TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 1327860
BY MARIO VALENTINO S.p.A.
TO REGISTER A TRADE MARK IN CLASS 14

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 41790 BY VALENTINO GLOBE B.V.
(FORMERLY GLOBELEGANCE B.V.)

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DECISION

On 24 November 1987 Mario Valentino S.p.A of Napoli, Italy applied under Section 17(1) of the Trade Marks Act 1938 to register the trade mark shown below:-

in Class 14 in respect of the following goods:

> Jewellery, imitation jewellery; cuff links, tie pins; handicraft articles, ornamental articles, ashtrays, boxes for cigars, boxes for cigarettes, cigar holders, cigarette holders, all made of precious metals or their alloys or coated therewith; clocks, watches, cases for clocks and watches; all included in Class 14.

On 9th December 1994 Valentino Globe B.V. filed notice of opposition against the application. The opponents claim an international reputation in their trade mark VALENTINO, solus and in various other forms, and that registration of the applicants trade mark would cause deception and confusion and therefore be contrary to the provisions of Section 11 of the Act. They also asked the Registrar to exercise discretion in their favour.

The applicants filed a counterstatement denying the grounds of opposition and also seek the exercise of the Registrar's discretion. The applicants also stated in their counterstatement that the opponents were estopped from opposing the registration of this application by virtue of an agreement between the them and the applicants' predecessors in business.

Both sides seek an award of costs in their favour.

The matter came to be heard on 29 July 1998 when the applicants were represented by Ms. Denise MacFarland of Counsel, instructed by D. Young & Co. The opponents were represented by Mr.George Hamer of Counsel, instructed by G F Redfern & Co.

By the time the matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to

apply the relevant provisions of the old law to these proceedings. Accordingly, all references in this decision are references to the provisions of the old law unless otherwise indicated.

OPPONENTS EVIDENCE (RULE 49)

The opponents filed an Affidavit dated 5 August 1995 by George Frederik Nicolaï who is Managing Director of Valentino Globe B.V. (formerly Globelegance B.V.) a position he has held since 28 September 1989.

Mr. Nicolaï states that the opponents trade mark is derived from the name of Valentino Garavani who commenced designing and selling clothes and other products under the VALENTINO trade mark in Italy in 1959. Valentino Garavani or 'Valentino' as he became known showed his first collection of ladies' fashion in October 1959 and opened a showroom in Rome in 1960. His fashion shows were attended by buyers from the United Kingdom (including Debenham and Freebody) and other European countries. After 1960 Mr. Garavani's clothing achieved such popularity that he commenced holding regular fashion shows in Rome and New York.

Mr. Nicolaï goes on to state that his company was incorporated on 4 November 1968 for the purpose of licensing the VALENTINO name and trade marks. With the consent of Valentino Garavino and his design company, Valentino Couture (also known as Valentino S.p.A.), which is exhibited in Annex 1, Mr. Nicolaï's company commenced to register, use and license the rights of the VALENTINO name and trade marks in respect of clothing and accessories shortly afterwards.

Mr. Nicolaï states that clothing using the name VALENTINO, was first used on ladies' clothing sold at the top end of the market. This included dresses, gowns, blouses, suits, tailleurs, coats, shoes and accessories. This represented, and continues to represent, Mr. Garavani's "haute couture" range. In the mid 1960's Mr. Garavani expanded his business to include a second level of clothing products which were released by him as his VALENTINO collection. This line of goods, which were less expensive than the haute couture range of goods, was designed specifically for very high level speciality shops. By the late 1960's Mr. Garavani was also designing clothing for men which were sold at the top end of the men's fashion market. These products included suits, trousers, shirts, ties, sweaters, coats and shoes. By 1965 Mr. Garavani expanded his designing activities to include "ready-to-wear- clothing for women which was sold as the VALENTINO BOUTIQUE line, as well as a greater range of clothes for men.

In addition, Mr. Nicolaï states that fashion accessories including belts, shoes, socks, ties, jewellery, perfumes, watches, leather garments, leatherwear, sleepwear, underwear, wallpapers, fabrics, bathroom and other ceramic tiles and umbrellas have all been produced, advertised and promoted under the VALENTINO trade mark.

Mr. Nicolaï states that Mr. Garavani has been recognised from early in his career to the current time as one of the foremost fashion designers in the world. Mr. Garavani has received various awards both in Italy and abroad; he has had many famous clients. A copy of a detailed biography

of Mr. Garavani written to celebrate the 30th anniversary of Mr. Garavani as a designer is exhibited as Annex 2.

