-ewwel parti taghom identika u fejn l-ewwel parti tkun deskrittiva, ir-registrazzjoni tal-kelma sommiljanti dejjem giet rifjutata.

Din il-Qorti, fuq l-iskorta ta’ dawn is-sentenzi tal-Qrati Nglizi, u in bazi ghall-principji kif spjegati mill-awtur Kerly, li huwa ndubbjament awtorita’ndiskussa fil-materja, u wara li kkunsidrat li l-marka “Nutella” hija marka internazzjonalment rikonoxxuta u ilha tintuza mis-socjeta’ attrici anke hawn Malta, kif ukoll li l-prodott tghha huwa, skond ma xehed il-konvenut Charles Busuttil, identiku ghall-prodott tas-socejta’ konvenuta – dak li fuqu ghandha tintuza l-marka “Nutina” – u allura z-zewg prodotti ser jinbieghu mill-istess ‘xkaffa’, u tenut kont li l-ewwel sillaba taz-zewg marki hija komuni u, dippiu’, l-ewwel sillaba hij deskrittiva u, ghalhekk, tezisti l-possibilita’ li l-ahhar parti tal-kelma tigi pronunzjata hazin, tasal ghall-konkluzzjoni li r-registrazzjoni tat-Trade Mark 19707 konsistenti fil-kelma “Nutina” mhix legalment gustifikata”.

Konsiderazzjonijiet ta’ din il-Qorti

Is-socjeta’ konvenuta Foster Clark Products Limited appellat minn din is-sentenza u ilmentat li l-ewwel Qorti ghamlet apprezzament ghal kollox zbaljat tal-punti nvoluti fil-vertenza. Hi ssottomettiet li anke jekk wiehed jaccetta l-premessa ta’ l-ewwel Qorti li l-azzjoni originali ezercitata mill-attur nomine kienet dik kontemplata fl-artikolu 88 ta’ l-Ordinanza dwar il-protezzjoni tal-proprijeta’ industrijali, wiehed xorta ma jistax jasal ghall-konkluzzjonijiet li kienet waslet ghalihom l-ewwel Qorti. Dan ghaliex il-kelma “Nutina” hi fil-fatt sufficjentement differenti mill-marka "Nutella" biex tkun tista’ tigi registrata nonostante l-opposizzjoni

ta' l-attur nomine. Mhux sorprendement is-socjeta' appellanti tistrieħ ukoll fuq l-awtur Kerly, citat in extenso mill-ewwel Qorti, biex tiggustifika s-sottomissjoni principali tagħha illi z-zewg marki ma setghux jagħtu lok għal konfuzzjoni fil-mohħ tal-konsumatur.

F'kazijiet ta' din ix-xorta mhux insolitu li kull parti ssib konfort f'gurisprudenza estera li tul iz-zmien tat interpretazzjoni tal-principji guridici applikabbli għall-kazi bħal dawn u illi jissufragaw posizzjonijiet differenti. Hekk is-socjeta' appellanti tagħmel riferenza għal dak li jikkwota il-Kerly mill-kaz magħruf "Harrods Application" fis-sens illi

“It is a well recognised principle that has to be taken into account in considering the possibility of confusion arising between any two marks that where the two marks contain a common element which is also contained in a number of other marks in use in the same market, such a common occurrence in the market tends to cause purchasers to pay more attention to the other features of the respective marks and to distinguish between them by those features”.

Citazzjoni li timplika li kultant is-somiljanza bejn zewg marki tista' tkun ta' vantagg propju biex taccentwa d-differenza bejniethom, propju għaliex l-attenzjoni tal-konsumatur tigi attratta lejn id-differenzi li kienu jezistu bejn zewg marki li kellhom xi haga in komun.

Finalment pero' l-appellanti jissottomettu li d-differenza sostanzjali, kemm fil-kitba kif ukoll fil-fonetika, li tezisti bejn iz-zewg kelmiet, u cioe'

bejn il-kelma “Nutina” u l-kelma “Nutella” kienet tali li l-ebda konfuzzjoni ma setghet tqum bejniethom. L-istess Kerly isostni illi t-test tas-somiljanza kellu jkun pjuttost wiehed sostantiv. Hu ghalhekk jispjega:

“But for a mere accidental phonetic resemblance (in the sense that the idea of the marks, once properly grasped, is quite different) to convince the court of deceptive resemblances calls for something special: for a convincing demonstration that some context likely to occur in actual commerce would convert the accidental resemblance into something approaching identity of sound”.

