



INVESTOR IN PEOPLE

The Patent Office
Trade Marks Registry

Cardiff Road
Newport
South Wales
NP10 8QQ

Switchboard: 01633 814000
Direct Line: 01633 811033
Fax: 01633 811175
Minicom: 0645 222250
Website: www.patent.gov.uk

World Intellectual Property Organisation (WIPO)

International Bureau

34, chemin des Colombettes

1211 Geneva 20

Switzerland



Our Ref: OPP 71206/LAW/LH

Date: 21 June 2005

Please quote our complete reference on all correspondence

Dear Sirs

**NOTIFICATION OF A TOTAL REFUSAL OF PROTECTION BASED ON AN
OPPOSITION BY THE UNITED KINGDOM PATENT OFFICE IN ACCORDANCE
WITH ARTICLE 5 OF THE MADRID PROTOCOL**

RE: International Registration number : 826595
For the mark : GAMBLER
Holder of the International Registration : Republic Tobacco LP
Opposition number : 71206

I must advise you that following receipt of an opposition to the above Trade Mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods and services of the International Registration.

Please find attached a copy of the Form TM7 (Notice of Opposition) that was received by the United Kingdom Trade Mark Registry.

We also attach:

Copies of the marks referred to in the statement of case.
 Form TM8, for any reply to this opposition to be filed.
 Form TM33 for an agent/ address for service in the United Kingdom to be appointed.
 A copy of an extract from the United Kingdom Trade Marks Act 1994.



INVESTOR IN PEOPLE

If the holder of the International Registration wishes to file a counterstatement, they must complete the attached Form TM8 and return it together with the counterstatement within **3 months** of the date of this letter. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a Form TM8 and counterstatement will result in the provisional refusal being upheld in accordance with article 10 of the Trade Marks International Registration Order 1996 (as amended).

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the Form TM8 can be extended for a further nine months by the filing of a Form TM9c.

The Form TM8 and counterstatement should be received on or before **21 September 2005** unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom on the attached TM33 within this 3 month period. If one is not provided within this time the refusal will be made final.

Yours faithfully

Lara Hayes

LAW SECTION ASSISTANT CASE WORK EXAMINER

71206

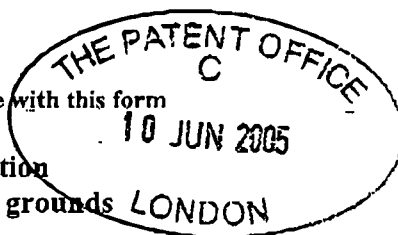
Sheet 1 of 7

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13JUN05 200.00 ACCOUNT

Document 1092299

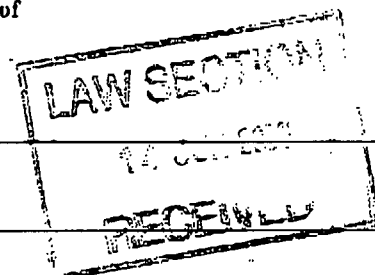
Form TM7

Official fee £200 due with this form

Notice of Opposition
and statement of grounds LONDONThe Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance notes below about filling in this form

| | | |
|---|---|--|
| 1 | Trade Mark number. | M826595 |
| 2 | Full name of the applicant or registered proprietor. | Republic Tobacco, L.P. |
| 3 | Full name and address (including postcode) of the opponent. | House of Prince A/S Tobaksvejen 4 2860 Søborg Denmark |
| 4 | Name and address (including postcode) of the agent (if any). | Marks & Clerk 90 Long Acre London WC2E 9RA United Kingdom |
| 5 | Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number. | None that we are aware of |
| 6 | Under what sections of the Trade Marks Act are you opposing this application? | Section 5(2)(b) |
| 7 | Declaration Your signature | <i>Marks & Clerk</i> |
| | Your name in BLOCK CAPITALS | MARKS & CLERK |
| | Date | 10 June 2005 |
| 8 | Name and daytime phone number of the person we should contact in case of query. | Mr Aidan Clarke 020 742 0004 |
| | Your reference. | X18141 |
| | Number of sheets attached to this form. | This is sheet 1 of a total of 7 pages |



Notes you must attach a separate sheet with your statement of grounds for opposing the mark under each section of the Trade Marks Act. You must also attach a separate sheet for each earlier mark you rely on.

