

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2065719 BY VALENTIN
YUDASHKIN INTERNATIONAL S.A.R.L. TO REGISTER THE
MARK VALENTIN YUDASHKIN IN CLASSES 3 AND 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 45489
BY VALENTINO GLOBE B.V. (FORMERLY GLOBELEGANCE B.V.)**

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DECISION

On 28 March 1996 Valentin Yudashkin International SARL applied to register the mark VALENTIN YUDASHKIN for the following specifications of goods:

Class 3 - Soaps, perfumes, essential oils, hair lotions; cosmetic creams for use in slimming; sun-tanning creams, cosmetic creams for skin care, shaving creams, beauty masks, depilatory wax, cosmetic pencils, cleansing creams, deodorants for personal use, cleansing milk for toilet purposes, nail varnish, lipsticks.

Class 25 - Bathing suits, stockings, overalls, braces, drawers, belts, shawls, dressing gowns, sweaters, socks, shirts, short-sleeved shirts, tights, underwear, corsets, suits, neckties, breeches, undergarments, sashes, scarves, furs (clothing), gloves, vests, raincoats, parkas, housecoats, pullovers, pyjamas, frocks, underpants, aprons, pea-jackets, jackets, footwear, headgear.

The application is numbered 2065719 and claims an international priority date of 4 March 1996.

On 25 September 1996 Valentino Globe B.V, filed notice of opposition to this application. The opponents say they are “inter alia” the registered proprietors of trade mark No. 1465853 and have a reputation in that mark (VALENTINO) in relation to clothes. They further say that there is a substantial identity in the fashion industry between these goods and Class 3 goods. As a result of this they go on to say

“There is therefore a great danger of confusion and/or deception occurring in the mind of the public and trade if similar products enter the market place bearing the respective Trade Marks of both the Opponents and the Applicants.

Consideration must also be paid to the doctrine of “imperfect recollection”. Further, or alternatively, use of the Trade Mark applied for by the Applicants would, by reason of it being likely to deceive or cause confusion, be disentitled to protection in a Court of Justice.

In the premises the Trade Mark being opposed ought not to be registered having regard to the provisions of the Trade Marks Act 1994.”

5 It will be apparent from the above that the opponents have at no point explicitly identified the
Section of the Act on which they rely and have further compounded the problem by adopting
wording which appears to be drawn from the preceding Act. In the light of Geoffrey Hobbs QC’s
10 comments in WILD CHILD Trade Mark, 1998 RPC 455, and the more recent comments of the
Vice Chancellor in NASA v Julian Lamorgan Higgins (unreported at the time of writing but the
Case No. is HC 1999 710 of 16 June 1999) in relation to the need for properly particularised
15 pleadings the above seems to me to represent an unsatisfactory foundation on which to base a
case. Not surprisingly the applicants in filing a counterstatement commented on these
inadequacies. For practical purposes it is, I think, possible to discern that a Section 5(2)(b)
objection is intended based on the opponents’ registration. Mr Axe in his affidavit for the
20 applicants assumes this to be the case and has not, I think, been contradicted. For my part, and
for reasons which I will explain later in this decision, I do not propose to treat the scope of the
opposition as extending beyond Section 5(2)(b).

Both sides have asked for an award of costs in their favour. Both sides filed evidence. Neither
party has asked to be heard. Acting on behalf of the Registrar and after a careful study of the
25 papers I give this decision.

Opponents’ Evidence

25 The opponents filed a declaration by George Frederick Nicolai, the Managing Director of
Valentino Globe BV. He firstly gives full details of the registration (No. 1465853) referred to in
the statement of grounds. It is registered for a specification which reads “bathing suits,
beachwear, coats, dresses, dressing gowns, jackets, knitwear, overcoats, pants, scarves, shirts,
blouses, suits, sweaters, trousers, skirts, underwear, headgear; all included in Class 25”. He goes
30 on to refer to a number of other registrations but concedes that No. 1465853 is the most relevant
to the proceedings before me. As these other registrations were not expressly included in the
pleadings I do not intend to consider them but will simply note that it is one of the marks
concerned (that of No. 1372023) that is the form currently used by the opponents. It is as
follows:-



