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THE PATENT OFFICE

Harmsworth House,
13-15 Bouverie Street,
London, EC4Y 8DP.

Wednesday, 15th September 2004

Before:

MR. GEOFFREY HOBBS QC
(The Appointed Person)

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In the Matter of the Trade Marks Act 1994

and

In the Matter of International Trade Mark Registration
No. M795588 in the name of TVRDIK
MIROSLAV

and

In the Matter of Application No. 16038 for a
Declaration of Invalidity in relation
thereto by FRATELLI GUZZINI S.P.A.

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Appeal of Applicant from the Decision of Mr. Graham Attfield,
acting on behalf of the Registrar, dated 4th June 2004.

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(Transcript of the Shorthand Notes of Marten Walsh Cherer Ltd
Midway House, 27/29 Cursitor Street, London EC4A 1LT.
Telephone No: 020 7405 5010. Fax No: 020 7405 5026.)

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THE APPLICANT did not attend and was not represented.
THE REGISTERED PROPRIETOR did not attend and was not
represented.
THE REGISTRAR was not represented.

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D E C I S I O N
(As approved)

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1 MR. HOBBS QC: Fratelli Guzzini SpA ('FGS') is the proprietor of
2 the trade mark registration identified in Annex A and Tvrdik
3 Miroslav is the proprietor of the later trade mark
4 registration identified in Annex B.

5 On 5th January 2004 FGS applied for a declaration that
6 the later trade mark was registered invalidly, in breach of
7 the rights to which it was entitled by virtue of registration
8 and use of its earlier trade mark. The objection based upon
9 prior registration was raised under section 5(2)(b) of the
10 Trade Marks Act 1994. The objection based upon prior use was
11 raised under section 5(4)(a) of the Act.

12 A short witness statement relating to use of the
13 earlier trade mark was filed on behalf of FGS. No evidence
14 was filed in defence of the later registration. However, the
15 later registration benefited from the rebuttable presumption
16 of validity contained in section 72 of the Act. It was
17 therefore necessary for the Registrar to examine the
18 objections to registration for acceptability on their merits.
19 This was done by reference to the papers on file without
20 recourse to a hearing.

21 On 4th June 2004, Mr. Graham Attfield issued a decision
22 on behalf of the Registrar in which he held that the later
23 registration was not invalid on the grounds put forward by
24 FGS. He considered that the evidence on file was
25 insufficient to substantiate any elements of the objection

1 raised under section 5(4)(a). In particular, he observed
2 that the evidence did not demonstrate that FGS had acquired a
3 goodwill or reputation through use of its earlier trade mark
4 in the United Kingdom.

5 On this view of the matter the protection afforded to
6 the earlier trade mark under section 5(2)(b) of the Act
7 depended on the degree of distinctiveness it possessed
8 independently of any use that might have been made of it.
9 However, the hearing officer did not say in his decision what
10 degree of distinctiveness he was prepared to ascribe to the
11 earlier trade mark. He also saw no need to consider the
12 degree of similarity between the goods covered by the earlier
13 and later registrations in order to determine the outcome of
14 the objection. In the result, the objection was dismissed
15 entirely upon the basis that the trade marks in issue were
16 not sufficiently similar to bring about consequences of the
17 kind proscribed by section 5(2)(b).

18 The hearing officer arrived at that conclusion on the
19 basis of the following observations (in which FGS is referred
20 to as 'the applicant'):

21 "17. The applicant has argued that International
22 registration M795588 is incorrectly represented on the
23 trade marks register, that it is represented as the
24 word 'GUZZANTI' rather than the word 'GUZZNTI'.

25 However, the representation as a word was not that

1 decided upon by the UK trade marks registry but the
2 official representation placed upon it by the World
3 Intellectual Property Organisation (WIPO). In the
4 graphical representation the second letter 'Z' and the
5 following two curved lines, those prior to the letter
6 'T', are seen as a stylisation of the letters 'ZAN'
7 and as such the representation of the graphical mark
8 as the word 'GUZZANTI' is correct. Therefore, the
9 applicant's trade mark is 'GUZZINI' and that of the
10 registered proprietor is 'GUZZANTI'.

11
12 "18. The trade marks differ only in as far as the last
13 three, applicant's trade mark, or four, registered
14 proprietor's trade mark, characters are different, in
15 one these are the letters 'INI' and in the other the
16 letters 'ANTI', and as such the trade marks have a
17 small degree of visual similarity. This is reinforced
18 by the applicant's mark being in a standard, lower
19 case, sans serif style typeface and that of the
20 registered proprietor being in a stylised script form.

21
22 "19. From the phonetic perspective the trade marks
23 have differing syllabic constructions, albeit both
24 having three syllables. The first being in the form
25 GU-ZZI-NI (phonetically GOO-ZEE-NEE) and the second in

1 the form GU-ZZAN-TI (phonetically GOO-ZAN-TEE). With
2 the only common syllable being the first, the overall
3 aural impression is that the trade marks can be
4 distinguished one from the other. Therefore from the
5 phonetic point of view, I regard these marks as
6 dissimilar.

7
8 "20. Both trade marks give the impression of being
9 surnames, although neither appears in the London
10 Residential Phone Book, and as such do not relay a
11 common concept that would attract consumers' attention
12 and thereby imply a conceptual similarity.

13
14 "21. Overall, on taking the visual, aural and
15 conceptual analysis into account I consider there to
16 be little similarity between these trade marks. I
17 will therefore not proceed to analyse the relative
18 specifications for similarity of the goods."

