

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2160590A  
BY ASDA STORES LIMITED  
TO REGISTER A SERIES OF THREE TRADE MARKS IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 46549  
BY GIORGIO BEVERLY HILLS INC.

## BACKGROUND

1) On 11 March 1998, Asda Stores Ltd of Asda House, Southbank, Great Wilson Street, Leeds, LS11 5AD applied under the Trade Marks Act 1994 for registration of the following series of three trade marks:

GEORGE

GEORGE

GEORGE

2) The original application was divided and only the Class 3 goods remained in this application. Registration is sought for the following goods:

In Class 3: “Non-medicated toilet preparations; cosmetics; perfumery; soaps; cleaning preparations; non-medicated preparations for the care of the skin, scalp, hair or the body; deodorants for personal use; dentifrices and non-medicated preparations for the care of teeth and gums; preparations for the bath; sun tanning preparations; preparations for inhibiting or preventing sun tanning; cotton wool and cotton wool buds for cosmetic or non-medicated purposes; tissues impregnated with cosmetic lotions.”

3) On the 2 March 1999 Giorgio Beverly Hills Inc. of 2400 Broadway, Santa Monica, California 90404- 4021, United States of America filed notice of opposition to the application, subsequently amended. The amended grounds of opposition, are in summary:

a) The opponent is the proprietor of eight Trade Marks (detailed at annex A) and has used these marks extensively in relation to its perfumery business in the UK and has, consequently, acquired a reputation therein.

b) The mark applied for is phonetically and visually similar to the opponent's marks and is for identical or similar goods. It is therefore contrary to Section 5(2) of the Trade Marks Act 1994.

c) The applicant's mark is to be used only in relation to goods for sale in the applicant's retail supermarket outlets; it is submitted that the applicant has no intention to use their mark in relation to the goods claimed under application number 2160590 other than in relation to such goods and, as a consequence, the said application is made in bad faith insofar as this extends to goods for sale other than in the said retail supermarket outlets. Registration of the mark should accordingly be refused in accordance with the provisions of Section 3(6) of the Trade Marks Act 1994.

4) The applicant subsequently filed a counterstatement denying the opponent's claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 4 February 2002 when the applicant was represented by Mr Purvis of Counsel instructed by Messrs Appleyard Lees, and the opponent by Mr Baldwin of Queen's Counsel instructed by Messrs D Young & Co.

#### OPPONENT'S EVIDENCE

6) The opponent filed a declaration, dated 7 March 2000, by Robert Martin Downey a Solicitor and General Counsel of Procter & Gamble UK. He explains that his company is a partnership of two companies, Procter & Gamble (L & CP) Limited and Procter & Gamble (Health & Beauty Care) Limited, both of which are members of the Procter & Gamble Group of companies. The opponent is also a member of the Procter & Gamble group which has as its ultimate parent The Procter & Gamble Company of Ohio. He also states that goods bearing the opponent's trade marks "Giorgio" and "Giorgio Beverly Hills" (herein after referred to as the trade marks) are sold in the UK by Procter & Gamble UK.

7) Mr Downey states that the trade marks were first used in the UK in 1983 and have been in continuous use since that date in relation to a wide range of toiletries and luxury goods. At exhibit RMD1 he provides items of literature which lists the range of goods offered for sale under the marks. The goods offered include perfume, eau de toilette, bath and body moisturizer and wash, aftershave, shampoo and shower gel. The literature shows use of the "Giorgio Beverly Hills" mark only. It is shown sometimes with all the letters being of equal size and, on occasions, with the word "Giorgio" being prominent and the words "Beverly Hills" some ten times smaller and barely visible.

8) Mr Downey states that between 1 July 1996 and 30 June 1997 approximately £1.7 million was spent on promoting the marks. He states that between July 1997 and June 1998 advertisements were placed in publications such as *Cosmopolitan*, *Hello*, *Marie Claire*, *OK magazine*, *19*, *New Woman* and *YOU magazine*. He states that the goods were sold throughout the UK and he provides a list of towns and cities where goods were sold which shows total UK coverage. He also provides the approximate annual value of goods supplied under the marks in the UK. The figures supplied were in US\$ so I have converted them to UK£ as follows:

Fiscal year	£
95/96	5,700,000
96/97	8,450,000
97/98	5,060,000

## APPLICANT'S EVIDENCE

9) The applicant filed four witness statements. The first, dated 7 September 2000, is by Anthony Paul Brierley the applicant's Trade Mark Attorney. In his evidence he lists other registered marks which he believes are similar to those of the two parties. However, this is of little or no relevance to the case because "state of the Register" evidence is, in principle, irrelevant: TREAT 1996 RPC 281. He also provides details of other marks being used in the marketplace which he believes to be similar to the opponent's marks. However, full details of whether the marks are registered, or how they became registered, the goods offered for sale and scale of use etc. are not provided. I do not find this evidence useful in reaching my decision.

