

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2275145
BY AVENUE FASHIONWEAR LTD
TO REGISTER THE TRADE MARK:**

GINAARTI

IN

CLASS 25

AND

**THE OPPOSITION THERETO
UNDER No 80420
BY GINA SHOES LIMITED
BASED UPON THE EARLIER TRADE MARK:**

GINA

Trade Marks Act 1994
in the matter of application no 2275145
by Avenue Fashionwear Ltd
to register the trade mark:
GINAARTI
in class 25
and
the opposition thereto
under no 80420
by Gina Shoes Limited

BACKGROUND

1) On 13 July 2001 Avenue Fashionwear Ltd (referred to afterwards as AFL) applied to register the trade mark **GINAARTI** (the trade mark). The application was published for opposition purposes in the Trade Marks Journal on 29 August 2001 with the following specification:

articles of clothing

The above goods are in class 25 of the International Classification of Goods and Services.

2) On 29 November 2001 Gina Shoes Limited (referred to afterwards as GSL) filed a notice of opposition to this application.

3) GSL limited its grounds of opposition in its written submissions and I will only deal with these limited grounds. GSL lists four trade mark registrations and one trade mark application in its grounds of opposition. The registrations are for the word GINA on its own and the application for GINA and a logo. Owing to the breadth of its specification GSL none of its other trade marks can put it in a better position than its Community trade mark registration no 1283217 of the trade mark **GINA**. This trade mark was filed on 16 August 1999 and registered on 25 June 2002 for the following goods:

articles of clothing, footwear, headgear

The above goods are in class 25 of the International Classification of Goods and Services.

GSL states that the above registration is similar to AFL's trade mark and encompasses identical or similar goods. GSL states that it has a reputation in the trade mark GINA. Consequently, there exists a likelihood of confusion between its trade mark and that of AFL and so registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

4) GSL states that it has a goodwill in the business of luxury footwear and handbag products which is associated with the signs GINA and GINA and logo. Consequent upon this goodwill it considers that use of the trade mark is liable to be prevented by the law of passing-off. Consequently, registration of the trade mark would be contrary to section 5(4)(a) of the Act.

5) AFL filed a counterstatement in which it denies the grounds of opposition.

6) Both sides have filed evidence and both sides seek an award of costs.

7) After the completion of the evidence rounds both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing, so I will make a decision after a careful study of the papers.

8) Both sides filed written submissions and I take these into account in reaching my decision.

EVIDENCE

Main evidence of GSL

9) This consists of a statutory declaration by Attila Kurdash. Mr Kurdash is a director of GSL. Included in the exhibits is a judgment of Laddie J, exhibited at AK6. This judgment does not relate to AFL nor to the trade mark GINAARTI. The evidence before me does not bring me to any different conclusions as to the findings of fact about the business of GSL made by Laddie J. The trade mark was first used in 1954 for shoes. At the time of the writing of the declaration, April 2002, GSL had a turnover of £2 million. Half of this sum is retails sales in the United Kingdom and half wholesale sales. Of the wholesale sales 70% are for the United Kingdom and 30% for abroad. Mr Kurdash states that GSL manufactures all of the 25,000 pairs of shoes that it sells each year in London. GSL has two ranges. One range sold predominantly in the provinces, in the price range £120-150. The other sold predominantly in London, in the price range £160- 250.

10) Mr Kurdash states that GSL does not advertise. However, included in the exhibits are four advertisements from Vogue and Harpers & Queen Magazine between 1999 and 2000 for GINA shoes. The evidence tells me that GINA is used for women's shoes at the expensive end of the market. The goods are certainly not mass market. The evidence also shows, to a very limited extent, use for bags. The shoes have appeared in fashion articles in various publications, both general publications and publications specifically for fashion such as "Vogue". GINA footwear has also been the subject of some television coverage; a videotape is exhibited in relation to this. There is no doubt, in my mind, that GSL has a goodwill for the business of women's shoes associated with the sign.

The evidence of AFL

11) This consists of witness statements by Darran Ainsley Thacker and Bhupinder Dhami. Mr Thacker is a trainee trade mark agent. His witness statement relates to other United Kingdom and Community trade marks which are registered for goods in class 25 and include the word GINA; what is commonly referred to as state of the register evidence. The comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 have been quoted time and time again by the registrar:

In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g.*

MADAME Trade Mark (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.@

I will, therefore, say nothing about the state of the register evidence that Mr Thacker exhibits as it will have no bearing upon my deliberations.

12) Mr Dhami is a director of AFL. He states that the name GINAARTI was formed from the first three letters of the name of his daughter, Ginder, and the name of a friend of his daughter, Aarti. Mr Dhami states that the trade mark has been used on articles of clothing since August 2001. He states that the clothing includes t-shirts, tops and general leisurewear. Mr Dhami exhibits various items to show how AFL's trade mark has been used. The use seems to have all been on various types of casual shirtage for men. The use that has been shown is very much trade use eg at trade fairs and in a trade magazine. Mr Dhami states that AFL has been the owner of the domain name GINAARTI.CO.UK since 24 July 2001. He ends by stating that in his dealings with the general public and other members of the clothing industry he has never been aware of any instances of confusion between the trade mark GINAARTI and GSL's GINA trade mark.

