

O-423-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2633113  
BY LUKE ANTHONY CONNELLY  
TO REGISTER THE TRADE MARK:**



**IN CLASS 25**

**AND:**

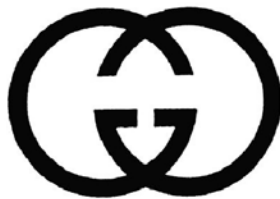
**OPPOSITION THERETO UNDER NO. 104130  
BY GUCCIO GUCCI S.p.A**

## BACKGROUND

1. On 26 August 2012, Luke Anthony Connelly applied to register the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 21 September 2012 for a specification of goods in class 25 which reads: "Clothing".

2. The application is opposed by Guccio Gucci S.p.A ("the opponent"). The opposition, which is directed against all of the goods in the application, is based upon grounds under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 ("the Act"). For its opposition under both grounds, the opponent relies upon all of the goods and services in the following registrations:

**CTM no. 9604653** for the mark:



applied for on 16 December 2010 and which completed its registration procedure on 26 April 2011. The mark is registered in a range of classes which includes the following:

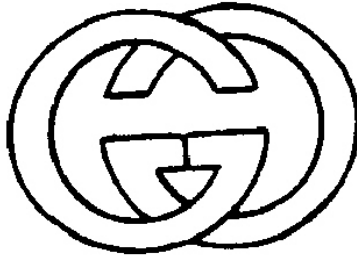
**Class 3** – Bleaching preparations and other substances for laundry use; Cleaning, polishing, scouring and abrasive preparations; Soaps; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices.

**Class 14** – Precious metals and their alloys and goods in precious metals or coated therewith, not included in other classes; Jewellery, precious stones; Horological and chronometric instruments.

**Class 18** - Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas, parasols and walking sticks; Whips, harness and saddlery.

**Class 25** - Clothing, footwear, headgear

UK no. 1082541 for the mark:



applied for on 17 August 1977 (with a priority claim from Italy dated 4 May 1977) and which completed its registration procedure on 11 July 1984. The mark is registered in the following classes:

**Class 3** –Non-medicated toilet preparations, cosmetic preparations, perfumes, soaps, dentifrices, preparations for the hair; anti-perspirants, depilatory preparations.

**Class 14** –Bracelets included in Class 14, watches, necklaces, earrings; tableware and keyrings, all of precious metals or coated therewith.

**Class 18** – Handbags, pocket wallets, shoulder bags, holdalls, travelling bags, toilet bags, brief cases, umbrellas, attache cases, document cases, whips, walking sticks; pouches, cases all included in Class 18; purses (not of precious metal or coated therewith); key fobs, card cases, holders for paper tissues, passport cases, all made of leather.

**Class 25** - Scarves, blouses, trousers, T-shirts, cardigans, jumpers, skirts, coats; socks and belts, all being articles of clothing; all made from textile materials or from knitted materials; shoes and boots.

The registration is subject to the following disclaimer: “Registration of this mark shall give no right to the exclusive use of the letter "G".”

In its notice of opposition the opponent states:

“1.1 The opponent...was founded by Mr Guccio Gucci in Florence in 1921, starting as a small family owned saddler and leather goods retailer. The first Gucci boutique was opened in 1938 in Rome and Gucci has been trading in the UK for over 50 years. The Gucci brand is now one of the most iconic and recognisable luxury goods brands in the world with a reputation for excellence, style and quality of products. The goods are marketed in the UK and around the world under a variety of brands including the iconic GG logo.”

4.1 The mark [the subject of the application] is comprised of a symmetrical mirror image of the letter G and a second G's reflection, i.e. it is comprised of two letter Gs in total. Equally, the earlier Gucci trade marks are both comprised of a double letter G. As per the visual representation [of the application], the Gs in the earlier Gucci trade marks face one another, giving the visual impression of a symmetrical mirror image. As such, there is a notable visual link between the trade marks. Aurally, our client's trade marks are referred to in the UK as GG or double G and [the mark the subject of the application] may also be referred to as such, creating aural identity between the trade marks."

