

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NO. 80150  
BY SERGIO ROSSI S.P.A.  
FOR A DECLARATION OF INVALIDITY  
IN RESPECT OF TRADE MARK REGISTRATION NO. 2157558  
IN THE NAME OF RAZMIK GHARIBIAN

## **DECISION**

1) Trade Mark 2157558 LEO ROSSI is registered, with effect from 9 February 1998 in respect of the following goods in Class 25: "Clothing; headgear".

2) By an application dated 22 November 2001, Sergio Rossi S.P.A. of Via Indipendenza, 15, 47030, San Mauro Pascoli (Forli), Italy, applied for a declaration of invalidity in respect of this registration. The grounds for invalidity are in summary:

a) The applicant is the proprietor of Community Trade Mark (CTM) 391656 SERGIO ROSSI which is registered with effect from 18 October 1996, for the following goods in Class 25: "Clothing, namely, scarves, neckerchief, ties, shirts, blouses, belts, hats, T-shirts, pullovers, raincoats, skirts, jackets, trousers, socks, stockings, shoes, boots, sandals, slippers";

b) The applicant seeks a declaration of invalidity under Section 47(2)(a) on the ground that the registered proprietor's mark is similar to its earlier trade mark and is registered for identical or similar goods and therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The registered proprietor filed a counterstatement denying the ground of invalidity.

4) Both sides ask for an award of costs. Only the applicant filed evidence in these proceedings. Neither party wished to be heard. My decision will therefore be based on the pleadings and the evidence filed.

## **APPLICANT'S EVIDENCE**

5) The applicant filed two witness statements. The first, dated 11 April 2002, is by Victoria Jane Martin the applicant's Trade Mark Attorney. At exhibits VJM1-5 she provides copies of two declarations filed in relation to earlier opposition proceedings. The first declaration, dated 25 January 1999 is by Enrico Zaccarelli, (under certification by Carmela Rotundo). 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 Mr Sergio Rossi.

6) 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 59 billion Italian Lira.
- 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.

7) 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), an extract from the periodical Harpers & Queen (dated December 1998) published in the UK containing an advertisement for SERGIO ROSSI shoes and a collection of advertisements from Vogue Italia.

8) 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.

9) 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 shoe shop situated in Knightsbridge. This shop sells high class ladies' and men's footwear, fashion accessories, handbags, belts and other leather goods.

10) 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.

11) The applicant's second witness statement, dated 22 April 2002, is by Massimo Braglia. Mr Braglia is the Chief Executive Officer of the applicant company, which "manufactures and markets the goods distinguished by the SERGIO ROSSI trade mark". Mr Braglia states that in November 2000 the Gucci Group acquired "a majority stake" in the company and have since that date managed the international expansion and consolidation of the Sergio Rossi name.

12) At exhibit EZ1 he provides a copy of a brochure "describing recent developments of Sergio Rossi S.p.A. in the United Kingdom and throughout Europe and elsewhere". The brochure refers

to the “spring/summer 2001 women’s collection”. The brochure gives a potted history of the company and a list of boutiques where the shoes and bags mentioned in the text can be purchased.

13) Exhibit EZ2 consists of copies of eighteen UK advertisements for shoes from magazines such as Vogue, Elle, Marie Claire, Tatler for the period Sept 97-March 99, three of which are prior to the relevant date of 9 February 1998. All show the name Sergio Rossi. Also included are similar adverts for the same period in the same magazines for Spain, Italy, Benelux, France and Spain.

14) At exhibit EZ3 are “two brochures showing some of the current product lines of Sergio Rossi S. p. A. and pictures of shops selling Sergio Rossi products in Italy”. Neither brochure is dated.

15) Mr Braglia claims that the Sergio Rossi brand is well known in the UK, Europe and elsewhere in the world. He claims that the collaboration with Gucci will make the name “even more famous”. Finally, he states that “although the Sergio Rossi name is presently most well known in relation to footwear, the name is already used in relation to bags, and there are plans to use the name in relation to other accessories”.

#### APPLICANT’S ADDITIONAL EVIDENCE

16) The applicant filed a second witness statement by Mr Braglia, dated 29 August 2002. He states:

“It is my opinion that footwear and clothing are similar products as they are both meant to cover or protect the feet and the body respectively. Both footwear and clothing are of the same nature and often sold in the same outlets. Furthermore, their end-users, the consumers are the same.”

17) Lastly he states:

“I believe that the British public would recognise “Rossi” as a surname of Italian origin and Leo Rossi as a relative of Sergio Rossi; as a consequence the public would assume that the products bearing the Leo Rossi brand come from my company also in consideration of the fame of the Sergio Rossi brand.”