GSL's evidence in reply

13) This consists of a witness statement by Mr Kurdash. Mr Kurdash states that the style, presentation and font used by AFL is similar to that used by GSL. He exhibits a photograph of AFL's trade mark in use and examples of GSL's GINA trade mark in use.

DECISION

Likelihood of confusion - section 5(2)(b) of the Act

14) According to section 5(2)(b) of the Act a trade mark shall not be registered if because-

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

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark 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”

GSL's Community trade mark is an earlier trade mark as defined above.

15) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *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 BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG* [2000] ETMR 723.

Comparison of goods

16) AFL accept that identical or similar goods are involved. I accept the submission of GSL that the goods of the application are identical to clothing and similar to footwear.

Comparison of trade marks

17) The trade marks to be compared are:

GSL's trade mark

GINA

AFL's trade mark:

GINAARTI

The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG* page 224). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG* page 224). I take into account the matter must be judged through the eyes of the average consumer of the goods/services in question (*Sabel BV v Puma AG* page 224) 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 (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* page 84, paragraph 27).

18) GSL argues that a consumer is likely to identify the two elements as GINA and ARTI, regardless of the derivation advised by AFL. GSL states that GINA is a significant and identifiable element of the trade mark of AFL. This premise relies upon me deciding that the public will analyse the various details of AFL's trade mark; moreover, analyse them in a similar fashion to GSL. I do not discount this claim as a matter of principle. Each case will rest on its merits. Certain trade marks will readily suggest that they will be perceived as consisting of two or more parts. In this case I am not convinced that the public will naturally or readily divide GINAARTI into two parts. It was certainly not my first reaction which was to see it as one word; the double a in fact suggested to me a Dutch derivation. I am not reciting this as a definitive view, simply my first impression. I do not discount GSL's argument. It is a possibility and a possibility that I must bear in mind.

19) I think that it is accepted that GINA is a well-known female forename. GINAARTI is an invented word, as such it has no conceptual association. Consequently, on this basis there is no conceptual similarity. If one indulged in GSL's dissection of the trade mark one would be left with the name GINA and the "word" ARTI. The best that could be said of this is that it might suggest a full name. If it did one would be comparing a female forename to a female full name. If that was the position taken then there would be a limited degree of conceptual similarity. However, this is very speculative. It is based on the division of the trade mark and then the presumption that ARTI is a surname. I come to the conclusion that a proposition that the trade marks share a conceptual similarity would have very weak foundations.

20) I am of the view that any consumer will pronounce the first syllable of each trade mark in the same way with a soft G. I am then left with the choice of deciding if the consumer, in the case of AFL's trade mark, is likely to form a syllable with GIN and the second syllable with A or AART (the double a making a long a sound). The latter pronunciation would make a

greater phonetic difference between the two trade marks. The former would mean that the first four letters of each are pronounced in the same manner. On the basis of the former basis this would leave the syllables ART and I, which I imagine will be pronounced as an EE sound. I consider that both these syllables would be clearly voiced, they are not likely to die away. In considering the emphasis on the various sounds I am of the view that the a in GINA and the first A in GINAARTI, if the trade mark is divided as GSL suggest, will have a dieing fall and will be the least strong of the syllables in each of the trade marks. I take into account that it is the tendency in spoken English to emphasise the beginnings of words and for the ends to be spoken less clearly. In the case of AFL's trade mark I consider that if there is any tailoring off it will be of a limited scale; the strength of the final two syllables militating against any pronounced tailoring off. I have considered here what is the best case for GSL vis-à-vis pronunciation. Considering the trade marks in their entireties I am of the view that there are noticeable phonetic differences and do not consider them to be phonetically similar.

21) GSL has invoked *Open Country Trade Mark* [2000] RPC 477. As this relates to the nature of use and in effect get-up it seems appropriate to deal with this matter in the visual comparison of the two trade marks. In that case Aldous LJ states:

“However, no court would be astute to believe that the way that an applicant has used his trade mark was not a normal and fair way to use it, unless the applicant submitted that it was not. It does not follow that the way that the applicant has used his trade mark is the only normal and fair manner. However in many cases actual use by an applicant can be used to make the comparison.”

GSL relies to some extent upon the get-up of AFL's trade mark in use. It compares this to its own get-up. I can have regard to the actual use if it can be considered normal and fair. I consider that the example shown of both the AFL's and GSL's trade mark would be normal and fair use. The alleged common get-up rests upon the similarity of the fonts used. GSL admits that the font is not unique. I would go further, I would say it is common and is unlikely to grab the memory or the recall of the consumer. There is nothing particularly noticeable about it. I cannot see that the average consumer would make any association between the trade mark because of the font used. She/he will see the word first and foremost. The nature of the fonts is such that it is unlikely to leave any residue in the memory and so nothing upon which imperfect recollection can work. In considering AFL's trade mark I note the unusual use of a double a. GSL itself states that the occurrence of the double a is unusual. I consider that this will certainly have a striking effect upon the eye. Taking into account all the elements of each trade mark I consider that they are not visually similar.