Mr. Nicolaï states that Mr. Garavani and his creative studio Valentino S.p.A. Rome have since 1968 continued to develop products to be sold by or through the opponent and its licensees under and by reference to the VALENTINO trade mark. The opponent has worked with Mr. Garavani to ensure the maintenance of the high prestige of the VALENTINO name and trade mark and the technical excellence of the garments sold under it.

Mr. Nicolaï states that the opponents are the registered proprietor of VALENTINO trade marks throughout the world. A list of the various trade mark registrations under which goods are sold in at least 48 countries in the world is exhibited in Annex 4. There are no registrations in respect of the VALENTINO trade marks in the United Kingdom. Due to an error an application for registration dated 18 March 1991 which was proceeding for the trade mark VALENTINO, in Class 14 in the name of another party, and which was assigned to the opponent with goodwill in the trade mark on 1st December 1994, was abandoned.

Mr. Nicolaï states that the exhibits at annexes 7 and 8, contain information about the use of the trade mark the subject of application no. 1458176 and supplied to the Trade Marks Registry, by the assignor of the application demonstrate that watches bearing the brand VALENTINO were sold from 1987-1991. Annexes 9 and 10 demonstrate that VALENTINO watches were sold in the United Kingdom by the Company's licensee "vb vogue bijoux" in 1986 and 1987. Annex 11 which is also an invoice demonstrates that VALENTINO jewellery was sold to the London Valentino Boutique in 1994.

Mr. Nicolaï says that VALENTINO products have been promoted by advertising throughout Europe, the USA and Canada in internationally circulating magazines such as: Vogue, Interview, L'Espresso, Epoca, Max, Grazia, M-The Civilized Man, Tatler, GQ, Harpers & Queen, Esquire, Arena, Figaro Madame, Harper's Bazar, Polo International, Smash Hit Parade, Class, Marie-Clare, Racing World, Elle, Time, Town & Country, Allure, W Europe. He exhibits at Annex 3 examples of these in relation to Class 14 goods. Those which are clearly in English are in respect of 'M' magazine in 1986 (that would appear to be a US magazine or edition); 'GQ' magazine of September 1986; 'W' magazine of February 1987. In the United Kingdom the following amounts were spent on promotion by the opponents' predecessor as proprietor of the trade mark the subject of the abandoned application for registration:

1988 £15,000
1989 £15,000
1990 £10,000
1991 £5,000

TOTAL £45,000

Mr. Nicolaï states that the sales figures of VALENTINO branded goods in Class 14 in the United Kingdom from 1987 to 1994 were as follows:

1987 £15000

1988 £60000
1989 £100000
1990 £75000
1991 £20000
1994 £4100
TOTAL £275100

They take into account (up until 1991) sales made by the previous owner of the trade mark.

Mr. Nicolaï finally states that by reason of the widespread activities of Mr. Valentino Garavani, the Valentino group of companies including the opponent and its licensees he believes that the VALENTINO trade mark under which the VALENTINO products are known and referred to internationally is and has for many years been extremely well and widely known and used throughout the world in the field of clothing and accessories, including in the United Kingdom.

THE APPLICANTS' EVIDENCE (RULE 50)

The applicants filed a Statutory Declaration from Mr. Vincenzo Valentino dated 26th September 1996. He is the Chairman of the Board of Directors of Mario Valentino S.p.A.. He has been involved with the company and its predecessors in various positions and capacities since the early 1970's.

Mr. Valentino states that his late father, Mario Valentino, was the main shareholder and a principal of Mario Valentino S.p.A. until his death on January 31, 1991. Mr. Valentino states that his father began his career as a shoe designer in the early 1950's. An extract from The New York Times (exhibit VV1) shows that his first major success was a coral sandal shown at a Rome fashion show in 1954. The sandal was shown on the cover of Paris Vogue in 1954 and is exhibited at the Matt Balley Shoe Museum in Switzerland.

Mr. Valentino states that his father adopted and began using his name Mario Valentino as well as Valentino as trade marks in relation to footwear in the early 1950's. In the 1960's he expanded his merchandise to include other leather goods such as handbags, wallets and luggage. His father shortly thereafter began designing and selling leather clothes such as coats, jackets, trousers, skirts and dresses. In the 1970's the range of goods expanded to include fashion apparel of other materials such as silk, jersey and linen and accessories such as belts, gloves, scarves and jewellery/imitation jewellery. In the late 1980's there was further expansion with women's and men's fragrances.

