

**TRADE MARKS ACT 1994**

**TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF**

**OPPOSITION No. 70681 BY GA MODEFINE SA**

**TO THE REQUEST BY DI GIO' Srl**

**FOR PROTECTION IN THE UNITED KINGDOM**

**OF INTERNATIONAL TRADE MARK No. 748500**

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**DECISION**

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**Introduction**

1. On 16 November 2000 Di Gio' Srl (**'the Applicant'**) requested protection in the United Kingdom under the provisions of the Trade Marks (International Registration) Order 1996 for the trade mark:

**LE SPOSE DI GIO'**

for use in relation to the following goods specified in International Registration No. 748500:

Clothing of all types, including bridal gowns, formal wear, beach wear, clothes for gymnastics, sports and leisure wear; footwear; underwear and clothing accessories, namely gloves, belts, ties, hats, scarves and headscarves

2. A notice and grounds of opposition to the request for protection were filed by GA Modefine SA (**‘the Opponent’**) on 9 October 2001. It was contended that use of the opposed trade mark for goods of the kind specified by the Applicant would conflict with the rights of the Opponent as proprietor of the following ‘earlier trade marks’ (as defined in section 6 of the Trade Marks Act 1994):

Community Trade Mark No. 505669

**ACQUA DI GIO’**

Date of filing: 1 April 1997

Date of registration: 30 January 2001

Goods:

Class 3: Perfumery, essential oils, cosmetics, hair lotions; dentifrices, soaps for personal use and other preparations for personal use.

Class 25: Articles of clothing, footwear and headgear.

Community Trade Mark No. 505636

**GIO’**

Date of filing: 1 April 1997

Date of registration: 27 September 2004

Goods:

Class 3: Perfumery, essential oils, cosmetics, hair lotions; dentifrices, soaps for personal use and other preparations for personal use.

Class 25: Articles of clothing, footwear and headgear.

3. For present purposes I need only mention that the request for protection was opposed under section 5(2)(b) of the 1994 Act on the ground that there were similarities (in terms of marks and goods) that would combine to give rise to the existence of a

likelihood of confusion if the later trade mark was used concurrently with either of the earlier trade marks, in the United Kingdom, in relation to goods of the kind for which the marks were respectively specified. Insofar as the opposition was based on Community trade mark number 505636, it was conditional upon the trade mark proceeding to registration. Insofar as it was based on Community trade mark number 505669, it fell to be determined in accordance with the presumption that the trade mark was and remained validly registered: Article 103 of the Community Trade Mark Regulation ('CTMR').

4. The Applicant filed a counter-statement in which it joined issue with the Opponent on the grounds of opposition. Both sides filed evidence in relation to the matters in issue between them.

5. The opposition was determined without recourse to a hearing. It was determined on the basis of the papers on file by Mr. M. Reynolds acting on behalf of the Registrar of Trade Marks. Only the Opponent filed written submissions in support of its case.

#### **The Hearing Officer's Decision**

6. In his decision issued on 2 December 2003 (BL O-377-03) Mr. Reynolds upheld the opposition under section 5(2)(b) of the Act and ordered the Applicant to pay the Opponent £1,000 as a contribution towards its costs of the Registry proceedings.

7. The hearing officer's findings, as summarised by me, were as follows:

(1) The evidence provided by the Opponent was insufficient to support a claim to any enhanced degree of distinctive character for either of the earlier trade marks; it's

claim that **GIO'** was a well known mark was unsustainable, as was its claim that **GIO'** was synonymous with '**GIORGIO ARMANI'** (paragraph 26).

- (2) The goods specified by the Applicant were a sub-set of those specified by the Opponent with the result that the goods in issue fell to be regarded as identical for the purposes of section 5(2)(b) (paragraph 31).
- (3) The word **ACQUA** makes a full contribution to the character of the mark **ACQUA DI GIO'** with **GIO'** being a distinctive and important element of the mark aided in small measure by the apostrophe: *'The impact of the mark therefore rests on its totality. I see no reason why the average consumer should accord particular weight to any single element or discount a particular element in his or her appreciation of the mark'* (paragraph 24).
- (4) For those with some understanding of Italian or other Romance languages the mark **ACQUA DI GIO** will mean 'water of gio', but for those without such an understanding the mark and its components presents a meaningless and somewhat impenetrable combination (paragraph 39).
- (5) Someone familiar with the Italian language would be likely to understand that **LE SPOSE** means 'the brides' and therefore regard the words as indicative of bridal wear and so accord them less weight within the totality of the mark **LE SPOSE DI GIO'**. However, it is more likely that non-Italian speakers *'would simply see the mark as a foreign language combination with no obvious or discernible meaning. On that basis they would have no reason to discount any particular*

*element of the mark and would accord full weight to the entirety of the mark'*  
(paragraph 35).

