

**TRADE MARKS ACT 1938 (AS AMENDED) AND
TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS Nos 1482813/4/5/6
IN THE NAME OF GUÉPARD SA TO REGISTER A
MARK IN CLASSES 3, 16, 18 AND 25**

AND

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER Nos 34995/6/7 AND 35796 BY CHANEL LIMITED**

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TRADE MARKS ACT 1994**

5 **IN THE MATTER OF Applications Nos 1482813/4/5/6
in the name of Guépard SA to register a mark in
Classes 3, 16, 18 and 25**

10 **and**

**IN THE MATTER OF Consolidated Oppositions
thereto under Nos 34995/6/7 and 35796 by
Chanel Limited**

15

DECISION

20 On 15 November 1991 Guépard SA of Freiburg, Switzerland applied under Section 17 of the
Trade Marks Act 1938 to register the mark, a representation of which appears below, for
specifications of goods which read as follows:-

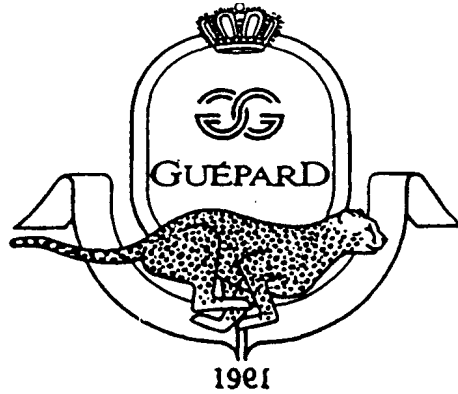
25 “Soaps, perfumes; perfumery, non-medicated toilet preparations; cosmetics;
preparations for the hair; deodorants; all included in Class 3.”

“Office requisites; stationery; printed matter; writing materials; all included in
Class 16.”

30 “Leather and imitations of leather; articles made from all the aforesaid materials;
articles of luggage; trunks and travelling bags; umbrellas and parasols; all included in
Class 18.”

35 “Shirts, shorts, skirts, blouses, trousers, jackets, coats, waistcoats, hats, neckties;
articles of underclothing; pyjamas, night-dresses, sleeping garments, negligees,
dressing gowns; jumpers, cardigans, pullovers, sweaters, overalls, swimming costumes;
dresses, dungarees, over-trousers; boots, shoes, sandals, slippers; tops, caps; robes,
aprons, jeans; socks, leg-warmers, dancewear, wrist-bands, head-bands, gloves and
40 footwear; belts made of leather; all included in Class 25.”

The applications are numbered 1482813, 1482814, 1482815 and 1482816 respectively. The
mark referred to above is as follows.



On 12 March 1993 Chanel Limited filed notice of opposition to application numbers 1482813, 1482814 and 1482815 and on 22 May 1993 the same party filed opposition to 1482816. The proceedings were subsequently consolidated.

In summary the grounds of opposition are as follows:-

- (i) under Section 12(1) by reason of the opponents' registrations. For the sake of completeness I have reproduced full details at Annex A though as indicated later in this decision not all of these were relied on at the hearing;
- (ii) under Section 11 by reason of the opponents' use of their marks;
- (iii) under Section 17(1) in that the mark at issue has been applied for in bad faith. More specifically the opponents say:-

“The Applicant and/or its Officers are connected with individuals who previously provided an undertaking to an associated company of the Opponent, namely Chanel S.A., that they would not use the trade mark now sought to be registered. Accordingly, the adoption of the Trade Mark now sought to be registered is not bona fide since the Applicant is not entitled to apply. Moreover, the intended use of the mark implied by the making of the application is false in view of the undertaking which has been given. In the premises, registration of the Trade Mark sought to be registered would be contrary to Section 17(1) of The Trade Marks Act, 1938.”

The opponents also ask the Registrar to refuse the applications in the exercise of his discretion.

The applicants filed a counterstatement denying these grounds. Both sides seek an award of costs in their favour.

Both sides filed evidence in these proceedings. The matter came to be heard on 17 June 1998 when the opponents were represented by Mr C Morcom of Her Majesty's Counsel instructed by Withers & Rogers, their trade mark attorneys and the applicants by Mr A M Poulter of Marks & Clerk, their trade mark agents.

By the time this matter came to be heard, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references
5 in the later parts of this decision are references to the provisions of the old law.

Opponents' evidence (Rule 49)

10 The opponents filed a statutory declaration dated 19 September 1995 by Martin Hamilton, a Director of Chanel Ltd. He has been employed by the company for over 16 years.

Mr Hamilton says that the company was established in England in 1925 and is well-known for a wide range of perfumes, toiletries, jewellery, clothing and accessories along with related services. The business and its principal trade marks CHANEL and a double C device are, he
15 says, now world famous. He exhibits (MH1) a copy of the certificate of registration for the various CC devices (those listed in Annex A) and (MH2) copy certificates relating to registrations for No 19.

