

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK Application
No: 2124466 by Sax Design Limited to register
a trade mark in class 25**

**AND IN THE MATTER OF Opposition
No: 47434 by Studio Soprani Srl .**

Decision

On 4 February 2000 I heard an opposition by Studio Soprani Srl to an application by Sax Design Limited to register the trade mark:



2. The Opponents are the proprietors of the mark:



At the hearing they were represented by Mr Krause of Haseltine Lake Trade Marks; the Applicants were represented by Mr Golding of J E Evans-Jackson & Company.

3. For the reasons I gave at the hearing, and which are recorded in the attached approved transcript, I decided that opposition under s 5(2) of the Act failed.

4. This being the only ground of opposition the Applicants were successful and are entitled to a contribution towards their costs. I order the Opponents to pay the Applicants the sum of £635. This sum is to be paid within one month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of February 2000

Dr W J Trott
For the Registrar
The Comptroller General

DECISION

The application is opposed by Studio Soprani Srl, in that there exists a conflicting earlier trade mark under s 5(2) of the Act, that is registration No. 1125924, LUCIANO SOPRANI, which is composed of a cursive script that I think we all agree is reflective of a signature.

5 I note that there were other grounds of objection to the mark, but these fell away as the opposition proceeded.

The Opponents' mark is registered for goods in Class 25, that is, stockings, trousers, skirts, shirts, pullovers, jackets, coats, scarves, hats, shoes, boots, slippers, socks, mantles, gloves,
10 foulards and caps, all being articles of clothing.

The evidence submitted by both parties is not extensive and can be readily summarised. The Opponents' evidence consists of one statutory declaration by Martin Hermann Krause, a partner in the firm of Haseltine Lake, trade mark attorneys. Mr Krause's declaration is very
15 short, referring only to the Opponents' registration certificate for the mark LUCIANO SOPRANI.

The Applicants' evidence is somewhat fuller. This consists of a statutory declaration by Keri Perifimou, their Managing Director, a position he has held since 1993. Mr Perifimou
20 explains that his company is involved in the manufacture, sale and distribution of articles of clothing, in particular, neckwear. Goods are sold under or in relation to the trade mark SOPRANO, and an example of this mark is enclosed in an exhibit, and is essentially the mark which is applied for. He says the mark was adopted early in 1996 for use in a range of neckwear, and has been continuously used since. Sales up to the date of application, that is
25 the only evidence that I think I can regard as relevant, are in 1996, £150,000, and in 1997, £200,000.

Mr Perifimou says the goods were advertised by a range of methods with rather little being spent on promotion; some £2,000. He draws attention to use of the mark on the Internet in
30 August, 1998, and the Annual Fashion Index, also in 1998. Clearly both these are past the

date of application and, as such, can be given no weight.

Mr Perifimou adds that he is aware there have been no reports of instances of confusion in the marks, either in the trade or from the public. The remainder of his declaration consists of a
5 detailed comparison of marks, which I will return to later, and some discussion of the proprietorship of the mark.

I wish to turn to the main decision now. There is only one ground pleaded. This is under
10 Section 5(2)(b) of the Act which, for the record, I would like to read:

‘A trade mark shall not be registered if because-

(a) ..., ..

15 (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
20 association with the earlier trade mark’.

An earlier mark is defined in Section 6(1), *inter alia*, as a registered trade mark, and so, by
25 virtue of this section, the mark cited by the Opponents is an earlier mark for the purposes of Section 5(2)(b).

I note there was some argument in evidence, and there was also some discussion this morning,
30 as to the true ownership of the LUCIANO SOPRANI mark, but I do not regard this as an issue relevant to the ground pleaded. As Mr Krause said, it was not crucial to the opposition, and I agree. There is nothing in the Act which requires an opponent to be the proprietor of the mark relied upon under Section 5. As I am sure you are aware, Section 8 gives the Secretary of State power to introduce such a requirement, but that is not the law now.

I think, as both parties were aware, this matter falls to be decided on a direct comparison between the marks and, in doing so, I am guided by the approach set out in recent European Court of Justice decisions, particularly, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] ETMR 1, which requires me to consider the likelihood of confusion in the light of an independence between a similarity between the trade marks and between the goods or services; that is, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks and vice versa.

Here the goods, in my view, are identical, or very similar. I agree with Mr Krause on this, and I think it was a point conceded by Mr Golding. It follows from the fact that the Applicants' specification falls within that of the Opponents'.

Mr Krause referred me to *Sabel BV v Puma AG, Rudolph Dassler Sport* [1998] RPC 199, and I think that is a helpful case to look at. This says that the likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. The global appreciation of the visual, oral, or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind in particular that there are distinctive and dominant components.

