

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2013588
BY VALDISERE FASHIONS LIMITED
TO REGISTER A TRADE MARK
VAL D'ISERE
IN CLASS 25

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 44825
BY TRIUMPH INTERNATIONAL SPIESSHOFER & BRAUN

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DECISION

BACKGROUND

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On 9 March 1995 Valdisere Fashions Limited of 324 -326 Hornsey Road, London, N11 2EY applied under the Trade Marks Act 1994 for registration of the trade mark **VAL D'ISERE** in respect of the following goods in Class 25: "Ladies' lingerie; briefs, brassieres; dressing gowns, nightshirts and bodies."

20

On 3 March 1997 the trade mark was assigned to Val D' Isere Fashions Limited. The original applicant company, Valdisere Fashions Limited was struck off the Register of Companies on 6 October 1998 and dissolved on 13 October 1998.

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On the 28 June 1996 Triumph International Spiesshofer & Braun filed notice of opposition to the application. The grounds of opposition are in summary:

i) The opponent is the proprietor of the following trade marks;

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Trade mark	Number	Date registered	Specification
VALISERE	144579	26.6.35	Cotton piece goods. Class 24
VALISERE	561110	25.6.35	Piece goods of artificial silk or in which artificial silk predominates. Class 50
VALISERE	558630	8.3.35	Articles of clothing; all included in class 25.
VALISERE PARIS & DEVICE	1507781	22.7.92	Textiles and textile goods; bed and table covers; all included in Class 24.
VALISERE PARIS & DEVICE	1507529	22.7.92	Articles of clothing, footwear and headgear; all manufactured in France; all included in Class 25.

The mark applied for offends against the following section of the Trade Marks Act 1994:

- Section 1. The mark is not capable of distinguishing goods of one undertaking from those of others; it is not an indication of origin of goods; it is not a guarantee of quality.
- 5 • Section 3(1)(a) The trade mark is not capable of distinguishing the applicant's goods from those of other undertakings.
- Section 3(1)(b) the mark is devoid of any distinctive character.
- 10 • Section 3(3)(b) The mark as applied for is of such a nature as to deceive the public.
- Section 3(4) Use of the mark applied for is prohibited in the UK by any enactment or rule of law.
- 15 • Section 3(6) The application was made in bad faith and claim to extensive use of the mark is false.
- Section 5(2)(b) & 5(3) (a - b) The mark applied for is identical to or similar to the opponent's marks which have a reputation in the UK and the use of the mark applied for would take unfair advantage of or be detrimental to, to the distinctive character or the repute of the earlier trade marks.
- 20 • Section 5(4)(a - b) Use of the mark applied for is liable to be prevented by virtue of any rule of law protecting an unregistered trade mark or other sign in the course of trade and by virtue of the law of copyright, design right or registered design.
- 25

30 The opponent also questioned the validity of the assignment, but at the hearing that the opponent withdrew this ground of opposition having viewed documents provided by the applicant in correspondence prior to the hearing. Evidence relating to this has not been referred to in this decision.

35 The applicant filed a counterstatement denying all the grounds. The applicant also claims to have used the mark for seven years prior to the date of the application and that this would enable the application to proceed, if necessary, under Section 7 by reason of honest concurrent use. They also claim that this use was sufficient, if necessary, for the mark to have acquired a distinctive character.

40 Both sides ask for an award of costs. Both sides filed evidence in these proceedings and the matter came to be heard on 15 December 1999 when the applicant was represented by Mr Moody-Stuart of Counsel instructed by Forrester Ketley & Co., and the opponent by Ms McFarland of Counsel instructed by Trade Marks Owners Association Limited.

45 OPPONENT'S EVIDENCE

This takes the form of a joint statutory declaration by Heinz Dietrich and Peter Geiselhart, dated

15 May 1997. They describe themselves as proxies of Triumph International Spiesshofer & Braun. However the declaration then continues in the single person form, and states that the declarant has been employed by the company for over 20 years.

5 They state that the opponent is the successor in title to the trade mark VALISERE either alone or in combination with a device, following an assignment in 1991 from Valisere S.A. which they state was liquidated.

10 It is claimed that the opponent is the registered proprietor of a number of marks which consist of or incorporate the word VALISERE; photocopies of the journal advertisements are provided at exhibit A1. It is also claimed that the opponent is the registered proprietor of the trade mark VALISERE (both in word and device form) in a number of countries and at exhibit A2 is a list of the registrations.