- (6) The evidence relating to use of the mark **LE SPOSE DI GIO'** indicated that the Applicant had two main sources of business with regard to the United Kingdom: various websites (of the 11 listed, 5 having *.com* suffixes and 6 having *.it* suffixes) and Italian language magazines dedicated to weddings, bridal wear and so forth with circulation in the United Kingdom. *'It appears, therefore, that the applicant's mark is primarily used in a context which requires familiarity with the Italian language. I regard that as being a relevant consideration in determining consumer perception of the applicant's mark'* (paragraph 36).
- (7) The significance of **GIO** as an abbreviation may not be apparent to those who are not familiar with Italian forenames and it was not material to engage in debate as to whether it is an abbreviation of Giorgio, Giovanni, Giovanna or some other name (paragraph 34).
- (8) Although visually and aurally the marks **ACQUA DI GIO'** and **LE SPOSE DI GIO'** converged on the elements **DI GIO'**, they differed in their first elements. That was normally regarded as a significant factor, but *'That is counterbalanced to a certain extent here by the fact that the element LE SPOSE would be seen as descriptive in the context of the goods and circumstances in which the mark is brought to customers' attention. Furthermore, I see no reason why consumers would not give due weight to the common elements DI GIO' or fail to observe that the marks had this distinctive element in common'* (paragraphs 37, 38).

8. The hearing officer's conclusions in the light of these findings were as follows:

41. I have found that identical goods are involved and that the applied for mark reproduces an important element of the opponents' mark. I have hesitated over the outcome of this case because of the prominence of and differences between the first elements of the respective marks. However, LE SPOSE is likely to be taken as descriptive by those whose exposure to the mark is through the medium of Italian language magazines circulating in the UK. I note that the website material at EG1 suggests that, in the same documents there are mixed uses of the full mark, and DI GIO'. The importance and status of the DI GIO' element is thus actively promulgated to consumers.

42. That is not to say that consumers will mistake one mark for the other (direct confusion). However, I take the view that the common element DI GIO' will lead consumers to think that goods sold under the respective marks emanate from the same trade source. According to *Canon v. MGM* that is sufficient to hold that there is a likelihood of confusion. Accordingly the opposition succeeds under Section 5(2)(b). There is also the matter of the opponents' application No. 505636 for the mark GIO'. It does not, I think, require further exhaustive consideration to come to the view that the opponents would succeed on the basis of this mark as well, if or to the extent that it achieves registration for the goods in Class 25 which are currently shown as being applied for. It is not necessary to consider the other grounds and the nature of the opponents' evidence suggests that they would be unlikely to succeed under any of the alternative heads if I were found to be wrong in the above decision.

### **The Appeal**

9. The Applicant appealed to an Appointed Person under section 76 of the 1994 Act. In the Grounds of Appeal it was contended that the hearing officer's decision was flawed and should be reversed because he took into account the following matters which he should not have taken into account, namely:-

- '(a) LE SPOSE is likely to be taken as descriptive by those whose exposure to the Mark is through the medium of the Italian language magazines circulating in the UK. This was not a relevant consideration. Furthermore, there were no satisfactory bases on which the Hearing Officer could have reached the conclusion that LE SPOSE is likely to be taken as descriptive on the facts before him; and
- (b) his conclusion that the importance and status of the DI GIO' element of the Trade Mark had been actively promulgated to consumers.'

In support of point (a) it was further contended that:

- the hearing officer was wrong to have given any or any material weight to the fact that use of the mark **LE SPOSE DI GIO'** had taken place in an Italian context
- on the material before him the hearing officer had no adequate reason to conclude that (a) the average consumer would understand LE SPOSE to have a descriptive meaning and/or (b) that a material number of the consumers of the Applicant's products would understand LE SPOSE to have a descriptive meaning.

10. On reading the papers for the hearing of the appeal, it appeared to me that the case raised what I shall refer to as the question of English equivalents: is it permissible and, if so, when is it permissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom? I asked for submissions from the parties and the Registrar in relation to that matter as it applied to the present case. The point was addressed orally at the hearing of the appeal and subsequently in writing in accordance

with a timetable agreed at the hearing. I am grateful to the parties and the Registrar for their helpful submissions.

11. I should mention that I was asked by the Applicant, the Opponent and the Registrar to determine the appeal to the best of my understanding without making an order for reference to the ECJ under Article 234 of the EC Treaty or an order referring the case to the Court under section 76(3) of the Act. This was subject to the caveat that I would remain able of my own motion to make an order for reference to the ECJ if I found it necessary to do so in the course of my deliberations on the points arising for consideration. In the event, I have not found it necessary to make an order for reference.

#### **Submissions on behalf of the Registrar**

12. In the submissions made on behalf of the Registrar it was pointed out that the registrability of non-English words which describe characteristics of the goods for which protection is sought, and the scope of protection to be afforded to complex trade marks including such words, are closely related questions in the context of Council Directive 89/104 of 21 December 1988 (**‘the Directive’**).

13. The approach taken by Mr. Simon Thorley Q.C. in TONALITE HENNE Trade Mark [2001] RPC 36, p.729 and by me in EL CANAL DE LAS ESTRELLAS Trade Mark [2000] RPC 291 indicated that due account should be taken of the likely reaction of an average UK consumer to the mark in question, but that there was also a public interest consideration relating to the need to avoid placing unjustified obstacles in the path of intra-Community trade. The more recent judgments of the ECJ in relation to the proper

interpretation of Article 3(1)(c) of the Directive (for example, the answer to the second question in Joined Cases C-53/01 to C-55/01 Linde AG and others v. Deutsches Patent- und Markenamt [2003] ECR I-3161) provided support for the view that it was appropriate when applying that Article to have regard to the public interest underlying that provision. And that interest includes maintaining the availability of descriptive terms so that they may be freely used by all, including as part of complex or graphical marks: Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraph 25. The Registry guidelines with regard to the examination of non-English words for registrability in the United Kingdom allow for refusal of registration of non-English descriptive terms that are likely to be used in the trade in relevant goods/services in the UK.