22) In considering the issue of similarity I have at all times tried to consider the average consumer. She or he is likely to be subject to the vagaries of imperfect recollection. The nature of the purchasing decision has to be considered by me. Clothing clearly covers a multitude of goods at a multitude of prices. However, that consumer is reasonably attentive and in my experience takes some notice of trade marks when purchasing clothing. I also note the comments of Mr Simon Thorley QC, sitting as the appointed person, in *React Trade Mark* [2000] RPC 285 when he stated:

“The Hearing Officer was prepared of his own experience to hold that the initial selection of goods would be made by eye, and I believe this is correct. I must therefore, in taking into account the likelihood of aural confusion, bear in mind the fact that the primary use of the trade marks in the purchasing of clothes is a visual act.”

Consequently, I consider that the issue of visual similarity or otherwise is of importance. It is my view that there is a large distance between the respective trade marks visually. I have also had to bear in mind the distinctive and dominant components of the trade marks. GSL's trade mark is GINA and this is not readily divisible; it is the distinctive and dominant component. To consider that GINA is the distinctive and dominant component of AFL's trade mark would, in my view, require firstly an artificial dissection of the trade mark and then a discarding of its second half. I consider that its distinctive and dominant component is its entirety, if that is not a contradiction.

23) Consequent upon the above I am led to the inevitable conclusion that the respective trade marks are not similar.

Conclusion

24) For GSL to succeed the respective trade marks must be similar. This is what the Directive states and it is what is pointed out in *Sabel*:

“it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if by reason of the identity or similarity both of the marks and of the goods or services which they designate, “there exists a likelihood of confusion on the part of the public”.”

It is stating the obvious to some extent. For if the trade marks are not similar then confusion is not going to arise. GSL seems to rely a lot on its claim to a reputation for women's shoes. Reputation does not make the dissimilar similar. 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 (*Marca Mode CV v. Adidas AG* page 732, paragraph 41). So even if there had been an association between the trade marks, in the strict sense, reputation would not have got GSL home. AFL in its submissions states:

“The applicant has never disputed the fact that the Opponent has a reputation in the United Kingdom for luxury designer footwear and handbags. However, we do not believe that the reputation or the degree of similarity between the goods is sufficient to overcome the visual, phonetic and conceptual differences between the two Trade Marks.”

Accepting this reputation where would it have got GSL anyway? Under the jurisprudence reputation can have an effect in three areas in relation to likelihood of confusion. A trade mark that is not particularly distinctive can become distinctive through reputation (*Sabel*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)*). In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgement of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49). In relation to clothing and footwear I cannot

see, despite the claims of AFL, that GINA is other than highly distinctive. It has no allusion to the goods, it is not a commonly used term. So reputation is not necessary to make GSL's trade mark particularly distinctive. Reputation can assist an opponent where there is only a low degree of similarity between the goods (*Canon*). In this case the goods of the application are identical to those of the registration. So nothing would be added to the pot here. Finally, *Canon* allows for reputation to be of assistance to an opponent where it would lead the public to believe that the goods "come from the same undertaking or, as the case may be, from economically-linked undertakings". So it is only in this latter case that GSL could be assisted by reputation. However, without similarity of trade marks there is no reason for the public to consider that the goods come from the same undertaking or a linked undertaking. Without similarity of trade marks there cannot be a likelihood of confusion. Throw everything you will in the pot: reputation, identity of goods, imperfect recollection, nature of the purchasing decision. It makes no difference where the trade marks are not similar. **Consequently, I find that there is not a likelihood of confusion.**

25) I note for the sake of completeness that Mr Dhami comments that he is not aware of any instances of confusion having arisen. It seems to me that the current markets for the goods in actual use are so different that this is hardly surprising. I need to consider fair and notional use upon all the goods in the respective specifications. The absence of evidence of confusion also tells me little, other than that there is such an absence of evidence. If a customer had been completely confused she/he would be unlikely to be aware of that confusion. If she/he had been confused and was aware of it there is no reason she/he would comment to either side. So the absence of evidence of actual confusion has had no weight in my deliberations.

Passing-off – section 5(4)(a) of the Act

26) Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

For a claim to passing-off to succeed the plaintiff needs to satisfy the classic trinity of requirements:

- that he has goodwill in his trade mark
- that there is a misrepresentation by the defendant (whether intentional or not)
- that he has been damaged or is likely to be damaged by the misrepresentation

27) For a misrepresentation to take place there must be deception or confusion and for this to take place the respective trade marks must be similar. I have already decided in relation to likelihood of confusion that they are not similar. I have even in relation to this ground taken into account the way in which both sides present their trade marks. As the trade marks are not similar there is not going to be deception or confusion. I cannot see that GSL can be in any better a position than under section 5(2)(b). **I, therefore, dismiss the grounds of opposition under section 5(4)(a).**

COSTS

28) Avenue Fashionwear Ltd having been successful it is entitled towards a contribution towards its costs. I order Gina Shoes Limited to pay Avenue Fashionwear Ltd the sum of £1,150. 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 07 day of April 2003

**David Landau
For the Registrar
the Comptroller-General**