

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK
APPLICATION m 2049490 BY POMODORO CLOTHING CO LTD
TO REGISTER THE MARK **SORRENTO**

AND

IN THE MATTER OF OPPOSITION
THERE TO UNDER OPPOSITION m 46245
BY WARNERS (UK) LTD

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application **m** 2049490 by
Pomodoro Clothing Co Ltd
5 to register the mark SORRENTO

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thereto under opposition **m** 46245
by Warners (UK) Ltd

10 DECISION

Pomodoro Clothing Co Ltd (hereafter “Pomodoro”) applied on 22 December 1995 to register the mark SORRENTO in class 25 in respect of :

“Articles of clothing for men, women and children.”

15 The application is opposed by Warners (UK) Ltd. I summarise the grounds of opposition as follows:

M Section 3(1) - The mark is devoid of any distinctive character and/or consists of an indication of geographic origin. These relate to subsections (b) and (c) of section 3(1).

M Section 3(3)(b) - The mark is likely to deceive the public as to geographic origin.

20 **M** Section 3(6) - The opponent claims that the application is made in bad faith because the applicant does not have a *bona fide* intention to use the mark on all articles of clothing for men, women and children.

The applicant filed a counterstatement denying each and every ground of opposition.

Both parties ask for an award of costs in their favour.

25 Both parties also filed evidence in these proceedings, and agreed that the Registrar should make his decision on the basis of the written evidence without the need for a hearing. Acting on the Registrar’s behalf and after a careful study of the papers, I now give this decision.

Opponent’s Evidence

30 This comprises a statutory declaration by Howard Nicholas Matthews of Page Hargrave, dated 18 July 1997. Mr Matthews represents the opponent in these proceedings. He says that

SORRENTO is a geographic place name, primarily that of an Italian town, and that it is therefore non-distinctive for Italian fashion clothing and shoes. He exhibits a number of extracts about Sorrento from a range of reference books, and copies of several pages from travel brochures. From these, it appears that Sorrento in Italy has a population of 7,035.

5 The remainder of Mr Matthews' evidence concerns a visit by one of his assistants to the applicant's premises. It is clearly hearsay, as the applicant has complained in evidence, and I do not propose to give it any weight in reaching my decision.

Applicant's Evidence

10 This comprises a statutory declaration by Hemant Puri dated 13 October 1997. Mr Puri is the managing director of Pomodoro, the applicant company. He says that his company first used the SORRENTO trade mark in August 1995 in connection with a wide variety of clothing garments, including skirts, blouses, trousers, jackets, dresses, shorts, tops and camisoles. He confirms that the mark has been used continuously since that date. A selection of the garments is exhibited to Mr Puri's declaration. Mr Puri provides details of the number of
15 garments sold under the mark, and explains how his company has advertised and promoted the mark. He declares that to the best of his knowledge and belief, no members of the public have ever been deceived into thinking that his company's garments originate from the Italian town of Sorrento. Finally, Mr Puri concludes by stating that his company intends to sell all articles of clothing for men, women and children under the trade mark.

20 That completes my review of the evidence filed in these proceedings.

Section 3(1)

I first consider the opposition in relation to section 3(1)(b) & 3(1)(c). This part of the Act reads:

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

- 25 (a)
(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
30 of goods or services,
(d)

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.

35 *Section 3(1)(b)*

No evidence has been brought forward to support the opponent's claim that the trade mark is devoid of distinctive character. In the absence of any evidence to the contrary, I find that the mark is distinctive for the goods specified; the opposition under section 3(1)(b) fails accordingly.

Section 3(1)(c)

This subsection excludes from registration those 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. The opponent's evidence does prove that there are a number of places with the name 'Sorrento'. In particular 'Sorrento' is the name of a town in Italy, a fact which the applicant does not dispute, but it is also the name of a village somewhere in Australia.

The applicant does not deny that Italy has a reputation as a geographical origin for clothing, but argues that Sorrento is not a particularly famous town in Italy. Indeed Mr Puri says that he was not aware of the existence of the Italian town of Sorrento until he received the notice of opposition in these proceedings.

More importantly for the purposes of my decision in these proceedings, there is nothing to suggest that the mark **may serve** in trade to designate geographical origin, particularly when used in relation to clothing. I am conscious that there are no obvious geographical or logistical obstacles preventing or discouraging the establishment of a clothing industry in Sorrento, Italy. Nevertheless it does not in my view follow that just because Italy in general has a reputation for clothing, every town in that country necessarily shares that reputation. For example, the evidence shows that Sorrento in Italy is noted for its wine and olive oil, and has a flourishing tourist industry, but there is no suggestion of any clothing manufacturers in or near the town. It is also not clear to what extent the public in this country is aware that Sorrento is the name of a place in Italy. The opponent's case rests heavily on Italy's reputation for fashion clothing and shoes, but without evidence that members of the public in this country recognise that Sorrento is the name of a town in Italy I cannot see that Italy's reputation for clothing assists the opponent. Neither does the evidence suggest to me any reason why the name of the town alone may be effective as a designation of geographical origin for clothes, not least because there are a number of places that share the same name. Consequently the opposition under section 3(1)(c) fails.

Section 3(3)(b)

I turn now to the opposition under section 3(3)(b). This section reads:

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

(a)

(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).

Beyond establishing that Sorrento is used as a place-name, most notably as the name of a town in Italy, the opponent has not filed any evidence to support the allegation that the mark in suit is of such a nature as to deceive the public as to the geographical origin of the applicant's goods - ie clothes. Mr Matthews does not say that he himself would be deceived as to the geographical origin of the goods, neither does he provide any evidence of others having been deceived, or being likely to be deceived. On the other hand, Mr Puri has declared that no instances of the public having been confused or deceived have come to his attention. As I have

stated above, it does not follow that because Italy has a reputation for clothing, the name of each and every town in Italy will be associated with that country's reputation in the mind of the public. In the case of major towns and cities (the example used by Mr Puri in his evidence is Milan), there is more likely to be an association with the country's reputation for clothing because the public is more likely to recognise the connection with Italy. But Sorrento has a population of only 7, 035; notwithstanding its tourist industry (which presumably increases public awareness) I am not persuaded that it attracts sufficient of Italy's reputation for clothing to suggest that the name 'Sorrento' is likely to deceive the public as to geographical origin. In the circumstances the opposition under section 3(3) fails.

10 *Section 3(6)*

The opposition under section 3(6) rests on an allegation that the applicant does not have a bona fide intention to use the trade mark on all the goods covered by the application. This is a requirement for an application to register a trade mark, and is found in Section 32(3). That is:

15 “(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a bona fide intention that it should be so used.”

The application form used in this case contains a signed statement that “the trade mark is being used by the applicant or with his consent in relation to the goods stated, or there is a bona fide intention that it will be so used.” Furthermore, in his statutory declaration, Mr Puri confirms that it is his company's intention to sell all articles of clothing for men, women and children under the trade mark, although at present only women's clothes are sold under the mark. Any challenge that this application was made in bad faith must be proven in evidence, and I can find no support for such a claim in the opponent's evidence. In the absence of evidence which proves otherwise, I can only conclude that the application was made in good faith. The opposition under section 3(6) fails accordingly.

The applicant, having been successful in these proceedings, is entitled to a contribution towards the cost of defending the application. I therefore order the opponent to pay to the applicant the sum of **£450**.

Dated this 9th day of June 1998

30 **Mr S J Probert**
Principal Hearing Officer
For the Registrar, the Comptroller-General