20 The CC device was first used in 1925 and has been in continuous use since that date.

Mr Hamilton says that perfumery and toiletry products are available from selected retail outlets throughout the country, and beauty consultants are on hand at various outlets to provide specialist beauty services. All products sold by the opponents are available from the two London CHANEL BOUTIQUE outlets located in Sloane Street and Old Bond Street,
25 respectively. These products include ladies' fashion clothing, accessories, handbags, watches and jewellery as well as perfumery and toiletry products. The CC device trade mark is used in relation to the goods both by use of the trade mark on the goods, and, in the case of fashion and accessory items, by means of a swing tag. The CHANEL BOUTIQUE outlets also offer alteration and repair services as well as specialist beauty services.

30 In support of this he exhibits (MH3) selected pages of the "CHANEL Collections" for 1988 and 1989, a CHANEL carrier bag, packaging and swing tags, all bearing the mark.

35 The trade mark, No 19, was first used in the United Kingdom in 1971 and has been used continuously since that date in respect of perfumery, toiletry products and related services. Sample packaging and advertisements in support are exhibited at MH4. Mr Hamilton then goes on to give information on turnover and advertising figures in relation to goods sold under the marks between 1987 and 1991. This material is subject to a confidentiality order dated 28 October 1995 whereby the information concerned is to be disclosed to the Registrar
40 and the applicants but not to any other persons. I have, therefore, included this information in a separate Annex (B) which will not be part of the publicly available version of this decision. Exhibited (MH5) in support of the advertising position is a selection of advertisements which have appeared in principal fashion magazines.

45 Mr Hamilton goes on to express his belief that as a result of the extensive use and advertising the CC device and No 19 trade marks are well-known to the public. He expresses his concern

about the applicants' mark based on the device of crossed letter 'G' and, in the case of the Class 3 application, the fact that the numeral 19 appears at the bottom of the mark.

Mr Hamilton says that the opponents have additional concerns in that there appears to be a connection between the applicants, Guépard SA and/or its officers and individuals who had traded as Léonard SA and who, several years ago provided an undertaking to Chanel SA, the opponents' associated company in France, not to use the double G device element of the mark at issue. The facts are said to be as follows:-

“(a) on 12th. March, 1984 a device mark including the Applicant's GG device was registered in Switzerland under No. 329647 in the name of Léonard S.A. This was subsequently renewed on 27th. August, 1984 under No. 334733 with an extension of the list of products and protection for twenty years from this later date, and was transferred, on 28th. July, 1989, to Guépard S.A., who are still the Proprietors thereof.

“(b) in 1984, Léonard S.A. was controlled by a Mr. Homsy and at the time when the mark No. 334733 was transferred, in 1989, Léonard S.A. and Guépard S.A. had the same sole director, Mr. Touron, and the same registered address in Freiburg.”

Mr Hamilton says that this information is derived from company records. He goes on to give brief details relating to Léonard SA and Guépard SA covering dates of registration, objects, registered addresses and directors. This material is at Annex C. Based on the information supplied he carries on to say that:-

“(c) It will be noted that during some of the period, A. Homsy was a director of each of the two companies Léonard S.A. and Guépard S.A. and I understand Adel Christian Homsy was the husband (sic) of Laurence Homsy.

“(d) A third company to which I wish to refer is InterLéonard S.A. That company was registered on 26th August, 1982 and marketed the products of Léonard S.A. The company had its registered office in Geneva at the residence of Mr. & Mrs. Homsy. The named directors were:

- Adel Homsy (August 1982 to February 1987)
- Laurence Homsy (July 1984 to July 1988)
- R.M. Léonard (August 1982 to February 1988)
- Samir Fahmy (May 1987 to February 1988).

The company was dissolved as a result of bankruptcy on 26th. July, 1988.

The marketing of the products of Léonard S.A. and subsequently Guépard S.A. was taken over by a fourth company, Brandmark S.A. Brandmark S.A. was incorporated on 30th. April, 1976 under the name of Alphaconsultants and Trading S.A. It changed its name on 2nd. March, 1982 to Autoquip Accessories S.A., and on 4th. September, 1987 it changed its name again to Brandmark S.A., with the object of trading in jewellery, watches, car accessories, etc.”

Again Mr Hamilton gives details of Brandmark's registered address and directors.

Against the above background Mr Hamilton says that on 19 August 1985 Chanel S.A. objected to Léonard SA in respect of registration No 334733. A reply was received from
5 Interléonard SA dated 23 August 1985 signed by Adel Homsy "accepting the undertaking not to use the upper part of the Guépard monogram", ie the two interlocking Gs. Mr Hamilton assumes from this that there must be a connection between Léonard SA and Interléonard SA, such that the undertaking would also have involved Léonard SA. It is the similarity of the applicants' device, which is said to be subject to the undertaking, to the opponents' CC
10 device that is the main reason for the opponents' objections. In consequence of further correspondence Léonard SA agreed in a letter dated 29 May 1986 (signed by Adel Homsy) not to use the element of the entwined Gs on products of nine classes including Classes 3, 16, 18 and 25.

