

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2142181
BY DANELLA FASHION LIMITED
TO REGISTER A TRADE MARK IN CLASSES 18 & 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 49539
BY ZAPA FASHION GROUP GMBH

BACKGROUND

1) On 15 August 1997, Danella Fashion Limited of Unit 6, Bow Triangle Business Centre, Eleanor Street, London, E3 4UR applied under the Trade Marks Act 1994 for registration of the mark DAPA in respect of the following goods:

In Class 18: "Imitation leather goods".

And

In Class 25 "Imitation leather jackets, skirts and trousers".

2) The mark proceeded because of distinctiveness acquired through use.

3) On the 2 March 1999 Zapa Fashion Group GmbH of Grunberger Strasse 54, D-10245 Berlin, Germany filed notice of opposition to the application, subsequently amended. The amended grounds of opposition, are in summary:

a) The opponent is the proprietor of three Trade Marks (detailed at annex A) for the word ZAPA. The opponent changed its name from Christian Frieser GmbH, to Zapa Fashion Group GmbH on 4 January 1999.

b) The mark applied for is phonetically identical or equivalent to the word "Dapper" and is therefore contrary to Section 3(1) of the Trade Marks Act 1994.

c) The opponent and its predecessors in title have used the mark ZAPA extensively in the UK. The mark applied for therefore offends against Sections 3(4), 3(6), 5(2), 5(3), & 5(4) of the Trade Marks Act 1994.

d) The applicant has filed insufficient use to establish honest concurrent use in terms of Section 7(1) and (3) and therefore the mark should be refused under Section 7(2).

4) The opponent further requested that the Registrar refuse application number 2142181 in the exercise of her discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as she did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects

5) The applicant subsequently filed a counterstatement denying the opponent's claims and claiming that they have used their mark for almost fifteen years prior to seeking a registration.

6) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The

matter came to be heard on 9 August 2001 when the applicant was represented by Dr Asjadi of the applicant company, and the opponent by Dr Ackroyd of Messrs W P Thompson & Co.

OPPONENT'S EVIDENCE

7) The opponent filed a declaration, dated 7 December 1999, by Joachim Heimrich the manager of the opponent company. He states that he is fully conversant with the English language.

8) On 4 January 1999 the opponent company changed its name from Christian Frieser GmbH to its current title. A change of name certificate is provided at exhibit JH1.

9) Mr Heimrich states that the mark ZAPA was first used by his company in the UK in 1990. It has been used on a wide range of clothing items including inter alia shirts, trousers, blouses, dresses, blazers, suits, coats, sweaters, , skirts and t-shirts. Sales figures for goods covered in the specification of trade mark 1251095 and sold in the UK under the ZAPA mark are provided in DM, which I have converted. The figures are as follows:

Year	£ approximately
1991	463,350
1992	550,703
1993	244,018
1994	182,301
1995	114,255
1996	55,386
1997	57,602

10) At exhibit JH3 Mr Heimrich provides copies of invoices for goods supplied to various UK retailers for the years 1991 - 1999. The invoices all have the mark ZAPA at the top of the page and there are references to a wide range of garments. He also provides, at exhibit JM4, examples of ZAPA labels which he states were sewn into the garments.

11) At exhibit JH5 Mr Heimrich provides copies of advertisements placed in fashion magazines which he believes were available in the UK. The magazines all appear to be in German or Italian. A brochure dated 1990 in English is provided and shows photographs of female models in various outer garments.

12) Mr Heimrich comments that the goods of the two parties are similar if not identical. He also exhibits at JH6 an affidavit sworn by a director of the applicant company stating that the applicant first used their mark on jackets and skirts in the UK in 1986 with use on trousers beginning in 1996. Mr Heimrich notes that no figures were given for total sales in these years. He casts doubts on the assertions in the affidavit and notes that it refers to events which took place some eight years before the person swearing the affidavit took up office in the applicant company.

APPLICANT'S EVIDENCE

13) The applicant filed an affidavit , dated 8 June 2000, by Dr Ahmad Mohammadi a Director of the applicant company, a position he has held since 1986.

14) Dr Mohammadi provides, at exhibit 4 & 5, examples of main labels, swing labels, hanger labels and garment covers used on garments by the applicant company since 1986. These all show the mark DAPA prominently. At exhibits 4,6,7,8 &9 photographs of various jackets are provided all with a DAPA label clearly visible.

15) Dr Mohammadi claims that the parties are in different markets as the applicant deals almost exclusively in imitation leather jackets whereas the opponent deals in what might be termed "high fashion". He provides turnover figures relating to sales under the DAPA mark in the UK as follows:

Year	£
1991	2,131,526
1992	1,248,000
1993	437,097
1994	487,456
1995	588,662
1996	293,834
1997	528,633

16) Invoices from February 1997 - October 1999 are provided at exhibit 3 and show sales mostly of jackets to a variety of retailers in the UK. The invoices do not refer to DAPA.

