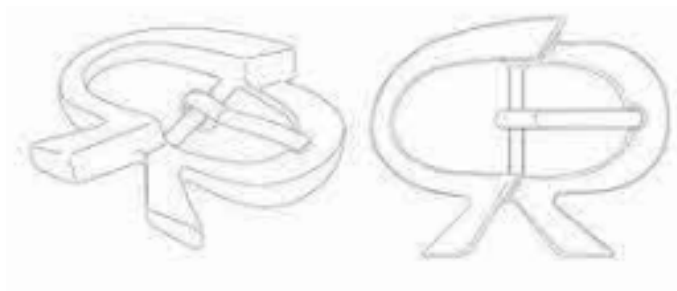


O/1162/23

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3637377 BY  
GIANVITO ROSSI S.R.L.  
TO REGISTER THE TRADE MARK:**



**IN CLASSES 18 & 25**

**AND**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 434172  
BY HADOPA INVESTISSEMENTS S.À.R.L.**

## BACKGROUND & PLEADINGS

1. On 6 May 2021, Gianvito Rossi S.R.L. (“**the applicant**”), applied to register the three-dimensional trade mark shown on the front page of this decision in the United Kingdom. It was accepted and published in the Trade Marks Journal on 22 April 2022 for the following goods:

*Class 18: Trunks [luggage]; Vanity cases, not fitted; Suitcases; Bags, handbags; Travelling sets [leatherware]; Shoe bags; Key cases; Umbrellas; Leather wallets; Pouch baby carriers; Leather coin purses; Document cases of leather; Briefcases [leather goods]; Boxes made of leather.*

*Class 25: Footwear; Gloves [clothing]; Waist belts.*

2. Hadopa Investissements S.à.r.l. (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following “earlier mark”<sup>1</sup> and claims that the application would lead to a likelihood of confusion. Pertinent details of the earlier mark are as follows:



**Mark:**  
**UK TM No:** 801328339<sup>2</sup>  
**Filing date:** 22 June 2016<sup>3</sup>  
**Priority date:** 5 April 2016<sup>4</sup>  
**Registration date:** 14 June 2017  
**Goods relied upon:**

Class 18 - Leather and imitations of leather, goods made of these materials, namely, key cases (leatherware), briefcases (leatherware and wallets); wallets; purses, card cases (wallets); credit card cases; cases for telephone cards; business card cases; tie cases; leather cases (briefcases); handbags; traveling bags; traveling sets (leatherware); garment bags (for travel); luggage (hand bags, traveling bags) and suitcases; satchels; attaché cases; moleskin; small bags; clutch bags; satchels; shoe bags, cosmetic bags; toiletry sets; animal

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<sup>1</sup> Under Section 6(1) of the Act, the opponent’s trade mark qualifies as an earlier trade mark.

<sup>2</sup> Under Article 54 of the Withdrawal Agreement, the Registry created comparable UK trade marks for all right holders with an existing EUTM or IR(EU). As a result of the opponent’s IR(EU) number 1328339 being protected as at the end of the Implementation Period, a comparable UK trade mark was automatically created. The comparable UK mark now recorded on the UK trade mark register has the same legal status as if it had been applied for and registered under UK law, and retains its original international registration date as its filing date.

<sup>3</sup> The earlier mark derives from an IR(EU) that was designated for protection in the EU on 22 June 2016.

<sup>4</sup> Priority is claimed from Benelux Trademark No. 1330074

skins; imitation fur; furs; garment bags for suits, shirts and dresses; covers for footwear; covers for parasols; umbrellas; parasols; walking sticks; trunks [luggage]; suitcases; briefcases of leather; beach umbrellas; backsacks, beach bags; vanity cases (not fitted); bags and small bags (envelopes, pouches) of leather for packaging.