15 On 17 March 1989, four months before the transfer of the Swiss registration to Guépard SA, Léonard SA signed (under Christine Homsy's signature) an attestation in which they undertook (to quote from the certified translation) "not to file, during the future, the two interlinked Gs of the Guépard trade mark and to suppress any renewals of this mark". Mr Hamilton says that even if the undertakings were not drawn to the attention of
20 Guépard SA at the time of the transfer the latter should still have been aware of them "because of the overlap between the companies". Mr Hamilton elaborates on this latter point as follows:

25 "In particular, in view of the residences and the directors of the companies as detailed above, it seems to me that Mr. Homsy, or Mr. & Mrs. Homsy together controlled Léonard S.A. from the start until June 1987. Moreover, although no member of the Homsy family appears as a director of Léonard S.A. at the time of the transfer of Swiss Registration No. 334733 in July 1989, it is conceivable that the Homsys still controlled both Léonard S.A. and Guépard S.A. at the time. In particular, as indicated
30 above, it is a matter of fact that the two companies were, at the beginning and up until 1987, controlled by the Homsy family. In addition, I understand that the common director at the time of the transfer, Mr. Tournon, was a barrister and, as such, likely to be only of the fiduciary type. Certainly, the existence of a common sole director shows that the two companies were connected and does not, in itself, mean that there
35 was a change of shareholders.

In addition, it is reasonable to assume that Guépard S.A. (with Laurence Homsy as administrator from 1983 to 1988) must have known about the restrictions applying to the GG device because of the connection between their user in Switzerland,
40 Brandmark S.A., and Léonard S.A."

Copies of a number of the documents referred to are exhibited at MH6 in support of these claims. I will return to this later in my decision.

45 Mr Hamilton is, therefore, of the view that the applications in suit have not been bona fide made and are in breach of the undertakings previously given. He concludes by saying that

the opponents are not aware of any use of the subject mark in the United Kingdom but that a similar mark has been used in Switzerland though not for goods in Class 3. He exhibits (MH7) a copy of a Guépard SA brochure as used in Switzerland.

5 Applicants' evidence (Rule 50)

The applicants filed a declaration dated 2 July 1996 by Clément Barras who describes himself as an Administrator of Guépard SA, a position he has held for 7 years. He confirms that the facts stated are either within his own knowledge or from the records of the applicants to
10 which he has access. He also confirms he is fully conversant with the English language.

He deals firstly with the issue of whether confusingly similar marks are involved. His comments cover both the interlocking G and C devices and the objection based on the number 19. I note his remarks but do not propose to summarise his views here as this is
15 essentially a matter for the tribunal. In relation to the undertaking between Interléonard SA/ Léonard SA and Chanel SA. Mr Barras comments as follows:-

“I do not propose to deal in any detail with the allegations made in paragraphs 12-17 of the Declaration of Martin Hamilton other than to state that I fail to see the
20 relevance of an undertaking allegedly provided by Interléonard S.A. and/or Léonard S.A. to Chanel S.A. arising out of a dispute in Switzerland. In Paragraph 12 of Martin Hamilton's Declaration, he states that Interléonard S.A. was dissolved as a result of bankruptcy on 26th July, 1988. There is no suggestion that the burden of the undertaking was transferred to any other company. It is suggested, however, that
25 Léonard S.A. later provided an undertaking that they would not use the element of the intertwined G on products of certain classes. Again, it has not been suggested that this undertaking is in any way binding on any other company other than Léonard S.A. There is clearly no justification for the statement in paragraph 17 of Martin
30 Hamilton's Declaration that any intention to use the mark in the United Kingdom implied by the making of the application would be in breach of the undertakings previously given.”

Opponents' evidence in reply (Rule 51)

35 The opponents filed evidence in reply in the form of a further statutory declaration dated 28 July 1997 by Martin Hamilton. Most of this evidence is taken up with a commentary on the comparison of marks issue and is by way of response to the points made by Mr Barras. For the same reason as given above I do not propose to review these comments here.

40 In relation to Mr Barras' comments on the paragraphs of his previous declaration dealing with the undertaking Mr Hamilton comments that the purpose of introducing this information contained in that Declaration, was merely to emphasize that the Applicant should have been aware of undertakings given to Chanel S.A. in respect of the device element of the mark the subject of the applications. He adds that “If the various companies have nothing to do with
45 Guépard S.A., then I find it rather surprising that the Applicant has adopted the same logo as part of its mark”.

