

O/463/11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2543354  
BY  
MOHADO LIMITED  
TO REGISTER THE TRADE MARK**

A stylized, serif letter 'M' logo consisting of two vertical strokes and a central vertical stroke that is slightly wider at the top and bottom, creating a double-lined effect.

**MARCO VALENTINO**

**IN CLASS 14**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 100679  
BY  
VALENTINO S.P.A.**

**Trade Marks Act 1994  
IN THE MATTER OF application number 2543354  
By Mohado Limited  
To register the trade mark**



**MARCO VALENTINO**

**In Class 14  
AND IN THE MATTER OF opposition thereto  
Under no. 100679  
By Valentino S.p.A.**

**BACKGROUND**

1. On 30 March 2010, Mohado Ltd (hereafter “the applicant”) applied to register the above mark in respect of goods in class 14 of the Nice Classification System<sup>1</sup> as follows:

Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.



2. The application was published on 7 May 2010 in the Trade Marks Journal.

3. On 6 July 2010, Valentino S.p.A. (hereafter “the opponent”) filed a notice of opposition, claiming that registration would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).

4. The opposition is directed against all of the applicant's goods. The opponent relies on the following earlier marks:

<b>MARK DETAILS AND RELEVANT DATES</b>	<b>GOODS RELIED UPON</b>
<b>CTM:</b> 1990407 <b>Mark:</b> VALENTINO <b>Date of application:</b> 7 December 2000 <b>Date of completion of registration procedure:</b> 18 Sept 2008	<b>Class 14:</b> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments for personal use only.

<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<p><b>CTM:</b> 1990712</p> <p><b>Mark:</b></p>  <p><b>Date of application:</b> 7 December 2000</p> <p><b>Date of completion of registration procedure:</b> 18 Sept 2008</p>	<p><b>Class 14:</b></p> <p>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments for personal use only.</p>
<p><b>UK:</b> 2256247</p> <p><b>Mark:</b></p>  <p><b>Date of application:</b> 19 Dec 2000</p> <p><b>Date of completion of registration procedure:</b> 17 Mar 2006</p>	<p><b>Class 14:</b></p> <p>Precious metals and their alloys and goods in precious metals or coated therewith, not included in other Classes; jewellery, precious stones; horological and chronometric instruments.</p>

5. The opponent's marks are earlier marks not subject to proof of use because at the date of publication, of the application, they had not been registered for five years.<sup>2</sup>

6. The applicant subsequently filed a counter-statement on 8 September 2010, denying the grounds of opposition. In an attempt to demonstrate that 'valentino' is commonly used within class 14, the applicant's counter-statement includes several prints from the Intellectual Property Office (IPO) website showing marks which include the word 'valentino'. The UK and European courts have made clear that state of the register evidence is rarely relevant.<sup>3</sup> No evidence has been provided to illustrate which of the marks, if any, is actually in use in the UK and what the relevant public's perception of these marks may be in relation to the goods in question.

Both sides filed evidence and written submissions and both are content for a decision to be made from the papers on file.

## EVIDENCE

<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5<sup>th</sup> May 2004.

<sup>3</sup> *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

## Opponent's evidence

7. Valentino's evidence is in the form of written submissions which I will bear in mind but will not detail here.

## Applicant's evidence

8. The applicant's evidence consists of a witness statement, dated 4 April 2011, in the name of Mohan Ladharam, Company Secretary for Mohado Ltd. Paragraph 10 of the witness statement provides the following turnover figures for watches and jewellery:

2006	£22,000
2007	£18,000
2008	£16,000
2009	£12,000
2010	£11,000

It is not clear from the witness statement whether these sales figures refer to the UK.

9. Exhibited at ML2 are copies of three invoices from Mohado's address in Hong Kong to Vimora (UK) Ltd in London. These detail shipments of watches and a small volume of jewellery. The invoice dated 21 October 2001 carries no reference to the mark 'MARCO VALENTINO'. The invoice dated 20 August 2001 has listings for 32 watches described as 'MARCO VALENTINO QUARTZ WATCH' but does not show the trade mark. The invoice dated 20 August 2009 contains no reference to 'MARCO VALENTINO'.

10. Exhibit ML3 show the results of a search conducted using '*wayback machine*'. The exhibited pages date from 1 March 2007 and show example content from the website [www.vimora.co.uk](http://www.vimora.co.uk). The first page shows three rings, the second and third show two watches. 'MARCO VALENTINO' cannot be seen on any of the pages.

