

O-159-04

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL TRADE MARK
REGISTRATION NO. M795588
IN THE NAME OF TVRDÍK MIROSLAV**

AND

**IN THE MATTER OF APPLICATION FOR A
DECLARATION OF INVALIDITY NO. 16038
THERETO BY FRATELLI GUZZINI S.P.A.**

IN THE MATTER OF International trade mark registration No. M795588
in the name of Tvrdík Miroslav

AND

IN THE MATTER OF application for a Declaration of Invalidity
No. 16038 thereto by Fratelli Guzzini S.p.A.

BACKGROUND

1. The International trade mark  has been protected in the UK since 23 September 2002 under number M795588 and stands in the name of Tvrdík Miroslav. It is protected in respect of:

Class 07:

Mixers, coffee grinders, grinding machines, cuttlers, all the aforementioned goods other than hand-operated.

Class 09:

Irons.

Class 11:

Electric coffee machines.

Class 21:

Mixers, coffee grinders, coffee percolators, all the aforementioned goods non-electric.

2. On 5 January 2004, Fratelli Guzzini S.p.A. filed an application for a declaration of invalidity of the UK designation. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the application set out the grounds of action, which are as follows:

- Under sections 47(2) and 5(4)(a) of the Act as the applicant claims a reputation in the trade mark GUZZINI and device and that use of the protected trade mark would amount to passing off.
- Under sections 47(2) and 5(2)(b) of the Act as the applicant claims that use of the protected mark is likely to cause confusion on the part of the public with the applicant's earlier trade marks.

The applicant gave details of its earlier trade mark in the statement of case, this was listed as "GUZZINI and device" (see below), which has been registered in the UK under trade mark number 1131272 and stands in the name of Fratelli Guzzini S.p.A. It is registered in respect of:

Class 21:

Small domestic utensils and containers, and serving trays, none of precious metals or coated therewith; holders for drinking glasses, toilet tissues, toothbrushes, toothpaste, soap and for toilet brushes; towel rails (not being parts of heating installations), towel rings and soap dishes.

And the trade mark is:



3. In the statement of case the applicant asserted that the protected trade mark was incorrectly recorded on the register as the word “GUZZANTI”, that there was no letter “A” in the mark and it should be recorded as “GUZZNTI”; that viewed in this way the marks are phonetically and visually similar; also they argue that the word “GUZZINI” is part of the name of the applicant and is a very rare name in the UK, there being no entries for that name in the 2003 London Residential Phone Book; further they argue that the applicant is a very large manufacturing company distributing its goods world-wide; that its trade mark has been used in the UK since 1970 on products, packaging, brochures and trade information in relation to a wide range of goods; that as a consequence of this use the applicant’s trade mark has acquired a substantial reputation.

4. On 12 January 2004 a copy of the application for invalidation and the statement of grounds were sent to the registered proprietor at his address as recorded on the register. In the accompanying letter it was stated that the registered proprietor would need to appoint a representative in the UK to act for them as well as filing a Form TM8 and counter statement. The registered proprietor did not appoint a representative, neither did they file a Form TM8 and counter-statement to defend the registration. The consequences of failure to defend the registration were set out in the letter dated 12 January 2004, namely that the application for declaration of invalidity could be granted in whole or in part.

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to prove why it is that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL 0/278/01) where the Hearing Officer stated:

“It is not sufficient to simply allege that a registration offends either Section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to

fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

8. With this in mind, on 6 April 2004, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

9. On 30 April 2004 the applicant for invalidity provided a witness statement, with exhibits, detailing the case against the registered proprietor.

10. The evidence and exhibits submitted consist of a witness statement, by David Ronald Berry, European trade mark attorney at the applicant’s representative (Stevens Hewlett & Perkins), dated 29 April 2004, and two bundles of exhibits. The witness statement first introduces exhibit 1, supplied by the applicant’s Italian trade mark attorneys, Ing. Barzano & Zanardo. It goes on to state that the Italian attorneys instructed him to contact Forma House Limited for further evidence of use of the applicant’s mark in the UK, this is exhibit 2.

- Exhibit 1 – Enclosure 1 is a document, typed, purporting to show the gross value of sales of products by Fratelli Guzzini S.p.A. under the “GUZZINI” trade mark to the UK, quantified in Euros, for the years 2000, 2001, 2002 and 2003 (January to September only). Enclosure 2 is a copy of the first page of a press release referring to Harrogate Gift Fair, 19-23 July 1987, showing the “GUZZINI” trade mark in relation to acrylic housewear. Enclosure 3 is a copy of the upper part of a press release header sheet, dated September 1987, showing the “GUZZINI” trade mark but all the text is in Italian and is not translated, this cannot be taken into account. Enclosure 4 is copies of the header sheets of the “GUZZINI” product export price lists for 1987, 1988, 1993, 1995 and 1996; additionally there is a copy of a header sheet of the “FORME CASA” product price list for 1 June 1995. Enclosure 5 is copies of single pages from the price lists dated 1993 and 1997; the first having a preamble in Italian and the products listed in both English and French, products included being spaghetti serving forks and jars, storage jars, mixing bowls, measuring jugs, cutlery drainers, cutlery and kitchen roll holders, spice racks, colanders, strainers, sieves, juicers and graters; the second having a preamble in Italian and the products listed in English, products included being weighing scales, pitchers, ice buckets, salt and pepper grinders, candle holders and storage jars, there are also items that cannot be clearly identified from their