15 It is claimed that the “mark VALISERE is very well known, particularly in France. However, since acquisition of the trade mark VALISERE from Valisere S.A. my company has made considerable use of the mark in the UK since 1991 and there is now produced and shown to me as exhibit A3 a collection of copy documents which clearly show use of the mark VALISERE by my company.”

20 Exhibit A3 consists of the following:

- A press release dated April 1994 announcing the introduction of the Valisere brand to the UK.
- Figures showing the advertising cost equivalent of press coverage in 1994 a figure of £15,427 being provided. Many of the publications listed have uncertified circulation figures. The same figures for the first three months of 1995 are also provided and show £8,829.
- A copy of a document which has “From April 94 report” written on it in pencil. This gives lists of persons to whom press releases and samples were sent. The list includes national and local newspapers, TV stations and national magazines
- Four press releases and two publications dated after the relevant date of 9 March 1995.
- Three brochures in French.
- The cost of display material in German Deutschemarks
- A brochure in German (with parts having an English translation)
- A brochure under the VALISERE PARIS and DEVICE mark which is dated 4 August 1994 and details the product range and the range for 1995.
- A brochure under the VALISERE PARIS and DEVICE trade mark which gives a short overview of the marketing strategy and also the product range. Although not dated, the

brochure has details of delivery dates which show it to date from 1994.

The declaration states that the opponent has initiated legal action against Valdisere Fashions Ltd in Landgericht koln and also in Portugal. Finally they state:

5 “I believe that the mark VALISERE is a very well known mark. Therefore its exclusivity is very important and I believe that if the mark VAL D’ISERE were allowed to be registered it could seriously reduce the rights my company has built up and would tend to deceive or cause confusion in the minds of the purchasing public.”

10 “Exclusivity is of the essence of my company’s goodwill and the value of the mark VALISERE. My company is therefore vigilant in the protection of its marks because otherwise there would be a risk of the mark VALISERE losing its select image and consequent lack of confidence amongst the public in my company’s products. Brand
15 image is one of the most important but unquantifiable assets of my company within the market in which we operate. Obviously the higher the brand image and the more exclusive the reputation the more important it is to protect that asset against damage. I believe that the mark VAL D’ISERE is so close to my company’s trade mark that serious confusion is likely, such that the exclusivity and the all important image of my company and the
20 status conferred by my company’s trade mark could be seriously damaged.”

APPLICANTS’ EVIDENCE

25 This consists of a statutory declaration, dated 26 November 1997, by Hilit Shaya a director of Val D’Isere Fashions Limited, a position he has held since the company’s inception in November 1994. Mr Shaya states that by virtue of an assignment dated 3 March 1997 his company acquired all rights in relation to the trade mark VAL D’ISERE including trade mark application 2013588.

30 Mr Shaya claims that although application number 2013588 initially identified Val D’Isere fashions Ltd as the proprietor, the correct identity of the applicant company at the time of filing was Valdisere Fashions Ltd and that appropriate steps were taken to correct the records in relation to the application to reflect the correct spelling of the applicant’s name.

35 Mr Shaya claims that his company has been using the trade mark VAL D’ISERE for “many years in the UK without any problems having arisen concerning the opponent’s mark VALISERE. He claims that “my company and Penta Lingerie, which belongs to the same group, have been using the trade mark VAL D’ISERE in the UK in relation to ladies lingerie continuously for the last ten
40 years.” At exhibit HS1 is a copy of a statutory declaration by Larry Olaoshun dated 31 August 1995 and also some exhibits which were originally filed in support of application 2013588. In his declaration Mr Olaoshun states that he is a director of Valdisere Fashions Ltd, a position he had held for six years. He states that whilst the application form was filled in under the name of Val D’Isere Fashions Ltd, a name by which his company is known, the company is registered as
45 Valdisere Fashions Ltd.

Mr Olaoshun states that his company and Penta Lingerie belong to the same group and that they

5 have been using the trade mark VAL D'ISERE in the UK in relation to ladies lingerie comprising
briefs, bras, dressing gowns, nightshirts and bodies continuously for the last eight years. At exhibit
LO1 he provides three brochures which have "Val d'Isere" on the front cover and the name Penta
Lingerie Ltd on either the front or back cover. There is no mention of the applicant company on
this brochure nor are they dated.

Mr Olaoshun also comments on sales:

10 "the annual turnover of my company and Penta Lingerie Ltd varies between £1 million to
£2.5million of which I estimate that approximately 70% is attributable to the said goods
under the trade mark VAL D'ISERE. All my company's sales are wholesales; we do not
operate any retailing."