If there is not enough space for your answers to any section, you may use extra blank sheets.

Number every extra sheet and say in question 8 above how many sheets you have used.

MARKS&CLERK

Fax:02078363339

20 Jun 2005 13:54

P.02/08

Sheet 1 of 7

Document: 1092299

Form TM7

Official fee £200 due with this form

**Notice of Opposition
and statement of grounds****LAW SECTION****20 JUN 2005****RECEIVED**The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance notes below about filling in this form

| | | |
|---|---|--|
| 1 | Trade Mark number. | M826595 |
| 2 | Full name of the applicant or registered proprietor. | Republic Tobacco, L.P. |
| 3 | Full name and address (including postcode) of the opponent. | House of Prince A/S Tobaksvejen 4 2860 Søborg Denmark |
| 4 | Name and address (including postcode) of the agent (if any). | Marks & Clerk 90 Long Acre London WC2E 9RA United Kingdom |
| 5 | Are there any related proceedings currently with the Registry or the courts? If so, give application, registration or opposition number. | None that we are aware of |
| 6 | Under what sections of the Trade Marks Act are you opposing this application? | Section 5(2)(b) |
| 7 | Declaration Your signature | I believe that the facts stated in this notice and in the attached statement of grounds are true <i>Marks & Clerk</i> |
| | Your name in BLOCK CAPITALS | MARKS & CLERK |
| | Date | 10 June 2005 |
| 8 | Name and daytime phone number of the person we should contact in case of query. | Mr Aidan Clarke 020 742 0004 |
| | Your reference. | X18141 |
| | Number of sheets attached to this form. | This is sheet 1 of a total of 7 pages |

Notes you must attach a separate sheet with your statement of grounds for opposing the mark under each section of the Trade Marks Act. You must also attach a separate sheet for each earlier mark you rely on.

If there is not enough space for your answers to any section, you may use extra blank sheets.

Number every extra sheet and say in question 8 above how many sheets you have used.

Sheet 2 of 7

Form TM7

Use this sheet if you are basing your opposition on Section 3 of the Trade Marks Act.
Tick which section you are relying on and give your grounds.

Grounds for opposition based on section 3 of the Trade Marks Act 1994.

- ☐ 3 (1)(a) signs which do not satisfy the requirements of section 1 (1) because:
- ☐ 3 (1)(b) trade marks which are devoid of any distinctive character because:
- ☐ 3 (1)(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 because:
- ☐ 3 (1)(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 because:
- ☐ 3 (6) trade marks which shall not be registered if or to the extent that the application is made in bad faith because:
- ☐ other State which other part of section 3 you are relying on and give your grounds.

Sheet 3 of 7

Form TM7

Use this sheet if you are basing your opposition on section 5(1) or 5 (2) of the Trade Marks Act

Tick which section you are relying on and give details of the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

Grounds for opposition based on section 5(1) or (2) of the Trade Marks Act 1994.

- ☐ 5 (1) identical with an earlier mark and for identical goods or services as the earlier mark.
- ☐ 5 (2)(a) identical with an earlier mark and for similar goods or services as the earlier mark.
- ☒ 5 (2)(b) similar to an earlier mark and for identical or similar goods or services as the earlier mark.

Details of earlier trade mark

Number: 3669744

Is it a UK, Community or International mark?

CTM

Representation of the mark:

RAMBLER

What goods or services are covered by this mark?

Tobacco, cigarettes, smokers' articles, matches.

State which goods or services in the application you say are identical or similar to those covered by the earlier mark.

All of the goods claimed**Statement of use**

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time:

Not applicable

Sheet 4 of 7

Form TM7

Use this sheet if you are basing your opposition on section 5(3) of the Trade Marks Act and give details of the earlier mark.

Grounds for opposition based on section 5(3) of the Trade Marks Act 1994.

☐ 5(3) identical with or similar to an earlier mark with a reputation

Details of earlier trade mark

Number:

Is it a UK, Community or International mark?

Representation of the mark:

What goods or services are covered by this mark?

State which goods or services you say this mark has a reputation for.

State which goods or services in the application you say would take unfair advantage of or be detrimental to the distinctive character or reputation of the earlier mark.