Mr. Valentino states that the goods referred to above have been sold worldwide under the trade mark MARIO VALENTINO per se or accompanied by other trade marks of the applicant.

Mr. Valentino states that his father's customers have included Jacqueline Onassis, Mrs. Mitterand, Sting and Sissy Spacek. An article from FN (Footwear News) is produced as exhibit VV3 identifying these persons as customers.

Mr. Valentino states that a great number of articles, biographies and similar literature has been written and published about his father, his business and his company in many countries.

Examples of these articles form exhibit VV 5. Mr. Valentino states that "Leaders in Fashion" (reproduced in exhibit VV 3) refers to Valentino Garavani whom he states started his activity at a later date to that of his father.

Mr. Valentino states that in 1973 his father, Mario Valentino, established a general partnership named Mario Valentino S.n.c to which his MARIO VALENTINO and other trade marks were transferred. A copy of the relevant notarial deed is given at exhibit VV 6. On December 12, 1979 Mario Valentino S.n.c was re-organised to form the present company, Mario Valentino S.p.A.. The relevant notarial deed is given at exhibit VV 7.

Mr. Valentino states that MARIO VALENTINO branded products are sold in many countries as well as the United Kingdom. The approximate worldwide sales figures in respect of the applicants' MARIO VALENTINO branded goods from 1985 to 1995 are as follows:

Year	Sales Figures (In Italian Lire)	Corresponding approximately to US$
1985	78,790 million	41,256,925.00
1986	122,006 million	81,879,374.00
1987	139,002 million	107,221,536.00
1988	176,329 million	135,466,795.00
1989	232,437 million	169,403,610.00
1990	250,697 million	209,215,786.00
1991	155,237 million	125,127,556.00
1992	249,331 million	202,210,003.00
1993	315,507 million	200,770,611.00
1994	317,900 million	197,239,025.00
1995	360,566 million	221,354,157.00

These figures relate to the prices charged by the applicants and the applicants' licensees to wholesalers and retailers. The sales figures to the public are approximately two or three times higher. Mr. Valentino states that consequent upon the above the approximate retail sales of MARIO VALENTINO products in 1995 are likely to have been in access of 500 million dollars.

Mr. Valentino states that MARIO VALENTINO products have been advertised extensively in a variety of fashion magazines having an international circulation such as Vogue, Harper's Bazaar, W, Interview, Gentlemen's Quarterly, Women's Wear Daily, Burda International, The New York Times, Elle and Allure. He states that the applicants and their predecessors have attended the most important shows in the fashion field in Italy and abroad. The total approximate amount expended by the applicant on advertising and promotional activities from 1985 to 1995, not including advertising and promotional activities by the applicant's licensees, is as follows:

Year	Amount (In Italian Lire)	Corresponding approximately to US$
1985	2,602,641,000	1,362,825.00
1986	2,976,833,000	1,997,781.00
1987	3,939,865,000	3,039,081.00
1988	3,435,654,000	2,639,481.00

1989	3,447,904,000	2,512,885.00
1990	3,024,782,000	2,524,291.00
1991	3,048,635,729	2,457,329.00
1992	2,048,910,864	1,661,688,00
1993	1,351,884,738	860,262.00
1994	4,766,588,201	2,957,399.00
1995	843,314,700	517,717.00

Copies of a few advertisements are given in exhibit VV 8. These include 'Vogue' of March 1993 and 'Next Fashion', both in English.

Mr. Valentino states that the trade mark MARIO VALENTINO has been registered extensively in Italy and elsewhere since the 1960's to cover the broad range of goods made by the applicant and /or its licensees; including the United Kingdom, France, Germany, Austria, Switzerland, Benelux, Denmark, Finland, Norway, Sweden, Ireland, Spain and Portugal. In the United Kingdom the applicant has registered the following trade marks:

Class	Trade Mark	Number	Date	
8	MARIO VALENTINO (script)	1260680	18.02.86	
14	MARIO VALENTINO (script)	1327860	24.11.87	(advertised)
18	MARIO VALENTINO	1256585	17.12.85	
18	VALENTINO	1324226	15.10.87	
21	MARIO VALENTINO (script)	1260682	18.02.86	
25	MARIO VALENTINO (script)	1069845	24.10.86	
25	MARIO VALENTINO	1256586	17.12.85	
25	VALENTINO	1324227	15.10.87	
34	MARIO VALENTINO (script)	1260683	18.02.86	

Mr. Valentino states that many of the registrations for the trade mark MARIO VALENTINO coexist in various countries with trade mark registrations of the opponent. He is not aware of any instances of actual confusion with products sold by the opponents under the trade mark VALENTINO. He states that in Milan the respective stores of applicant and opponent have been located for many years only a few metres from one another and this has not led to confusion.