11. Exhibit ML4 is a print from [www.ejojo.co.uk](http://www.ejojo.co.uk) dated 31 March 2011. It is described by Mr Ladharam in the following terms: '*The website is owned by Marco Valentino Ltd, a limited company, established on 24 November 2004.*' The first page appears to be the homepage with selectable options which include handbags, jewellery and watches. There is no specific reference to MARCO VALENTINO. The second page of the exhibit shows a watch under the heading 'Marco Valentino'. The third page shows sixteen watches, the first of which appears to be the watch enlarged on page two. The images are not clear enough to determine whether or not the watches are branded.

12. Exhibit ML5 consists of a catalogue by Vimora (UK) Ltd. It shows a range of watches which have the words 'MARCO VALENTINO' on the face and are displayed under the heading 'MARCO VALENTINO'. The catalogue is not dated.

13. Exhibit ML6 shows a presentation box and clear envelope both of which are printed with the words MARCO VALENTINO. ML7 is a photograph of two watches, described by Mr. Ladharam as samples of the type supplied in the aforementioned packaging. No wording is visible on either of the watches and the exhibit is not dated.

14. Exhibit ML8 shows the front cover of the official catalogue for Spring Fair 2006, a trade show held at Birmingham NEC. The second page of the exhibit is a page from the same catalogue numbered 554. This shows Vimora (UK) Ltd to be the holder of a stand at the Spring Fair. Marco Valentino is listed under the heading 'main product', along with several other brand names.

### **Opponent's evidence in reply**

15. This consists of a witness statement, dated 27 June 2011, in the name of Jeremy Bridge-Butler, a partner at Baron Warren Redfern, acting for the opponent. Paragraph 4 of the witness statement contains the following turnover figures (in Euros) in respect of watches, bearing its marks, sold by the opponent in the UK:

2003	14136
2004	50472
2005	6885
2006	25378
2007	Unknown
2008	46777
2009	37210
2010	9579

16. Exhibit JBB2 consists of a letter from Stella Padovani of an Italian Intellectual Property firm Jacobacci & Partners to Mr Bridge-Butler with the figures above. A spreadsheet is also included which provides global sales figures of wristwatches sold under the Valentino mark.

17. Exhibit JBB3 shows a further letter from the aforementioned Italian IP firm. Mr Bridge-Butler states that this letter provides details of stockists of watches sold under the VALENTINO mark. These include Boutique Valentino Sloane Street, Harrod's Department Store and Selfridges Oxford Street.

18. This concludes my summary of the evidence. Neither side requested a hearing but further written submissions were filed by both sides in lieu of a hearing. I will not detail these here but will bear them in mind.

### **DECISION**

19. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994, which states:

*“(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 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.”*

20. The leading authorities pertinent to this ground are from the Court of Justice of the European Union (CJEU), namely: *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 B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)* C-334/05 P (*LIMONCELLO*).

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*;

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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.*;

(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*;

(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*;

(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*;

(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*;

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into

account: *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*;

(h) 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*;

(i) 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 and Adidas Benelux BV*;

(j) 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. (hereafter Canon)*;

k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components: *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*;

l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element: *LIMONCELLO*.

### Comparison of goods

21. The opponent relies on three earlier marks in these proceedings. All three are in respect of an identical list of goods that are reproduced below:

<b>Valentino's goods and services</b>	<b>Mohado's goods</b>
<b>Class 14:</b> Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; jewellery, precious stones; horological and chronometric instruments for personal use only.	<b>Class 14:</b> Precious metals and their alloys; jewellery, costume jewellery, precious stones; horological and chronometric instruments, clocks and watches.

22. I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05, the GC held that:

“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

23. *Precious metals and their alloys, jewellery and precious stones* are included in both specifications and are self evidently identical. The term *jewellery* in the opponent's specification clearly encompasses costume jewellery within the application. The opponent's *horological and chronometric instruments for personal use only* are included within the wider term *horological and chronometric instruments, clocks and watches* in the application. In accordance with the guidance in *Meric* these are also identical goods.


