



OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

Opposition Division

DECISION No 1092/2000

of 29/05/2000

RULING ON OPPOSITION No B 62291.

Opponent: **Zaza Confectie-Industrie B.V.**
Pilotenstraat 32
1059 CJ Amsterdam
The Netherlands

Representative: **Shield Mark B.V.**
The Larmag Building
Overschiestraat 61
1062 XD Amsterdam
The Netherlands

Trade Marks: **ZAZA**

a g a i n s t

Applicant: **Ms. Isabelle Van Hulle**
10 rue de Turbigo
75001 Paris
France

Representative: **Ms. Aline Ballot**
7, rue Le Sueur
75116 Paris
France

Contested application: **MADemoiselle ZAZA**

THE OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET
(TRADE MARKS AND DESIGNS)

I. FACTS AND PROCEDURE

On 20/07/1998 Ms. Isabelle Van Hulle, "the applicant", filed application No 300897 to register the sign MADemoiselle ZAZA as a trade mark in classes 3, 24 and 25. The applicant was represented by Ms Aline Ballot, authorised to represent others before the Office.

The application was published in Community Trade Marks Bulletin No 29/98 of 20/04/1998.

On 20/07/1998 Zaza Confectie-Industrie B.V., "the opponent", filed a notice of opposition to the application. The opponent was represented by Shield Mark B.V., authorised to represent others before the Office.

The opposition is based on the following earlier rights:

-Benelux trade mark registration No 456 781 of the word mark ZAZA. It was filed and registered on 17/03/1989 for a range of goods in class 25.

-International trade mark registration No 540 608 of the word mark ZAZA with effect in Austria, Germany, Spain, France, Italy and Portugal. It was filed and registered on 20/06/1989 for a range of goods in class 25.

The opponent bases his opposition on all the goods which are covered by his registrations namely:

-BENELUX-456781: "*Clothing for women, namely skirts, trousers and blazers (jackets) for women in the age category of 30-60 years*" in class 25.

-INT-540608: "*Clothing for women*" in class 25.

The opponent directs his opposition against all the goods of the application:

"*Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices*" in class 3;

"*Bed and table covers*" in class 24.

"*Clothing, footwear, headgear*" in class 25.

The grounds of the opposition are those of Article 8(1)(a) and (b) of the CTMR (Council Regulation 40/94).

On 23/09/1998 the applicant was notified of the opposition which was assigned number B 62291.

English was established as the language of the proceedings.

The original cooling-off period of two months was extended for two months.

The adversarial part of the proceedings began on 24/01/1999.

Both parties filed observations and evidence within the time limits given by the Office. The applicant required the opponent to submit proof of use of the earlier marks on which the opposition is based and the opponent submitted documents with the purpose of establishing the use.

The Office considers that it has sufficient information and now gives a ruling on the opposition.

II. ARGUMENTS OF THE PARTIES

The opponent claims that there is a likelihood of confusion between the CTM application and the earlier marks. The only distinctive word of the CTM application is the word ZAZA which is identical to the earlier marks. The goods in class 25 of the CTM application are identical to the goods of the earlier marks. The goods in classes 3 and 24 of the CTM application are similar to the goods of the of the earlier marks.

In reply the applicant argues that he has been the owner of a French registration of the word mark ZAZA since 13/01/86.

Furthermore the applicant argues that the goods covered by the earlier marks are only clothes for women. Moreover the goods of the CTM application in classes 3 and 24 are not similar to "*Clothing for women*" of the earlier marks; the goods in class 3 refer to bodycare are not used for dress of and the goods in class 24 are related to interior décor.

He adds that visually the contested sign is composed of two words, the feminine noun MADEMOISELLE (12 letters) and the word ZAZA (4 letters) while the earlier marks are composed of only one word ZAZA. He points out the phonetic importance of the word MADEMOISELLE in the CTM application which stands at the beginning and is composed of five syllables.

He further argues that MADEMOISELLE is a distinctive word for goods in classes 3, 24 and 25. In France it refers to the fact that the goods are going to be sold to young ladies. MADEMOISELLE also refers to the family situation of the applicant and to her nickname and therefore to a very precise person. On the other hand, the earlier marks ZAZA do not have any special significance. The two signs are not conceptually similar.

The applicant concludes that there is no likelihood of confusion between the CTM application and the earlier marks.

The opponent further argues that his marks predate the mark of the applicant in all the relevant countries except France. He repeats that the word MADEMOISELLE is descriptive for women's clothes and that the goods in class 25 are identical. He adds that it is very common for clothes manufacturers to launch cosmetics and goods of class 24. Therefore the products of the CTM application in classes 3 and 24 should be considered as similar to those of the earlier marks.