15 He also states that approximately £15,000 per annum is spent on advertisements and promotions,
of which approx. 70% relates to promotion of the mark in suit. Copies of entries in various
directories are provided at LO2. One shows an entry for the applicant in what appears to be a
clothing directory, which is undated. The other two pages appear to be copies of "yellow pages"
one of which is dated April 1995. At exhibit LO3 are two examples of labels which would be
20 sown into garments. These have the trade mark "Val d'Isere" only on them with no mention of
the manufacturer. At exhibit LO4 is a list of towns and cities where Mr Olaoshun claims that
goods under the mark in suit are sold. The list shows UK wide coverage. The list does not have
the name of the applicant company on it or any date.

25 Mr Shaya states that his company "has made use of the trade mark VAL D'ISERE since 1987."
He then passes comment on the evidence filed by the opponent pointing out that much is after the
relevant date and is also clearly not for use in the UK. He also voices doubt as to the use of the
opponent's mark in the UK.

30 OPPONENT'S EVIDENCE IN REPLY

This consists of another joint statutory declaration by Heinz Dietrich and Peter Geiselhart, dated
16 March 1998.

35 They claim that no use in the mark prior to March 1995 has been shown by the applicant. They
claim that the evidence that they filed shows use of their mark VALISERE since late 1994.

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

DECISION

45 At the hearing the ground of opposition under Section 3(6) was withdrawn. The opponent also
withdrew their claims regarding proprietorship of the mark.

I consider first the grounds of opposition under Sections 1(1) and 3(1)(a) of the Act. Section 1(1) of the Act is in the following terms:

5 *“1 (1) In this Act a “trade mark” means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings”.*

10 *“A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.”*

Section 3(1) of the Act is in the following terms:

15 3 (1) *The following shall not be registered -*

 (a) *signs which do not satisfy the requirements of section 1(1),*

In Phillips Electronics NV v Remington Consumer Products Ltd (1998 RPC page 283), Jacob J said (at page 301) that the appropriate test is:

20 *“Whether no matter how much the sign may be used and recognised, it can really serve to convey in substance only the message: “here are a particular traders goods”.”*

The opponent has offered no evidence as to why the mark cannot function as a trade mark. I do not think that the mark VAL D’ISERE is so descriptive that I can say now that the applicant will never be able to educate the public to regard the words as a trade mark denoting only its goods or services. The grounds of opposition under Sections 1(1) & 3(1)(a) therefore fail.

Next is the ground of opposition under Sections 3(1)(b) & (c) which read as follows:

30 3(1)(b) *trade marks which are devoid of any distinctive character,*

 (c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services*

40 The mark in question is VAL D’ISERE. Section 3(1)(c) excludes from registration “signs or indications which may serve, **in trade**, to designate the geographical origin of the goods or services” (emphasis added). If the words VAL D’ISERE are a sign which is likely to be used honestly, in trade, to describe characteristics of the goods or services at issue, the sign is excluded from registration by Section 3(1)(c). Words excluded from registration by Section 3(1)(c) will also be excluded by Section 3(1)(b).

45 The opponent relies here on the fact that Val D’Isere is a well known ski resort. Although not referred to at the hearing I take note of the comments of the European Court of Justice (ECJ) in the Windsurfing Chiemsee Produktions-und Vertriebs GmbH v. Boots-und Segelzubehor Walter Huber (Case C-108 / 97) , Same v. Attenberger (Case C-109 / 97). The ECJ stated that one must

decide whether the location in question is:

5 “Currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.”

10 There is no evidence that ladies underwear is currently made or designed in Val D’Isere. The characteristics of the location, a ski resort, make it inherently unlikely that the name will be used in future to identify the geographical origin of the goods in suit. The name is fanciful in relation to the goods at issue and would be perceived only as a trade mark. For this reason the objections under Section 3(1)(b) & (c) of the Act fail.

I next consider the ground of opposition under Section 3(3)(b) which states:

15 3 (3) *A trade mark shall not be registered if it is -*

(a) *.....*

20 (b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

25 The opponent contends that the mark applied for, VAL D’ISERE, will deceive members of the public as there would be an association with the ski resort as a badge of provenance or the geographical origin of the goods. No evidence has been filed as to why the public would be so deceived. It was accepted at the hearing that the Ski resort does not have a reputation for the goods in suit. The opposition under Section 3(3)(b) of the Act fails.