Having commented that its marks are registered for goods in class 25 which are identical to those for which Mr Connelly seeks registration, the opponent comments on its opposition based upon section 5(3) of the Act in the following terms:

"7.1 In view of the longstanding use of the earlier Gucci trade marks in the UK for over 50 years, the marks have acquired enhanced distinctive character, by virtue of such use. The trade marks have also acquired significant repute in the UK, such that they are entitled to protection under section 5(3) of the Act. As a result of Gucci's fame and repute in the earlier Gucci trade marks, the use of the application may take unfair advantage of or be detrimental to the distinctive character or repute of the earlier Gucci trade marks. It is claimed that all three types of harm may occur.

7.2 Gucci has carved a reputation specifically in the luxury goods market, including luxury designer and couture clothing, as well as related accessories. The use of the application without due cause, particularly in the general non-luxury fashion market, may lead to a change of economic behaviour on the part of UK customers. Gucci's reputation may suffer damage by association with a non-luxury or low cost fashion brand. In particular, the use of the application in this marketplace would be liable to tarnish the aura of luxury and prestige surrounding the earlier Gucci trade marks. In view of the foregoing, there is liable to be a change in UK consumer's purchasing decisions, and in particular their association of the earlier Gucci trade marks in the luxury market.

7.3. It is submitted that the harm is unfair because the [mark the subject of the application] benefits from the aura of luxury and prestige surrounding the earlier Gucci trade marks. In particular, it benefits from the amount invested by Gucci in preserving and maintaining a market share in the luxury and couture clothing markets, as opposed to the general low cost fashion market. The [mark the subject of the application] therefore gains an unfair leg up in the market place since it benefits from a marketing advantage without any financial investment in the luxury goods market. Equally, without any investment in the quality of design, fabrics, and luxury distribution channels, the [mark the subject of the application] gains an association with the luxury fashion market, meaning that consumers may be willing to pay higher prices for the clothing because of the association

with the earlier Gucci trade marks and their position in this specific sector of the fashion market place.”

3. Mr Connelly filed a counterstatement. As this counterstatement contains the only comments I have from him, they are reproduced in full below:

“The opponent refers to a notable visual link between the trade marks, which is, in my opinion, greatly exaggerated. To the contrary, my trade mark is distinguishably, notably and overall fundamentally different.

I also think it is worthy to note the curious fact, especially for a company of Gucci’s size, that they do not have a strong visual presence on the world’s largest search engine to a visual identity they claim to value so much. A quick GG search on Google Images will show that the offended can’t place too valuable a claim on the invented GG visual or aural identity to support their brand and this is after all, the evidence of their opposition to my trademark logo.

I believe, in this case, the opponent uses generalities and hyperbole to exaggerate the repercussions of my brand imitation. They can’t convincingly or otherwise, demonstrate nor justify why my specific trade mark causes likelihood of confusion to the consumer-through similarities or imitation-and therefore can’t justify why my specific trade mark is ultimately unfair.”

4. Only the opponent filed evidence. Neither party has asked to be heard, nor did they file written submissions in lieu of attendance at a hearing.

### **The Opponents’ evidence**

5. This consists of two witness statements. The first, is from Vanni Volpi, the opponent’s Intellectual Property Counsel. The main points emerging from Mr Volpi’s statement are:

- The opponent is a luxury Italian fashion house selling ready to wear and couture clothing, handbags, wallets, sunglasses, watches, shoes, jewellery and associated accessories;
- The opponent has been trading in the UK for over 50 years;
- The opponent’s goods are marketed in the UK and around the world under a variety of brands including the GG logo [i.e. the subject of its registrations];
- The GG logo was first used in the early 1960s in Italy and the USA. The GG logo was a prominent feature of the opponent’s first ready to wear clothing range in the late 1960s featuring as a fastening/buckle on bags and belts;
- The GG logo pattern also appeared on suits, coats, men’s raincoats, as well as on suitcases, sports and shoulder bags;