17) At exhibit 2 a copy of a company registration certificate dated March 1995 is provided and shows the registration of a company called Dapa International Limited.

18) That concludes my review of the evidence. I now turn to the decision.

DECISION

19) The first ground of opposition is under Section 3(4) which reads:

3. (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.

20) At the hearing Dr Ackroyd sought to rely upon Section 3(4) in relation to a claim that use of the applicant's mark would amount to passing off. I do not accept this approach. Section

3(4) is derived from Article 3(2)(a) of the Directive 89/104 which reads:

“3(2) Any Member State may provide that a trade mark shall not be registered or, if registered, shall be liable to be declared invalid where and to the extent that:

(A) the use of that trade mark may be prohibited pursuant to provisions of law other than trade mark law of the Member State concerned or of the Community,…”

21) I also note that the Section is annotated with the words “Absolute grounds”, thus precluding a comparison with other trade marks. The opponent did not file any evidence other than on relative grounds, and so the opposition under this section fails.

22) The next ground of opposition is under Section 3(6) which states:

“ A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

23) The Act does not define the term bad faith, leaving it to the Tribunal or the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

(i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;

(ii) where the applicant was aware that someone else intends to use and /or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

(iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

24) I also take account of the views of Lindsay.J. in *Gromax Plasticulture Ltd v Don and Low Nonwovens Ltd* (1999 RPC 367 at page 379) where the learned judge said:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

25) It is well established that in an opposition under Section 3(6) of the Act the onus is on the opponent, reflecting the usual approach under English law that he who asserts must prove.

26) An allegation that the applicant should have been aware of the earlier trade mark, which the opponent considers similar to the applicant's trade mark in suit, is not sufficient to sustain an objection to registration under this head. The applicant in this case has denied the allegation and the opponent on whom the onus rests has provided no evidence. Therefore the ground of opposition based on Section 3(6) is dismissed.

27) I next consider the grounds of opposition under Section 1(1) and 3(1) of the Act.

28) Section 1(1) of the Act is in the following terms:

“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.”

29) Section 3(1) of the Act is in the following terms:

3 (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.

30) There is no suggestion that the mark is not represented graphically so the objection relates to the inherent capacity of the mark to distinguish the applicant's goods. The question is whether the word DAPA can perform the function of a trade mark. In considering this question I have regard to the comments of Aldous L.J. in *Philips Electronics NV v. Remington Consumer Products Ltd* [1999 RPC 809 at 818]:

“The more the trade mark describes the goods, whether it consists of a word or shape, the less likely it will be capable of distinguishing those goods from similar goods of another trader. An example of a trade mark which is capable of distinguishing is

WELDMESH, whereas WELDED MESH would not be. The former, despite its primary descriptive meaning, has sufficient capricious alteration to enable it to acquire a secondary meaning, thereby demonstrating that it is capable of distinguishing. The latter has no such alteration. Whatever the extent of use, whether or not it be monopoly use and whether or not there is evidence that the trade and public associate it with one person, it retains its primary meaning, namely mesh that is welded. It does not have any feature which renders it capable of distinguishing one trader's mesh from another trader's welded mesh."

31) I also have regard to the comments of Morritt L.J. in the *Bach and Bach Flower Remedies Trade Marks* case [2000 RPC 513 at page 526 line 10]:

"The question is whether or not the word BACH had, by 1979, acquired such a meaning so as to be incapable, without more, of affording the requisite distinction. If it had then section 1(1) is not satisfied, the word BACH cannot be a capricious addition so that registration of the sign would be in breach of paragraph (a); if it had not then the word BACH is an addition to the words FLOWER REMEDIES which is 'capricious' because it is not purely descriptive, so that both the expression BACH FLOWER REMEDIES and the word BACH are capable of affording the necessary distinction. Accordingly I accept the submission that it is both permissible and necessary in considering the application of paragraph (a) to determine the meaning of the word as used at the time of the application for registration. I do not understand Aldous L.J. in *Philips v. Remington* in the passage I have quoted, to have been considering the relevance of use to the meaning of the word."

"The usage in question must be by those engaged in the relevant trade or activity. Normally that will be the usage of the average consumer of the goods in question as described in *Lloyd Schuhfabrik* [European Court of Justice, *Lloyd Schuhfabrik Meyer v. Klijsen Handel BV* 1999 ETMR 690]. Obviously the evidence on that question is not limited to those who are consumers or end-users but may extend to others concerned in the trade such as manufacturers, wholesalers and retailers."