Mr. Valentino states that the lack of actual confusion is due to the nature of the fashion industry. It is very common for designers to use names as trade marks and many designers have names which are similar and he refers to ANN KLEIN and CALVIN KLEIN as both being trade marks for clothing and accessories that originate from two independent internationally famous clothing designers. Products under the ANN KLEIN and CALVIN KLEIN trade marks are sold in the same shops and consumers are able to distinguish between them as the people who purchase the products clearly know the designer products they wish to purchase and would not mistakenly purchase one designer's fashion products. Mr. Valentino states that these products are at the upper end of the market and the retail cost of them is relatively expensive.

OPPONENT'S EVIDENCE IN REPLY (Rule 51)

The opponent filed a second statutory declaration by Mr. Nicolaï in reply to the applicant's evidence.

Mr. Nicolaï states that exhibit VV1 of the applicant's evidence emphasises the high risk of confusion between MARIO VALENTINO and VALENTINO as in the third paragraph of the article the following is written "Mr. Valentino who was not related to Valentino the dress designer."

Mr. Nicolaï states that although Mr. Mario Valentino's father's business was a luxury shoe business Mr. Valentino Garavani had started his activities prior to Mr. Mario Valentino and the latter benefitted from Mr. Garavani's fame; Mr. Mario Valentino extending his family business to leather goods, clothing, accessories, jewellery and perfumes as fast as Mr. Garavani's fame increased in the same fields.

Mr. Nicolaï states that no specific examples of sales or promotional expenses in the UK are given in the statutory declaration of Mr. Vincenzo Valentino.

Mr. Nicolaï states that in exhibit GFN1 examples of sales of the opponent's goods in Class 14 both worldwide and in the UK is given. It is assumed that he means the opponent's goods rather than the applicant's. He states that exhibit GFN 2 consists of photocopies and photographs of the goods referred to in GFN 1.

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

DECISION

Ms MacFarland referred to paragraph 5 of the Statement of Grounds of the applicant, which claims that the opponents and the applicants' predecessor had entered into an agreement recognising the applicants right to the use and registration of the trade mark the subject of Application No. 1327860 in the United Kingdom. It was claimed in the pleadings that this estopped the opposition to the registration of the mark in suit.

The agreement was not exhibited and no reference was made to it by either party in their evidence. Consequently I do not find that these opposition proceedings are subject to estoppel.

I turn therefore to the ground of opposition which is based upon Section 11 of the Act, which states:

> It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

The established test for grounds of opposition based upon Section 11 is set down in Smith Hayden & Co Ltd's application (1936 63 RPC 101) as adapted by Lord Upjohn in the BALI trade

mark case (1969 RPC 496). Adapted to the matter in hand, the relevant test may be expressed as follows:

> Having regard to the user of the trade mark VALENTINO is the tribunal satisfied that the mark applied for, MARIO VALENTINO (stylised), if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

There was no dispute between the parties that the goods covered by the applicants' and the opponents' trade marks were the same.

I go on therefore to consider whether the trade mark VALENTINO is confusingly similar to the trade mark in suit, in doing so I take account of the guidance set down by Parker J in Pianotist Companies application (1906) 23 RPC 777 at line 26 et seq, which reads as follows:

> You must take the two words. You must judge of 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 those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration.

In the pleadings and the evidence the trade mark VALENTINO is used by the opponents in various forms (see appendix A to this decision). However, I consider that in all the various forms the word VALENTINO is the distinguishing or essential feature of the marks.

In her submission Ms MacFarland submitted that the applicants trade mark was a full signature and, taking into account the inclusion of the word MARIO, that there was no danger of confusion with the opponents VALENTINO and V trade mark. I agree however, with Mr. Hamer and consider that if one takes that VALENTINO and V trade mark and compare it with the applicants' trade mark there is a danger of confusion. In doing so I take into account the comments made by Sir Wilfred Green M.R. in Saville Perfumery Ltd v June Perfect Ltd and FW Woolworth & Co Ltd (1941) 58 RPC 147 at page 162 line 2 et seq:-

> ".....traders who have to deal with a very large number of marks used in the trade in which they are interested, do not, in practice, and indeed cannot be expected to, carry in their heads the details of any particular mark, while the class of customer among the public which buys the goods does not interest itself in such details. In such cases the mark comes to be remembered by some feature in it which strikes the eyes and fixes itself in the recollection. Such a feature is referred to sometimes as the distinguishing feature, sometimes as the essential feature, of the mark."

and at page 162 lines 18-20

> "Now the question of resemblance and the likelihood of deception are to be considered by reference not only to the whole mark, but also to its distinguishing or essential features, if any."