description (“square dome” and “Amanda set”). Enclosure 6 is copies of correspondence between Fratelli Guzzini S.p.A. and H.R.H. The Prince of Wales, dated May 1988, when Fratelli Guzzini S.p.A. presented H.R.H. The Prince of Wales with some of their products during a visit he made to the town of Recanati and the sites associated with the Italian poet Conte Giacomo Leopardi. Enclosure 7 is a copy of a list of products ordered by Forma House Limited, the UK distributor for Fratelli Guzzini S.p.A, for the years 2000, 2001, 2002 and 2003, this is entirely in Italian and is not translated, therefore this cannot be taken into account.

- Exhibit 2 – Enclosure 1 is a letter from Guido Maghnagi, managing director of Forma House Ltd, stating that his company was formed in 1979 but he had been trading with Fratelli Guzzini S.p.A. since 1968; that as far as he can remember they have always used the “GUZZINI” and square logo trade mark; that it had been used on all products, packaging and trade information. Enclosure 2 is a letter from Frank Andrews, company secretary of Forma House Ltd, stating that Fratelli Guzzini S.p.A. are a very large manufacturing company in Italy which distributes its products worldwide; it reiterates the information given in enclosure 1 and states that the trade mark has been used in relation to “small domestic utensils and containers, serving trays, holders for drinking glasses, bathroom scales, trolleys, CD racks, electric toasters and coffee makers etc.” Enclosure 3 is three “GUZZINI” catalogues introduced by enclosure 2; these are the catering catalogue dated 2002/2003, the pocket catalogue dated 2003/2004 and the basic catalogue dated 2003/2004.

11. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

DECISION

12. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 5(2)(b) and 5(4)(a). The relevant parts of the Act are as follows:

“47. - (1)

(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

“5. - (1)

(2) A trade mark shall not be registered if because -

(a)

(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.

(3)

(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, or

(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.”

13. With regard to section 5(4)(a) of the Act the requirements for this ground of action have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child* trade mark [1998] RPC 455. Adapted to these proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicants’ goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietor are goods of the applicant, and
- (3) that the applicants have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the registered proprietors’ misrepresentation.

14. In this instance no evidence has been directed to any of the elements which must be present and there is therefore nothing to substantiate this ground of action. In particular, the evidence of use of a sign, as provided, does not in isolation demonstrate that the applicant has either goodwill or a reputation. Therefore, I dismiss the application in so far as it is based upon sections 47(2)(b) & 5(4)(a) of the Act.

15. In dealing with the grounds based on section 5(2) and in my consideration of a likelihood of confusion or deception I take into account the guidance provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [2000] 45 FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723, in particular, that the likelihood of confusion must be appreciated globally and take into account all relevant factors.

16. The trade marks the subject of this action are shown below.

UK registration 1131272 (applicant)



International registration M795588



17. The applicant has argued that International registration M795588 is incorrectly represented on the trade marks register, that it is represented as the word “GUZZANTI” rather than the word “GUZZNTI”. However, the representation as a word was not that decided upon by the UK trade marks registry but the official representation placed upon it by the World Intellectual Property Organisation (WIPO). In the graphical representation the second letter “Z” and the following two curved lines, those prior to the letter “T”, are seen as a stylisation of the letters “ZAN” and as such the representation of the graphical mark as the word “GUZZANTI” is correct. Therefore, the applicant’s trade mark is “GUZZINI” and that of the registered proprietor is “GUZZANTI”.

18. The trade marks differ only in as far as the last three, applicant’s trade mark, or four, registered proprietor’s trade mark, characters are different, in one these are the letters “INI” and in the other the letters “ANTI”, and as such the trade marks have a small degree of visual similarity. This is reinforced by the applicant’s mark being in a standard, lower case, sans serif style typeface and that of the registered proprietor being in a stylised script form.

19. From the phonetic perspective the trade marks have differing syllabic constructions, albeit both having three syllables. The first being in the form GU – ZZI – NI (phonetically GOO – ZEE – NEE) and the second in the form GU – ZZAN – TI (phonetically GOO – ZAN – TEE). With the only common syllable being the first, the overall aural impression is that the trade marks can be distinguished one from the other. Therefore from the phonetic point of view I regard these marks as dissimilar.

20. Both trade marks give the impression of being surnames, although neither appears in the London Residential Phone Book, and as such do not relay a common concept that would attract consumers' attention and thereby imply a conceptual similarity.

21. Overall, on taking the visual, aural and conceptual analysis into account I consider there to be little similarity between these trade marks. I will therefore not proceed to analyse the relative specifications for similarity of the goods.

22. The applicant has been unsuccessful, and I therefore make no order as to costs.

Dated this 4th day of June 2004

**Graham Attfield
For the Registrar
the Comptroller-General**