Why do you say this?

Statement of use

If the earlier mark has been registered for five years or more before the publication of the mark you are opposing, state which goods or services the earlier mark has been used on in that time, or state why the mark has not been used in that time:

Sheet 5 of 7

Form TM7

Use this sheet if you are basing your opposition on section 5 (4) of the Trade Marks Act.
Tick which section you are relying on and give details of the earlier mark.

Grounds for opposition based on section 5(4) of the Trade Marks Act 1994.

- ☐ 5(4)(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade.
- ☐ 5(4)(b) by virtue of an earlier right other than those referred to in other subsections of section 5, in particular by virtue of the law of copyright, design right or registered designs; and state what type of right is involved:

Representation of the earlier mark, sign or right.

How and where has the earlier right been used, and on what goods or services?

When was the earlier right first used on goods or service you have listed?

Sheet 6 of 7

Form TM7

Use this sheet if you are basing your opposition on any other grounds and tick the appropriate box.

Other grounds for opposition

- ☐ Section 56 Protection of well-known trade marks.
- ☐ Section 60 Acts of agent or representative.
- ☐ Rule 18(2) Application amended after publication.
- ☐ Rule 22 Regulations for collective or certification marks.
- ☐ Rule 23(4) Amendment of regulations for collective or certification marks.
- ☐ Rule 25(3) Alteration of registered mark.
- ☐ Rule 45(2) Removal of matter from the register.
- ☐ Rule 47(1) Reclassification of specification.

Give details to support your opposition:

Sheet 7 of 7

IN THE MATTER OF the UK
designation of International Trade Mark
No. M826595 GAMBLER in Class 34
in the name of Republic Tobacco, L.P.

- and -

IN THE MATTER of an Opposition
thereto by House of Prince A/S

STATEMENT OF GROUNDS

The grounds of opposition are as follows:

1. The Opponent is the proprietor of CTM application No. 3669744 for the trade mark RAMBLER filed on 26 February 2004.
2. The date of designation in the UK of International trade mark No. 826595 is 26 May 2004 with a priority claim of 27 April 2004 from US application No. 76/589208.
3. The Opponent's trade mark is therefore an earlier trade mark within the meaning of Section 6(2) of the Trade Marks Act 1994.
4. The mark applied for is similar to the Opponent's trade mark and the goods contained in the UK designation are identical/similar to the goods contained in the Opponent's application, and there exists a likelihood of confusion and/or association on the part of the public. Registration of the trade mark applied for would therefore be contrary to the provisions of Section 5(2)(b) of the Trade Marks Act, 1994.
5. By reason of the matters set forth, the mark applied for is not a registrable trade mark within the meaning of the Trade Marks Act, 1994.
6. The Opponent asks that registration of the mark applied for be refused with an award of costs against the Applicant.

For and on behalf of House of Prince A/S



.....
Marks & Clerk
Trade Mark Attorneys for the Opponent
10 June 2005

Form TM8

Nil Fee



Notice of defence and counterstatement

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please read the guidance note about filling in this form.

| | |
|--|----------------|
| 1. Trade Mark number. | (Lowest) Class |
| 2. Full name of the applicant or registered proprietor. | |
| 3. Opposition, invalidation, revocation, or rectification number. | |
| 4. Name and address (including postcode) of the agent (if any). | |
| 5. If a statement of use of any earlier trade marks has been given in support of the opposition or invalidation action, do you accept this statement? | |
| 6. If you answered "No" to question 5, do you want the other side to provide proof of use of the earlier marks? If you want the other side to provide proof of use you must state in your counterstatement for which earlier marks and for which goods and services you require that proof. | |
| 7. Counterstatement | |

Counterstatement (continued from previous sheet)

| | | |
|----|---|--|
| 8. | Declaration | I believe that the facts stated in this notice of defence and counterstatement are true. |
| | Your signature | |
| | Your name in BLOCK CAPITALS | |
| | Date | |
| 9. | Name and daytime phone number of the person we should contact in case of query. | |
| | Your reference. | |
| | Number of sheets attached to this form. | This is sheet 1 of |

Note If you need more space for your counterstatement you may attach separate sheets. Number each one and say in question 9 how many sheets you have used.