10) Mr Brierley points out that the opponent claims to have used the their marks on "toiletries and luxury goods". He claims that the turnover figures provided therefore relate to goods in Classes 3,9,14,18 and 25. He also points out that the opponent has registrations for goods in Classes 3,14, 18 and 25 under their two marks. Details of these registrations are provided at exhibit APB6.

11) The next statement, dated 25 January 2001, is by Ben Appleton a technical assistant for the applicant's Trade Mark Attorney. Mr Appleton provides information on fashion and clothing designers who have, subsequent to designing clothes, sold perfumes and/or aftershave under the same name. I accept that there is a history of well known clothing designers launching their own brands of perfume and so will not detail the examples quoted by the witness.

12) At exhibit BA3 Mr Appleton provides a copy of an article from the Daily Mail dated 20 December 1996 which states that Asda were selling a fragrance under the mark "George 1". Further references to sales of this product are made in exhibit BA7.

13) At exhibits BA5 & 6 are numerous articles about the designer George Davies which mention the "George" brand. These show that prior to the relevant date, Mr Davies was a well known designer in the UK.

14) The third statement, dated 5 February 2001, is by Karen Lee the owner and Managing Director of Lee & Knight Public Relations. Ms Lee states that her company has been employed to undertake public relations work in relation to the "George" brand for over five years. At exhibit KL1 she provides a selection of press articles published in local and national newspapers and magazines across the UK which mention the launch and sale of GEORGE 1 fragrance by Asda Stores. These are dated from December 1996 to February 1997.

15) The last statement, dated 25 January 2001, is by Keith Bolton a Director of Publicis Limited. He states that between 1991 and 1997 four advertisements were prepared by his company for Asda in respect of the GEORGE brand. The first was shown on television in 1991, the second in 1995 and the last two in 1997. All were broadcast throughout the UK. Copies of the advertisements are provided at exhibits KB2 and 3. They show use of the applicant's marks in relation to clothing only.

#### OPPONENT'S EVIDENCE IN REPLY

16) The opponent filed two witness statements in reply. The first, dated 15 August 2001, is by Penelope Ann Nicholls the opponent's Trade Mark Attorney. She disputes Mr Brierley's definition of the term "luxury goods", pointing out that he is not an expert witness. She also states that the evidence relating to the use of the applicant's mark on goods in Class 25 is not relevant to these proceedings.

17) With regard to the claims put forward regarding the link between designers and perfumery, Ms Nicholls states that the examples quoted were all famous designers supplying luxury goods, "...aimed at the top end of the market", and not a supermarket.

18) The second statement, dated 7 September 2001, is by Rebecca Louise Ferrari an Associate with the opponent's Trade Mark Agency. She describes a visit to an Asda store in Roehampton, Surrey where she could find no perfumery products with the "George" mark, or indeed any items of perfumery howsoever branded. Her tour of the store included the pharmacy.

19) That concludes my review of the evidence. I now turn to the decision.

#### DECISION

20) At the hearing Mr Baldwin withdrew the ground of opposition based on Section 3(6).

21) The only ground of opposition is under Section 5(2)(b) of the Act which states:-

*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 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."*

22) An earlier right is defined in Section 6, 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 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,

(b)...

(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

23) In determining the question under section 5(2), 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-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;

(b) 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 Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;

(c) 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;

(d) 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;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel Bv v Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel Bv v Puma AG* page 224;

(h) further, 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;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a

likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

24) At the hearing Mr Baldwin indicated that his strongest case was under the three registered marks 1266551, 1328780 and 2014138. The marks registered consist of the name GIORGIO solus. For the applicant, Mr Purvis accepted that the goods in the specifications of each of the opponent's three marks were either identical or very similar to the specification of the mark in suit. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors. In making my global assessment I shall consider the goods as identical as this provides the opponent with the strongest possible case.

25) The applicant's mark has a small degree of stylisation in that the letter "O" is not a complete circle. At the "three o'clock" position the line travels towards the centre before heading upwards in the shape of a "W". There is also what looks to be a very small letter "D" within the letter as well. However, from a short distance the stylisation is lost and the impression is that the letter "O" is fully formed thus giving the name GEORGE. For the purposes of the global comparison I shall consider the applicant's mark to consist of the name GEORGE.