The next ground of opposition is under Section 3(4) which states:

30 (4) *A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.*

35 Again the opponent has offered no evidence in support of this ground of opposition. Therefore, the opposition under this Section of the Act fails.

I now turn to the ground of opposition under Section 5(2) of the Act which states: -

40 “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.”

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

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

5 (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)...

10 (c) *a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”*

15 At the hearing it was common ground that the goods were similar if not identical. It was also agreed by Mr Moody-Stuart that the opponent has an earlier trade marks. The area of dispute is whether the marks are similar enough to create a likelihood of confusion.

 I rely on the decision of the Court of Justice of the European Communities (ECJ) in the *Sabel BV v Puma AG, Rudolf Dassler Sport* case [1998] RPC 199. In that case the court stated that:

20 “*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 to 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*
25 *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.*”

30 *Global appreciation of the visual, aural or conceptual similarity of the marks 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 the 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*
35 *of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.*

40 *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 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.”*

45 I also take account of the following guidance of the European Court of Justice in *Lloyd Schuhfabrik Meyer & Co.* (1999 ETMR 690) in which the court held that:

 “*For the purposes of ... global appreciation, the average consumer of the category of*

5 products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (*see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998]ECR I-4657, paragraph 31*). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should be also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question."

10 Visually the opponent's mark differs from the applicant's only by the splitting of the single word VALISERE into three words by use of the letter D and apostrophe.

Phonetically the marks differ only in that the applicant's mark has a soft "D" in the middle. The beginning and end of both VALSIERE and VAL D'ISERE are the same.

15 Conceptually the applicant's mark identifies a French ski resort, whilst the opponent's mark has no meaning - except to the extent that it is mistaken for Val D'Isere.

20 The opponent has claimed use of the mark in the UK since 1991. However, the supporting evidence is somewhat ambiguous. There is a press release announcing the introduction of the Valisere brand to the UK dated April 1994. The brochures also all seem to date from 1994. No turnover figures have been provided, and the figures relating to advertising are the cost equivalents of the editorial press coverage obtained. Even these figures, based in part on unsubstantiated circulation figures, are relatively low with the equivalent of less than £25,000 worth of advertising. Therefore, the opponent cannot claim to have any significant reputation at the relevant date of 9 March 1995.

30 In this case the marks will be used on ladies lingerie of relatively low value where, in my opinion, the average consumer will not be over vigilant. The marks are similar to the ear and to the eye. It is my opinion that taking all the above factors into account and comparing the marks as wholes, the marks are confusingly similar. The opposition under this section of the Act succeeds.

I next turn to the claims by the applicant to have honest concurrent use under Section 7. This reads:

35 7. - (1) This section applies where on an application for the registration of a trade mark it appears to the registrar -

40 (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 conditions set out in section 5(4) is satisfied,

45 but the applicant shows to the satisfaction of the registrar that there has been honest concurrent use of the trade mark for which registration is sought.

(2) In that case the registrar shall not refuse the application by reason of the earlier trade

mark or other earlier right unless objection on that ground is raised in opposition proceedings by the proprietor of that earlier trade mark or earlier right.

5 (3) For the purposes of this section “honest concurrent use” means such use in the United Kingdom, by the applicant or with his consent, as would formerly have amounted to honest concurrent use for the purposes of section 12(2) of the Trade Marks Act 1938.

10 I note the wording at (2) above, and in this case the proprietor of an earlier trade mark has raised an objection to the registrar allowing the mark in suit on the grounds of honest concurrent use. In Road Tech Computer Systems limited v Unison Software (UK) Limited [1996] Fleet Street Reports 805 at page 813 Walker J stated:

15 “Nevertheless there can be only two eventual outcomes to an application - registration or refusal - and in the absence of any words conferring a discretion on the registrar I think it is reasonably clear that refusal is mandatory under section 7(2) if the proprietor of the earlier mark objects. That construction is consistent with Article 4.5 of the Directive, and with the added importance which seems to be attached to registration under the 1994 Act.”

20 The applicant’s claim for relief under Section 7 on the grounds of honest concurrent use therefore fails.

In view of my findings under Section 5(2) above, I do not need to consider the remaining grounds of objection under Sections 5(3) and 5(4) of the Act.

25 The opposition having succeeded the opponent is entitled to a contribution towards its costs. The original applicant having been dissolved, the assignee defended the opposition. Therefore I order Val D’Isere Fashions Limited to pay the opponent the sum of £1335. This sum 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.

30 Dated this 7 day of March 2000

35 George W Salthouse
For the Registrar
The Comptroller General