I consider that the distinguishing features of the all marks in relation to these proceedings is the word VALENTINO. The applicant's trade mark is described as a signature, but the VALENTINO element is very clear and dominant.

Ms MacFarland, in order to make clear that any rights were in the trade mark as a whole, offered to voluntarily disclaim the word VALENTINO. But the entry of a disclaimer will not affect the issue of confusability. The Assistant Registrar stated in GRANADA 1979 RPC 13:-

> "As Lloyd-Jacob J. put it in Ford-Werke's application [1955] RPC 191 at 195 lines 30-38, a disclaimer does not affect the significance which a mark conveys to others when used in the course of trade. Disclaimers do not go into the market place, and the public generally has no notice of them."

I am of the view that a purchaser seeing VALENTINO in any of its various forms and seeing MARIO VALENTINO in the stylised form of the application would, unless educated otherwise, believe that MARIO VALENTINO was simply the full name of VALENTINO and so assume the goods were from the same source. Reference was made by the applicants to ANN KLEIN and CALVIN KLEIN co-existing. I do not consider that this example supports the argument that the trade marks in suit are not confusingly similar. I do not know how those trade marks co-exist and what is their history . Also the addition of the forenames gives greater distance between the marks. I think CHANEL represents a better exemplum of the potential confusability. If one saw the trade marks COCO CHANEL and CHANEL one would assume, in that case quite correctly, that the goods sold under them emanated from the same source. The purchaser would make the assumption that COCO was simply the forename of CHANEL and would be correct in that assumption.

However, the fact that the applicants' and the opponents' trade marks are prima facie confusable does not mean that the registration of the application in suit will cause deception and confusion I must consider the user of the opponents trade mark. The terms of Section 11 bar the registration of any mark disentitled to protection in a court of justice. In Kerly's "Law of Trade Marks and Trade Names", 12th edition (10-26) this scope of Section 11 is expressed as follows:-

> "This section is directed to some positive objection to registration and not to mere lack of qualification. It contemplates some illegality or other disentitlement in the mark itself."

In the view of the opponents this disentitlement in the trade mark applied for arises from the fact that their trade mark is so well known in relation to clothing, and goods associated with clothing and because of use of the trade mark in relation to Class 14 goods that use by the applicant will be such that deception and confusion will arise. The applicants have countered by stating that their trade mark is also well known in relation to clothing and goods associated with clothing and thus deception and confusion will not arise.

Both parties argue that the reputation from their original core business has expanded to encompass other goods and I am happy to accept that in this case the respective reputations of the parties have accrued to other goods. It is clear from the high street that some manufacturers of fashion items expand their brands into Class 3, 18 and 14 goods, amongst other areas of interest.

The evidence presented in this case (and not otherwise challenged) I think supports the international reputation of both the applicants and the opponents in respect of `designer' goods. Both can be described as fashion icons, but, the question arises as to how much, if any, of this reputation has been built up in the United Kingdom. In the Crazy Horse case (1967) RPC 581 and the Athletes Foot case (1980) RPC 343 the inability to demonstrate a reputation in the UK was fatal to the plaintiff's case. In this case there is very little evidence from either side of use in the United Kingdom. Mr. Hamer considered that the evidence supplied by the applicants did not support any such use in the United Kingdom. Ms MacFarland attacked the evidence of the opponent on the basis that it did not show use in the United Kingdom either. Mr. Hamer referred, however, to a passing off case brought by the opponents in 1973 [(1974) RPC 603 Globelegance B.V. v. Sarkissan] on the basis of their reputation in the United Kingdom. It can be questioned how relevant an action taken in 1973 is to this action, so many things could have changed in the intervening years. The case in question certainly did not demonstrate a great deal of use in the United Kingdom at the time of the action. As no evidence has been put forward to show continuing use since 1973 in the United Kingdom or the scope of any such use. I do not consider that that case assists me greatly in the current action.