In his final observations in response the applicant reaffirms that the word MADEMOISELLE is not descriptive for women's clothes. It only suggests that the clothing is intended as ladies' wear.

Moreover he requests that the evidence of use be translated into English. He adds that apparently the opponent manufactures clothes for distributors which then display their own labels and trade marks.

Finally the opponent argues that the word MADEMOISELLE fully refers to the public for which the products are made. Therefore in the CTM application ZAZA is the only distinctive word and is identical to the earlier marks.

He adds that most of the evidence provided is on several languages including English. Therefore he has fulfilled his obligation to provide proof of use of his earlier mark not only as a trade name but also as a trade mark in the language of the proceedings.

III. DECISION

A. ON THE ADMISSIBILITY OF THE OPPOSITION

The opposition fee has been paid in accordance with the Regulation.

The opposition has been entered within the time limit, form and conditions prescribed.

Consequently, the opposition is admissible.

B. ON THE SUBSTANCE

According to Article 43(2) and (3) of the CTM Regulation (Council Regulation No 40/94) :

"if the applicant so requests, the proprietor of an earlier national trade mark shall furnish proof that, during the period of five years preceding the date of publication of the

Community trade mark application, the earlier national trade mark has been put to genuine use in the Member State in which it is protected in connection with the goods or services in respect of which it is registered and which he cites as justification for his opposition, or shall prove that there are justifiable reasons for its non-use, provided the earlier national trade mark has at that date been registered for not less than five years. In the absence of this proof the opposition shall be rejected. If the earlier national trade mark has been used in relation to part only of the goods or services for which it is registered it shall, for the purposes of the examination of the opposition, be deemed to be registered in respect only of that part of the goods or services".

According to Rule 22(1) and (2) of the Implementing Regulation (Commission Regulation EC No 2868/95) :

"Where, pursuant to Article 43 (2) or (3) of the Regulation, the opposing party has to furnish proof of use or show that there are proper reason for non-use, the Office shall invite him to provide the proof required within such period as it shall specify. If the opposing party does not provide such proof before the time-limit expires, the Office shall reject the opposition.

The indication and evidence for the furnishing of proof of use shall consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods and services in respect of which it is registered and on which the opposition is based, and evidence in support of these indications in accordance with paragraph 3".

In accordance with Article 43 of the Regulation, the applicant requested proof of use of the earlier Benelux trade mark No 456 781 and the earlier International trade mark No 540 608 for all the goods i.e. :

-BENELUX-456781: "*Clothing for women, namely skirts, trousers and blazers (jacket) for women in the age category of 30-60 years*" in class 25.

-INT-540608: "*Clothing for women*" in class 25.

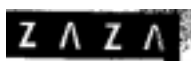
On 12/03/1999 the Office forwarded the request of proof of use to the applicant and invited him to provide the proof required within two months, that is on or before 12/05/1999.

On 12/05/1999, by fax, within the time limit, the opponent submitted the following evidence to prove the use of the earlier marks :

-an article written in Dutch about the acquisition of the mark ZAZA in 1986, its development until 1991 with a picture of a blouse of the 1992 collection.

-a photo of a shop with the name ZAZA accompanied by an address in the Netherlands;

-a blank envelope, packing list, payment reminder, invoice, stationary and business cards with the following sign:



-a blank freight list with the address of ZAZA Confectie Industrie B.V.;

-a clothing label with the sign



and the indication of the size in the The Dutch, Belgian, German, French, Spanish and English

-a copy of an extract from the Dutch company names register related to the company ZAZA Confectie-Industrie B.V dated 10/07/1998.

Together with the confirmation copy of his fax, which the Office received on the 17/05/1999, the opponent provided a catalogue called Hesco-Fashion. As this catalogue was received at the Office after the time limit for the opponent to provide proof of use it will not be taken into consideration as evidence. Only the two pages of this catalogue referring to the history of the mark ZAZA and showing a photo of a shop with the name ZAZA will be taken into consideration as they were included in the fax dated 12/05/1999 and therefore were received by the Office within the time limit.

The opponent has provide evidence of use for the following countries: Austria, Germany, Spain, France, Italy Portugal and Benelux countries.

