

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

**IN THE MATTER OF APPLICATION NO 1547824
BY SULEMAN TAHIR TO REGISTER THE MARK
VISACHI IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO 42837 BY GIANNI VERSACE S.p.A.**

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

5

**IN THE MATTER OF Application No 1547824
by Suleman Tahir to register the mark
VISACHI in Class 25**

10 **and**

**IN THE MATTER OF Opposition thereto under
No 42837 by Gianni Versace S.p.A.**

15

DECISION

20 On 13 September 1993 Suleman Tahir of Manchester applied under Section 17 of the Act to register the mark VISACHI for a specification of goods which reads “articles of outerclotthing for men, women and children; all included in Class 25”.

The application is numbered 1547824.

25 On 19 July 1995 Gianni Versace S.p.A. filed notice of opposition to this application. The grounds of opposition are in summary as follows:

- under Sections 9 and 10 of the Act (no further particularisation provided)
- 30 - under Section 11 by reason of the use of the trade marks details of which are given in Annex A to this decision. Full details are given of registrations in Class 25 (the most relevant Class). Brief details only of other registrations have been included to indicate the range of goods classes covered
- 35 - under Section 12 by reason of the registration of the trade marks referred to above
- under Section 68 in that the application is “not being used as a trade mark by the applicant”
- 40 - under Section 17 in that the applicant is not the true proprietor of the mark.

45 The opponents also say that the applicant had no bona fide intention to use the trade mark and, therefore, registration should be refused under Section 26. As the latter Section deals with circumstances in which a mark can be removed from the register it can play no part in

opposition proceedings and I need say no more about it. Finally the opponents ask for the application to be refused in the exercise of the Registrar's discretion.

5 The applicant filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour. Only the opponents filed evidence. Neither side has asked to be heard. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

10 By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994.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 the later parts of this decision are references to the provisions of the old law.

15 Opponents' evidence

The opponents filed two declarations. The first is by Santo Versace, the President of Gianni Versace.

20 Mr Versace describes the opponents' business as marketing and sale of a wide range of products, including in particular (but not limited to) articles of clothing, fabrics, fashion accessories, leather goods, handbags, luggage, jewellery, watches, glasses and sunglasses, perfumery, cosmetics and toiletries.

25 He describes in some detail the history of the Versace companies and supports this with Exhibits SV1 and SV2 being respectively biographical notes of Mr Gianni Versace's life and 'The Versace Story'.

30 Mr Versace says that the opponents enjoy a substantial international reputation as evidenced by the following sales figures for goods under the GIANNI VERSACE and VERSACE brands

(a) Worldwide sales: GIANNI VERSACE and VERSACE brands

	Italian lire
	1992 220,499,000,000
	1993 216,168,000,000
	1994 293,622,000,000
40	1995 439,560,000,000
	1996 (estimated) 572,411,000,000

45

(b) UK sales: GIANNI VERSACE and VERSACE brands

	1992	10,086,000,000
	1993	9,784,000,000
5	1994	11,023,000,000
	1995	19,803,000,000
	1996 (estimated)	24,040,000,000

Expenditure on advertising and promotional activity is said to have been as follows:

10

(i) Worldwide expenditure: GIANNI VERSACE and VERSACE brands

	1993	12,600,000,000
	1994	16,600,000,000
15	1995	20,500,000,000

(ii) UK expenditure: GIANNI VERSACE and VERSACE brands

	1993	737,924,000
20	1994	947,611,000
	1995	1,082,301,000

He lists the markets worldwide where goods have been sold under the marks. He exhibits at SV3 a list of the international fashion magazines and other publications which have carried VERSACE advertising. I note that in the United Kingdom this includes Arena, Elle, Esquire, GQ, Harpers and Queen, Marie Claire, the Sunday Times, Tatler, Vanity Fair, Vogue and World International. Sample advertising from these magazines is exhibited at SV4.

Mr Versace goes on to say that the opponents hold four fashion shows each year in Milan and participate in other international fashion shows and exhibitions which are reported by the international fashion press. A list of such Exhibitions along with other supporting material is exhibited at SV5. I note that attendance at shows in this country goes back to 1985. As a result of all this he concludes that the opponents have a substantial reputation both internationally and in the UK. He concludes with a number of observations on the applied for mark VISACHI and the fact that its use will lead to confusion and deception. He says

35
40
“Indeed, having regard to the long and extensive use by the Opponent of the trademarks VERSACE and GIANNI VERSACE, and to the consequent reputation and goodwill which the Opponent enjoys, it seems to me that the adoption, proposed use and/or use, and registration by the Applicant of the trademark VISACHI was the result of a conscious decision to trade upon the opponent’s goodwill and reputation in the name VERSACE and in all associated trademarks.”