That completes my review of the evidence.

I go on to consider the grounds of opposition beginning with those under Sections 11 and 12 of the Act. These read as follows:-

5 “11 It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.”

10 “12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- 15 a. the same goods
- b. the same description of goods, or
- 20 c. services or a description of services which are associated with those goods or goods of that description.”

25 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

30 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd’s application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

35 **(Under Section 11)** Having regard to the user of the opponents’ marks (see Annex A) is the tribunal satisfied that the mark applied for if used in a normal and fair manner in connection with any goods covered by the registrations proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

40 **(Under Section 12)** Assuming user by the opponents of their marks (see Annex A) in a normal and fair manner for any of the goods covered by the registrations of those marks, is the tribunal satisfied that there will be no reasonable likelihood of deception among a substantial number of persons if the applicants use their mark normally and fairly in respect of any goods covered by their proposed registrations?

45 Mr Morcom, for the opponents, indicated at the outset that he would rely on the registrations that were in the same classes as the applications under attack. He also said that the opponents were not pursuing the oppositions in so far as they were based on the No 19 trade mark.

Taking the Section 12(1) position first, I think it is common ground that the respective sets of specifications cover the same goods so the matter is essentially one of comparison of marks. The opponents have their double C device registered in all four classes covered by the applications in suit. As can be seen from Annex A there are a number of variations on the
5 basic theme but the underlying concept in each case is interlocking Cs with one C reversed so that the mark has a symmetrical pattern. On the basis of these registrations the opponents express concern at the proposed registration and use of the applicants' mark containing an interlocking G device.

10 It is apparent that the applicants' mark consists of more than the interlocking G device. In the context of the mark at issue my immediate reaction is that the dominant and memorable impression is of the word GUÉPARD and the device of a cheetah. Guépard is, of course, the name of the applicant company as well as being the French word for cheetah. The principal elements of the mark can in a sense, therefore, be said to reinforce one another but my view of
15 the mark does not depend on any such association being made. The mark also contains a crown device, a scroll and surround, the interlocking Gs and the numerals at the foot of the mark. Mr Morcom argued that I should make allowance for the effects of imperfect recollection and not base my decision purely on a direct comparison of the marks. Even allowing for this I do not consider, that, in the context of the overall design and presentation
20 of the mark applied for, there is any real tangible risk of confusion with the opponents' registered marks. The opposition, therefore, fails under Section 12(1).

Mr Morcom conceded at the hearing that this was not a case where Section 11 was likely to give rise to very different considerations to those under Section 12. I think that is right but I
25 will briefly record my view of the Section 11 position. It is arguable that in fact the opponents' position is somewhat weaker as most of their use of the double C device is in close association with the word CHANEL. The presence of a strong housemark serves as an additional point of differentiation between the respective marks. I was, however, referred at the hearing to evidence filed showing the applicants' use of their G device on its own in a
30 brochure. The brochure does not appear to bear a date nor can it easily be determined which markets it is intended to serve (if other than the domestic Swiss market). For the purposes of the proceedings before me I must, of course, consider normal and fair use of the mark applied for rather than speculate on what the position would be if the applicants commenced to use an element of their mark on its own. In the circumstances of the case I think the outcome under
35 Section 11 follows that under Section 12 and accordingly this ground of opposition fails.

I go on to consider what I think is the opponents' principal ground of objection, namely that the applications have been made in bad faith having regard to the undertaking referred to in the summary of the grounds of opposition. This goes to Section 17(1) of the Act which reads
40 as follows:-

“17 (1) Any person claiming to be the proprietor of a trade mark used or proposed to be used by him who is desirous of registering it must apply in writing to the Registrar in the prescribed manner for registration either in Part A or in
45 Part B of the register.”

As indicated in my summary of the evidence the dispute centres on correspondence and an undertaking some years ago involving Léonard SA/Interléonard SA on the one hand and Chanel SA, the opponents' associated company in France on the other. I will consider the context and significance of the undertaking later in this decision. Prima facie, however, it is of indeterminate scope and between different parties and, indeed, the applicants point to these factors as part of their defence. For the opponents to be successful, therefore, they need to persuade me that there is a connection between Léonard/Interléonard and Guépard; that obligations contained in the undertaking passed to Guépard; and that the undertaking is relevant to my consideration of the trade mark position in this country.

For their part the opponents have provided information derived from company records which, they say, shows that both companies, Léonard and Guépard, had similar objectives, a common registered address at the residence of Mr Homsy at least for the period between 1982 and 1987, a number of common directors, and that both companies had Mr Alain Tournon and Mr Clément Barras as their sole director in turn during the period 1987 and 1990 (see Annex C). Other evidence filed by the opponents links Léonard SA and Interléonard SA. I do not understand that there is any dispute that Interléonard was responsible for marketing Léonard's products.