Form TM33

No official fee due



Request to appoint or change an agent or to enter or change an address for service

The Patent Office
Trade Marks Registry
Cardiff Road, Newport
South Wales NP10 8QQ

Please refer to notes for guidance on completing this form

| 1. Give details of the applications or registrations this will affect or the designation under the Madrid Protocol to which this request relates | <table border="1"> <thead> <tr> <th>Number(s)</th> <th>(Lowest) Class</th> <th>Licensee Numbers</th> </tr> </thead> <tbody> <tr> <td> </td> <td> </td> <td> </td> </tr> </tbody> </table> | Number(s) | (Lowest) Class | Licensee Numbers | | | |
|---|---|------------------|----------------|------------------|--|--|--|
| Number(s) | (Lowest) Class | Licensee Numbers | | | | | |
| | | | | | | | |
| 2. Full name of (a) proprietor (b) opponent (c) licensee (indicate a) to c) as appropriate) | 2. Full name of (a) proprietor (b) opponent (c) licensee (indicate a) to c) as appropriate) | | | | | | |
| 3. On behalf of the proprietor, grantor, licensee or opponent we notify you that we are the authorised: a) agent and address for service or b) address for service or c) agent (indicate a) to c) as appropriate) | 3. On behalf of the proprietor, grantor, licensee or opponent we notify you that we are the authorised: a) agent and address for service or b) address for service or c) agent (indicate a) to c) as appropriate) | | | | | | |
| 4. Is the agent or address for service authorised for: a) all transactions or b) this transaction only (indicate a) or b) and if b) provide details of transaction) | 4. Is the agent or address for service authorised for: a) all transactions or b) this transaction only (indicate a) or b) and if b) provide details of transaction) | | | | | | |
| 5. New address for service or agent's details to be recorded Trade Marks ADP number (if you know it) Your reference | 5. New address for service or agent's details to be recorded Trade Marks ADP number (if you know it) Your reference | | | | | | |
| Signature | Signature | | | | | | |
| Name (block capitals) | Name (block capitals) | | | | | | |
| Date | Date | | | | | | |
| Name and daytime telephone number of person to contact | Name and daytime telephone number of person to contact | | | | | | |
| State number of sheets attached to this form | State number of sheets attached to this form | | | | | | |

(REV/1)

Form TM33

Form TM33

Specific notes

- a) *This form is used if you want to appoint an agent either for the first time or to replace an existing agent recorded against a trade mark application or registration or international trade mark (UK) or protected international trade mark (UK). You may also use it to enter or change an address for service. (Rules 10 and 38 of the Trade Marks Rules 1994 refer).*
- b) *This form can be used for as many cases as you need. You should indicate at Section 1 the registration or application numbers of all the cases affected by these changes.*

General notes

- c) *Complete the form in capital letters or type it.*
- d) *If there is not enough space for your answer to any section of this form, use separate sheets. Number each one and write on the form how many extra sheets you have used.*
- e) *Once you have completed the form you must remember to sign and date it.*
- f) *If you need help or have any questions, please contact the Trade Marks Registry on 0645 500505.*



RELEVANT SECTIONS OF THE UNITED KINGDOM TRADE MARKS ACT 1994



SECTION 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.

References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see Section 49) or certification mark (see Section 50).

SECTION 2

(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.

(2) A sign shall not be registered as a trade mark if it consists exclusively of—

(a) the shape which results from the nature of the goods themselves;

(b) the shape of goods which is necessary to obtain a technical result; or

(c) the shape which gives substantial value to the goods.

(3) A trade mark shall not be registered if it is—

(a) contrary to public policy or to accepted principles of morality; or

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).

(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community Law.

(5) A trade mark shall not be registered in the cases specified, or referred to, in Section 4 (especially protected emblems).

— (6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.

SECTION 4

(1) A trade mark which consists of or contains—

(a) the Royal arms, or any of the principal armorial bearings of the Royal arms, or any insignia or device so nearly resembling the Royal arms or any such armorial bearing as to be likely to be mistaken for them or it;

(b) a representation of the Royal crown or any of the Royal flags;

(c) a representation of Her Majesty or any member of the Royal family, or any colourable imitation thereof; or

(d) words, letters or devices likely to lead persons to think that the applicant either has or recently has had Royal patronage or authorisation,

shall not be given unless it appears to the registrar that consent has been given by or on behalf of Her Majesty or, as the case may be, the relevant member of the Royal family.