The second declaration comes from Salim Kamourieh, a Director of Gorland Corporation. He is the agent/distributor for most of the Versace products in the UK and has 24 years experience in the fashion industry. He says that he knows the VERSACE ranges of fashion

45

items and is aware that the trade mark VERSACE has been used in this country for at least fifteen years (his declaration was made in October 1996).

That concludes my review of the evidence.

5

The opponents have not particularised their objection under Sections 9 and 10 and so far as I can see there is no evidence bearing directly on the matter of the distinctiveness of the mark. In the circumstances I do not need to deal with these grounds other than to say that I can see no reason for overturning the decision reached during the examination process in the Registry.

10

The main objections are under Sections 11 and 12 of the Act which read as follows:

15

“11 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.”

20

“12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

25

- a. the same goods
- b. the same description of goods, or
- c. services or a description of services which are associated with those goods or goods of that description.”

30

The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

35

The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

40

(Under Section 11). Having regard to the user of the marks VERSACE and GIANNI VERSACE is the tribunal satisfied that the mark applied for, VISACHI, 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?

45

(Under Section 12). Assuming user by the opponents of their mark
GIANNI VERSACE in a normal and fair manner for any of the goods covered by the
registration of that mark, is the tribunal satisfied that there will be no reasonable
likelihood of deception among a substantial number of persons if the applicant uses
his mark VISACHI, normally and fairly in respect of any goods covered by the
proposed registration?

I will deal firstly with Section 12. I propose to consider the matter on the basis of
Registration No 1340115 which is for the mark GIANNI VERSACE and I have expressed the
above test accordingly. The other registrations in Class 25 are of little assistance to the
opponents being either a signature mark (No 1112102), a signature plus the word VERSUS
(No 1390802) or a later filed application (No 2020703). Nor of course are the opponents
likely to be in a better position under Section 12 on the basis of their registrations outside of
Class 25.

It is beyond dispute that the application at issue contains identical goods to Registration
No 1340115. The matter therefore resolves itself into a comparison of the marks themselves.
For this purpose I adopt the well known test propounded by Parker J in Pianotist Co's
application (1906) 23 RPC 774. The relevant passage 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 those goods. In
fact, you must consider all the surrounding circumstances; and you must further
consider what is likely to happen if each of these 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 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 that case.”

In my view the respective marks can easily be distinguished visually. Not only does the
opponents' mark consist of two words, a forename and a surname, but the spelling of the
applicant's mark creates a rather different visual impression. However I feel that the
applicant's mark is, or at least can be, pronounced in a very similar manner to the second
element of the opponents' registration. In saying this I accept that neither VERSACE or
VISACHI are common English words and there must be some doubt as to their precise
pronunciation. I have therefore considered the matter on the basis of what I consider to be a
reasonably likely way of pronouncing the respective words. In short I consider there is a real
tangible risk of phonetic confusion arising from use of the marks in oral recommendation of
or references to the goods. I must of course consider the totality of the opponents' mark but
bearing in mind that VERSACE is a dominant and essential feature I am not persuaded that I
should come to any different view of the matter. It can of course be said that in relation to the
type of customer for the goods and the surrounding circumstances that the target audiences
may be different. However I have no evidence before me as to the applicant's trading

practices or intentions and I must in any case consider what it will be open to him to do if he secures a registration. I find that the opposition succeeds under Section 12.

5 The test under Section 11 requires me to consider the opponents' user. I have expressed the test in the above terms because the evidence and exhibits show use of a number of different marks but it is reasonable to say that both VERSACE and GIANNI VERSACE are used (and appear to predominate over other marks such as the signature form). For obvious reasons the opponents have concentrated on providing exhibits demonstrating use in relation to clothing but I also note use on other goods such as perfumery. The evidence is open to some slight criticism in that not all the exhibits are clearly dated and some that appear to be after the material date. It would also perhaps have assisted if the opponents had provided disaggregated figures for their UK business so as to give a clearer picture of sales across the spectrum of fashion goods. Nevertheless I regard the evidence as establishing that VERSACE is a well established name in the clothing and fashion industry. Nor would I expect that to be a controversial finding. Given also my views on the marks themselves I find that the opponents succeed under Section 11.