The company information and records on which the opponents base their case are not directly challenged by the applicants. There are also other pointers in the evidence to links between Léonard SA and Guépard SA. I note that the Swiss registration is said to have been registered on 12 March 1984 in the name of Léonard SA. The mark incorporates the interlocking G device, the word Guépard and device of a cheetah. At that time both companies had the same registered address at the residence of Mr Homsy. Certainly it is not suggested that Guépard SA had any objection to Léonard SA registering the mark. It would seem to be a remarkable coincidence that the registration was subsequently (on 28 July 1989) transferred to Guépard SA if there were in fact no connection between the two companies.

I do not say that all the above factors establish incontrovertible proof that there was a link between Léonard SA and Guépard SA. There were at various times, for instance, directors who were not common to both companies. It is also difficult to draw firm conclusions about issues of ownership and control from the material supplied. Nevertheless the opponents have in my view established a strong prima facie case that the two companies were closely connected. In the light of this it is incumbent on the applicants to explain their position and to deny, if they were able to do so, that any such connection existed. In saying this I acknowledge Mr Poulter's comment at the hearing that his clients were Guépard SA and that he could not, therefore, speak for Léonard SA. Even so I consider that the applicants' evidence falls significantly short of being an effective response to the opponents' claims. There must, for instance, be papers in Guépard's records relating to the transfer of ownership of the Swiss registration which might have shed light on the matter. I have quoted verbatim in my evidence summary the relevant part of Mr Barras' declaration for the applicants. He does not explicitly deny a link nor does he offer a positive statement as to the independence of the firms or an explanation as to the circumstances surrounding the transfer of ownership of the Swiss registration. I find this even more surprising as Mr Barras is said to have been the sole director of both companies at the date of the transfer in July 1989. In coming to the

above view I have not needed to deal with Mr Hamilton's suggestion that "the Homsys still controlled both Léonard SA and Guépard SA at the time". That seems to me to be unsupported speculation. I do, however, bear in mind that the undertaking entered into on 17 March 1989 was signed on behalf of Léonard SA by Christine Homsy. As the sole director of Léonard SA at that date was Alain Touron I take this to indicate that the Homsy family, or at least one member thereof, had a continuing interest in, and ability to act for, the company even though not represented at director level.

The applicants say there is no evidence that the burden of the undertaking was transferred to any other company or that it is binding on any other company. I have not had the benefit of evidence or submissions as to the precise legal significance of the undertaking but, having freely given it, I take the view that Léonard SA were under an obligation to notify Guépard of the position. It seems unlikely that Guépard would have been unaware of the undertaking as it was given in March 1989 just four months before ownership of the Swiss registration was transferred to it from Léonard SA in July 1989. Between those dates, in May 1989, Mr Touron ceased to be sole director and Mr Barras took on that role. Mr Touron is said to be a barrister and "likely to be of the fiduciary type". Mr Barras describes himself as an Administrator. Given the nature of their roles and likely involvement in the legal affairs of the companies it does not seem entirely credible that Guépard was not made aware of the existence of the undertaking.

Turning to the correspondence between Chanel SA and Léonard SA/Interléonard SA and the undertaking itself I find myself having to reach a decision on issues of some importance to the parties with what I regard as incomplete information. I have in effect only three documents before me namely Interléonard's letter of 23 August 1985, Léonard's letter of 29 May 1986 and the undertaking dated 17 March 1989. Both the letters refer to correspondence which must have emanated from Chanel but those letters have not been made available.

There is also a considerable time lag between the letters and the undertaking. It is not clear, therefore, whether the undertaking is the end product of these earlier exchanges or whether it resulted from other negotiations or contacts between the parties. As one of the issues I have to consider is the scope of the undertaking it would have been of assistance if material had been filed to place the document in a legal, commercial and geographical context or if the applicants had been more forthcoming about their understanding of the position at the date of transfer of the Swiss registration.

It is clear from the first of the letters, dated 23 August 1985, that discussions between the parties at the point in time related primarily to the applicants' Swiss registration (329647) though I note that reference is made to a "double L" device which appears to have been a separate cause of concern to Chanel. This letter from Interléonard says that

"Apart from our agreement not to use the upper part of the GUÉPARD monogram, it is out of the question for us to deregister Mark No. 329-647. For further details, we would ask you to contact our Trade Mark Lawyer: Maître GUYET, who is, if we are not mistaken, also CHANEL's lawyer in Switzerland."

