

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2157558
BY RAZMIK GHARIBIAN
TO REGISTER A TRADE MARK
LEO ROSSI
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER No 48768
BY SERGIO ROSSI

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DECISION

BACKGROUND

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On 9 February 1998, Razmik Gharibian of 19 Carlton Place, Southampton, Hampshire, SO15 2DY applied under the Trade Marks Act 1994 for registration of the trade mark **LEO ROSSI** in respect of the following goods in Class 25:

“Clothing; footwear, headgear.”

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On the 3 July 1998 Sergio Rossi of Via Vittorio Veneto 16, 47030, San Mauro Pascoli (Forli), Italy, filed notice of opposition to the application. The grounds on which the opposition is based are under Sections 5(2)(b), 5(3)(b) & 5(4)(a) of the Trade Marks Act 1994, because the opponent is the proprietor of the mark 1124126 SERGIO ROSSI and Device. He also states that SERGIO ROSSI is entitled to protection under the Paris convention as a well-known trade mark. The opponent claims substantial goodwill and reputation under both marks.

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The applicant filed a counterstatement accepting that the opponent was the proprietor of trade mark No1124126. The applicant agreed that his revised specification of “clothing; headgear” is similar to the opponent’s specification of “boots, shoes and slippers”. All the other grounds of opposition are denied. Subsequently, on the 6 April 1999 the applicant amended the specification by the deletion of “footwear”.

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Both sides ask for an award of costs. Only the opponent filed evidence in these proceedings, and the matter came to be heard on 20 October 2000 when the opponent was represented by Mr Symonds from Messrs Brookes & Martin, whilst the applicant was not represented.

OPPONENT’S EVIDENCE

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This takes the form of two statutory declarations. The first is by Mr Enrico Zaccarelli, (under certification by Carmela Rotundo) dated 25 January 1999. Mr Zaccarelli is the Managing Director of Calzaturificio Rossi S.P.A. a position he has held since 1973. His company manufactures and market’s goods designed by the opponent.

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Mr Zaccarelli claims that:

- SERGIO ROSSI was first registered as a trade mark in 1962 (but he does not say where).

- In 1997 products designed by Mr Rossi were being sold in about 1800 outlets throughout the world. In 1997 340,000 pairs of shoes were manufactured to Mr Rossi's designs. The sales figure for 1997 was provided in Italian Lira, I have converted it into the Sterling equivalent which is approximately £18 million.
- He has a very good knowledge of the International shoe trade, and that he is not aware of another shoe designer with the surname ROSSI. Also Rossi is a typical Italian name and that customers would expect shoes sold under the name Rossi to be manufactured in Italy and designed by Sergio Rossi.
- Customers would either overlook the differences between the first name's SERGIO and LEO, or would assume a connection between the two parties marks. As LEO is an abbreviation of Leonardo customers might think that shoes sold under the mark in suit were designed by a relative of the opponent working with him in his business.

At exhibit A is a list of SERGIO ROSSI marks registered in various countries. Exhibit B consists of a brochure sent to customers throughout the World (dated 1997) and extracts from the periodical Harpers & Queen (dated December 1998) published in the UK and containing advertisements for SERGIO ROSSI goods.

Exhibit C consists of invoices illustrating sales of "products made to Mr Rossi's designs" in the UK. These are dated from May 1993 - January 1998, although the description of the goods and the amounts are in Italian. The earlier invoices do refer to "Pairs / Quantity" in one of the columns.

The second statutory declaration, dated 3 February 1999, is by Gulia Talipova, the Managing Director of Groupleader Limited, a position held since 1992. Groupleader Ltd own a single shoes shop situated in Knightsbridge. This shop sells high class ladies' and men's footwear, fashion accessories, handbags, belts and other leather goods.

Ms Talipova states:

- Her company has been the sole United Kingdom importer of footwear and other leather goods manufactured by Sergio Rossi since 1992.
- During the year to February 1998, approximately 200 pairs of Sergio Rossi shoes were sold per month at an average retail price of £250.
- Customers sometimes ask for ROSSI shoes.

