

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2147788
BY FASHION MARK LTD TO REGISTER THE MARK
BONETTI IN CLASS 25**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 48543
BY DEUTSCHE HERRENWASCHE-FABRIKEN DORNBUSCH & CO GMBH**

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DECISION

On 11 October 1997 Fashion Mark Ltd applied to register the following mark for 'clothing, footwear and headgear'

Bonetti

The application is numbered 2147788.

On 11 May 1998 Deutsche Herrenwasche-Fabriken Dornbusch & Co GmbH filed notice of opposition to this application. The grounds are in summary

- (i) under Section 3(6) by reason of the conduct of the applicant and/or the nature and/or the use of the mark
- (ii) under Section 5(2) by reason of a confusingly similar mark standing in the name of the opponents (see below for details)
- (iii) under Section 5(4)(a) by reason of the use of the opponents' mark. They say that use of the mark applied for would be liable to be prevented by the law of passing off

Details of the earlier trade mark referred to above are as follows

No.	Mark	Class	Journal	Specification
1401471	benetti	25	5906/251	Articles of clothing included in Class 25; but not including boots, shoes and slippers.

The applicants filed a counterstatement denying the above grounds. Both sides ask for an award of costs in their favour.

5 Only the opponents filed evidence. Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' Evidence

10 The opponents filed a declaration by Wolfgang Holk, their Managing Director. He confirms that he is fully conversant with the English language.

15 He says that the mark was first used in the United Kingdom in 1990 and has been used continuously since that date. Goods sold under the mark include casual clothing and beach clothing. Of particular interest are shirts of various types such as polo shirts, sweatshirts and T-shirts as well as pullovers and blouson jackets. The goods are aimed primarily at men. A brochure illustrating the goods is at Exhibit A.

Annual turnover is given as

<u>Year</u>	<u>Approximate value of sales (DM)</u>	<u>Approximate value of sales (£) based on a conversion rate of 2.365</u>
1990	100,000	42,280
1991	210,000	88,790
25 1992	248,000	104,860
1993	66,000	27,900
1994	107,000	45,240
1995	228,000	96,400

30 The above are said to be ex factory figures with the end customer figure being approximately 120 per cent higher. Mr Holk says that his company regularly advertises in the leading European Trade Journal 'Textilwirtschaft' which is available in this country. Copies of advertisements are at Exhibit B. The company is also regularly represented at the bi-annual International Trade Fair "Internationale Herren-Mode-Woche" in Cologne. Exhibit C contains
35 copies of supplements of the Trade Fair edition of the Journal 'Textilwirtschaft'.

40 Until 1996 the company is said to have enlisted the services of an independent trade representative who visited customers in the UK. Currently sales are handled directly by the company's export department in Germany. Sample sales invoices are at Exhibit D and clothing labels at Exhibit E.

45 The remainder of Mr Holk's declaration is mainly concerned with submissions in relation to the marks themselves. I bear these comments in mind. He concludes by exhibiting at F copies of letters issued by the Trade Marks Registry in relation to the opponents' observations on acceptance of the mark at issue (under Section 40 of the Act).

That concludes my review of the evidence.

I will deal first of all with the ground based on Section 5(2) of the Act which reads

"(2) A trade mark shall not be registered if because-

- 5 (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- 10 (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,

15 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

In doing so I take account of the guidance provided by the European Court of Justice in *Sabel BV v Puma AG* (1998 RPC 199 at 224), *Canon v MGM* (1999 ETMR 1) and *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV* (1999 ETMR 690 at 698).

20 It is clear from these cases that

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 25 (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, 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;
- 30 (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 35 (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;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- 40 (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.

45 For convenience I set out below the respective marks

5

10

benetti *Bonetti*

15 Both marks are presented in slightly stylised form rather than plain block capitals. The degree
of stylisation is small. Bearing in mind also that the average consumer does not normally have
the benefit of a side by side comparison, the particular forms of presentation are unlikely in my
view to make a significant impact or would be seen as simply the use of variant typefaces. The
20 result is that the average customer is likely to regard the words themselves as being the
distinguishing features of the marks.

25 Visually the words BONETTI and BENETTI differ only in the second letter. In length,
construction and appearance they are in other respects very similar. I come to the same view
on the basis of aural considerations. No doubt if the words were very carefully articulated it
would be possible to differentiate between them. But vowel sounds are often weak and
indistinct in comparison to consonants. There is a risk that the words become
indistinguishable in speech. Conceptually I suspect the words would be taken as foreign,
perhaps Italian, surnames. To that extent there is a risk of confusion on this account as well.

30 Turning to the goods the opponents' registration covers the full range of clothing save for
certain types of footwear. The mark applied for is in respect of clothing, footwear and
headgear. Identical and/or similar goods are involved. I note that the opponents have
excluded from the generality of their specification a number of specific terms, namely 'boots,
shoes and slippers'. Other items of clothing for covering the feet (hosiery items for instance)
35 would still be included in their specification. The whole of the applicants' specification would,
therefore, conflict with that of the opponents.

40 Taking all the above factors into account I have no hesitation in concluding that there is a
likelihood of confusion on the part of the public if the applicants' mark were to proceed to
registration. Thus the opposition succeeds under Section 5(2)(b).

45 In the light of the clear decision I have been able to reach under Section 5(2) I see no need to
consider the other grounds put forward by the opponents save to say that, if on appeal I was
found to be wrong in relation to Section 5(2), I do not think the opponents would be in a
better position on the basis of the other grounds pleaded.

As the opposition has been successful I order the applicants to pay the opponents the sum of £535. 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.

5 **Dated this 27 day of April 2000**

10

15 **M REYNOLDS
For the Registrar
The Comptroller General**