14. However, the case law of the ECJ adopting the likely reaction of the average consumer as a benchmark against which to assess the existence of a likelihood of confusion in opposition and infringement proceedings under Articles 4(1)(b) and 5(1)(b) of the Directive does not provide any obvious scope for taking account of the public interest in avoiding the reservation to one party of terms which describe characteristics of the relevant goods or services in another European language and which may therefore be used on or in relation to goods arriving in one Member State from another. This could result in the position that an applicant who is denied registration of a trade mark as **TONALITE HENNE** under Article 3(1)(c) of the Directive on account of the public interest in avoiding the reservation to one trader of descriptive terms, might yet be able to assert infringement of a registration for (say) **WELLA TONALITE HENNE** by unauthorised use of the words **TONALITE HENNE** assessed purely by reference to the inaccessibility of the meaning of **TONALITE HENNE** to an abstract UK consumer.

15. There are two potential answers to that point. First, the average consumer is deemed to be reasonably well-informed and might therefore be taken to be cognisant of the fact that words forming part of a mark are relevantly descriptive in another EU language and therefore contribute descriptively to the overall impact of the mark. However, the judgment of the Court of First Instance in Case T-6/01 Matratzen Concord GmbH v. OHIM [2002] ECR II-4335 would appear to preclude the adoption of that approach. Secondly, the judgment of the ECJ in Case C-100/02 Gerolsteiner Brunnen GmbH v. Putsch GmbH [2004] RPC 39, p.761 might be applied by extension so as to make the question of conflict with the protected trade mark dependent upon whether use of the allegedly conflicting trade mark accorded (or would accord) with honest practices in industrial or commercial matters. In Gerolsteiner the Court ruled that Article 6(1)(b) of the Directive should be interpreted as meaning that, where there exists a likelihood of aural confusion between a word mark registered in one Member State (in that case **GERRI** registered in Germany) and an indication in the course of trade of the geographical origin of a product originating in another Member State (in that case **KERRY** spring water from Ireland) the proprietor of the trade mark may only prevent use of the indication of geographical origin if that use is not in accordance with honest practices in industrial or commercial matters.

16. The Registrar's preferred solution would be the first of the two possibilities identified above. This is not to suggest that non-English language descriptions should in all cases be treated as though the words were English. The degree of disguise afforded to the descriptive significance of non-English words should be given due weight. Where non-English words are concerned, their descriptive significance should therefore be just

one of the factors to be taken into account in the assessment of registrability and subsequent scope of protection. The greater the likelihood of foreign words being used by third parties in relation to goods entering the UK the greater the public interest in the avoidance of statutory restrictions on their use and the greater the need to apply the law in a way which is consistent with the public interest. However the Registrar recognises that neither of the above answers is fully satisfactory.

17. In the present case, the hearing officer's finding that the Applicant's mark **LE SPOSE DI GIO** 'is primarily used in a context which requires familiarity with the Italian language' could, if treated as determinative, make it unnecessary to consider the wider implications of the foreign language issue. Where, as here, the evidence suggests that the applicant trades amongst a particular section of the community it is not inconsistent with the case law of the ECJ for this to be taken into account in the application of the average consumer test. The alternative approach of basing the test on an abstract UK consumer, rather than an average consumer in the market targeted by the applicant, may produce a result which is inconsistent with the overriding objective of Articles 4(1) and 5(1) of the Directive, which is, of course, to avoid confusion in the marketplace.

#### **Submissions on behalf of the Applicant**

18. The Applicant submitted that the law as laid down in the decision of the Court of First Instance in Matratzen should be followed. The Registrar's submissions based on the public interest did not make the decision in Matratzen unclear or give rise to a need for further explanation. The present case was not concerned with the registrability or

otherwise of non-English words. It was concerned with the question whether, on the facts, there existed a likelihood of confusion for the purposes of section 5(2)(b).

19. It made no difference for the purposes of the appeal whether the trade marks **LE SPOSE DI GIO'** and **ACQUA DI GIO'** were compared on the basis that they were understood to be words from an unintelligible foreign language or translated into English and therefore fully understood. If, however, it was right to have regard to the English translations, it would be wrong to leave the word **GIO'** untranslated: that would give too much weight to a word which is commonly used as a name in Italy but not commonly used as such in England.

20. The suggestion that the present case could be determined on the basis that the Applicant's mark '*is primarily used in a context which requires familiarity with the Italian language*' and therefore on the basis that the relevant average consumer would understand the meaning of the words **LE SPOSE DI GIO'**, was wrong. There was no proper basis for thinking either that the relevant audience for the Applicant's mark was predominantly Italian speaking or that if it was, it would treat its translation of the mark as descriptive.