Mr Nicolai goes on to say that it is well recognised that designers of garments frequently also sell
scents, perfumes and other toiletries under the same mark. He exhibits at (GFN1) a retail perfume
45 catalogue in support of this proposition. He also gives details of VALENTINO perfume sales in
the UK from 1986 to 1995 as follows:

	YEAR	US\$
	1986	508,343
	1987	592,662
5	1988	- (not available)
	1989	- (not available)
	1990	183,889
	1991	538,956
	1992	829,604
10	1993	354,340
	1994	146,170
	1995	552,145

		US\$3,706,109
15		=====

Clothing sales in recent years have been

	YEAR	£ sterling
	1980	133,420
	1981	416,874
	1982	876,458
25	1983	2,208,162
	1984	4,165,592
	1985	6,334,136
	1986	7,488,870
	1987	8,209,076
30	1988	8,345,008
	1989	8,747,764
	1990	10,596,354
	1991	9,944,172
	1992	11,440,046
35	1993	6,999,728
	1994	10,216,440
	1995	7,231,476

		£103,353,576
40		=====

Opponents' evidence in reply

Mr Nicolai has filed a further declaration by way of reply evidence. It too is a lengthy declaration which responds to Mr Axe's criticisms with further evidence to bolster the opponents' stated position. In particular

- further information is supplied on sale of Class 3 goods including samples of packaging, invoices etc (GFN6)

- Mr Nicolai exhibits (GHN7) a bundle of sample editorials from magazines, newspapers etc and a bundle of advertisements and magazine covers. Also (GFN8) copies of the covers of books about Valentino.

- further information is supplied on fashion shows and costume designs undertaken for major events or corporate clients. A list of celebrity clients is provided along with examples of awards won.

I have noted the remaining contents of the declaration and, to the extent necessary, will refer to it in the decision which follows.

That concludes my review of the evidence.

Section 5(2)(b) reads:

“(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.”

The correct approach to the interpretation of the expression “a likelihood of confusion on the part of the public” as used in article 4(1)(b) and section 5(2) was considered by the European Court of Justice in Case C-251/95 *Sabel BV v. Puma AG. Rudolf Dassler Sport* [1998] RPC 199. The way in which the presence or absence of a “likelihood of confusion” should be assessed was identified in paragraphs 23 and 24 of the judgment of the court at 223:

“Article 4(1)(b) of the Directive does not apply where there is no likelihood of confusion on the part of the public. In that respect, it is clear from the tenth recital in the preamble of the Directive that the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign, and between the goods or services identified’. The

likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

5 That global appreciation of the visual, aural or conceptual similarity of the mark in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘there exists a likelihood of confusion on the part of the public’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.

10 In that perspective, the more distinctive the earlier mark the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that the two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either *per se* or because of the reputation it enjoys with the public.”

15 The opponents’ earlier trade mark (No. 1465853) is the word VALENTINO and covers goods which are identical and/or similar to the applicants’. It is thus clear from the outset that my views on the marks themselves will be critical to the outcome of the case. The guidance given in *Sabel v. Puma* (above) requires me to take into account the distinctive character of the earlier trade mark “either *per se* or because of the reputation it enjoys with the public”. I do not regard the opponents’ mark as having any enhanced level of distinctiveness arising from the characteristics of the mark itself. It is commonplace in the fashion world for designers to use their own names as trade marks. There is nothing inherently surprising about that as the major fashion houses, although substantial businesses in their own right, have been built on the design flair of the founder. The name is thus the cornerstone of the business. There is a further factor in play here to the extent that the opponents concede that they are in dispute with the proprietor of the mark MARIO VALENTINO over use of their respective marks both in Italy and in this country. There is therefore a claimant with a rival interest in the word VALENTINO.

20 In the terms of the reputation enjoyed by the mark VALENTINO I have set out brief details of the use claimed. I am prepared to accept that the opponents do have a reputation in the fashion clothing field. The applicants have directed a number of valid criticisms at the evidence filed but the totality of that evidence leads me to believe that it is a business of substance which enjoys an international reputation. However this finding must be qualified to take account of the marks actually used. Mr Nicolai in his second declaration says that:

25 30 35 40 “The list of the Company’s marks worldwide (all being VALENTINO marks, i.e. either the name VALENTINO, or a mark abbreviating it, such as the V-Logo, OLIVER BY VALENTINO, V-one VALENTINO and Miss V VALENTINO or combinations of such marks) runs to some 34 pages.”