- The GG logo has appeared and reappeared over the years. After the 1960s it appeared in Gucci's autumn/winter 1995/96 advertising campaign and then again in the 2000 clothing/accessory collection. Exhibit 1 consists of: (i) extracts taken from a book entitled: "GUCCI THE MAKING OF" (the publication date of which is not provided) and (ii) extracts taken from a book entitled: "GUCCI BY GUCCI 85 years of Gucci" which bears a copyright date of 2006. The extracts provided refer, inter alia, to "the iconic double G", "double G monogram" and "The GG" as well as showing the logo on women's clothing and a bag. The logo on the bag (page 17) looks like this:



- In 2005, 2006, 2007 and 2008, according to a Business Week Report, "the opponent was amongst the 50 most valuable brands in the world". Exhibit 2 consists of extracts from Wikipedia dated 24 January 2008 which includes the following text: "Gucci generated over US\$7 billion worldwide of revenue in 2006 according to Business Week magazine and was ranked 46<sup>th</sup> in the magazine's annual chart "Top 100 Brands";
- The opponent's website [www.gucci.com](http://www.gucci.com), which was established in 1996, received the following views from the UK: 2008 – 1,442,697, 2009 – 2,777,615, 2010 – 277,846 and 2011 – 3,172,420 [a total of 7.7m];
- The opponent either owns or has concessions in a number of stores in the UK. Exhibit 3 indicates there are 12 stores in London (including at airports), 2 in Manchester and 1 each in Birmingham and Glasgow. The London Sloane store was the first to open in 1996 and all of the stores were opened prior to the date of Mr Connelly's application in 2012. The logo is used throughout the stores, on the goods, at point of sale and on receipts, swing tags and bags;
- The logo is also used in catalogues. These are produced on an annual basis with different items in each collection i.e. Autumn-Winter, Spring-Summer and Cruise. The items in the catalogue are also available in stores;

6. The quality of much of the opponent's catalogue/website evidence is very poor and it is often difficult to discern which (if any) of the opponent's marks are depicted. However, to the extent that either of the opponent's marks relied upon is shown in the evidence, I shall refer to that fact throughout this summary as the goods bear "the logo".

- Exhibit 4 is provided to show use on "shoes, belts and other goods in class 25." Page 30 comes from the 2006 spring-summer catalogue and shows the use of the logo on watches; the 2006-2007 fall-winter catalogue shows use of the logo on a range of ladies' bags (pages 34-37 and 39-43), on a man's belt (page 38), on ladies' boots and shoes (pages 44-50) and on jewellery (page 52). Pages 53-58 were downloaded from [www.gucci.com/it](http://www.gucci.com/it) and [www.gucci.com/images](http://www.gucci.com/images) on 5 March 2009. The pages, which are all in Italian, bear images of what appears to be primarily a range of wallets and purses. The logo can be seen on some of the goods. Pages 59-63 are from the "small leather goods collection fall-winter 2004-2005"; the logo can be seen on belts for men and women. Pages 65-68 are from the spring-summer 2005 catalogue; the logo can be seen on belts for men and women. Pages 70-74 are from the 2005-2006 fall-winter catalogue; the logo can be seen on men's belts. Pages 75-77 appear to relate to a video of some description; the date of the pages cannot be made out. Pages 78-84 were downloaded on 31 March 2008 from [www.gucci.com/uk](http://www.gucci.com/uk) and appear to come from the 2008 spring-summer catalogue. The goods shown are handbags and women's shoes and the logo can be seen on some of these goods. Pages 85-87 were downloaded from [www.gucci.com/uk](http://www.gucci.com/uk) on 1 September 2008 and appear to come from the 2008 fall-winter catalogue. The goods are all items of silver jewellery upon some of which the logo can be seen. The date of pages 88 and 89 cannot be made out. The logo can be seen on both pages on a pair of ladies' shoes;
- Sales of goods in class 25 featuring the UK mark are as follows: 2007 - £8,378, 2008 - £52,301, 2009 - £88,317, 2010 - £34,818 and 2011 - £1,732 [a total of £186k];
- The opponent advertises in national and international fashion, lifestyle and business magazines, with newspapers used for store opening and short-term marketing. Its franchisees and licensees are required to spend no less than 5% of the total annual purchase from the opponent on "local communications". The opponent's perfume licensees are required to spend not less than 4% of net sales on advertising and marketing the opponent's products;
- The opponent has its own team of public relations professionals based in major cities including London; these are supplemented by external public relations professionals. The opponent targets the fashion press, offering products bearing the logo for photographic shoots and providing up-to-date product information;
- In the period 2008 to 2011, the opponent spent €238k advertising in the UK: "on the proprietor's brands including the [logo]..." Advertisements have been placed