Class 25 - All clothing, namely, shirts, suits, pants, dresses, jeans, jogging suits; knitwear (clothing); furs (clothing); anoraks; capes and pelerines; shawls; swimsuits; denim clothing; skirts; swimwear; dressing gowns; polo shirts; sweaters; pullovers; pyjamas; shorts; tee-shirts; underwear; hosiery; socks; hats; caps; neckties; coats; jackets; overcoats; raincoats; parkas; stockings; tights, scarves; sashes for wear; belts (clothing); gloves (clothing); footwear; boots; slippers; sandals, flip-flops; headgear; clothing of leather or imitation leather; hoods (clothing); shoes; beach clothing; overalls; short-sleeved shirts; turtlenecks; slippers (underwear); vests; sweaters; shirt yokes; shirt fronts; ready-made linings (parts of clothing); stuff jackets; pelerines; gabardines (clothing); pockets for clothing; jerseys (clothing); underwear [lingerie]; dressing gowns (robes); visors (headwear); bow ties; suits and pant suits; formal wear; dress suits; casual wear; ready-made clothing.

3. The applicant filed a counterstatement denying the claims made.
4. Both parties filed evidence in these proceedings. On 18 July 2023, a hearing took place before me, whereby Mrs Marine Body of Bromhead Johnson LLP professionally represented the applicant and the opponent was professionally represented by Mr Lewis Jones of Dummett Copp LLP.
5. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to trade mark case law of EU courts.

### **Evidence**

6. The opponent's evidence consists of a witness statement of Melanie Pellissard, a trade mark attorney for Lecomte & Partners who are responsible for the opponent's EU IP portfolio.
7. The witness statement includes a translation of an EUIPO decision. In essence, the decision confirms that under European caselaw the earlier relied upon mark is sufficiently distinctive for it to be entered on to the European Register.

## DECISION

### Section 5(2)(b)

8. The relevant law is as follows:

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

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.””

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 be dominated by one or more of its components

(f) however, it is also 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 creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Comparison of goods**

10. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (“CJEU”) stated that:

“23. In assessing the similarity of the goods or services concerned [...] all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or complementary.”

11. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

12. The competing goods to be compared are shown in the following table:

<b>Applied for goods</b>	<b>Opponent’s goods</b>
<p><i>Class 18: Trunks [luggage]; Vanity cases, not fitted; Suitcases; Bags, handbags; Travelling sets [leatherware]; Shoe bags; Key cases; Umbrellas; Leather wallets; Pouch baby carriers; Leather coin purses; Document cases of leather; Briefcases [leather goods]; Boxes made of leather.</i></p>	<p><i>Class 18 - Leather and imitations of leather, goods made of these materials, namely, key cases (leatherware),briefcases (leatherware and wallets); wallets; purses, card cases (wallets); credit card cases; cases for telephone cards; business card cases; tie cases; leather cases (briefcases); handbags; traveling bags; traveling sets (leatherware); garment bags (for travel); luggage (hand bags, traveling bags) and suitcases; satchels; attaché cases; moleskin; small bags; clutch bags; satchels; shoe bags, cosmetic bags; toiletry sets; animal skins; imitation fur; furs; garment bags for suits, shirts and dresses; covers for footwear; covers for parasols; umbrellas; parasols; walking sticks; trunks [luggage]; suitcases; briefcases of leather; beach umbrellas; backpacks, beach bags; vanity cases (not fitted); bags and small bags (envelopes, pouches) of leather for packaging.</i></p>
<p><i>Class 25: Footwear; Gloves [clothing]; Waist belts.</i></p>	<p><i>Class 25 - All clothing, namely, shirts, suits, pants, dresses, jeans, jogging suits; knitwear (clothing); furs (clothing); anoraks; capes and pelerines; shawls; swimsuits; denim clothing; skirts; swimwear; dressing gowns; polo shirts; sweaters; pullovers; pyjamas; shorts; tee-shirts; underwear;</i></p>

	<p><i>hosiery; socks; hats; caps; neckties; coats; jackets; overcoats; raincoats; parkas; stockings; tights, scarves; sashes for wear; belts (clothing); gloves (clothing); footwear; boots; slippers; sandals, flip-flops; headgear; clothing of leather or imitation leather; hoods (clothing); shoes; beach clothing; overalls; short-sleeved shirts; turtlenecks; slips (underwear); vests; sweaters; shirt yokes; shirt fronts; ready-made linings (parts of clothing); stuff jackets; pelerines; gabardines (clothing); pockets for clothing; jerseys (clothing); underwear [lingerie]; dressing gowns (robes); visors (headwear); bow ties; suits and pant suits; formal wear; dress suits; casual wear; ready-made clothing.</i></p>
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### **Class 18**