The documents provided by the opponent seems to refer only to The Netherlands. Most of them are written in Dutch (with some translations into English) and above all the address which appears on all the documents is in Amsterdam. The only item which may refer to other countries is the clothes label. However the fact that a label bears the size of the clothes in several different countries does not prove that those clothes have been sold in all those countries. It may be that its purpose is simply to provide information for foreign consumer in the Netherlands. Therefore the opponent did not prove the use of the earlier marks in the following countries: Belgium, Luxembourg, Austria, Germany, Spain, France, Italy or Portugal.

Moreover, according to Article 43 the opponent has to furnish proof showing use of the earlier marks during the period of five years preceding the date of publication of the Community trade mark application. In the present case the CTM application was published on 20/04/1998. Therefore the period to be taken into consideration is from 20/04/1993 to 20/04/1998.

As regards the documents provided by the opponent for The Netherlands the article about the acquisition and development of the mark ZAZA only refers to a period of time from 1986 to 1991 and the picture added refers to the 1992 collection. It does not provide any information about the relevant period. Therefore this document cannot be taken into consideration as proof of use for the relevant period of time. Moreover most of the documents provided by the opponent do not bear any date. The only other document with a date is the copy of the extract of the company name register. Eventough this document shows that the company ZAZA Confectie-Industrie B.V. was created in 1965 and still existed on the 10/07/1998, it does not show the use of the Benelux trade mark ZAZA in connection with the goods. Therefore taking into consideration all the documents provided by the opponent the Office does not have a clear indication of the time of use.

Furthermore the registered sign consists of the word ZAZA. However the sign which appears on most of the documents is as follows:



Even if the earlier mark is a word mark which is protected in any font the sign used on the documents is substantially different from the one registered.

Nevertheless, the evidence submitted with that sign could still be considered as appropriate for showing the use of the opponent's mark provided that the difference shown in the sign could be considered as not altering the distinctive character of the original. Article 15(2) CTMR provides that the use of a Community trade mark in a form differing "in the elements which do not alter the distinctive character of the mark in the form in which it was registered" shall also constitute use within the meaning required by the obligation of use set in paragraph 1 of the same article. Although this provision only refers to the compulsory use of the Community trade mark, it can also be applied by analogy to the use made of opposing trade marks, in order to apply an equal treatment for all opposing trade marks. Moreover, the concept of the obligation of use of the registered trade mark is common to the Community regulation and national regulations as a consequence of the harmonising effect of the First Directive of the Council CE/89/104, of 21 December 1988, "to approximate the laws of the Member States relating to trade marks" (Article 10(2) of the First Directive).

In the present case, the perception of the sign as registered and the sign as used is quite different. The registered mark is the word mark ZAZA while the sign shown on some of the documents submitted is a device mark which consists of a black rectangle including two Zs and besides each Z the symbol Λ. This sign differs from the registered trade mark in elements substantially affecting the general appearance of the sign as the sign on the evidence may be seen as an original presentation of the word ZAZA but also as the combination of letters VZVZ or the as the two letters Z with figurative elements.

These differences lead to the conclusion that there is an alteration of the distinctive character of the opponent's mark in the form in which it is shown in the evidence filed before the Office. Therefore, the evidence submitted which contains the sign:



cannot be considered as evidence of use of the earlier Benelux trademark ZAZA.

Finally, added to the fact that the Office has received no precise indication of the period of use of the earlier mark and that some of the documents submitted show a sign which is quite different from the registered sign, the opponent did not provide any document such as bills, sales figures, price lists etc. showing the extent of use. None of the evidence filed showed actual sales of the products under the earlier mark and that sufficient products finally reached the market in order to prove effective use.

Therefore in view of the foregoing, the opponent has not proved that the earlier marks were actually used over the period of five years preceding the date of publication of the Community trade mark in the relevant territories or that there are justifiable reasons for its non-use. Consequently, the opposition must be rejected.

An examination of further factors, in particular the existence of a likelihood of confusion or the adequacy of the evidence is thus unnecessary as the opponent did not prove the use of the earlier marks.

C. COSTS

According to the provisions of Article 81(1) of the CTMR, the losing party in opposition proceedings must bear the fees incurred by the other party, as well as all costs.

According to Rule 94(1) of the Implementing Regulation (Commission Regulation EC No. 2868/95), the apportionment of costs is dealt with in the decision on the opposition.

Since the opponent is the losing party in the opposition proceedings, he must bear all costs incurred by the other party in the course of these proceedings.

ON THESE GROUNDS, THE OFFICE DECIDES:

1. Opposition number **B 62291** is rejected in its entirety.
2. The costs are to be borne by the opponent.

Alicante, 29/05/2000

Unit 15 of the Opposition Division

Virginia DOUGLAS

Isabelle ROUVEURE

Udo PFLEGHAR