

O/589/15

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 700394

IN THE NAME OF

SOCIÉTÉ ANONYME MONÉGASQUE MC COMPANY

TO REGISTER:

LIVIA

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401778 BY LIVIA CORSETTI FASHION S.J. W.L. ZENTALA**

SUPPLEMENTARY DECISION

BACKGROUND

1. On 19 November 2015, I issued an interim decision in these proceedings (BL O-541-15). In relation to the competing goods, I stated:

“12. As all of the opponent’s goods are, in my view, encompassed by, inter alia, the phrases “Clothing for men, women, children” and “footwear” appearing in the applicant’s specification, the competing goods are identical on the principle outlined in *Meric*. However, as the opponent’s specification is very specific, it is possible that within the general phrases included in the applicant’s specification there may be goods which share no similarity with those of the opponent. That said, if one compares, in particular, the “underwear” and “corsetry products” in the opponent’s specification with the goods which, on the basis of the applicant’s evidence, appears to be of interest to it i.e. bathing suits for women, the coincidence in the nature, users, to some extent intended purpose and trade channels through which the competing goods pass, I am lead to conclude that such goods are similar to the opponent’s named goods to at least a low degree. I will return to this point when I consider the likelihood of confusion.”

2. Having reached the primary conclusion that the opposition succeeded in full, I went on to state:

30. Notwithstanding my primary conclusion, earlier in this decision (paragraph 12), I concluded that there may be goods within the scope of the applicant’s specification which are not similar to the opponent’s goods. Given the nature of the applicant’s evidence which indicates that it conducts a business in relation to bathing suits for women, I have paused, given the likely similarity between these goods and those goods in the opponent’s specification I have identified, before offering the applicant an opportunity to provide a restriction to its specification which may avoid the clash with the opponent’s goods. However, as its application has been made in relation to:

Clothing for men, women, children, ready-to-wear clothing, ready-made clothing, footwear, bathing suits,

it is, in my view, appropriate to allow the applicant an opportunity to consider the position. In those circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file submissions in which it should identify any goods it wishes to register that fall within the above descriptions and explain why it considers such goods not to be similar to those relied upon by the opponent. A period of 14 days from the date of this decision is allowed for such action. Upon receipt of the above, the opponent is allowed a period of 14 days to comment upon any revised list of goods the applicant suggests. I will then consider the position and issue a supplementary decision in which I will decide whether any of the goods in the revised list of goods provided is free from objection. If the applicant does not respond to this invitation, I will issue a supplementary decision

confirming my primary conclusion and the application will, subject to any successful appeal, be refused in full.”

3. Both parties responded to the above invitation. In its letter of 2 December 2015, the applicant stated:

“Nevertheless, given to the fact that the applicant’s trademark LIVIA is used for bathing creations namely **bathing suits**, the applicant wishes to identify and register such goods considered not to be similar to those relied upon by the opponent.

Really, LIVIA is a brand of swimsuits for women...

These specialised goods share no similarity with those of the opponent: Trade channels are not similar, LIVIA bathing creations are sold by specialised retailers which offer exclusively an extensive selection of bathing suits for women.

If eventually these bathing quality creations will be offered to sale in large stores in summer, these goods will be proposed in elegant corners or areas reserved to bathing creations for women, and really will not cause a likelihood of confusion with the opponent’s goods.

Consequently, the revised list of goods proposed by the applicant is limited to bathing suits for women.”

4. In its letter of 8 December 2015, the opponent responded to the above. It began by reminding me of my comments contained in paragraph 12 (above) and to the following part of paragraph 28, which read:

“28... In relation to either the identical goods at issue, or what appears to be the goods of interest to the applicant. i.e. bathing suits for women (which I have concluded are similar to the opponent’s “underwear” and “corsetry products” to at least a low degree), the fact that the word Livia dominates the overall impression the opponent’s trade mark conveys will inevitably cause a likelihood of confusion with the applicant’s trade mark which consists exclusively of this word...”

5. In relation to the applicant’s claim that there is no similarity between its now limited specification of goods and those of the opponent, it stated:

“..The applicant has provided no evidence to substantiate their claim that the goods share no similarity with those of the opponent. Indeed, the trade channels of bathing suits and underwear will be highly similar if not the same. In a department store bathing suits are frequently sold alongside underwear, hosiery and corsetry products due to the nature of both categories of goods being more intimate garments than outerwear. In any case, the applicant has not restricted the specification of goods to bathing suits of a particular type so that any

registration which might follow would cover bathing suits for women without restriction on whereabouts the goods are sold, and by whom.

The opponent respectfully submits that nothing in the applicant's submissions has changed the *prima facie* case and they should not affect the Hearing Officer's final decision which should confirm the interim decision issued."

6. As the opponent points out, in my interim decision I considered the degree of similarity between what, at that point, I thought was the likely goods of interest to the applicant i.e. "bathing suits for women" and "underwear" and "corsetry products" in the opponent's specification. Having done so, I concluded that given "the coincidence in the nature, users, to some extent intended purpose and trade channels through which the competing goods pass" there was at least a low degree of similarity between them.

7. Although the applicant has concluded that the competing goods are not similar, that conclusion appears to be based upon various characteristics of its goods and the trade channels thorough which the goods are sold or may be sold in the future. However, as the opponent points out, the specification of the IR has not been limited in any way beyond "bathing suits for women" which would, of course, include bathing suits for women sold at all price points and in all manner of, for example, retail outlets. Although the applicant has now agreed to limit its specification, as the limited specification is exactly the same as the specification I contemplated in the interim decision and in relation to which I concluded there would be a likelihood of confusion, I agree with the opponent that it does nothing to alter the conclusions I reached in the interim decision.

Conclusion

8. The opposition to the now limited specification of the designation of the IR i.e. "bathing suits for women", succeeds in full, and, subject to any successful appeal, the designation of the IR will be refused.

Costs

9. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. In its letter of 8 December 2015, the opponent stated:

"The Hearing Officer is also respectfully asked to take into account the additional work required by this interim decision and the actions of the applicant throughout when making an award of costs."

10. As the opponent has not identified the "actions of the applicant throughout" to which it refers and to which it appears to object, this is not something which I can take into account. As to the reference to "the additional work required by this interim decision", I assume the opponent is referring to its letter of 8 December 2015. However, given its very clear conclusion that the applicant's submissions did nothing to affect my interim

decision, its response was, arguably, unnecessary, and, as a consequence, I make no additional award in this regard. Keeping the above in mind, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Considering the applicant's evidence:	£500
Official fee:	£100
Total:	£800

11. I order société anonyme monégasque MC COMPANY to pay to Livia Corsetti Fashion S.J. W.L. Zentala the sum of **£800**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful. The period for appeal against the interim decision runs concurrently with the appeal period for this supplementary decision

Dated this 14th day of December 2015

C J BOWEN
For the Registrar
The Comptroller-General