19
20 The proprietor of the later registration had taken no
21 part in the proceedings. The application for a declaration
22 of invalidity was therefore dismissed with no order for
23 costs.

24 On 29th June 2004, FGS gave notice of appeal under
25 section 76 of the Act contending, in substance, that the

1 hearing officer had erred by giving no, or no adequate,
2 weight to the distinctiveness of the trade mark protected by
3 the earlier registration. There was said to be at least a
4 prima facie case that the public might believe that the goods
5 offered by the proprietor of the later trade mark
6 registration came directly or indirectly from the proprietor
7 of the earlier trade mark registration, with the result that
8 the later trade mark registration should be regarded as
9 invalid under sections 5(2)(b) and 5(4)(a).

10 In a letter dated 26th August 2004, the proprietor of
11 the later trade mark registration provided a summary of his
12 reasons for contending that the hearing officer's decision
13 should be upheld on the basis of dissimilarity between the
14 goods and the marks in issue. The parties indicated that
15 they were content for the appeal to be determined without
16 oral argument, and neither of them is present or represented
17 before me.

18 The evidence filed on behalf of FGS is summarised in
19 paragraph 10 of the hearing officer's decision. It was
20 somewhat perfunctory. It nevertheless stands unchallenged
21 and I do not think it was open to the hearing officer to
22 hold, in the light of the information it contained, that FGS
23 had established no unregistered right to protection for its
24 earlier trade mark. It appears to me that the correct view
25 of the matter is that FGS had not shown by means of the

1 evidence on file that it had any greater right to protection
2 under section 5(4)(a) than it could otherwise claim on the
3 basis of its earlier registration under section 5(2)(b).

4 In order to resolve the objections to registration it
5 was therefore necessary for the hearing officer to decide
6 whether there were similarities (in terms of marks and goods)
7 that would have combined to give rise to a likelihood of
8 confusion if, in September 2002, the earlier trade mark and
9 the later trade mark had been used concurrently in the course
10 of trade in the United Kingdom in relation to goods of the
11 kind for which they were respectively registered.

12 Due weight had to be given to the distinctive character
13 of the earlier trade mark and the degree to which the goods
14 in issue were liable to be regarded as similar from the
15 viewpoint of the average consumer.

16 Since the marks in issue were not identical, it was
17 necessary for the hearing officer to assess the net effect of
18 the differences and similarities between them. Each mark had
19 to be considered without excision or dismemberment. The
20 differences and the similarities had to be given as much or
21 as little significance as the average consumer would have
22 attached to them at the relevant date.

23 If it was concluded that the marks in issue were
24 distinctively similar, there would need to have been a
25 finding that the goods in issue were none the less

1 sufficiently different to forestall a likelihood of confusion
2 before the objections to registration could have been
3 rejected. It would only have been unnecessary to consider
4 the question of similarity between the goods in issue if the
5 marks in issue were distinctively different to a degree which
6 rendered further assessment of the objections to registration
7 pointless.

8 I am not satisfied that the hearing officer's
9 evaluation of the objections to registration conformed to the
10 required approach. That prompts me to consider the pivotally
11 important aspects of the assessment for myself. In my view
12 the trade marks in issue possess a relatively high degree of
13 linguistic and presentational distinctiveness. They differ
14 distinctively from a presentational perspective. I do not
15 think that the same is true from a linguistic perspective.
16 The linguistic impact of the word GUZZINI, on the one hand,
17 and the word GUZZANTI, on the other, gives them an affinity
18 for one another. Each 'speaks Italian' to rather similar
19 effect so far as its verbal message to the observer is
20 concerned. This makes it necessary to consider whether the
21 presentational differences would be sufficient, in
22 combination with the differences between the goods for which
23 the marks are registered, to enable them to co-exist without
24 confusion in the marketplace.

25 I do not think that the answer to this question is as

1 clear-cut as the hearing officer's decision would suggest.
2 It is frequently difficult to assess the relative
3 significance of linguistic similarities and presentational
4 differences. The present case is no exception. I have paused
5 over the comparison because I am aware of the tendency for
6 words to "speak louder" than non-verbal elements. However, on
7 balance I consider that the presentational differences
8 between the marks would impact on the perceptions and
9 recollections of the average consumer of the goods concerned
10 to a degree which would, in combination with the differences
11 between the goods covered by the respective registrations, be
12 just about sufficient to offset the potential for confusion
13 by reason of linguistic similarity. That, together with the
14 provisions of section 72 of the Act, leads me to the
15 conclusion that the appeal should be dismissed.

16 I see no reason to suppose that the proprietor of the
17 later registration has incurred costs to any measurable
18 extent in connection with the appeal. The appeal will
19 therefore be dismissed with no order for costs.

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ANNEX A

UK Registered Trade Mark No 1131272



Filing Date: 31.03.1980

Class 21:

Small domestic utensils and containers, and serving trays, none of precious metals or coated therewith; holders for drinking glasses, toilet tissues, toothbrushes, toothpaste, soap and for toilet brushes; towel rails (not being parts of heating installations), towel rings and soap dishes.

ANNEX B

International Trade Mark No M795588



Date of Designation in UK : 23.09.2002

Class 07:

Mixers, coffee grinders, grinding machines, cuttlers, all the aforementioned goods other than hand-operated.

Class 09:

Irons.

Class 11:

Electric coffee machines.

Class 21:

Mixers, coffee grinders, coffee percolators, all the aforementioned goods non-electric.