26) Visually the marks differ only in that the second letter of the applicant's mark is an "E" compared to "I" in the opponent's mark, and the applicant's mark ends with an "E" whereas the opponent's mark ends in "IO". Clearly in relatively short marks differences as more noticeable, particularly when at least one of the marks is a recognised forename.

27) The opponent contended that the marks are very similar phonetically, in that the applicant's mark is a single syllable name "GEORGE" whereas the opponent's mark is a two syllable name "GEORGE - IO". Mr Baldwin contended that the initial syllable was therefore identical. The only difference was in the endings of the names.

28) It was common ground that the marks are the same name, the opponent's mark being the Italian version whilst the applicant's mark is the English version.

29) Perfume and cosmetics products are not, I would suggest, chosen without some consideration. These products tend to be rather expensive and consumers of such products are very "brand aware" due to the cachet believed to be associated with certain brand names. The average consumer of such products would, in my opinion, exercise some care in the selection. Even so allowance must be made for the notion of imperfect recollection.

30) I also have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. Clearly as a name it has a certain inherent distinctiveness. The evidence of use filed by the opponent showed that in the year prior to the relevant date goods bearing the opponent's marks to the value of approximately £8,500,000 were sold in the UK. The opponent has three different marks, and has registrations covering goods in Classes 3,4,18 and 25. No evidence was provided relating to sales of goods in Class 3 under the mark GIORGIO solus. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date.

31) In carrying the global assessment of the likelihood of confusion I take note of the comments of Buckley, J. in the *Buler* trade mark case [1966 RPC 141]:

“It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other person than the person to whom one supposes the name to belong.”

“I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear prima facie to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question.”

32) Although these comments were made regarding a case under the 1938 Act I do believe that the views expressed are still valid under the 1994 Act. Similarly, although the learned judge referred to surnames, I believe that his comments would extend to forenames, particularly where one is a very well known and established English forename and the other obviously foreign.

33) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 11 March 1998. Consequently, the opposition under Section 5(2)(b) fails.

34) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1535. This sum 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 14<sup>TH</sup> day of March 2002

George W Salthouse  
For the Registrar  
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
GIORGIO	B1266551	07.05.86	3	Cosmetics; eau de cologne; aftershave lotions; aftershave balms; toilet preparations and creams for the care of the body; perfumes; soaps; hair lotions; essential oils; dentifrices; toilet articles and perfumed articles, all included in Class 3.
GIORGIO	B1328780	03.12.87	3	Cosmetics; eau-de-cologne; aftershave lotions; aftershave balms; toilet preparations; creams for the care of the body; perfumes; soaps; hair lotions; essential oils; dentifrices; toilet articles; perfumed articles; all included in Class 3.
	2014138	13.03.95	3	Perfumes and colognes; toiletries; toiletry, cosmetics and soap preparations, aftershave lotions, and aftershave balms, body moisturisers, body talcs, body shampoos and body creams; perfumed soaps and gels, perfumed dusting powders; deodorants for personal use and antiperspirants, suntan lotions; dentifrices; all included in Class 3.
	1271257	14.07.86	3	Cosmetics; colognes; aftershave lotions; aftershave balms; toilet preparations and creams, all for the care of the body; perfumes; soaps; hair lotions; essential oils; dentifrices; toilet articles; perfumed articles; all included in Class 3.
GIORGIO BEVERLY HILLS	1193484	06.04.83	3	Perfumes.

<p>GIORGIO BEVERLY HILLS</p> <p>Registration of this mark shall give no right to the exclusive use of the words “Beverly Hills”.</p>	1489394	30.01.92	4	Candles, perfumed candles; spills/tapers for lighting; all included in Class 4.
			18	Bags, handbags, shoulder bags and beach bags; hip pouches; cases; luggage; parasols, umbrellas and canes; goods made of leather and imitations of leather; all included in Class 18.
<p>GIORGIO</p> <p>By consent no.B1287748 (5714,0584)</p>	1573626	31.05.94	18	Travel bags, beach bags, sports bags, tote bags, carry-on luggage, clutch bags, overnight luggage, bags for travel accessories and shoe bags for travel; trunks for travel; parts and fittings for all the aforesaid goods; all included in Class 18.
<p>GIORGIO BEVERLY HILLS</p> <p>Registration of this mark shall give no right to the exclusive use of the words “Beverly Hills”.</p>	B1253985	07.11.85	25	Articles of clothing.