

**TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION NO 2205983
BY A. SOBTI
TO REGISTER THE TRADE MARK:**



**IN CLASS 25
AND
IN THE MATTER OF OPPOSITION THERETO UNDER NO 50642
BY EDWIN CO. LTD
BASED UPON THE EARLIER RIGHT:
FIORUCCI *inter alia***

TRADE MARKS ACT 1994
IN THE MATTER OF Application No 2205983
by A. Sobti
to register the trade mark:



in class 25
and
IN THE MATTER OF Opposition thereto under No 50642
by Edwin Co. Ltd

Background

1) On 16 August 1999 A Sobti applied to register the above trade mark.

The application was published on 20 October 1999 with the following specification:

clothing; footwear

2) On 20 January 2000 Edwin Co Ltd of Tokyo, Japan filed notice of opposition to this application.

The opponent bases his opposition on sections 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994. In relation to section 5(4)(a) the opponent claims that use of the trade mark in suit would be prevented by virtue of the law of passing-off. The opponent claims that he has acquired extensive goodwill and reputation in relation to the goods encompassed by his earlier registrations.

In relation to the section 5(2) and 5(3) grounds of opposition the opponent relies upon the following earlier registrations of the trade mark **FIORUCCI**: United Kingdom trade mark registration numbers 2008391, 1154825, 1119863, Community trade mark registration no 367250. He also relies upon Community Trade Mark registration no 709006 of **ELIO FIORUCCI**.

3) The applicant filed a counterstatement denying the above grounds.

4) Both sides seek an award of costs.

5) The opponent filed evidence to substantiate his claim to reputation and goodwill. Owing to my findings below I do not consider it necessary to summarise the evidence adduced by the opponent.

6) The matter came to be heard on 12 February 2002. The opponent was represented by Ms Arenal of Mewburn Ellis. The applicant requested the hearing but, in the end, filed written submissions in lieu of attending.

Decision

7) I consider that the opposition before me can be determined under section 5(2)(b) of the Act. I also consider that the opponent's strongest case lays with Community Trade Mark registration no 367520 of the trade mark FIORUCCI. Consequently I have decided to consider the matter under this head only.

8) The relevant provision is as follows:

Section 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 trade 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.

The term 'earlier trade mark' is defined in section 6 of the Act as follows:

"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."

9) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik 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 Schuhfabrik 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-Mayer 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-Mayer Inc* page 9 paragraph 29.

Comparison of goods

10) The earlier registration includes, inter alia, the following goods: *clothing articles, footwear, headwear*. The specification of the application in suit is for: *clothing, footwear*. Therefore the specification of the application in suit is completely encompassed by that of the earlier registration. The goods are, therefore, identical.

Comparison of signs

11) The signs to be compared are:

Earlier registration:

FIORUCCI

Application:



12) I consider that the only phonetic difference in normal usage will occur in relation to the first vowel of the trade mark in suit and the first two vowels of the earlier registration. I consider that in normal oral usage the presence of two “r’s” in the trade mark in suit will not have a different sound to the one “r” in the earlier registration. In considering the respective trade marks in their entireties I consider that the phonetic difference between them is minimal and that phonetically they are highly similar. The applicant in his written submissions stated that the trade mark in suit would be pronounced FUROOCHEE and the earlier registration FEARUCHEE. He gives no explanation as to why the letter “u” should be pronounced differently in the respective trade marks. I cannot see why it should be. Ms Arenal submitted that even if I accepted the pronunciations proffered by the applicant that the respective signs are still phonetically similar. I agree with her. I also note, from his submission, that the

applicant gives the “ch” sound to the double “c”. This reflects an Italian way of pronouncing the respective trade marks. I believe this reinforces the view I express in paragraph 13 below.

13) I consider that both trade marks have the “flavour” of Italian surnames; whether they are or are not. This is especially the case owing to the reputation of Italy in relation to clothing and footwear. The combination of the goods and the respective trade marks is likely to lead the average consumer to consider the respective signs as Italian surnames.

14) There is a limited stylisation of the trade mark in suit. However, I consider that nothing turns upon this. Both trade marks begin with the same letter and end with the same five letters. I consider that visually the trade marks are similar.

15) Consequent upon the above I consider that the respective trade marks are highly similar.

Conclusion

16) No evidence has been submitted to indicate that the earlier registration is not distinctive. In *Lloyd* the European Court of Justice stated:

“In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).”

On the facts before me I consider that the earlier registration has a greater capacity to identify the goods of the opponent and so has a high degree of inherent distinctiveness.

17) In considering whether there is a likelihood of confusion I take into account the following factors:

- interdependency principle – as the respective goods are identical less similarity between the signs could lead to the likelihood of confusion
- distinctiveness of the earlier trade mark – I have decided that the earlier registration is inherently distinctive – again this increases the possibility of confusion
- imperfect recollection – the public seldom compare trade marks side by side. In the instant case both trade marks, for the average citizen of the United Kingdom, are unusual words which have no ready “hook” to hang onto the memory. I consider that this increases the dangers of confusion through imperfect recollection.