21. With or without translation, **LE SPOSE DI GIO'** and **ACQUA DI GIO'** are totally different marks from a graphic, phonetic, visual and semantic point of view. The mark **LE SPOSE DI GIO'** is not descriptive and there is no likelihood of confusion.

## **Submissions on behalf of the Opponent**

22. The Opponent maintained that the policy considerations were not significant in the present case. Its primary submission was that the relevant average consumer does not speak Italian. However, he or she would understand that 'di' means 'of' and that led to the conclusion that the marks in issue were confusingly similar because they would be taken to suggest that the goods marketed thereunder came from the **GIO** or **DI GIO** stable. Just as envisaged by the Court of First Instance in Matratzen, the relevant average consumer should not be regarded as a linguist or translator. The reasoning of the Court of First Instance in Case T-286/02 Oriental Kitchen SARL v. OHIM (KIAP MOU) [2003] ECR II – 0000 (25 November 2003) at paragraphs 40 to 45 was directly applicable.

23. Additionally, the Registrar had supported the hearing officer's approach to assessment of the objection under section 5(2)(b) and the Opponent would do so on the same basis.

24. Policy considerations relating to the monopolisation of foreign descriptive terms were more significant in relation to Community registrations than in relation to national registrations containing elements that were descriptive in other territories, because the latter were less likely to affect intra-Community trade.

25. Article 6(1) of the Directive, as interpreted by the ECJ in Gerolsteiner, goes as far as might be considered necessary to deal with the problem of linguistic diversity within the Community. It deals with defences to infringement and does not address the prior

question of registrability. It allows limited scope for confusing use of a foreign descriptive term to be regarded as unobjectionable.

### **Analysis**

26. I shall begin by considering whether the objection under section 5(2)(b) should be assessed on the basis that **LE SPOSE DI GIO'** was put forward for protection in the United Kingdom as a trade mark used and proposed to be used primarily in a context requiring familiarity with the Italian language.

27. The suggestion that it should echoes the 'target market' approach that is used for the purpose of testing whether a word mark is free of objection on absolute grounds under the CTMR. According to that approach, word marks are assessed by reference to the impact they are likely to have upon people who are familiar with the Community language or languages in which the mark in question is most likely to be regarded as meaningful. The aim is to identify the Member State(s) in which the mark is most likely to be open to objection on absolute grounds and determine whether the Community criteria for registration are satisfied in the Member State(s) concerned.

28. That is clearly the most efficient way of addressing the requirement that the mark must be acceptable for protection as a Community trade mark on a Community-wide basis: Article 1(2) CTMR. However, it does not envisage that the question of acceptability on relative grounds will be determined under the CTMR by reference only to the impact that the mark is likely to have in the Member State(s) used for the purpose of testing acceptability on absolute grounds. So within the framework of the CTMR, the

impact of a word mark on speakers of English is used to determine whether it can be regarded as free of objection in the United Kingdom either on absolute grounds or on relative grounds. That is necessary to give effect to the Community law of trade marks at the Community level.

29. I do not see how anything less could logically be required to give effect to the Community law of trade marks at the national level under the Trade Marks Act 1994. The Court of Justice has confirmed that it is necessary to bear in mind, when assessing requests for trade mark protection at the national level, that perceptions and recollections of a mark may vary as a result of social, linguistic and cultural differences between Member States: see, for example, Case C-313/94 Fratelli Graffione SNC v. Ditta Fransa [1996] ECR I-6039, paragraph 22; Case C-220/98 Estée Lauder Cosmetics GmbH v. Lancaster Group GmbH [2000] ECR I-1117, paragraph 29. It is therefore not correct to assume that acceptance or refusal of registration in one Member State is, of itself, sufficient to justify acceptance or refusal of registration in another, even in cases where the mark and the goods or services under consideration are the same: Case C-218/01 Henkel KgaA v. Deutsches Patent-und Markenamt [2004] ECR I – 0000 (12 February 2004), paragraphs 61 to 65. And the relevant languages for the purpose of testing whether a word mark is acceptable for registration are the officially recognised national and regional languages of the particular territory for which protection has been sought or obtained: Case C-363/99 Koninklijke KPN Nederland NV v Benelux Merkenbureau (POSTKANTOOR) [2004] ETMR 57, p. 771 at paragraphs 59 and 60. These considerations point to the conclusion that the impact of a word mark on speakers of

English should be used to determine whether it is acceptable for registration in the United Kingdom on absolute and relative grounds.

30. Hence the approach adopted by the Court of First Instance in Oriental Kitchen when considering whether a Community trade mark application for registration of the words **KIAP MOU** in Classes 29 to 30 conflicted with earlier registrations of the word **MOU** in the United Kingdom for use in relation to goods in Classes 29 to 30. The applicant stated that the goods of interest to it were food products intended exclusively for a clientele of Indochinese origin (Vietnamese, Laotian, Thai and Chinese). In Laotian and Thai **MOU** means ‘pork’ and the adjectival expression **KIAP** means ‘crispy’ or ‘crunchy’. The Court declined to accept that these factors could be used to narrow the scope of the objection on relative grounds based on the earlier United Kingdom trade marks:

31. Nor need account be taken of the applicant’s assertion that the goods referred to in the trade mark application are intended exclusively for a clientele of Chinese or Indochinese (Vietnamese, Laotian, Thai) origin living in Western Europe.