13. During the hearing Mrs Body rightfully conceded that many of the applied for goods are identical, these include the following which are identically contained in the opponent's list of goods:

*Trunks [luggage]; Vanity cases, not fitted; Suitcases; Bags, handbags; Travelling sets [leatherware]; Shoe bags; Key cases; Umbrellas; Briefcases [leather goods]*

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

*Leather wallets; leather coin purses*

15. Applying the principle set out in *Merich*, I find the applied for leather wallets to be identical to the earlier wallets, and leather coin purses to be identical to the earlier purses.

*Pouch baby carriers*

16. The opponent argues that pouch baby carriers are a small sub-section of bags/carriers and would therefore be encompassed by the broad term “backsacks” and “smallbags”.

I agree that the nature of the respective goods is similar insofar that they are intended to carry things, but there is a big difference between goods suitable to carry items and those to carry babies. They are not in competition with one another, nor are they complementary. They may be sold in the same establishments but are likely to be in different areas. Overall, I find them to be similar to a low degree.

*Document cases of leather; boxes made of leather*

17. The applied for goods are made out of leather and are aimed at carrying documents. By their very nature, users and use they are very similar to the earlier leather cases (briefcases). They are similar to a medium degree as there is also a degree of competition. The same logic applies to the applied for boxes made of leather, though there is a lesser degree of similarity as boxes will be used to store rather than transport goods. Therefore, they are similar but only to a low degree.

**Class 25**

18. The applied for class 25 goods are self-evidently identical to the opponent's goods as the competing specifications either contain identical terms or are *Meric* identical.

**Average Consumer and the Purchasing Act**

19. The average consumer is deemed to be reasonably well informed, observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

20. The average consumer of the goods in classes 18 and 25 will predominantly be the general public.
21. The selection of such goods is largely a visual process, as the average consumer will wish to physically handle the goods to ensure the correct size has been selected, whilst simultaneously appraising the overall aesthetic impact. If the consumer is buying online, then I also note they will see the marks on the websites. I do not, however, ignore the potential for the marks to be spoken, for example, by sales assistants in a

retail establishment or when making a purchase from a catalogue, over the telephone. However, in the latter circumstances, the consumer will have had an opportunity to view the goods, perhaps electronically via an online catalogue or website, or on paper in the traditional sense of catalogue shopping. Therefore, when considering the aural impact of the marks, the visual impression of these goods will already have played a part in the consumer's mind.

- 22. Although the prices of individual items will vary greatly, I consider that the average consumer will pay at least a medium degree of attention (but not the highest level) during the purchase of the remaining goods as they will be mindful of factors such as colour, size and fabric etc.

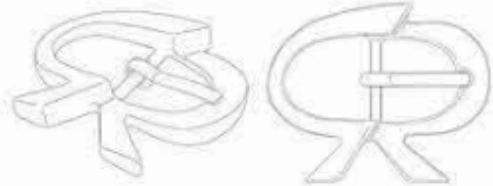

**Comparison of Trade Marks**

- 23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

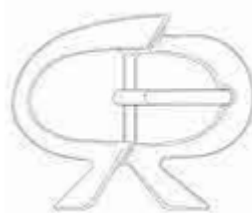
“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

- 24. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

- 25. The marks to be compared are:

Applied for mark	Earlier mark
	

26. The earlier mark consists of the letters “GR” in a vogue style font. As the letters are the only element, it is these that its overall impression resides in.
27. The applied for mark comprises of a three dimensional image of what appears to be a buckle. There are no other elements to the mark and so this is where the overall impression resides.
28. The opponent argues that when viewed from the front (see below), the mark would be viewed as a belt buckle in the shape of ‘GR’. Mr Lewis went on to argue that there are no further distinctive elements to the mark and therefore the text (GR), will have the greatest impact on and resonance with consumers.