24. Consequently, I find that all of the applicant's goods are identical to those in the opponent's specification.

### **The average consumer and the nature of the purchasing act**

25. As the goods are the same, it follows that the average consumer will be the same. The average consumer for jewellery, watches, and clocks is, on the whole, the general public, while precious stones and precious metals are likely to be purchased by jewellery makers/designers. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase. A diamond engagement ring is likely to afford a higher level of attention than would be evident during the purchase of costume jewellery, which could be a fairly frequent and inexpensive occurrence. For the most part the consumer will pay a reasonable, but not exceptional, level of attention, though in the case of those buying gemstones and precious metals for the creation of jewellery, I would expect the level of attention to be higher. The full range of goods is purchased visually, as their primary purpose is their appearance.

### **Comparison of marks**

26. The opponent's strongest case rests with its VALENTINO word mark. Consequently, I will restrict my analysis of the comparison of the marks to this. The marks to be compared are:

<b>The opponent's earlier mark</b>	<b>The applicant's mark</b>
VALENTINO	

27. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall



impressions created by the marks, bearing in mind their distinctive and dominant components,<sup>4</sup> but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

### **Distinctive and dominant components**

28. The opponent's mark, VALENTINO, does not split into separate distinctive and dominant components. It will be viewed as VALENTINO which is its only constituent part; consequently, the dominant distinctive element of the mark is this word.

29. The applicant's mark is a composite mark which consists of the words MARCO VALENTINO below a device, which is unlikely to be viewed as anything other than a stylised letter 'M'. The words MARCO VALENTINO will be perceived as the name of a person with neither word taking on a dominant role within the mark. The stylised M device and the words MARCO VALENTINO, together, share equal dominance in the mark.

### **Visual comparison**

30. The applicant's mark consists of a device element which appears to be a letter M with the words MARCO VALENTINO underneath. The applicant submits that the device *'cleverly depicts the letter M but also makes reference to the name Marco Valentino...the middle part of the letter M is highlighted to give the appearance of a 'V.'*

31. While I accept that this may have been the intention, the average consumer is unlikely to see the device element as anything other than a stylised letter 'M'. The device represents a point of difference as does the addition of the word 'MARCO' that results in the respective marks being of a different length.

32. The opponent's mark consists of the word VALENTINO. This element is shared by both marks and is a clear point of similarity. Taking all of these factors into account I find there to be a moderate degree of visual similarity between the marks.

### **Aural comparisons**

33. The opponent's mark consists of four syllables which will be pronounced VAL-EN-TEEN-O.

34. The applicant's mark contains a stylised letter 'M' presented above the word element of the mark. The device is unlikely to be pronounced by the average consumer. The word element consists of two words of two and four syllables respectively. It is likely to be pronounced MAR-CO VAL-EN-TEEN-O. The point of similarity rests in the VALENTINO elements of both marks.

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<sup>4</sup> *Sabel v Puma AG*, para. 23

35. Despite the additional elements present in the applicant's mark, taking all of these factors into account, I find there to be a moderately high degree of aural similarity between the marks.

### **Conceptual comparison**

36. For a conceptual meaning to be relevant it must be one capable of immediate grasp.<sup>5</sup> Such assessment must, of course, be made from the perspective of the average consumer.

37. The applicant's mark consists of the words MARCO VALENTINO which will be seen by the average consumer as the name of a person, in particular the first and second names of a person. The opponent's mark VALENTINO is likely to be understood as either a first or second name of a person.

This issue was recently considered by the CJEU in the 'Becker' case in which the Court held that while it is possible that, in any given part of the European Union, surnames have a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. In addition, the Court added that within a composite mark, a surname does not retain an independent distinctive role in every case solely because it will be perceived as a surname. The finding with respect to such a role may be based only on an examination of all the relevant factors of each case.<sup>6</sup>

38. Within the UK the average consumer is highly likely to be aware that MARCO and VALENTINO are names from a country outside the UK which they have heard but which are not common everyday names. Both marks will therefore be perceived as a person's name. In the case of watches, jewellery it is common for the designer to brand products with his/her name, either first name, second name or both. In the context of the goods in this case and taking into account that 'Valentino' is not a very common surname, I find a moderate degree of conceptual similarity.

39. I am required to factor these findings into an assessment of overall similarity. I have found that the marks share a moderate degree of visual and conceptual similarity and a moderately high degree of aural similarity. I find that these combine to result in a moderate degree of similarity overall.

### **Distinctive character of the earlier mark**

40. In order to make an overall global assessment of the likelihood of confusion, I must also assess the distinctive character of the opponent's mark. The distinctive character of a mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived

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<sup>5</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHMI* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

<sup>6</sup> *Barbara Becker v Harman International Industries*, C-51/09 P, paragraphs 36 and 38.

by the relevant public.<sup>7</sup>In determining the distinctive character of a trade mark, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings.<sup>8</sup> No evidence of use has been filed by the opponent, so I have only to consider the inherent level of distinctiveness.