Is-socjeta’ appellanti tissottometti li fil-kaz taht ezami zgur li ma kienx hemm dak li dan l-awtur isejjah “the accidental resemblance into something approaching identity of sound”. Anke jekk wiehed jiehu l-konsiderazzjonijiet li ghamlet l-Ewwel Qorti bhala korretti, wiehed jasal ghall-konkluzzjoni differenti minn dak li waslet ghaliha hi. Dan ghaliex jekk wiehed jiehu z-zewg kelmiet u jqishom kemm mid-dehra u kemm mill-hoss taghom dawn juru b’mod l-aktar car differenzi kbar bejniethom li ma jwasslux lill-konsumatur biex ikun konfuz dwar liema prodotti qieghed fil-fatt jixtri.

Naturalment is-socjeta’ attrici tirribatti dan l-aggravju billi tghid qabel xejn illi t-trade mark kellha tittiehed bhala unita’ wahda u l-paragun kellu jkun wiehed konkret u relatat mar-rejalta’ biex jigi identifikat x’kienu l-elementi komuni bejnha u bejn dawk tal-marka l-ohra li tkun qed tintalab ir-registrazzjoni taghha.

“The trademark is the whole thing – the whole picture, each has to be considered. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the part or parts is enough to make the whole dissimilar”.

Citazzjoni ohra mill-Kerly's Law of Trademarks and Tradenames.

L-appellat nomine jissottometti li l-krejjazzjoni tal-marka “Nutina” sehhet meta kienet diga' tezisti l-marka “Nutella”, u dana ukoll biex tkopri l-prodott identiku ghal dak maghruf tan-“Nutella”. Dan jindika b'certezza l-intenzjoni li kien hemm il-hsieb, da parti tas-socjeta' appellanti, li l-marki jkunu vicini u simili. L-attur nomine jaghmel riferenza ghall-insenjament ta' l-Imhallef Farwell fil-kawza li kienet tirrigwarda l-marka “ERECTIKO” ikkwotat mill-Kerly li jghid:-

“I do not think it right to take part of the word and compare it with a part of the other word: one word must be considered as a whole and compared with the other word as a whole.....I think it is a dangerous method to adopt to divide the word up and seek to distinguish a portion of it from the portion of the other word”.

Il-marka kellhom allura jigu analizzati fl-assjem tagghom minghajr ma jigi skartat il-fatt illi kienu jikkontjenu partijiet komuni.

Is-socjeta' appellata taghmel riferenza ghad-diversi sentenzi nglizi riportati fil-Kerly li jaghtu mportanza fondamentali lill-ewwel sillaba tal-marka konsistenti f'kelma. Aspett dan tal-kwistjoni trattat ukoll fis-

sentenza appellata. Dawn is-sentenzi stabbilew illi f'kazijiet fejn jezistu marki bl-ewwel parti taghhom identika, fejn l-ewwel parti tkun deskrittiva ir-registrazzjoni tal-kelma somiljanti dejjem giet rifjutata. Fost il-kazijiet isemmi li l-marka "TABLONES" ma gietx accettata ghax qrib il-marka "TABLOIDS", waqt li l-kelma "BULER" ma gietx accettata ghax qrib il-kelma "BULOVA" u l-kelma "ACCUTRON" ma gietx accettata ghax qrib il-kelma "ACCUTRIST".

Is-socjeta' attrici allura tissottometti li, tenut kont ta' dawn il-principji generali, wiehed bilfors kellu jasal ghall-konkluzzjoni li l-marka "Nutella" u "Nutina" huma somiljanti sal-punt li l-applikazzjoni ghar-registrazzjoni tal-kelma "Nutina" kellha tigi michuda. Hu pero' indikattiv li bl-ebda wahda minn dawn is-sentenzi li ghalihom l-attur nomine ghamel riferenza ma kienx il-kaz li l-ewwel sillaba tal-kelma tat-trade mark kienet effettivament tiffirma kelma generika u deskrittiva ta' oggett, f'dan il-kaz "nut".