18) I take no cognisance of the statements of Mr Jones and Mr Corre, adduced in the evidence of the opponent, as to the likelihood of confusion. Expert witnesses “are experts in the market, not on confusing similarity” – *European Limited v The Economist Newspaper Ltd* 1998 FSR 283 at 291. It is for me to decide if the signs are similar and if there is a likelihood of confusion.

19) In considering the issues before me I have borne in mind especially the following from *Sabel* :

“shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

20) Taking into account all the above I have no doubt that there is a likelihood of confusion. The opponent does not need to pray in aid to reputation as his case is so strong without it. For this reason I have not dealt with the evidence filed in relation to the opponent’s reputation. This evidence could not have lessened the strength of the opponent’s case. The applicant has argued that “purchasers of footwear are generally discerning customers who can easily distinguish between brands”. This ignores the fact that the specification of the application in suit is not only for footwear. It is also rather a bald statement. Purchasers of footwear will be virtually the entire population. Some may be circumspect, others are unlikely to be so. The argument also ignores the process of imperfect recollection and that the purchaser is unlikely to be in a situation where he is directly comparing the respective trade marks. In the instant case the signs are so similar that I find it difficult to envisage how in normal and fair usage confusion would not take place.

21) The opponent could do no better under the other heads of opposition. I, therefore, will say no more about them.

22) The application in suit is, therefore, to be refused in its entirety.

23) Ms Arenal made submissions as to the costs which should be awarded. She submitted that she wished to draw to my attention the conduct of the applicant. In particular she noted that the applicant requested extensions of time to file evidence and then decided not to file evidence without any explanation. She stated that, therefore, the proceedings had been extended needlessly. She also submitted that the opponent would have been content with a decision from the papers but that the applicant had requested a hearing. I cannot see that the requests for extensions of time to file the evidence would have put the opponent to any great expense. I, therefore, do not consider that costs off the scale should be awarded in relation to the requests for extensions of time by the applicant.

24) Rule 54(1) of The Trade Marks Rules 2000 states:

“Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard.”

The scale of costs includes a sum for preparation for and attendance at hearings and so this matter is dealt with under the scale. The applicant has a right to be heard in proceedings before the registrar (see above – rule 54(1)). I cannot see that it can be correct to penalise him for exercising that right. However, the matter does not rest there. The hearing officer, then responsible for the case, had written to the parties on 21 August 2001 advising them that he was of the view that the case could be decided from the papers. It is a view that I also would

have taken. The applicant responded that he wished to attend a hearing to make submissions. This was his right and was acceded to. The opponent did not comment upon the letter. The letter advised that if no request for a hearing was made a decision would be made from the papers. The opponent's representative advised in her submissions that the opponent would have been content for a decision from the papers. I have no reason to doubt that this was the case, especially as the opponent did not respond to the letter of the Office. The parties were advised on 5 December 2001 that the hearing would take place on 12 February 2001. On 11 February 2002 the applicant advised the Office and the opponent that he would not be attending the hearing but relied on written submissions instead. By this time the skeleton argument of the opponent had been received; it was received on 8 February 2002. To cancel the hearing at this short notice would have been likely to cause more expense and delay for the opponent. It would be reasonable to expect that if relying on written submissions the opponent would wish to file a more detailed case than that in the skeleton argument, which would be supported and fleshed out by oral submissions, as was the case. The opponent would have prepared for the case, as evidenced by the submission of the skeleton argument. The actions of the applicant put the opponent to pointless expenditure in both time and money. In these circumstances I consider that it is only fair and equitable that the opponent receives a reasonable sum in relation to the cost of preparing for and attending the hearing. At the hearing, in relation to Ms Arenal's submissions, I indicated that I was not willing to go off the scale in relation to the costs. However, I was willing to allow up to the maximum of the scale for the costs in relation to the hearing – this being an "old" costs case this is £900. I, therefore, advised Ms Arenal that I would allow costs up to a maximum of £900 subject to her submitting a written submission within two weeks in relation to the costs incurred. I advised that in relation to the hearing I would award either the actual costs if they were under £900, if they were over £900 that would be the ceiling. A similar approach was adopted by Mr Thorley QC, sitting as the appointed person, in BL 0/018/02. If the applicant had exercised the right he had demanded I would not have followed this course of action. To do so would be to place a de facto penalty for exercising the right. However, where the right has been allowed and then a party at the last moment decides to waive it, so placing extra costs on the other party, I consider that the inconvenienced party should be compensated for the needless costs that they have incurred.

25) On 13 February 2002 I received a letter from Ms Arenal giving details of the costs for the preparation and attendance at the hearing. These came to a total of £959. I will, therefore, award £900 to the opponent in respect of the costs of the preparation and attendance at the hearing. **Taking into account the other costs of the opponent I order the applicant to pay the opponent the sum of £1435 in total.** This sum is 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 18 day of February 2002

**D.W.Landau
For the Registrar
the Comptroller-General**