The second letter, dated 29 May 1986, is from Léonard SA to the Maître Guyet referred to above. This second letter omits any direct reference to the Swiss registration though it does refer to goods classes which correspond with that registration. None of the additional correspondence referred to in these letters has been filed in evidence. It is then almost three
5 years later that Léonard SA gave the undertaking. There is no stated qualification as to the geographical scope of the undertaking. Prima facie it permits a broad interpretation referring as it does to Léonard undertaking “not to file, during the future, the two interlinked Gs of the Guépard trade mark...”. Even so it is somewhat surprising that Chanel were satisfied with an undertaking of indeterminate scope given the international nature of their operations. Had
10 surrounding correspondence been filed the intent of the parties might have been clearer. Making the best I can of the matter I cannot say with any confidence that the undertaking was a local agreement only. It is distanced in time from the earlier correspondence relating to the Swiss registration and I can do no more than take the drafting at face value. Taking account of the body of evidence filed by the opponents it seems to me that they have done sufficient
15 to put an onus on the applicants to clarify their position. In the event the applicants have not persuaded that they were entitled to file the application in the face of the undertaking and taking account also of the likelihood of a connection between Léonard SA and Guépard SA. The opposition thus succeeds under Section 17(1).

20 Finally there is the matter of the Registrar’s discretion. It will be evident from my comments above that I have found it difficult to reach a firm view on the Section 17(1) objection based on the evidence filed. I do not consider the case established by the opponents to be unanswerable but equally I do not think the applicants have offered an effective rebuttal. Mr Barras does not say that he was unaware of the undertaking and, given his involvement at
25 a critical time, it is unlikely that he could make such a claim or be unaware of Chanel’s concerns. On the other hand if there was genuine uncertainty on Guépard’s part as to whether the undertaking was binding on them or effective in the United Kingdom the proper course would, it seems to me, have been to approach Chanel for clarification. It cannot have escaped Guépard that Chanel’s concerns were unlikely to be confined to the Swiss market. The
30 applicants point to proceedings between the parties in other jurisdictions (mainly in relation to the similarity of marks issues). It is not clear when these proceedings were initiated but if they preceded the filing date of the UK applications it must have been even more apparent to the applicants that Chanel had wider concerns. In these circumstances it seems inadvisable to have proceeded with applications in this country without first clarifying the position with
35 Chanel. I have, therefore, come to the conclusion that even if the undertaking given to Chanel does not permit the construction I have placed upon it, the applicants should at least have considered themselves on warning about the opponents’ possible objections. Additionally, therefore, I would exercise the Registrar’s discretion against the applicants.

40 As the opponents have been successful in these proceedings they are entitled to a contribution towards their costs. Mr Poulter, for the applicants, pointed out at the hearing that the ground based on Section 17(1) was only introduced as a result of an amendment to the original statement of grounds. He asked me to take this into account in the event that the opponents

failed (as they have done) under the original Sections 11 and 12 grounds. Mr Morcom on the other hand said that the amended grounds were admitted before any evidence had been filed. I take these comments into account. I order the applicants to pay the opponents the sum of **£1,000** in respect of the consolidated oppositions.

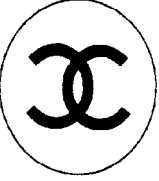
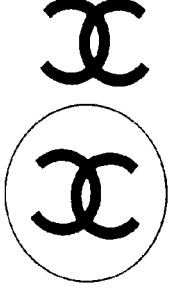
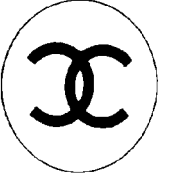
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Dated this 9th day of July 1998

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M REYNOLDS
For the Registrar
the Comptroller General

In respect of application No 1482813 in Class 3:

5	No	Mark	Class	Journal	Specification
10	796077		3	4260/465	Perfumes, eau de Cologne, toilet rouge, lipstick, toilet soap, toilet waters, face powder and talcum powder, all being non-medicated preparations.
15	1361083		3	5815/1558	Soaps; perfumes; eau de cologne; toilet water, cosmetics; essential oils, dentifrices; non-medicated toilet preparations; talcum powder for toilet use; preparations for the hair; non-medicated preparations for the care of the skin; cleansing masks; anti-perspirants; deodorants for personal use; mouth washes, not for medical use; nail care preparations; all included in Class 3.
25	1173120	No 19	3	5601/117	Soaps; perfumes; essentials oils; dentifrices; cosmetics; non-medicated toilet preparations; preparations for the hair; non-medicated preparations for the care of the skin and scalp.
30	1282807		42	5744/2897	Beauty salon services; hairdressing salon services; jewellers services; flower arranging services; design and

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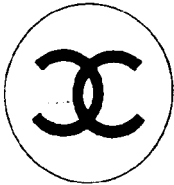
30

1282804 No 19 42 5757/490

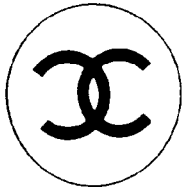

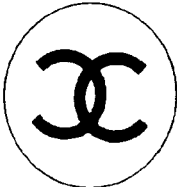

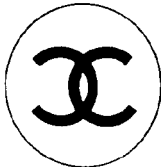
In respect of application No 1482814 in Class 16:

lithographic printing services, all for packages, publications or information, design services and decoration (design) services, all for chemist shops, boutiques, jewellers, florists, perfumeries, beauty salons and hairdressing salons; arranging and conducting of exhibitions relating to beauty, hairdressing, jewellery or floristry; hire services for clothing and jewellery and for vending machines for perfumery, cosmetics, toiletries or perfumed products; research and development services, all for cosmetics and perfumes; all included in Class 42. CANCELLED IN RESPECT OF: All services relating to jewellery other than those services relating to costume jewellery.