32. First, the Office has rightly pointed out that there is nothing in the wording of the contested application for registration to suggest that the goods in question are intended exclusively for such a clientele. The general terms used by the applicant suggest instead that those goods are intended for the usual, average clientele of the food products also covered by the earlier marks. Without being contradicted on that point by the applicant, the office states that those goods are distributed through the same channels and sold at the same points of sale to the same type of purchasers.

33. Second, the Office has also rightly submitted that, without further specification in the wording of the contested application, the mere fact that the word **mou** means

something in an Indochinese language or that the expression **kiap mou** refers, in that same language, to a characteristic of the goods is not sufficient to establish and define a particular category of consumers targeted by the contested trade mark application.

34. In any event, that assertion of the applicant does not seem to be relevant for the purposes of applying Article 8(1)(b) of Regulation No. 40/94 since, as the Office and the intervener have pointed out, following the Board of Appeal, the way in which the goods are described in the trade mark application does not preclude the later use of the mark in question for a broader market, namely the market targeted by the earlier marks.

35. Accordingly, account must be taken, for the purposes of the global assessment of the likelihood of confusion, of the point of view of the relevant public made up of the end users of everyday food products in the United Kingdom.

31. I think it is clear that essentially the same approach should have been adopted in relation to the objection under section 5(2)(b) in the present case. The evidence relating to the context and manner in which the Applicant has used the mark **LE SPOSE DI GIO'** was in no way limiting as to the ambit of the UK-wide rights it was seeking to acquire by registration under the 1994 Act. I am clear in my own mind that the objection to registration should not be resolved on the skewed view that any of the marks **LE SPOSE DI GIO'**, **ACQUA DI GIO'** or **GIO'** were or would remain used in the United Kingdom primarily in a context which requires familiarity with the Italian language.

32. I therefore return to the question whether, when assessing the objection, it is permissible for the English equivalents of the Italian words to be used for the purpose of testing the issues relating to distinctiveness, descriptiveness and deceptiveness of the marks under consideration. My preferred approach, if left to my own devices, would be

to proceed on the footing that ignorance of meaning is not the same thing as absence of meaning and that a degree of correction should be applied in order to prevent ignorance of meaning from being used as a justification for protection at the national level that would be liable to place unnecessary obstacles in the way of traders engaged in inter-state trade. I would wish to establish that protection should not be available if enforcement of the rights conferred by registration in relation to trading activities involving the import or export of goods or services would undermine the aims and objectives of Articles 28 to 30 and 49 to 55 of the EC Treaty applied in accordance with the principle of non-discrimination: cf EL CANAL DE LAS ESTRELLAS Trade Mark. The legitimacy of that concern appears to me to be confirmed by the first recital to the Directive and the first recital to the CTMR. However, the case law of the supervising courts in Luxembourg currently rejects the view that it may be used to curtail the availability of protection under the Directive.

33. The Registrar suggests that Article 3(1)(c) and Article 6(1)(b) of the Directive have the capacity to prevent monopolisation of words that are relevantly descriptive in the languages of other Members States.

34. I agree that it is particularly noticeable that the judgment of the ECJ in Gerolsteiner proceeded on the basis that the word **KERRY** identified the geographical origin of the spring water imported from Ireland, without adverting to any need for confirmation that it was likely to be perceived and remembered in that way by the average consumer of spring water in Germany. However, that may have been a matter that remained open for consideration by the referring court when it came to assess the

defence of use in accordance with honest practices in industrial or commercial matters. Moreover the judgment is directed to the interpretation of the saving provisions of Article 6(1)(b). An objection to the use of a mark can fail under that Article for reasons that provide no or no sufficient justification for allowing an objection to the registration of the mark to succeed. The prevailing view is that grounds for refusal of registration should be applied independently of the defences that might be available to traders accused of infringing the rights conferred by registration: Case C-404/02 Nichols Plc v. Registrar of Trade Marks [2005] RPC 12, p.243 at paragraphs 32 to 34. I believe that to be the applicable approach, both in relation to objections on absolute grounds and in relation to objections on relative grounds. The suggestion that an objection on relative grounds might be weakened by reference to Article 6(1) of the Directive (Article 12 of the CTMR) appears to have been rejected by the Court of First Instance and the ECJ in the Matratzen case.

35. On reverting to the position under Article 3(1)(c) there seems to be no real room for refusing to register word marks on the ground that they are relevantly descriptive in the languages of other Member States. This matter was considered by Advocate General Jacobs in paragraphs 79 to 90 of his Opinion in Case C-191/01P OHIM v. WM Wrigley Jr. Company (DOUBLEMINT) [2003] ETMR 88, p.1058. Having observed in paragraph 87 that it seemed inappropriate to take as a normal yardstick a consumer struggling with an imperfect knowledge of a foreign tongue, he went on to say:

88. It is moreover an important consideration that the existence of a trade mark composed of terms from one language does not in fact deprive traders who use a different language of any terms by which they may wish to designate

characteristics of their products in their own language subject of course to what I have said above concerning terms which, at least in form, are common to more than one language.