in: *Sun 2, Vogue, Dazed & Confused, Wallpaper, ID, Sunday Times Style, Conde Nast Traveller, Arena, Esquire, GQ, ID, Glamour, Another Man, Elle, Vanity Fair* and *The Times*. Exhibit 5 is said to consist of an extract from April 1981 which appeared in *Vogue*; although the quality of the image is very poor, the logo can, I think, be seen on a bag and a wallet/purse;

- In relation to its goods in class 3, the logo has been used in the UK since 1985 on EAU DE GUCCI, GUCCI NO.1, GUCCI NO 3 and GUCCI POUR HOMME. Exhibit 6 consists of an undated photograph of the “GUCCI No.3” Eau De Toilette product. Although the quality of the image is very poor, the logo can just about be made out.
- From October 2010, the logo was used for the fragrance GUCCI GUILTY. Exhibit 7 consists of a number of what appears to be undated Internet screen prints obtained from [www.gucci.com](http://www.gucci.com) and [www.gucciparfums.com](http://www.gucciparfums.com) (one of which appears to be of US origin and some of which are in Italian), together with two pages (104-105) directed at the trade. The logo can be seen on a range of personal care products in class 3. Exhibit 8 consists of invoices from P&G Prestige Products (who I assume is the opponent’s distributor) to: House of Frazer and Debenhams (dated 10 December 2010), Brook House Pharmacy and Debenhams (dated 7 October 2011), Gill Chemist (dated 22 November 2011) and Debenhams (dated 10 February, 13 March and 29 June 2012). All of the invoices refer to GUCCI GUILTY and relate to a range of personal care products in class 3. Sales of class 3 goods featuring the UK mark are as follows: 2010 - £11,281,133, 2011 - £21,851,339 and (to March) 2012 £1,768,068 [a total of £34.9m];
- In relation to its goods in class 14, sales of goods featuring the UK mark are as follows: 2006 - £2,730, 2007 – £3,063, 2008 - £4,770, 2009 - £17,337 and 2010 - £1,808 [a total of £30k]. Exhibit 9 consists of pages from: (i) fall-winter 2005-2006 showing the logo on a silver bracelet and necklace (pages 120-123), (ii) spring-summer 2006 showing the logo on a bracelet and necklace (pages 124-127), (iii) the “cruise collection/gift cruise” (the date of which is not provided but which is designated “season 21”) showing the logo in use on silver key chains (pages 128-131), (iv) “the home and gift collection fall winter 2004-2005” showing the logo on a key chain (pages 132-134), on a money clip (page 135), possibly on napkins and napkin rings and on a mixer spoon and olive picks (page 136) and on silver jewellery (pages 139-140), (v) spring-summer 2006, showing use on a bracelet and necklace (pages 142-145). Pages 146-161 consists of pages taken from the “GUCCI TIMEPIECE COLLECTION” which bears a copyright date of 1988. It features a range of men’s and ladies’ watches many of which, I think, bear the logo. Pages 162-163 are from the 2005 fall-winter catalogue; the logo can be seen on a bracelet and necklace;
- In relation to its goods in class 18, sales of goods featuring the UK mark are as follows: 2006 - £53,862, 2007 - £172,231, 2008 - £215,309, 2009 - £2,694,908,



2010 - £4,327,719 and 2011 - £1,914,418 [a total of £9.4m]. Exhibit 10 is an exact copy of exhibit 4 which I have summarised above.