Beauty salon and hairdressing salon services; arranging and conducting exhibitions relating to beauty or hairdressing; hire of vending machines used for dispensing perfumery, cosmetics, toiletries or perfumed products; research and development services, all for cosmetics or perfumes, all for others; all included in Class 42.

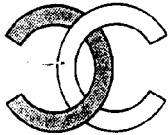
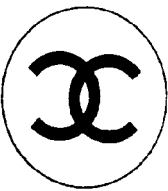
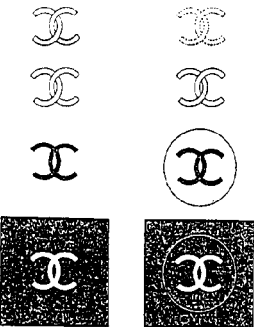
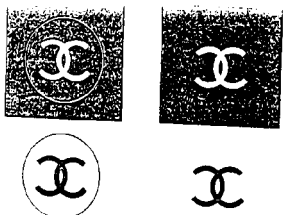


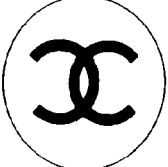
No	Mark	Class	Journal	Specification
5		16	5805/57	Paper, paper articles; cardboard, cardboard articles; inks, adhesive materials; printed matter; photographs, stationery, artists' materials; paint, brushes, paper patterns for use in making clothes; printed specification relating to paper patterns; albums, bags, calendars, playing cards, embroidery designs, face towels of paper, packaging materials; all included in Class 16.
10				

In respect of application No 1482815 in Class 18:

15		18	5872/2741	Handbags; purses; wallets; credit cards holders; belts; vanity cases; luggage; parts and fittings for all the aforesaid goods; all included in Class 18.
20				
				
		25	5627/1702	Articles of clothing for women and girls; stockings, pullovers, cardigans, scarves and cravats, tights, socks, gloves, belts and ties, all for wear.
25				
				
		25	5917/2630	Articles of clothing for women and for girls; stockings, tights; shirts, t-shirts, sweatshirts, pullovers, sweaters, cardigans; articles of outer clothing; hats; scarves; socks, gloves, belts, ties, cravats; footwear; all included in
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Class 25.

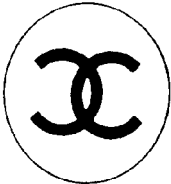

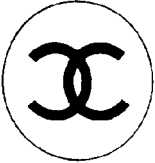

5	1132767	26	5548/96	Buttons included in Class 26; fastenings, buckles and clasps, all in the nature of clothing fasteners, ornaments (other than jewellery) for personal wear, and cuff links, none of precious metals or coated therewith.
				
10	1071585	26	5290/94	Lace, ribbands, braid, all being textile smallwares, buttons included in Class 26; artificial flowers.
				
15	1425026	26	5943/7141	Lace, embroidery, ribbons, braids; buttons; artificial flowers; hair ornaments, hair grips, hair slides; hair bands; fasteners; hooks and eyes; badges for wear; belt clasps; brooches, buckles; shoe buckles, shoe fasteners, shoe ornaments; all included in Class 26.
				
20	1417495	37	5931/5162	Alteration, cleaning, repair and renovation of jewellery, clothing, fashion accessories and handbags; all included in Class 37.
25				
	1282807	42	5744/2897	Beauty salon services; hairdressing salon services; jewellers services; flower arranging services; design and lithographic printing services, all for
30				

5 packages, publications or information, design services and decoration (design) services, all for chemist shops, boutiques, jewellers, florists, perfumeries, beauty salons and hairdressing salons; arranging and conducting of exhibitions relating to beauty, hairdressing, jewellery or floristry; hire services for clothing and jewellery and for vending machines for perfumery, cosmetics, toiletries or perfumed products; research and development services, all for cosmetics and perfumes; all included in Class 42.

10 CANCELLED IN RESPECT OF: All services relating to jewellery other than those services relating to costume jewellery.

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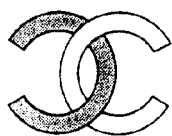
20 In respect of application No 1482816 in Class 25:

No	Mark	Class	Journal	Specification
25		25	5627/1702	Articles of clothing for women and girls; stockings, pullovers, cardigans, scarves and cravats, tights, socks, gloves, belts and ties, all for wear.
30	  	25	5917/2630	Articles of clothing for women and for girls; stockings, tights; shirts, t-shirts, sweatshirts, pullovers, sweaters,

cardigans; articles of outer clothing; hats; scarves; socks, gloves, belts, ties, cravats; footwear; all included in Class 25.