89. Regardless of how Italian-speakers may perceive the brand name BABY-DRY, for example, the range of Italian terms with which Italian purveyors of nappies may describe their goods is no more diminished by it than the range at the disposal of British or Irish nappy-makers would be by a brand name as purely descriptive (in Italian) as “Pannolino”. That is indeed why, as the agent for the Office pointed out at the hearing, many national trade mark offices take no account of the meaning of words from a foreign language when assessing an application for a national trade mark.

90. Assessment under Art. 7(1)(c) should thus not be based on the question whether a term in a language used in one part of the Community might in another part of the Community be thought to designate product characteristics, so that any innovative or unusual feature in the grammatical or semantic structure of a mark must thus pass the test of innovativeness and unusualness in each of those parts.

36. Essentially the same approach is evident in the determination of the relative rights objections in the Matratzen and Oriental Kitchen cases.

37. The question raised for consideration in Matratzen was whether an application to register the following device as a Community trade mark for cushions, pillows, mattresses and related goods in Classes 10, 20 and 24:



conflicted with the earlier word mark **MATRATZEN** registered in Spain for various goods in Class 20 including ‘spring mattresses, straw mattresses, mattresses and pillows’. **MATRATZEN** is the German word for mattresses. It was contended that convergence on the word **MATRATZEN** should be regarded as insufficient to give rise to conflict between the two marks in Spain consistently with the provisions of the EC Treaty relating to the free movement of goods and services within the European Union.

38. The Court of First Instance rejected that contention on the following basis:

38. First of all, it must be observed that, contrary to what is claimed by the applicant, the word ‘Matratzen’ is not descriptive, from the point of view of the relevant public, of the goods covered by the trade mark applied for. As was pointed out in paragraph 27 above, that public is mainly Spanish-speaking. The word ‘Matratzen’ has no meaning in Spanish. It does, admittedly, mean ‘mattresses’ in German and, on the basis of that meaning, it is descriptive of at least some of the goods covered by the trade mark applied for. However, the file does not contain any evidence that a significant proportion of the relevant public has sufficient knowledge of German to understand that meaning. Moreover, the word ‘Matratzen’ bears no resemblance to the word for ‘mattress’ in Spanish, namely, ‘colchón’. Finally,

the word 'Matratzen' is, admittedly, similar to the English word 'mattresses'. However, even if the relevant public does have some knowledge of English, the word 'mattresses' is not part of the basic vocabulary of that language and, despite the resemblance between that word and the word 'Matratzen', there are also differences between those two words.

...

54. It should be pointed out, first, that it in no way appears that the principle of the free movement of goods prohibits a Member State from registering, as a national trade mark, a sign which, in the language of another Member State, is descriptive of the goods or services concerned and which cannot therefore be registered as a Community trade mark. Such national registration does not in itself constitute a barrier to the free movement of goods. Moreover, under the case law of the Court of Justice, the Treaty does not affect the existence of rights recognised by the legislation of a Member State in matters of intellectual property, although the exercise of those rights may none the less, depending on the circumstances, be restricted (Case 199/75 *Terrapin* [1976] E.C.R. 1039, paragraph 5, and Case 58/80 *Dansk Supermarked* [1981] E.C.R. 181, paragraph 11).

55. Likewise, no prohibition on a Member State from registering a sign as a national trade mark which, in the language of another Member State, is descriptive of the goods or services concerned, is to be inferred from provisions of secondary legislation. As the OHIM observed in its defence, the Community legislature has established a system based on the coexistence of the Community trade mark with national trade marks (see, in that regard, the fifth recital in the preamble to Regulation 40/94). The OHIM further pointed out, rightly, in its defence that the validity of the registration of a sign as a national trade mark may not be called in question in proceedings for registration of a Community trade mark, but only in cancellation proceedings brought in the Member State concerned.

56. Secondly, the Community legislature did not disregard Arts 28 EC and 30 EC when providing, in Art. 8(1)(b) and (2)(a)(ii) of Regulation 40/94, that a Community trade mark applied for must not be registered if there exists a likelihood of confusion between that mark and an earlier trade mark registered in a Member State, irrespective of whether the latter mark has a descriptive character in a language other than that of the Member State of registration.

57. Neither that provision nor its application by the OHIM constitutes a barrier to the free movement of goods. It is clear from Art. 106(1) of Regulation 40/94 that the regulation does not affect the right existing under the laws of the Member States to bring claims for infringement of earlier rights in relation to the use of a later Community trade mark. Consequently, if, in a specific case, there exists a likelihood of confusion between an earlier national trade mark and a sign for which an application for registration as a Community trade mark has been made, the use of that sign may be prohibited by the national courts in infringement proceedings. Distinction is made, in that regard, according to whether or not that sign has actually been registered as a Community trade mark. Accordingly, neither the registration of a sign as a Community trade mark nor the refusal of such registration have any effect on the possibility for an applicant for a Community trade mark of marketing his goods under that sign in the Member State in which the earlier trade mark is registered.