(2) A trade mark which consists of or contains a representation of—

(a) the national flag of the United Kingdom (commonly known as the Union Jack); or

(b) the flag of England, Wales, Scotland, Northern Ireland or the Isle of Man,

shall not be registered if it appears to the registrar that the use of the trade mark would be misleading or grossly offensive.

Provision may be made by rules identifying the flags to which paragraph (b) applies.

(3) A trade mark shall not be registered in the cases specified in—

Section 57 (national emblems &c of Convention countries); or

Section 58 (emblems &c of certain international organisations).

(4) Provision may be made by rules prohibiting in such cases as may be prescribed the registration of a trade mark which consists of or contains—

(a) arms to which a person is entitled by virtue of a grant of arms by the Crown; or

(b) insignia so nearly resembling such arms as to be likely to be mistaken for them, unless it appears to the registrar that consent has been given by or on behalf of that person.

Where such a mark is registered, nothing in this Act shall be construed as authorising its use in any way contrary to the laws of arms.

(5) A trade mark which consists of or contains a controlled representation within the meaning of the Olympic Symbol etc (Protection) Act 1995 shall not be registered unless it appears to the registrar—

(a) that the application is made by the person for the time being appointed under Section 1(2) of the Olympic Symbol etc (Protection) Act 1995 (power of Secretary of State to appoint a person as the proprietor of the Olympics Association Right); or

(b) that consent has been given by or on behalf of the person mentioned in paragraph (a) above.

SECTION 5

(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(2) A trade mark shall not be registered if because—

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected; or

(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 confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark; and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade; or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as a proprietor of an "earlier right" in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

SECTION 6

(1) In this Act an "earlier trade mark" means—

(a) 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 mark;

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK); or

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the World Trade Organization Agreement as a well known trade mark.

(2) 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.

(3) A trade mark within subsection (1)(a) or (b) whose registration expires shall continue to be taken into account in determining the registrability of a later mark for a period of one year after the expiry unless the registrar is satisfied that there was no *bona fide* use of the mark during the two years immediately preceding the expiry.

SOURCES OF PROFESSIONAL HELP AND ADVICE

You may obtain details of where to get independent professional help/advice from either of the following:

♦ The Institute of Trade Mark Attorneys
Canterbury House
2-6 Wydenham Road
CROYDON
Surrey CR0 9XE

tel: +44(0) 20 8686 2652
fax: +44(0) 20 8680 5723

♦ The Chartered Institute of Patent Agents
Staple Inn Buildings
High Holborn
LONDON WC1V 7PZ

tel: +44(0) 20 7405 9450
tel: +44(0) 20 7430 0471

Trade Marks International Unit
June 2000



INVESTOR IN PEOPLE

UNITED KINGDOM TRADE MARKS REGISTRY
CONCEPT HOUSE, CARDIFF ROAD
NEWPORT, SOUTH WALES. NP10 8QQ. UK.
(☎SWITCHBOARD: 01633 814000 / OVERSEAS: 44 1633 814000)

☎ DIRECT LINE: (UK) 01633 811033 (OVERSEAS) 44 1633 811033
FAX: (UK) 01633 811437 (OVERSEAS) 44 1633 811437

DATE: 21 June 2005

FAX INFORMATION SHEET

TO: WIPO

FROM: Lara Hayes

NUMBER OF PAGES TO FOLLOW: 15

COMMENTS: **Please note:** New contact name, fax and telephone number.

Please confirm receipt of this information for International Registration number 826595 Opposition number 71206, for the mark GAMBLER by return of fax on fax number 44 1633 811437 for the attention of Lara Hayes.

Thank You

Lara Hayes

This fax transmission and the information it contains are confidential and intended for the addressee only. It may contain privileged information. If you are not the person or organisation to whom it is addressed, you must not look at or disclose its contents, nor copy or distribute or take any action in reliance upon it. If you have received this fax in error, please notify us immediately by telephone (44 1633 811033) or fax (44 1633 811437) or return it to us by post. Thank you in advance for your cooperation and assistance.