I have to say I was impressed by the points made in Mr Perifimou's declaration concerning comparison of the marks and, taken as a whole, I do not see how these marks can be confused in the way required by Section 5(2)(b). There are simply too many differences between them.

Visually, LUCIANO SOPRANI consists of two words - that is an obvious point to make, but it must be made - as opposed to one in the Applicants' mark. It is also in a highly stylised form as a signature. As is typical with many signatures, I am not convinced that many people would be able to discern the word SOPRANI from the second word, and I think a major part of the Opponents' case relies upon them doing so. Mr Krause says that a significant number of consumers would read this as LUCIANO SOPRANI, and he says there is no evidence that they would not. I see no evidence that they would. Certainly when I was looking at the word, I had difficulty determining whether the 'S' in it was an 'F', and also interpreting other letters

in the second word. Therefore I do not think I can describe it as the dominant element of the Opponents' mark.

5 In my view, even if the average consumer was able to decode SOPRANI from the latter part of the Opponents' mark, I remain to be convinced that phonetically there can be a risk of confusion between them. The marks are clearly pronounced differently, obviously because of the additional word LUCIANO; but also because they contain different suffixes in the word SOPRANI and SOPRANO. It was mentioned by Mr Golding, and I am myself aware of the importance the first syllable is traditionally given in assessing the likelihood of confusion, but I
10 do not believe it is decisive in this case. As I pointed out, the Opponents' mark carries a different first word, and the other word SOPRANI, like SOPRANO, places an emphasis on the last syllable.

Conceptually, I also believe the marks are dissimilar. SOPRANO has a clear meaning in the
15 English language as a person having a particularly high-pitched singing voice. Mr Krause says that, because of the particular goods in question, this meaning would be displaced. I have seen no evidence to support that, and I fail to be convinced that an ordinary person would disregard the obvious meaning of that English word.

20 Mr Krause also said that Italian names are common in the industry, and the word SOPRANO may well be taken as an Italian name. Again I have seen no evidence to support that, and I think SOPRANO would probably take on its ordinary meaning.

25 This is clearly different from the idea conveyed by LUCIANO SOPRANI, which are stylised words, and are suggestive, as I have said, of an Italian signature.

The final point I wish to record is that the Applicants' mark does not consist wholly of the word SOPRANO. There is other material there. There is the description PURE SILK and there is also the instruction - I take it as an instruction - DRY CLEAN in a device form which,
30 as I have said, gives it the appearance of a label.

Taken together, I do not believe that confusion will occur as required by Section 5(2)(b), and the Opponents' case must fail, in my view.

I would now like to take submissions as to costs.

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MR GOLDRING:

I would put forward just very simply that I feel that it is clear that you have made the decision in favour of the Applicants and that, as normal, the Applicants should therefore be awarded costs in the matter. I do not think that there is any particular area where there has been a negative response towards the defence put forward as far as the Applicants are concerned.

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I would ask you to bear in mind that originally the statement of grounds was much wider, and that after evidence had been put in by the Applicants that statement of grounds was narrowed down to the one point that we argued today. I would ask you to take that into consideration when considering an award of costs, and I would ask that an award be made in our favour in that way.

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MR KRAUSE:

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On the issue of costs being in the cause, clearly I accept that that is fair in this case. In so far as the issue of any consideration being given to the amendment of the statement of grounds, I submit that it is for the Applicants to show that there is evidence that they prepared and submitted which was negated by the amendment in the statement of grounds. At the end of the day, the evidence that they submitted went to the heart of the Section 5(2) objection, and in that respect I submit that it is simply evidence which was used to its fullest extent in these proceedings. I do know that there was one paragraph in there on Section 3(6), but I would submit that, in order to prepare that one paragraph which I think consisted of four or five lines, it would have involved no undue expense or consideration. There were no exhibits, for example, or anything else attached to that.

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THE HEARING OFFICER:

I understand the original ground was 5(4)(a).

5 **MR KRAUSE:**

Yes, there was 5(4). I concede that, but, as I say, the evidence that was filed supported the 5(2) objection, as you, yourself, have said, and therefore there was nothing additional in there, bearing in mind that under section 5(4) the onus is on the Opponents to file evidence of
10 goodwill and damage and misrepresentation, and, in the absence of doing that, there is essentially no case to answer.

THE HEARING OFFICER:

15 I think I agree. The fact that grounds fell away is normally regarded as helpful. It makes the Applicants' simpler. I do not see any real need to award costs beyond the usual scale, and I will make an order for costs of £635.