58. Moreover, it is clear from the case law of the Court of Justice that Art. 30 EC allows derogations from the fundamental principle of the free movement of goods arising from the exercise of the rights conferred by a national trade mark only to the extent to which such derogations are justified in order to 'safeguard the rights which constitute the specific subject-matter of the industrial property concerned' (see, to that effect, *Dansk Supermarked*, paragraph 11, and Case C-143/00 *Boehringer Ingelheim and Others* [2002] I-3759, paragraph 12). With regard to that specific subject-matter, the court has held that account must be taken of the essential function of the

trade mark, which is to guarantee to the consumer or end user the identity of the trade-marked product's origin by enabling him to distinguish it without any risk of confusion from products of different origin (*Boehringer Ingelheim*, paragraph 12). The right attributed to a trade mark proprietor of preventing any use of the trade mark which is likely to impair the guarantee of origin so understood is therefore part of the specific subject-matter of the trade mark rights (Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb* [1996] E.C.R. I-3457, paragraph 48, and *Boehringer Ingelheim*, paragraph 13).

59. Finally, a Community trade mark has a unitary character (see, to that effect, Case T-91/99 *Ford Motor v OHIM (OPTIONS)* [2000] E.C.R. II-1925, paragraphs 23 to 25). Consequently, as is clear, respectively, from Art. 7(2) of Regulation 40/94 and Art. 8(1)(b) of that regulation, an application for a Community trade mark is to be rejected if an absolute or relative ground for refusal exists in part of the Community. If, therefore, it is more difficult for an economic operator to obtain the registration of a sign as a Community trade mark than to obtain the registration of the same sign as a national trade mark, that is merely a corollary of the uniform protection enjoyed by a Community trade throughout the territory of the Community.

60. It follows that the plea in law based on breach of the principle of the free movements of goods must also be rejected.

61. It is clear from all the foregoing that the application must be dismissed.

39. This reasoning was upheld on appeal to the ECJ. In its Order of 28 April 2004 in Case C-3/03 P *Matratzen Concord GmbH v. OHIM* the Court decided as follows:

40. According to settled case-law, in the context of the application of the principle of the free movement of goods, the EC Treaty does not affect the

existence of rights recognised by the legislation of a Member State in matters of intellectual property, but only restricts, depending on the circumstances, the exercise of those rights (Case 119/75 *Terrapin* [1976] ECR 1039, paragraph 5, and Case 58/80 *Dansk Supermarked* [1981] ECR 181, paragraph 11).

41. Article 30 EC allows derogations from the fundamental principle of the free movement of goods between Member States only to the extent to which such derogations are justified in order to safeguard the rights which constitute the specific subject-matter of the industrial property concerned. In that context, the essential function of the trade mark is to guarantee to the consumer or end user the identity of the trade-marked product's origin by enabling him to distinguish it without any risk of confusion from products of different origin. Therefore, the right attributed to a trade-mark proprietor of preventing any use of the trade mark which is likely to impair the guarantee of origin so understood is therefore part of the specific subject-matter of the trade-mark rights, the protection of which may justify derogations from the principle of the free movement of goods (Joined Cases C-427/93, C-429/93 and C-436/93 *Bristol-Myers Squibb and Others* [1996] ECR I-3457, paragraph 48, and Case C-143/00 *Boehringer Ingelheim and Others* [2002] ECR I-3759, paragraphs 12 and 13).

42. Consequently, by holding, in paragraphs 54 and 56 of the contested decision, that the principle of the free movement of goods does not prohibit either a Member State from registering, as a national trade mark, a sign which, in the language of another Member State, is descriptive of the goods or services concerned, or the proprietor of such a trade mark from opposing, where there is a likelihood of confusion between that national trade mark and a Community trade mark applied for, registration of the latter, the Court of First Instance was not mistaken as to the objectives of the propositions in paragraphs 40 and 41 of this order, and accordingly interpreted them correctly.

43. The second plea must therefore be rejected as clearly unfounded.

40. In Oriental Kitchen the Court of First Instance likewise dealt with the foreign language considerations in unyielding terms:

40. In the present case, both visually and aurally, **mou** is both the single word constituting the earlier word marks and the second of the two words (the first being **kiap**) constituting the word mark applied for.

41. Moreover, conceptually, as was found above, the relevant public is made up of end users of everyday food products in the United Kingdom. Such a public is in the very great majority anglophone. The words **mou**, **kiap** and **kiap mou** have no meaning in English and they bear no resemblance to the English words which have a meaning equivalent to that of these words in Laotian or Thai. Moreover, there is nothing in the case file or the applicant's arguments to suggest that a significant proportion of that public has a sufficient knowledge of the Laotian or Thai languages to understand the meaning of the words in question in those languages.

42. It also follows from those considerations that, from the point of view of the relevant public, and contrary to the applicant's submission, **mou** is not descriptive of the goods covered by the earlier mark. It will be viewed by that public as a term which is invented and inherently distinctive.

43. As the same is true of the word **kiap**, the Court finds, as did the Office, that those two words have an equal power of attraction for the relevant public and that, coupled together in the expression **kiap mou**, they will be viewed by that public as equally dominant, without the word **mou** losing its distinctiveness.