20 Objections have also been raised under Sections 68 and 17. The Section 68 ground is that the mark at issue "is not being used as a trade mark by the applicant". This goes to the definition of "trade mark". The relevant parts of Sections 68 and 17 read respectively

25 "... "trade mark" means, except in relation to a certification trade mark, a mark used or proposed to be used in relation to goods for the purpose of indicating, or so as to indicate, a connection in the course of trade between the goods and some person having the right either as proprietor or as registered user to use the mark, whether with or without any indication of the identity of that person, and means, in relation to a certification trade mark, a mark registered or deemed to have been registered under section thirty-seven of this Act;..."

30 and

35 "17. - (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in Part B of the register."

40 As the applicant has filed no evidence I can only assume it was an unused mark at the time the application was filed. The above Sections of the Act make it clear that it is perfectly in order to apply for a registration on the basis of intention to use. The opponents do not elaborate on why they consider the applicant's proposed use would not be as a trade mark and I can see no reason for finding against the applicant. The opposition fails in this respect.

45 A separate objection arises under Section 17 in so far as it is claimed that the applicant is not the true proprietor of the trade mark. In his evidence Mr Versace expresses the view that "... the adoption, proposed use and/or use, and registration by the applicant of the trade mark VISACHI was the result of a conscious decision to trade upon the opponents' goodwill and

reputation in the name VERSACE...". The applicant denied the ground in his counterstatement but filed no evidence and so has not responded to the allegation made in the opponents' evidence. If the opponents' objection was considered to be speculative in nature it seems to me that it ought not to have been unduly burdensome for the applicant to counter the charge by briefly explaining how he came to adopt the mark. It does not help his cause that he has failed to do so. Equally, however, the opponents have adduced no evidence to substantiate their underlying claim. However given my finding under Sections 11 and 12 the point is not crucial to the outcome of the case. In the circumstances I decline to reach a formal finding on the matter.

5

10

As the effects of my decision under Sections 11 and 12 are mandatory it is neither necessary nor appropriate to consider an exercise of discretion.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicant to pay the opponents the sum of £535.

15

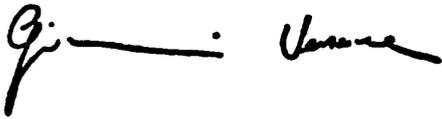
Dated this 11 day of January 1999

20

M REYNOLDS
For the Registrar
the Comptroller General

25

ANNEX A

NUMBER	MARK	CLASS	JOURNAL
1112102		25	5508/00872
<u>Specification</u>	Dresses, blouses, skirts, trousers, shirts, jackets, sweaters, jumpers, suits, shorts, coats, gowns, scarves, ties and footwear, all being articles of clothing.		
1340115	GIANNI VERSACE	25	5896/06227
<u>Specification</u>	Dresses, blouses, skirts, trousers, shirts jackets, sweaters, jumpers, suits, shorts, coats, gowns, scarves, ties and footwear; all included in Class 25.		
1390802		25	5909/00868
<u>Specification</u>	Articles of outer-clothing included in Class 25.		
2020703	VERSACE	18, 25	6115/01877
<u>Specification</u>	<p><u>Class 18</u> Leather; imitation leather; leather goods; imitation leather goods; handbags; wallets; purses; luggage; attache cases; tote bags; briefcases; document cases; all purpose sport bags; travelling trunks and carry-on bags; shoulder bags; garment bags for travelling; keycases; keyrings; keyfobs; umbrellas; parasols and walking sticks; whips; harnesses and saddlery; parts and fittings for the aforesaid goods.</p> <p><u>Class 25</u> Clothing for men; women and children; coats; raincoats; waistcoats; blouses and pullovers; jackets; trousers; skirts; dresses; suits; shirts and chemises; t-shirts; sweaters; underwear; socks and stockings; gloves; ties; belts; scarfs; hats and caps; boots; shoes and slippers; jumpers; shorts; gowns.</p>		

Brief details of other registrations referred to

NUMBER	CLASS
1466885	9
1330233	9
1330234	14
1385340	18
1465125	18
1390801	18
1274488	24
1547474	27
1145450	3
1395122	3
1390800	3
1465002	3
1563616	3