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

DECISION

At the hearing Mr Symonds withdrew the grounds of opposition under Section 5(3) of the Trade

Marks Act 1994 and also 6bis of the Paris Convention.

I first turn to the ground of opposition under Section 5(2) which reads as follows:

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

 (a) *it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or*

10 (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.

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

 6. - (1) *In this Act an 'earlier trade mark' means -*

20 (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)...

25 (c)

 (2) *References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which if registered, would be an earlier trade mark by virtue of subsection 1(a) or (b), subject to its being so registered.*

30 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR 690 at 698]*. It is clear from these cases that: -

35 (a) *The likelihood of confusion must be appreciated globally, taking account of all relevant factors;*

40 (b) *the matter must be judged through the eyes of the average consumer, of the goods / services in question, 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;*

45 (c) *the average consumer normally perceives a mark as a whole and does not proceed to*

analyse its various details;

(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;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(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;

(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);

(h) 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.

In order to make the global assessment on the likelihood of confusion, it is necessary to consider individual aspects of the question.

The opponent's registration in Class 25 is for "Boots, shoes and slippers". The applicant in his counterstatement has accepted that his specification of "clothing; headgear" contains similar goods to those listed in the opponent's specification.

I now consider the marks. For ease of reference the marks are reproduced below:

Applicant's Mark	Opponent's Mark
LEO ROSSI	 SERGIO ROSSI Registration of this trade mark shall give no right to the exclusive use of a device of a shoe.

The opponent's mark includes a shoe device. However, it is accepted that words speak louder than devices, especially where the device is merely a representation of the goods. In my view the average consumer would see the mark primarily as the name Sergio Rossi. Clearly the two marks are proper names, and they have an identical surname. The first names, LEO and SERGIO are

very different, although they have identical last syllables.

Mr Symonds contended that both marks would be seen as referring to persons of Italian extraction. He further asserted that the average consumer would assume that the persons belonged to the same family and that the “Rossi family” had branched out into clothing. However, there is no evidence that the “Rossi” family have any reputation for footwear. The limited reputation shown in the evidence is attached to the mark SERGIO ROSSI.

Neither of the marks in suit could be said to be common names in the UK. Although the marks of both parties would be viewed as the full names of persons of Italian origin I accept the evidence of the opponent that Italy has a limited reputation in fashion and that there are numerous Italian companies trading under the founders name. I also take into account the number of traders in the clothing and footwear market who trade under their own names. When considering the marks globally I take account that the goods are similar, but the marks are dissimilar. This is insufficient to give rise to a likelihood of confusion in these circumstances, and that mere association (in the strict sense) is not enough to justify refusal. Different first names are normally effective in conveying the message that different persons are involved, even though they share the same surname. There is no evidence to support the opponent’s assertion that the average consumer would expect a commercial connection between enterprises trading under the marks LEO ROSSI and SERGIO ROSSI.

Therefore, notwithstanding the fact that the goods are similar and even allowing for the notion of imperfect recollection, it is my opinion that the trade marks are not similar enough to have given rise to a likelihood of confusion at 9 February 1998. The opposition under Section 5(2) therefore fails.

Lastly I consider the ground of opposition under Section 5(4)(a) which reads as follows:

5 (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

A person thus entitled to prevent use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

Mr Hobbs QC set out a summary of the elements of an action for passing off in WILD CHILD Trade Mark (1998) RPC 445. The necessary elements are said to be as follows:

- that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

- that there is a misrepresentation by the defendant (whether or not intentional leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff: and

- that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

5 The evidence supports the view that at the relevant date, 9 February 1998, the opponent had goodwill in the mark SERGIO ROSSI and Device and also SERGIO ROSSI. As I found under Section 5(2) there is no likelihood of confusion as to the origin of the goods, and therefore there is no damage to the opponent's goodwill.

10 The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £435. 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.

15 Dated this 20 day of November 2000

20 George W Salthouse
For the Registrar
The Comptroller General