41. Having regard to the reasoning in the passages I have noted from the **DOUBLEMINT**, **MATRATZEN** and **KIAP MOU** cases, I can only conclude that it is

impermissible for the English equivalents of foreign words to be used for the purpose of testing issues relating to the distinctiveness, descriptiveness or deceptiveness of such words in the United Kingdom in the absence of good reason for thinking that a significant proportion of the predominantly anglophone public in the United Kingdom would understand the meaning of the word(s) in question. Even then, the insularity of the required approach leads to the English meaning of the foreign word(s) being treated as a matter of conceptual significance dependent on prior translation: Case T-33/03 Osotspa Co Ltd v OHIM (9 March 2005) paragraphs 51 to 54 and 64. Without a change of position by the supervising courts in Luxembourg there would appear to be no real room for refusing to register word marks under Article 3(1)(c) on the ground that they are relevantly descriptive in the languages of other Member States. The only remaining possibility of exclusion from registration would be under Article 3(1)(d). That could be used to prevent registration if it was legitimate to interpret the reference to ‘*trade*’ as a reference to ‘*trade in the Community*’ when determining whether trade marks ‘*consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade*’. However, that is a matter which does not directly impinge upon the question of English equivalents that I have thus far been considering.

### **Determination**

42. I come finally to the assessment and comparison of the marks in issue. This must be undertaken in the absence of any evidence in the present case as to the extent to which

the predominantly anglophone public in the United Kingdom would be likely to understand the meaning of the Italian words in which the marks are expressed.

43. The mark **ACQUA DI GIO** definitely ‘speaks Italian’ to those by whom it is likely to be seen and heard. The word **ACQUA** is apt to trigger recollections of English words incorporating the component ‘aqua’ and thus carry connotations of the English word ‘water’. I think the linking word **DI** would readily be taken to signify ‘of’ in the sense of ‘from’. It would thus be appreciated that the mark follows the pattern of what, from an English speaking point of view, appears to be word inversion as found in Italian and other Romance languages. That in turn would tend to invest the word **GIO** with individualising significance in the context of the mark as a whole. Visually, the word **GIO** might not immediately be seen as the diminutive of a name. Aurally (and in the inner voice of a person reading it) the word would sound like the familiar diminutive ‘Jo(e)’. That, I think, would quickly lead to an appreciation that the word was a personal name in abbreviated form like ‘Geo’ for ‘George’ or ‘Geoffrey’.

44. The mark **LE SPOSE DI GIO** definitely ‘speaks Italian’ to those by whom it is likely to be seen and heard. The word **LE** would readily be taken to signify ‘the’. I do not think that the word **SPOSE** would trigger recollections of the English word ‘spouse’. It would be synthesised as ‘something or other’ because it would be recognised as an unknown word. The linking word **DI** would readily be taken to signify ‘of’ in the sense of ‘from’ with the consequences I have already described. Visually and aurally the word **GIO** would come to be recognised as a personal name in abbreviated form in the way I have already described.

45. On comparison, it is evident that the marks are structurally (**XXXXX DI GIO'**) and conceptually (both Italian expressions) similar. There are differences between them: **ACQUA XX XXX** as compared with **LE SPOSE XX XXX**. The differences would be sufficient to render the marks acceptable for concurrent use by entities trading independently of one another if the average consumer of clothing in Class 25 would attach no particular significance to the fact that they both use the formula **XXXXX DI GIO'** for the purpose of distinguishing the clothing with reference to which they are used from the clothing of other suppliers. However, the formula uses word inversion in a way that appears likely to be perceived and remembered by the average consumer as giving weight to a personal name (**GIO'**) presented as part of an indication of provenance (**DI GIO'**). They are, accordingly, marks in which distinctiveness indicative of trade origin is not evenly dispersed throughout their constituents. In my view they are distinctively similar marks by reason of their convergence on the elements **DI GIO'**. And by reason of such similarity they appear to me to be marks which were liable, if used concurrently in relation to articles of clothing directly or indirectly marketed by the Applicant and the Opponent in the United Kingdom in November 2000, to give rise to the existence of '*a likelihood of confusion*' within the meaning of that expression as interpreted by the ECJ in Case C-39/97 Canon KK v Metro Goldwyn Mayer Inc [1998] ECR I-5507.

46. It does not appear to me that concurrent use of **ACQUA DI GIO'** on the one hand and **GIO'** rather than **LE SPOSE DI GIO'** on the other would have resulted in co-existence without a likelihood of confusion in the market for clothing in the United Kingdom in November 2000. That is as far as I need to go in relation to the objection based on the word mark **GIO'** having regard to the way in which this aspect of the

objection to registration was dealt with in the hearing officer's decision and at the hearing of the appeal before me.

47. For the reasons I have given, the appeal will be dismissed with an award of costs. I direct the Applicant to pay the Opponent £1,400. as a contribution towards its costs of the unsuccessful appeal, on or before 3 October 2005. That sum is payable in addition to the sum awarded in respect of the Registry proceedings. I make no order for costs in respect of the Registrar's involvement in the appeal.

Geoffrey Hobbs Q.C.

12 September 2005

Geoffrey Pritchard instructed by Messrs Forrester Ketley & Co appeared as Counsel on behalf of the Applicant.

Giles Fernando instructed by Messrs Murgitroyd & Company appeared as Counsel on behalf of the Opponent.

Allan James represented the Registrar.