7. The second statement is from Victoria Leach, a trade mark attorney at Mischon de Reya, the opponent's professional representatives. As the majority of Ms Leach's statement consists of submissions rather than evidence, it is neither necessary nor appropriate for me to summarise these submissions here. I will, of course, keep them in mind when reaching a conclusion. To the extent that Ms Leach's statement does contain evidence, she refers to exhibit 1 which consists of the results of a Google search conducted on 23 April 2013. Pages 8-11 indicate that insofar as necklaces, a pendant and a watch are concerned, four different retailers (i.e. goldsmiths.co.uk, johnlewis.com, ernestjones.co.uk and fraserhart.co.uk), refer to the logo by the word and letter "Double G". Pages 12-13 relate to sunglasses and were obtained from amazon.co.uk. The letters GG are, for example, being used in the following way: "New Gucci Sunglasses GG2887..." and "Gucci Sunglasses GG 3166S..."; the logo can be seen on the sunglasses.

8. That concludes my summary of the evidence filed to the extent I consider it necessary.

## **DECISION**

9. Sections 5(2)(b) and 5(3) of the Act read as follows:

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

(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, or

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

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

10. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6.-(1) In this Act an "earlier trade mark" means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. In these proceedings, the opponent is relying upon the marks shown in paragraph 2 above, both of which constitute earlier trade marks under the above provisions. Given the interplay between the date on which the application was published and the date on which the opponent’s marks completed their registration procedure, only UK no. 1082541 is, in principle, subject to proof of use, as per section 6A of the Act. However, as Mr Connelly did not ask the opponent to provide proof of use, it can rely upon all of the goods and services in both of its earlier marks.

### **The opposition based upon section 5(2)(b)**

#### **Section 5(2)(b) – case law**

12. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

#### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

#### **The principles**

“(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

- (b) the matter must be judged through the eyes of the average consumer of the goods or 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, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

## **Comparison of goods and services**

13. Having focused on the competing goods in class 25, in its submissions the opponent states:

“10...The registrations also extend to a number of similar and complementary goods in classes 3, 14 and 18. Many clothing brands and retailers produce their own brand perfume, jewellery and handbags and leather items under the same mark and/or a sub brand as part of a complete fashion range.”

14. Although the earlier marks are registered for a range of goods and services, as Mr Connelly has only applied for registration in respect of “clothing” in class 25, and as the earlier marks are also registered in this class, the focus of the opponent’s attention on class 25 is understandable. In my view, it is this class in the earlier marks which offers the opponent the best prospect of success. As CTM no. 9604653 includes the word “clothing”, the competing goods are clearly identical. As to UK no. 1082541, this is registered for: Scarves, blouses, trousers, T-shirts, cardigans, jumpers, skirts, coats; socks and belts, all being articles of clothing; all made from textile materials or from knitted materials; shoes and boots.” In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 the GC stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

15. As many of the goods in UK no. 1082541 would be included in the term “clothing” in Mr Connelly’s application, the competing goods are, on the principle outlined above, once again identical. Although the opponent also relies on its goods in classes 3, 14 and 18 (some of which contain goods which are, to varying degrees, similar to Mr Connelly’s goods), it is not, for reasons which will become obvious, necessary for me to conduct a further analysis in relation to these other classes.

## **The average consumer and the nature of the purchasing process**

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods and then to determine the manner in which these goods will be selected by the average consumer in the course of trade. Although the opponent also relies upon the other classes mentioned above, as once again its specifications which include articles of clothing offer it the best prospect

of success, it these goods upon which I will focus my considerations. The average consumer for such goods is a member of the general public, with the goods most likely to be the subject of self selection from retail outlets, catalogues and websites. In *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs)* Joined cases T-117/03 to T-119/03 and T-171/03 the General Court (GC) said in relation to the selection of clothing:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”




17. Considered overall, I agree that the selection of the goods will be predominantly a visual one; while aural considerations may play their part, in my view, it will be to a lesser extent. The cost of the goods can vary considerably. In *New Look* the GC also considered the level of attention taken purchasing goods in the clothing sector. It said:

“43 It should be noted in this regard that the average consumer’s level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trade marks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.”