41. VALENTINO does not have a dictionary meaning. It is a name and will be perceived as such by the average consumer. It is not descriptive or allusive of the goods in class 14. It is, however, as discussed above,<sup>9</sup> fairly common practice to sell watches and jewellery under the name of the designer. As a consequence the mark enjoys a moderate level of inherent distinctive character.

### **Likelihood of confusion**

42. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has in kept in his mind.<sup>10</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

43. I have found that the marks share a moderate degree of visual and conceptual similarity and a moderately high level of aural similarity and that this combines to result in a moderate level of similarity overall. I have also identified a moderate level of distinctive character in the opponent's earlier mark. I have concluded that the applicant's goods are identical to the opponent's goods. I have identified the average consumer, namely the jewellery and watch buying members of the general public and those traders and consumers who are making/manufacturing jewellery and I have concluded that the purchasing act will, generally, be visual (though aural considerations must also be borne in mind) and will involve a varying degree of care and attention.

44. Taking all the above factors into account, and considering the marks as a whole, I conclude that the differences between the marks are not sufficient to outweigh the obvious similarity, namely the VALENTINO element of both marks. It has no meaning in the context of the relevant goods and will therefore be a memorable part of both marks in the mind of the consumer who, when exposed to both marks, is likely to consider one mark to be the full name and the other to be the surname of the same person. Therefore, when used in respect of identical goods I find the

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<sup>7</sup> Rewe Zentral AG v OHIM (LITE) [2002] ETMR 91

<sup>8</sup> Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97 [1999] ETMR 585

<sup>9</sup> Paragraph 38

<sup>10</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

average consumer is likely to believe that the goods provided under one mark are provided by the same or a linked undertaking as the goods provided under the other.

### **Concurrent use**

45. Having found that a prima facie likelihood of confusion exists, the only factor that can save the application is the existence and effect of concurrent use. In its submissions the applicant states:

*“From the evidence filed the fact that co-existence has taken place over the last ten years, which is surely a sufficient time for an instance of confusion to have arisen...it is clear to see there is no risk of a likelihood of confusion”.*

46. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

*“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”*

47. In deciding this matter I am mindful of the comments of Anna Carboni sitting as the Appointed Person in *Ion Associates v Philip Stainton & Another*<sup>11</sup> in which she stated:

*“For honest concurrent use to be of assistance to an applicant, it must be possible for the tribunal to be satisfied that the effect of the concurrent trading is such as to suggest that the relevant public has shown itself able to distinguish between goods bearing the marks in question without any confusion as to trade origin. That implies that both parties are targeting an approximately similar, or at least overlapping, audience and that the use by the parties in nature, extent and duration of trade has been sufficient to satisfy the tribunal that any apparent capacity for confusion has been adequately tested and found not to exist”.*

In this case the evidence provided by both parties shows a limited share of the market with relatively low turnover when taken as a share of the self evidently large watch and jewellery market in the UK. The applicant has provided a very small number of exhibits which show its products available online and one exhibit which shows its products available from a catalogue, it is not clear how this catalogue is made available or to whom. The opponent has shown that its products are available through several London stores. From the limited evidence provided by both parties I am unable to conclude that the parties are targeting an approximately similar, or at least overlapping, audience, in fact the comparatively low figures increase the likelihood that consumers have not been exposed to both marks. Nor does the evidence show that the use is in nature, extent and duration of trade sufficient to show that any apparent capacity for confusion has been adequately tested and found not to exist.

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<sup>11</sup> BL O-211-09, para 52

**48. I do not find that the co-existence that has existed in the marketplace is of a level such as to demonstrate that the average consumer is likely to be exposed to both marks and consequently the criteria for concurrent use has not been met. My finding of a likelihood of confusion is therefore undisturbed and I find that the opposition succeeds.**

## **COSTS**

49. The opposition having succeeded Valentino S.p.A. is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that it filed evidence and written submissions in lieu.

Preparing a statement and considering the other side's statement: £400  
(including opposition fee)

Filing and considering evidence £500

Written submissions: £300

**Total: £1200**

50. I order Mohado Ltd to pay Valentino S.p.A. the sum of £1200. This sum is 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 20<sup>th</sup> day of December 2011**

**Ms Al Skilton  
For the Registrar**