29. In short, I do not accept the argument that the applied for mark would be viewed as ‘GR’. It would be viewed as a 3D shape of a belt buckle. I accept that as the mark has been granted registration it is distinctive, but it does not follow that the average consumer would see ‘GR’. I certainly did not see ‘GR’. Therefore, they are visually dissimilar. Applying the same logic, there can be no aural or conceptual similarity.

### **Distinctive Character of The Earlier Trade Mark**

30. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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, judgment 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 making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because

of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

31. Registered trade marks possess varying degrees of inherent distinctive character: perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities.
32. The opponent has filed evidence, but it does not relate to use of the mark. Therefore, I am only required to assess the level of inherent distinctive character.
33. The earlier mark is a two-letter mark (GR) in a mildly stylised font. Mr Iain Purvis QC, as he then was, sitting as the Appointed Person, referred with approval to a decision of the fourth Board of Appeal of OHIM (now the EUIPO), *Alfa-Beta Vissilopoulos AE v Agro de Bazan*, Case R 82/2011-4.12. The Board of Appeal considered the letters AB in a stylised form against AB in a different stylised form, saying at paragraph 16:

“As to the distinctive character of the letter combination ‘AB’ in the earlier marks and of the contested mark, either perceived as the letter ‘B’ or as a possible letter combination such as ‘PB’ or ‘AB’, it should be noted that letters or letter combinations of two or three letters are inherently weak, given the limited number of letters in the alphabet, the great number of meanings that acronyms and abbreviations may have and the fact that consumers frequently encounter abbreviations and letter combinations of all kinds in every day life and business as generic abbreviations but not as marks. In view of this, the graphical design in which the letter combinations appear strongly influences the consumer’s perception. The distinctive character of the conflicting marks to a large extent rests in their specific graphic elements.”

34. In view of the above, I consider the earlier mark to have a low level of inherent distinctive character.

### **Likelihood of confusion**

35. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, i.e., that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa.<sup>5</sup> It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the mark, the greater the likelihood of confusion. I must also keep

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<sup>5</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>6</sup>

36. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Having found that the marks are not similar, even where the goods are identical, confusion cannot arise directly or indirectly. Therefore, the opposition fails.
37. If I am found to be wrong and that a sufficient proportion of consumers would see the earlier mark as “GR” then I still do not consider there to be a likelihood of confusion. There are such striking differences between the marks that whilst they both may be referred to as “GR”, the visual differences are such that confusion will not arise. This is supported by there being no concept attached to “GR”, and that the earlier mark is of low distinctive character. In summary, I do not consider consumers would see “GR” and therefore there is not even a remote chance of a likelihood of confusion, and even if they did, the visual differences are such that no confusion (or economic link) would occur, directly or indirectly.

## **COSTS**

38. The applicant has been successful and is entitled to a contribution towards its costs. During the hearing Mrs Body referred to the opponent not filing a form TM7A “Notice of threatened opposition”, which could have led to this matter being resolved amicably. The parties did state that there was a possibility of reaching an amicable settlement and so I advised I would be willing to delay issuing the decision for the parties to explore this option. The parties subsequently notified me that a settlement was not possible, and therefore, I do not see how the filing of the form to extend the period to oppose would have made any difference, and how this should be reflected in costs. Whilst it is preferential, the opponent is not obliged to notify the applicant of its intention to oppose.
39. In view of the above and based on Annex A of Tribunal Practice Notice (TPN) 2/2016, I award contributory costs to the applicant on the following basis. This award reflects the evidence being light:

Considering the statement of grounds and preparing a defence	£250
Preparing evidence and considering the other side’s evidence	£600
Preparing for and attending a hearing	£400

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<sup>6</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

**TOTAL**

**£1250**

40. I, therefore, order Hadopa Investissements S.à.r.l. to pay Gianvito Rossi S.R.L. the sum of £1250. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 7<sup>th</sup> day of December 2023**

**Mark King  
For the Registrar,  
The Comptroller General**