32) I am not convinced that the term DAPA is so descriptive that I can say now that the applicant will never be able to educate the public to regard the term as a trade mark denoting only its goods or services. The term therefore passes the "soap for soap" test of Section 1(1) and 3(1)(a).

33) The opponent has claimed that the mark in suit is phonetically identical to the dictionary word "Dapper" and as such it is a laudatory word when used on clothing. At the hearing Dr Ackroyd claimed that the word "dapper" had a dictionary definition of "neat and spruce in dress and bearing". No evidence has been put forward showing that the word "dapper" is used in everyday speech to describe articles of clothing. In my opinion the word "dapper" is more appropriate to describe a person rather than an article of clothing. The meaning of the word clearly relates to the whole demeanor of the individual. It is also an old fashioned term and one normally used in relation to small, nimble individuals. Further, the mark DAPA is not simply a trivial mis-spelling of DAPPER. I doubt whether the average consumer would see any connection. No other evidence has been filed to show that the mark serves in trade to designate kind, quality etc. Nor has evidence been put forward to show that the mark in suit has become customary in the current language of the trade.

34) The opposition under Sections 3(1) and 3(3) therefore fails.

35) The next ground of opposition is under Section 5(2)(b) of the Act which states:-

*5.- (2) A trade mark shall not be registered if because -
(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 mark is protected,*

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

36) An earlier right is defined in Section 6, the relevant parts of which state

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 marks,

(b)...

(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 as a well known trade mark.”

37) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel Bv v Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

38) It was common ground at the hearing that the goods of the two parties in both classes 18 and 25 are identical. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

39) Visually the marks differ only in that the initial letter of the applicant's mark is a "D" whereas the opponent's mark begins with a "Z". However, it is accepted that particularly in short trade marks differences in the initial letter of a word is very significant.

40) Phonetically the marks have common endings. Both are two syllable words "DA - PER" and "ZZA-PER". Dr Ackroyd contended that phonetically "D" and "Z" were almost identical. I cannot concur with this assertion. To my mind they are quite different.

41) Conceptually, the opponent's mark has overtones of energy and vigour. The opponent contended that the applicant's mark draws to mind connotations of a neat or spruce bearing and image. I have already found in this decision that this would not occur to the average consumer. However, for the purposes of the global comparison I will accept this contention as it provides the opponent with a stronger case.

42) Items of clothing are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even so allowance must be made for the notion of imperfect recollection.

43) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, but it is an inherently strong mark. I must also take into account the dictum of imperfect

recollection.

44) With all of this in mind I come to the conclusion that when all factors are considered, that there was no realistic likelihood of confusion at 15 August 1997. Consequently, the opposition under Section 5(2)(b) fails.

45) I next consider the grounds of opposition under Sections 5(3) & 5(4) which read:

5 (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

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the 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.

46) It is claimed that the public would be confused as to the source of the applicant's goods believing them to originate from the opponent. The opponent states that their products are well-known in the UK. However, the evidence provided does not substantiate this claim. The opponent's sales in the four years prior to the application were approximately £100,000 per annum. Although no evidence has been provided as to the total size of the market for clothing in the UK it would clearly run in many millions.

47) I have already compared the two marks and found the opponent's mark ZAPA is not similar to the applicant's mark DAPA. In my view the lack of similarity will prevent the public believing that the products of the applicant originate from the opponent. The opposition under Section 5(3) and 5(4) therefore fail.

48) Given the above findings I do not have to consider the applicant's claim to honest concurrent use.

49) At the hearing Dr Ackroyd sought to have the applicant's specification restricted to "Imitation leather jackets." This contention was based upon the offer of the applicant to reduce their specification in return for the opponent withdrawing their action. Also at the hearing the applicant stated that their main interest was in jackets. However, in the context of the statement I took this to be a plea that if I were to find against them under Sections 5(2)-(4) that I should consider the evidence of honest concurrent use for jackets under Section 7. I therefore see no reason to restrict the specification applied for by the applicant.

50) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1535. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4 day of September 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
ZAPA	1251095	27/9/85	25	Blouses, shirts, skirts, jackets, sweaters, trousers, coats, cardigans, dresses, suits, blazers, scarves, shawls, neckerchiefs; belts and gloves, all being articles of clothing.
ZAPA	1370953	23/1/89	3	Perfumery, essential oils, cosmetics, toilet soaps, hair lotions, dentifrices; all included in Class 3.
ZAPA	1474047	22/8/91	18	Bags, handbags, travelling bags, shopping bags of leather or imitation leather, trunks, purses, wallets and luggage, parts and fittings for all the aforesaid goods; all included in Class 18.