Din il-Qorti tqis li l-gurisprudenza ngliza li ghaluha z-zewg partijiet fil-kawza ghamlu riferenza ghandha naturalment certu interess ghall-mertu taht ezami, anke ghaliex l-Ordinanza dwar il-Protezzjoni tal-Propjeta' Industrijali li antecedit l-Att XIV ta' l-2000 dwar it-Trademarks, (Kap 416) kienet mibnija fuq it-Trademarks Act 1883, Att tal-Parlament tar-Renju Unit.

Din il-Qorti tifhem pero' li l-qradi taghna evolwew ukoll id-duttrina taghhom in materja u l-istil, u kienet dik id-dottrina illi kellha tigi fil-parti l-kbira segwita u applikata ghall-kaz taht ezami. Infatti l-azzjoni promossa mill-attur nomine hi specifikatament bazata fuq l-art. 88 (3) tal-Kap 29 tal-Ligijiet ta' Malta li kienet allura tirregola l-protezzjoni tal-proprjeta' industrijali skond l-Ordinanza appena citata. Dik l-Ordinanza kienet tapplika nonostante li giet wara promulgata l-ligi l-gdida li tirregola t-trademarks. Effettivament fl-artikolu 91 ta' l-Att XVI ta' l-2000, li gie fis-sehh f'Janar, 2001, hemm provdut illi "proceedings under the old law (kif hu l-kaz taht ezami) which are pending on the commencement of this Act, shall be dealt with under the old law and any necessary alteration pursuant to such proceedings shall be made to the new register". L-artikolu 81 ta' l-Ordinanza l-antika jipprovdi mbaghad illi: "Il-marki u l-kelmiet imsemmija fl-ahhar artikolu qabel dan ghandhom ikunu differenti minn dawk li gew uzati legalment minn ohrain". Mhux diskuss li fil-mument meta ntalbet ir-registrazzjoni tat-trademark "Nutina" tas-socejta' konvenuta kien hemm diga' wzat f'dawn il-gzejjer il-prodott tas-socjeta' attrici zmercjat taht it-trademark "Nutella".

Gie ritenut mill-gurisprudenza nostrana illi l-"kwistjoni jekk ghandhiex tigi accettata oppozizzjoni ghar-registrazzjoni ta' Trade Mark, fuq il-motiv li dak it-trademark jista' jgib konfuzjoni ma' trademark ta' haddiehor li

jopponi dik ir-registrazzjoni, hija mpernjata fuq il-principju ta' l-idea dominanti taz-zewg marki, indipendentement mid-dettalji li jkunu jakkompanjaw dik l-idea dominanti. Jekk l-idea dominanti taz-zewg marki in kontestazzjoni thalli mpressjoni tali li tista' ggib il-konfuzzjoni bejniethom, l-opposizzjoni ghar-registrazzjoni hija gustifikata. Il-prodotti li ghalihom ikun irid jigi applikat il-markju li tieghu tintalab ir-registrazzjoni m'hemmx bzonn ikun identici ghal dawk tal-parti opposta, imma huwa bizzejjed li jkunu "of the same description" (Vol. XXXVI, P.III, p.616).

Jigi notat f'dan ir-rigward li s-socjeta' attrici qeghda toggezzjona ghar-registrazzjoni tat-trademark "Nutina" fir-rigward ta' wahda biss miz-zewg avvizi publikati fil-gazzetta tal-Gvern tal-31 ta' Awissu, 1990, ghall-klassi partikolari ta' prodotti, dik cioe' li tirrigwarda l-produzzjoni ta' oggetti "in respect of coffee, tea, cocoa, sugar etc." Dan ghaliex kjarament hija dik il-klassi ta' oggetti li s-socjeta' attrici tipproduci hi stess u tizmercja f'Malta taht it-trade mark "Nutella".