18. When selecting articles of clothing, factors such as material, size, colour, cost and compatibility with other items of clothing etc. may all come into play. This suggests that the average consumer will pay a reasonable level of attention when making their selection, a level of attention which is likely to increase as the cost and importance of the item of clothing increases.

## Comparison of marks

19. The competing marks are as follows:

The opponent's marks	Mr Connelly's mark
 <p data-bbox="435 594 505 625">CTM</p>	
 <p data-bbox="427 804 475 835">UK</p>	

20. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives marks as a whole and does not pause to analyse their various details. In addition, he 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. In reaching a conclusion on similarity I must compare the respective marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective marks.

21. In my view, neither parties' marks have any dominant elements; rather the distinctiveness lies in the totality of each mark (the disclaimer against the opponent's UK mark has no bearing in this regard). All of the opponent's submissions on the degree of similarity between the competing marks are based upon the assumption that both parties' marks will be seen by the average consumer as two letter Gs. When considered as unused marks, I very much doubt that the average consumer will see either parties' marks in this way. Much more likely, in my view, is that the average consumer will perceive both parties' marks as pure devices. Considered on that basis, the opponent's marks consist of two incomplete and overlapping circular elements presented in black and white which combine to create a device which looks not unlike an incomplete Venn diagram. Mr Connelly's mark is presented in red and consists of two separate incomplete semi-circles facing one another, the bottom parts of each combining to create the impression of a human torso or an article of clothing such as a t-shirt. While the fact that Mr Connelly's mark is presented in red does not, for the reasons given by Mann J in *Specsavers International Healthcare Ltd v Asda Stores Ltd* (No. 2) [2011] FSR 1 assist in distinguishing the competing marks, other than the fact that, broadly speaking, both parties' marks contain circular elements, they are, in my view, visually similar to only a very low degree. As neither parties' marks is likely to send any conceptual message to the average consumer, and as the average consumer

is, in my view, unlikely to know how to refer to the marks orally and will not, as a consequence attempt to do so, the competing marks are, in my view, neither conceptually or aurally similar to any degree.

### **Distinctive character of the earlier marks**

22. I must now assess the distinctive character of the earlier marks. The distinctive character of a mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In her statement Ms Leach stated:

“4...I believe that the principle of enhanced distinctive character through use should be applied to the registrations on the basis of the turnover figures, geographical scope of use, length of use, and level of advertising investment in the marks. Additionally, the marks the subject of the registrations are inherently distinctive on the basis that they do not describe or allude to any items in the specifications of the registrations.”

23. I agree with the opponent that absent use, its earlier marks are inherently distinctive, and, in my view, inherently distinctive to a high degree. The opponent has, of course, also provided evidence in support of its claim to enhanced distinctive character/reputation, none of which has been challenged by Mr Connelly. In its evidence, the opponent indicates that it has been trading in the UK for over fifty years, that it has 16 stores/concessions in the UK (the first of which opened in 1996) and it provides figures for the sale of goods in the UK in classes 3, 14, 18 and 25, which it indicates are sales featuring the mark the subject of UK no. 1082541. It also indicates that between 2008 and 2011 its website received some 7.7m views from the UK and that €238k has been spent in the UK promoting its brands (including the earlier marks).

24. Although the quality of much of the evidence is poor, considering the evidence as a totality, I am prepared to accept that it shows that prior to the date of Mr Connelly's application, the opponent has made use of (at least) the trade mark the subject of the UK registration. Sales of goods in class 3 between 2010 and March 2012 amounted to some £34.9m with use shown on a range of personal care products. Even allowing for what I assume to be the size of the market for such goods, this is a not insignificant sum and will, in my view, have built upon the already high degree of inherent distinctiveness the earlier UK mark possesses. Sales of goods in class 14 between 2006 and 2010 amounted to some £30k with use shown on jewellery, watches, key chains and money clips. However, given the obvious size of the market for such goods, this level of sales is clearly insufficient to improve upon the UK mark's inherent distinctive character.