Both sides it seems to me have sought to bring to the Tribunal's attention their 'international' reputation but I am faced with a paucity of evidence from both sides in relation to use, and therefore reputation, in the jurisdiction. The likelihood of confusion must be considered at the date of the application to register - McDowell (1927) 44 RPC 335 and Dixon v. Taylor (1933) 50 RPC 405. This further restricts the evidence of use in the United Kingdom furnished in these proceedings. The opponents have declared sales figures of £15,000 in 1987 and £60,000 in 1988 and advertising figures in 1988 of £15,000, deriving from the use by the previous owner of the trade mark the subject of application no 1458176. From the figures I am not able to ascertain how much of those 1988 figures occurred before 24th November 1987 but I think it reasonable to assume that at least some of the sums expended occurred prior to the relevant date.

Ms McFarland submitted that there was no evidence of actual use in the United Kingdom by the opponents, of the trade mark, only on invoices and there was no indication that voguebijou srl, from whom the invoices were issued, had any relationship to the opponent. In that connection, I note that the invoices, exhibited at Annexes 9 and 10 of the opponent's evidence show that the goods are described as "VALENTINO watches" and that they are dated within the relevant time period.

The invoices reflect the fact that watches were sent to the VALENTINO boutique in London. I find it difficult to believe that the VALENTINO boutique in London would sell VALENTINO goods which had not been so licensed. Therefore, taking into account the evidence and the exhibits I find that there has been use of the trade mark VALENTINO by the opponent before the relevant date in relation to watches. But, it seems to me, the scale of that use is not significant. Not least because the majority of the sales were in relation to a market which differs significantly from that which is occupied by the opponent i.e. the top end of the market. In this respect I note that the sales in the years 1987 and 1988 were made in a number of department stores and through the Great Universal Stores mail order catalogue. I am not therefore convinced that the relatively small volume of sales achieved through those outlets in the relevant period would actually accrue to the reputation of the opponents. That leaves the sales through the VALENTINO boutique in London as demonstrated by the invoices. Again the amounts are not significant. However, the presence of the boutique does indicate a use and presence of the trade mark VALENTINO in the United Kingdom. But as I am not given any details relating to the turnover of that particular retail outlet over any period of time I am unable to judge therefore whether it is significant in terms of the opponents' reputation.

The applicants, on the other hand, place significant weight behind the tranche of trade marks they have registered in the United Kingdom in order to suggest that they too have a reputation. As they are on the Register these registrations are valid but, in the circumstances of this present case, it does not demonstrate to me that the applicants have a specific reputation in the United Kingdom.

In the absence of any compelling evidence from either party to these proceedings, I am unable to judge whether either the applicant or the opponent has a reputation in the United Kingdom for either the goods covered by the application in suit or indeed more generally. Thus I am unable to deduce that the opponents have a reputation in the United Kingdom such that if the trade mark of the applicants is used in a normal and fair manner in connection with any goods covered by the registration proposed, it will be reasonably likely to cause deception and confusion amongst a substantial number of persons. Before Section 11 can be applied it must be established that the opponents' trade mark is known to a substantial number of persons in the United Kingdom (see NOVA (1968) RPC 357 at 360.

It seems to me from the evidence filed that both the applicants and the opponents have an international reputation and that, within the market that they serve, purchasers and would-be purchasers are able to distinguish the applicants' goods from those of the opponents. In that respect, I note that in his evidence Mr Vincento Valentino, on behalf of the applicants, states that in Milan the respective stores of the applicants and the opponents have been located for many years only a few metres from one another and that this has not led to confusion. This statement is not challenged in any way by the opponent. Therefore, despite the fact that it demonstrates respective uses of the trade marks in another jurisdiction and I have no indication what the trading arrangements are in Italy, I take the view that if the parties can live alongside one another in a major fashion and fashion accessory centre such as Milan, then it is unlikely that they would have any difficulty in doing so in the United Kingdom. In the result, since it has not been demonstrated that the opponent's trade mark is so well known in the United Kingdom that registration of the trade mark in suit would be contrary to the provisions of Section 11, the opposition under that Section fails.

Insofar as the Registrar's discretion is concerned, in view of my findings I do not consider it appropriate to exercise it in this case.

The applicants having succeeded in these proceedings I order the opponents to pay them the sum of £650 as a contribution towards their costs.

Dated this 3 day of September 1998

M KNIGHT
For the Registrar
The Comptroller General

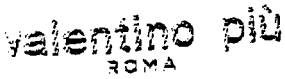
APPENDIX A.


valentino
uomo
roma italy


VALENTINO
BOUTIQUE


valentino
uomo
roma italy


valentino
UOMO


valentino più
ROMA


valentino


VALENTINO
COUTURE