Huwa fir-rigward ta' dawn il-prodotti li l-attur nomine qieghed jissottometti li t-trademark "Nutina" kienet ser tikkreja konfuzzjoni f'mohh il-konsumatur, b'mod li s-socjeta' konvenuta tkun, b'qerq, qed taghmel uzu a vantagg taghha mill-goodwill "Nutella" li gie krejat wara snin twal ta' marketing mis-socjeta' attrici, u dana bi pregudizzju gravi ghall-

interessi kummercjali taghha. L-attur nomine mhux qed joggezzjona ghar-registrazzjoni ta' l-isem "Nutina" fir-rigward ta' klassi ohra ta' oggetti kif indikat fl-applikazzjoni l-ohra, u dan propju ghaliex dawk l-oggetti ma kienux jinteressaw lis-socjeta' attrici. Dan almenu fis-suq Malti ghaliex, effettivament, hemm indikazzjoni fl-atti illi s-socjeta' estera effettivament kienet ghamlet registrazzjoni tat-trademark "Nutella" gewwa Franza ghall-ewwel klassi ta' prodotti li ghalih is-socjeta' konvenuta riedet tirregistra t-trademark "Nutina" f'Malta.

"Il-ligi thalli f'idejn il-Qorti biex tiddetermina jekk kellhiex jew le tilqa' l-opposizzjoni ghat-talba tar-registrazzjoni. Ma timponi l-ebda kriterju biex il-gudikant jasal ghad-decizjoni tieghu. Thalli fil-gudizzju tieghu. Imma hu ovvju li fuq kollox irid ikun gwidat mill-konsiderazzjonijiet dwar il-konfuzjoni u konkorrrenza zlejati fuq accennati". (Lilian Wayne noe vs. Kontroller of Industrial Property, deciza mill-Prim'Awla tal-Qorti Civili fl-1 ta' Ottubru, 1996). Kien ghalhekk fid-dawl ta' l-impossibilita' ta' konfuzjoni u konkorrrenza zleali li kien gie wkoll deciz minn dawn il-qrati, li fejn l-applikant qieghed jipprova li t-trademark tirreferi ghal xorta ta' oggetti ghal kollox differenti minn dawk tas-socjeta' li kienet qed topponi ghar-registrazzjoni tat-trademark, ma setghax ikun hemm vjolazzjoni tal-ligi. Fil-kaz taht ezami pero', il-Managing Director tas-socjeta' konvenuta xehed b'mod kategoriku: "Hsibna sabiex nirregistraw it-trademark taht l-isem "Nutina ghal *Chocolate Nut paste product*" (4/75).

Prodott dan fost l-aktar maghrufa tas-socjeta' "Nutella" kwazi sal-punt li dan il-prodott hu identifikat popolarment fis-suq ma' dan l-isem.

"Jekk hemmx jew le fil-marki dik is-somiljanza li tirrendi konfondibbli z-zewg marki, hija kwistjoni li tiddependi mill-gudizzju tal-gudikant, li fl-ezami li ghandu jaghmel ghandu jzomm proprjament bhala test mhux dak li wiehed ihares lejn iz-zewg marki hdejn xulxin biss, imma li jikkonsidra l-effett tal-markju oggezzjonat fuq xerrej li jkollu fil-hsieb tieghu l-markju ta' l-esponent bla ma jkollu quddiemu dak il-markju, imma jkollu quddiemu biss il-markju oggezzjonat. Ma hemmx bzonn li z-zewg marki jkunu identici imma huwa bizzzejjed li jkun hemm il-possibilita' tal-konfuzjoni taz-zewg marki ghan-nies ta' intelligenza medja u ragonevoli". (Dr. George Vassallo noe vs. Carmel Caruana et, deciza mill-Qorti tal-Kummerc fis-7 ta' Gunju, 1950).

"Whether the plaintiff's and defendant's name, mark or get up are so alike as to be likely to deceive is a question of fact for the courts to decide upon the evidence in each case. The Court will have regard to the nature of the goods, or business to which the mark or device is applied, the persons who purchase such goods or deal with the business and the impression that the mark or device could make on such persons. In comparing the marks or devices in dispute, and the impression they make, it is useful to consider whether they suggest the same idea, as considering them visually and orally".