The examples of use in the evidence confirm this to be the case. There is no breakdown of sales as between the various forms of the mark but I note that Mr Nicolai says in his first declaration:

5 “... for most of the period of use of the trade mark the Company has also used a logo as an additional trademark (the current form being the subject of registration no. 1372023 dated 3 February 1989).”

10 The latter mark is shown earlier in the decision. Certainly my impression is that the opponents’ use is overwhelmingly of the word VALENTINO in conjunction with the V device contained in no. 1372023. As a consequence I have no way of knowing quite what reputation attaches to VALENTINO solus though it seems likely to be the dominant element by which the opponents’ marks will be known. It is against these background considerations that I go on to take a view on the likelihood of confusion arising from the respective marks.

15 The opponents concerns are expressed in the following passage from Mr Nicolai’s first declaration.

20 “My concern arises particularly from my view that most people will consider the trademark VALENTIN YUDASHKIN to be a mark derived from the first name of a designer, with a family name which they do not know (which is in fact the case). For all they know, the full name might be VALENTIN YUDASHKIN, the missing “O” at the end of “VALENTIN” either not being noticed or being considered the difference between the given name and the name under which the designer is known (i.e. a nickname virtually the same as the actual name, the addition of an “O” in such circumstances, I believe, being

25 relatively common).”

 The above claim seems to me to go too far and to lack evidential support. Whilst self evidently VALENTIN and VALENTINO have the first eight letters in common there is no reason to suppose that the final letter ‘O’ will be ignored or taken to be a diminutive form or nickname.

30 The final letter ‘O’ seems to me to do two things. Firstly it adds a further syllable to the word and secondly it results in the stress being placed on the penultimate syllable whereas in VALENTIN it is in my view (and in the absence of evidence to the contrary) on the first syllable much as it would be in the English form Valentine. However I acknowledge that such differences on their own might not be sufficient to save the applicants if it were not for the fact that it is the applicants’ mark as a whole that must be considered. There is judicial authority (see, for instance ERECTIKO 1952 RPC 136) which cautions against dissecting marks and comparing elements thereof in a way which is quite contrary to how the public is likely to react when they meet marks in the normal course of trade. Sabel v Puma seems to me to reaffirm this general principle by indicating that “the average consumer normally perceives a mark as a whole and does not proceed

35 to analyse its various details”. The comparison must therefore be between VALENTINO and VALENTIN YUDASHKIN. My immediate impression of the mark applied for is that it has a markedly Russian (or similar) character. The history or origins of the mark are not explained. The name may be real or fictitious but I would be surprised if the public on encountering the mark were not similarly left with the impression that it was a Russian sounding name. VALENTINO

40 on the other hand, even though it would probably be regarded as having the same root, has to my mind a strong Italian flavour (the Italian actor Rudolf Valentino comes to mind but I do not think my view is dependent on such an association being made). Thus whatever similarities might

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5 superficially exist between the first elements of the respective marks are in my view lost when the marks are considered as totalities. I simply do not accept Mr Nicolai's proposition that "most people will consider the trade mark VALENTIN YUDASHKIN to be a mark derived from the first name of a designer, with a family name which they do not know". There is no basis for reaching such a view. In short I can see no likelihood of confusion if the applicants' mark is registered.

10 I have considered the matter on the basis of the opponents' Class 25 registration. The applicants in their evidence identified a Class 3 registration in the name of the opponents (also for the word VALENTINO). The opponents subsequently acknowledged that this registration had been overlooked. So far as I am aware there has been no request to amend the statement of grounds to formally introduce this registration as a further basis for objection. I, therefore, decline to consider it further. Arguments have been advanced on both sides as to the relationship between fashion clothing and other fashion goods such as perfumes, cosmetics etc based on the trading activities of fashion houses. Whilst the point is touched on in the opponent's statement of grounds it is not said on what basis this gives rise to any objection. I do not think I need or should speculate on the point. I would simply say that in the light of my above findings in relation to the marks I cannot see that the opponents would be in any better position in relation to whatever objections might arise in relation to Class 3 goods as opposed to Class 25.

20 The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435.

25 Dated this 20 day of September 1999.

30 M REYNOLDS
For the Registrar
the Comptroller General