25. Sales of goods in class 25 between 2007 and 2011 amounted to some £186k with use being shown on belts for men and women and boots and shoes for women. Given the obvious size of the market for clothing in the UK, this amount is, once again, clearly insufficient to improve upon the UK mark's inherent distinctiveness. Finally, sales of goods in class 18 between 2006 and 2011 amounted to some £9.4m with use shown on a range of ladies' bags as well as on wallets and purses. Much like sales in class 3, even allowing for the obvious size of the market for such goods, this is a not insignificant sum and will have built upon the already high degree of inherent distinctiveness the earlier UK mark possesses.

### **Likelihood of confusion**

26. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier marks as the more distinctive these marks are, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

27. As I mentioned earlier, the opponent's submissions concentrate on the goods in class 25. Considered on that basis, the competing goods are identical as is the average consumer i.e. a member of the public who will select the goods by primarily visual means and who will pay a reasonable degree of attention when doing so. Having found that the opponent's earlier marks are inherently distinctive to a high degree, I also found that the level of sales in class 25 of the UK mark were insufficient to have improved upon the mark's inherent distinctiveness. However, notwithstanding the identity in the goods and the high degree of inherent distinctive character the earlier mark possess, and keeping in mind the potential for imperfect recollection, I have no hesitation concluding that the very low level of visual similarity and complete lack of either aural or conceptual similarity between the competing marks is more than sufficient to avoid a likelihood of either direct or indirect confusion. In reaching the above conclusion, I have not overlooked the fact that by virtue of the use made of it in relation to a range of goods, the opponent's earlier UK mark may be referred to, for example, by the word and letter "double G." However, even if that were the case for both of the opponent's marks, as the average consumer would not, in my view, refer to Mr Connelly's mark in the same manner, my conclusions on the degree of aural and conceptual similarity are unaffected.

28. As to the other goods in classes 3, 14 and 18 upon which the opponent relies (some of which will, to varying degrees, be similar to Mr Connelly's goods), they are still, self evidently, less similar than those I have already considered in class 25. Although the



level of use the opponent has made of its UK mark in classes 3 and 18 (but not class 14) will have built upon its inherent distinctive character, given the very low level of visual similarity in the competing marks I identified earlier, any enhanced distinctive character this mark may possess does not, given the lesser degree of similarity in the competing goods, place the opponent in any better position.

### **Conclusion under section 5(2)(b)**

29. The opposition based upon section 5(2)(b) of the Act fails.

### **The objection based upon section 5(3) of the Act**

30. The principles to be applied when determining an objection under this ground were summarised by the Hearing Officer, Allan James, in BL O-179-11 as follows:

“(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors Corp v Yplon SA* [2000] RPC 572 (CJEU), paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel Corporation Inc v CPM United Kingdom Ltd* - [2009] RPC 15 (CJEU), paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10 (CJEU), paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in

the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; Intel, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; Intel, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal SA and others v Bellure NV and others* - C-487/07 (CJEU), paragraph 40.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal*, paragraph 41."

31. Even if I proceed on the basis that the evidence establishes that the opponent's UK mark has a reputation in the UK in classes 3 and 18 in line with that outlined in *General Motors*, the very low level of visual similarity between the competing marks is still, in my view, insufficient for any "link" to be made in the mind of the average consumer. Without this link being made, the opposition based upon section 5(3) of the Act cannot succeed and is dismissed accordingly.

### **Overall conclusion**

32. The opposition based upon sections 5(2)(b) and 5(3) of the Act has failed.

### **Costs**

33. As Mr Connelly has been successful he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, and keeping in mind that Mr Connelly has represented himself, I award costs to him on the following basis:

Preparing a statement and considering the opponent's statement: £150

Considering the opponent's evidence: £250

**Total: £400**

34. I order Guccio Gucci S.p.A. to pay to Luke Anthony Connelly the sum of **£400**. This sum is 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.

**Dated this 25th day of October 2013**

**C J BOWEN  
For the Registrar  
The Comptroller-General**