Lord Maugham in Aristoc Ltd. and Rysta Ltd. (1845 62 RPC 65), a registered trademark case said:-

“The answer to the question whether the sound of one word resembles too nearly the sound of anothermust nearly always depend on the first impression for obviously a person who is familiar with both words will neither be deceived or confused. It is the person who only knows one word and has perhaps an imperfect recollection of if who is likely to be deceived or confused..... The Court must be careful to make allowance for imperfect recollection and the effect of Kerly’s pronunciation and speech on the part, not only on the person seeking to buy under the trade description, but also of the shop assistant ministering to that person’s wants. Likelihood of deception is not disproved by showing that a careful person knowing both the plaintiff’s and defendant’s goods or business, would not be confused. The impression that a trademark or device will make will also depend on whether the mark or device is descriptive, whether it is a local or geographical name and whether it contains elements which are common to the trade”.

(Passing off minn David Young, 3rd Edition Longman’s Commercial Series 1994).

Dan it-tagħlim guriprudenzjali hu utili biex il-gudikant jasal għall-apprezzament li kien jehtieglu jagħmel biex jasal għall-gudizzju oggettiv u relatat mar-realtà tad-dinja tan-negozju dwar jekk l-introduzzjoni tal-markju gdid fis-suq setgħetx tikkreja il-konfuzjoni allegata fil-mohh tal-konsumatur. F’dan il-kontest hu allura tajjeb ukoll li jibda jsir rikjam lejn l-Awtorità tal-guriprudenza tal-Qorti Ewropeja tal-Gustizzja, li, f’din il-materja, diga’ stabbiliet kazistika awtorevoli. Dan fir-rigward ta’ l-interpretazzjoni ta’ l-art. 5 (1) (b) tal-First Council directive 84/104/EEC tal-21 ta’ Dicembru, 1988. Din id-direttiva taqra hekk:

“a) The Registered Trade Mark shall confer on the proprietor exclusive rights therein. The proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade;

b) Any sign where the cause of its identity with, or similarity to, the trade mark and the identity or similarity of the goods or services covered by the trademark and the sign, there exists a likelihood of confusion on the part of the public which includes the likelihood of association between the sign and the trademark”.

Direttiva din li sostanzjalment tkopri l-provvedimenti tal-ligi nostrana in materja. Gie ritenut f'dik il-Qorti fil-kawza Lloyd Schuhfabrik Meyer and Company GmbH vs Klipsen Handel BW deciza fit-22 ta' Gunju, 1999 hekk:-

“Furthermore the more distinctive the earlier mark the greater will be the likelihood of confusion (SABEL para. 24) and therefore marks with a highly distinctive character either per se or because of the recognition they possess in the market, enjoy broader protection than marks with a less distinctive character.

.....

It follows that for the purposes of Article 5 (1) (b) of the Directive, there may be a likelihood of confusion, notwithstanding a lesser degree of similarity between the trade marks, where the goods or services covered by them are very similar and the earlier mark is highly distinctive.

.....

In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus distinguish those goods or services from those of other undertakings.

.....

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

.....

For the purposes of their global appreciation the average customer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect.....However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question.

In order to assess the degree of similarity between the marks concerned, the National Court must determine the degree of visual, oral or conceptual similarity between them and, where appropriate, evaluate the importance to be attached to those different elements, taking account of the category of goods or services in question and the circumstances in which they are marketed.

In light of the foregoing, the answer to the questions referred to the Court must be that it is possible that mere aural similarity between trade marks may create a likelihood of confusion within the meaning of Article 5 (1)(b) of the Directive. The more similar the goods or services covered and the more distinctive the earlier mark, the greater will be the likelihood of confusion. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make a global assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings. In making that assessment, account should be taken of all relevant factors and, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered. (Ara wkoll kazijiet ohra decizi mill-istess Qorti Ewropea ta' Lussemburgu, fosthom SABEL BV vs Puma AG (1998) Canon Kabusshiki Kaisha vs. Metro Goldwyn Mayer Incorporated 1999, u Marka Mode CB vs. Adidas AG 2000)