18) That concludes my review of the evidence.

#### DECISION

19) The request for invalidity is based upon Section 47(2) which reads:

“47(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) .....

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

20) As the applicant’s Community Trade Mark (CTM) is clearly not identical to the mark in suit Section 5(2)(b) applies. This reads:

“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 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.”

21) An earlier trade mark is defined in Section 6, the relevant parts of which state

“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,”

22) The applicant’s CTM registration has a filing date of 18 October 1996. The mark is protected in the UK for the goods claimed under Class 25. It is therefore, an earlier trade mark for the purposes of Section 5(2).

23) In determining the question under section 5(2), 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] R.P.C. 117, *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 132, 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 224;
- (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 133 paragraph 29.

24) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the registered proprietor's mark and the applicant's registration on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods and services covered within the respective specifications.

### **Similarity of goods and services**

25) The applicant's mark is registered for the following goods in Class 25 "Clothing, namely, scarves, neckerchief, ties, shirts, blouses, belts, hats, T-shirts, pullovers, raincoats, skirts, jackets, trousers, socks, stockings, shoes, boots, sandals, slippers". The registered proprietor's mark has a Class 25 specification of "Clothing; headgear". The applicant's registration encapsulates the whole of the registered proprietor's specification, the goods of the two parties must therefore be regarded as identical or very similar.

### **Distinctive character of the applicant's mark**

26) The only evidence of use of the applicant's mark in the UK is in relation to shoes. It is stated

that in the year to February 1998 approximately 2400 pairs of shoes were sold at a retail value of approximately £600,000. All of the sales appear to have been made from a single retail outlet in Knightsbridge. No evidence has been filed as to the total size of the market for footwear in the UK, nor any evidence regarding the applicant's market share. Clearly advertising can affect the reputation of a mark. Whilst there is evidence of advertising occurring in national magazines very few of the advertisements provided in evidence are prior to the relevant date. In such circumstances the applicant's mark cannot be regarded as enjoying an above average reputation at the relevant date as a result of user. However, the mark itself is clearly the name of an individual. Both "SERGIO" and "ROSSI" are unusual names in the UK, and the combination has a relatively high capacity to distinguish the goods of one undertaking.

### **Similarity of marks**

27) There are visual and phonetic similarities, because both marks include the surname ROSSI, whilst there are also visual and phonetic differences in the forenames, LEO and SERGIO, although they have identical last syllables. Both the applicant's mark (SERGIO ROSSI) and the proprietor's mark (LEO ROSSI) would be seen as being the name of a male of Italian extraction.

### **Likelihood of confusion**

28) Neither of the marks in suit could be said to be common names in the UK, they would clearly be viewed as the full names of persons of Italian origin. It is common practice for traders in clothing and footwear to trade under their own name or that of the company founder. I also note that Italy has a reputation for fashion goods.

29) Items of clothing are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. In *REACT* [1999] 15 RPC 529 the Hearing Officer held the following:

"I am therefore prepared to accept that a majority of the public rely *primarily* on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon."

30) When considering all of the above factors it is my opinion that despite the identical nature of the goods the different forenames would convey to the average consumer that different persons are involved, even though they share the same surname. When it comes to the use of individuals names then these are viewed differently to ordinary words. Any differences are noted and the average consumer immediately questions whether or not it is the name of some other person than the person to whom one supposes the name to belong. I note the comments of Buckley, J. in the *Buler* trade mark case [1966 RPC 141]:

"It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other

person than the person to whom one supposes the name to belong.”

“I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear prima facie to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question.”

31) Although these comments were made regarding a case under the 1938 Act I do believe that the views expressed are still valid under the 1994 Act.

32) The applicant in its evidence has contended that the average consumer would assume that the proprietor was a relative of the applicant and that products bearing the mark LEO ROSSI came from the SERGIO ROSSI company. Mere association (in the strict sense) is not enough to justify refusal. There is no evidence to support the applicant’s assertion that the average consumer would expect a commercial connection between enterprises trading under the marks LEO ROSSI and SERGIO ROSSI.

33) The request for invalidity under Section 47(2) of the Trade Marks Act 1994 therefore fails.

#### **Conclusion and costs**

34) The application for a declaration of invalidity having failed the registered proprietor is entitled to a contribution towards costs. I order the applicant to pay the registered proprietor the sum of £500. 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.

Dated this 17 day of February 2003

George W Salthouse  
For the Registrar  
The Comptroller General