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1132767



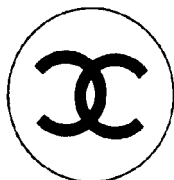
26

5548/96

Buttons included in Class 26; fastenings, buckles and clasps, all in the nature of clothing fasteners, ornaments (other than jewellery) for personal wear, and cuff links, none of precious metals or coated therewith.

10

1071585



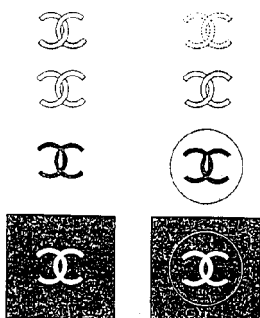
26

5290/94

Lace, ribbands, braid, all being textile smallwares, buttons included in Class 26; artificial flowers.

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1425026



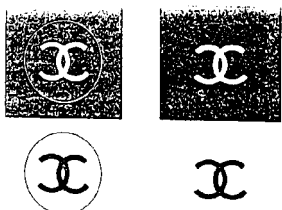
26

5943/7141

Lace, embroidery, ribbons, braids; buttons; artificial flowers; hair ornaments, hair grips, hair slides; hair bands; fasteners; hooks and eyes; badges for wear; belt clasps; brooches, buckles; shoe buckles, shoe fasteners, shoe ornaments; all included in Class 26.

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25 1417495

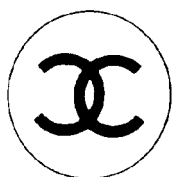


37

5931/5162

Alteration, cleaning, repair and renovation of jewellery, clothing, fashion accessories and handbags; all included in Class 37.

30 1282807



42

5744/2897

Beauty salon services; hairdressing salon services; jewellers services; flower

5 arranging services; design and lithographic
printing services, all for packages,
publications or information, design
services and decoration (design) services,
all for chemist shops,
boutiques, jewellers, florists,
perfumeries, beauty salons and
10 hairdressing salons; arranging and
conducting of exhibitions relating to
beauty, hairdressing, jewellery or floristry;
hire services for clothing and jewellery and
for vending machines for perfumery,
cosmetics, toiletries or perfumed products;
15 research and development services, all for
cosmetics and perfumes; all included in
Class 42. CANCELLED IN RESPECT
OF: All services relating to jewellery other
than those services relating to costume
20 jewellery.

ANNEX B

THE INFORMATION CONTAINED IN THIS ANNEX IS SUBJECT TO A
CONFIDENTIALITY ORDER DATED 28 OCTOBER 1995 AND IS NOT AVAILABLE
FOR PUBLIC INSPECTION

LÉONARD SA

5 Léonard S.A. was registered on 25th. July, 1974 with its principal objects being to trade in watches and jewellery. The registered address of Léonard S.A. was:

- Geneva, the residence of M. Homsy until June 1987.

10 Then from June to September 1987 it was:

- Geneva, c/o Fiduciaire Privée S.A. (Zihlmann).

then:

15

- c/o Alain Touron from September 1987 to May 1989, and
- c/o Fiduciaire Barras from May 1989 to December 1990.

20 The directors are given as:

- Adel Homsy: July 1974 to July 1983
- Laurence Homsy: December 1976 to June 1987
- Rose-Marie Léonard: July 1974 to June 1987
- 25 - Bernard Zihlmann (sole director) June to September 1987
- Alain Touron (sole director) September 1987 to May 1989
- Clément Barras (sole Director) May 1989 to October 1990

GUÉPARD SA

30

Guépard S.A. was registered on 26th. August, 1982 under the name of Intermovement S.A. and became Guépard S.A. on 19th. December, 1983. The main object of the company was indicated as being the trade in watches and jewellery, etc. The registered addresses of the company were:

35

- Geneva: at the residence of Mr. Homsy from August 1982 to April 1988 (i.e. identical to that of Léonard S.A. up until June 1987)
- Freiburg: chemin Saint-Marc, 9 (Touron April 1988 to May 1989);
- 40 - Fiduciaire Barras (since May 1989) (again identical to that of Léonard S.A. from 1988 to 1990).

The directors have been:

45

- Marie-Christine Modoux (sole director) August 1982 to June 1983)
- Laurence Homsy (June 1983 to April 1988)

- Samir Fahmy (June 1983 to February 1988)
- Deleamont (July 1983 to March 1984)
- Tornare (March 1984 to February 1988)
- Alain Touron (sole director) April 1988 to May 1989
- 5 - Clément Barras (sole director) since May 1989.