Konsidrati dawn il-principji ghall-kaz taht ezami, din il-Qorti m'ghandhiex ezitazzjoni li taqbel ma' l-apprezzament fattwali li waslet ghalih l-ewwel Qorti. Ghandu jigi mfakkar illi din il-Qorti qed tigi mitluba biss tippronunzja ruhha fuq is-somiljanza tal-marki "Nutella" u "Nutina" bhala kliem fihom infushom minghajr riferenza ghal get up li fihom tali isem kien ser ikun jew seta' jkun realizzat f'tikketta jew xort'ohra. Certament il-marka "Nutella" ilha zmien twil sewwa stabbilita fis-suq lokali u esteru. Gie kostatat illi r-registrazzjoni mitluba da parti tas-socjeta' konvenuta kienet ghal oggetti ta' l-istess generu ta' negozju li, f'dan il-kaz, kien sewwa assocjat ma' dak prodott mis-socjeta' attrici. L-isem bisillabu maghzul mid-ditta konvenuta jikkontjeni wahda mill-bisillabi fit-trade mark tas-socejta' attrici. Din hi l-kelma "Nut" li hi intiza propju biex tenfasizza l-kwalita' specjali u l-ingredjent principali tal-prodott manifatturat miz-zewg ditti. It-tieni sillaba tat-trade mark torigina mill-lingwa taljana, u ftit jew wisq, taghti l-istess impressjoni lill-konsumatur ta' affezzjoni lejn il-prodott innifsu – ella – ina.

Din il-Qorti allura ma tistax teskludi certu grad ta' "visual, oral and conceptual similarities of the mark" li jistghu iwasslu ghal konfuzzjoni fis-suq, fis-sens li wiehed jista' effettivament jasal biex jakkwista prodott flok iehor. Dana mhux biss minhabba l-fatt illi wiehed jista' ma jkunx f'posizzjoni jaghmel pargun bejn iz-zewg marki, jew minhabba aljenazzjoni momentarja komprensibbli fil-mument ta' l-akkwist, imma wkoll ghaliex ix-xerrej jista', zbaljatament, jassocja l-prodott "Nutina" bhala li hu manifatturat mid-ditta attrici li kienet ben stabbilita fis-suq bhala produttur ta' oggetti ta' dik ix-xorta u natura taht l-isem stabbilit "Nutella". Il-motivazzjoni ta' l-ewwel Qorti fis-sentenza appellata tirrizulta allura korretta. Dan anke konsidrat il-principju li hadd ma seta' jarroga ghalih innifsu l-uzu esklussiv ta' kliem b'sinifikat komuni – f'dan il-kaz il-kelma "Nut".

Jinghad finalment li sabiex wiehed jitlob protezzjoni fit-termini tal-Kap 29 ma kienx mehtieg li t-trademark tkun attwalment registrata f'Malta. L-artikolu 82 ta' dak il-Kap jipprovdi illi "Kull persuna jista' jkollha l-uzu esklussiv tat-trademark basta li thares id-disposizzjonijiet ta' l-artikoli li gejgin ta' din it-taqsim". Il-ligi stess allura taghti l-jedd lil persuna li topponi talba ghar-registrazzjoni. Konsegwentement ma jidhirx floku li wiehed jargumenta li t-trademark ta' min jimponi trid tkun registrata sabiex ikun jista' jipprocedi ai termini ta' l-art. 88 tal-Kap 12, kif iprocediet is-socjeta' attrici. D'altronde gie stabbilit fil-gurisprudenza illi

“il-fatt ta’ registrazzjoni m’huwiex fih innifsu il-krejjazzjoni tad-dritt ta’ proprjeta’, imma konferma ta’ dan id-dritt. Dan huwa ovvju anke mid-dicitura tal-ligi stess (art. 96) “Alfred Falzon Sant Manduca noe vs Albert Mizzi et noe, deciza minn din il-Qorti fil-21 ta’ Frar, 1996). Dan l-art. 96 tal-Kap 29 kien jipprovdi hekk: “Ir-registrazzjoni ma taghmilx tajjeb ghall-importanza u l-awtorita’ tat-trademark jew ghat-tjubija jew ghall-origini tal-prodotti, jew ghall-ezistenza tal-kondizzjonijiet l-ohra mehtiega, sabiex ic-certifikat tar-registrazzjoni jkun validu”.

Ghal dawn il-motivi u ghall-motivi dedotti mill-ewwel Qorti, is-sentenza appellata qed tigi konfermata u l-appell michud. L-ispejjez ta’ dan l-appell kellhom ikunu kollha a karigu tas-socjeta’ appellanti. Dawk tal-prim’istanza kellhom jibqghu kif gia mill-ewwel Qorti decizi.

Dep/Reg

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