

O-256-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2372279
BY CAROLINE KAVANAGH
TO REGISTER A TRADE MARK
IN CLASSES 3 & 18**

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 93139
BY EMILIO PUCCI S.R.L.**

BACKGROUND

1) On 1 September 2004, Caroline Kavanagh c/o Innovation Works Worldwide Ltd, 12 Christchurch Terrace, Cheltenham, GL50 2NS applied under the Trade Marks Act 1994 for registration of the following trade mark:



2) In respect of the following goods:

In Class 3: “Cosmetics, shampoos and materials for grooming of pets”.

In Class 18: “Leather and imitation leather goods, clothing and accessories for pets”.

3) On 25 January 2005 Emilio Pucci S.R.L. of 6 Via dei Pucci, Florence, Italy filed notice of opposition to the application. The grounds of opposition are in summary:

The opponent is the proprietor of trade mark No. 898920 EMILIO PUCCI which is registered for goods in Class 25. The opponent claims that the goods are identical and/or similar and that the marks are confusingly similar. The opponent also claims to have reputation in the UK in respect of clothing and fashion items. The opponent contends that consumers recognise that fashion houses produce a wide range of related accessories including cosmetics, shampoos, leather and imitation leather goods and for example items for pets. The mark therefore offends against Section 5(2)(b), 5(3), 5(4)(a) and 56 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. Neither side wished to be heard although both provided written submissions which I shall refer to as and when required in the course of my decision.

OPPONENT’S EVIDENCE

6) The opponent filed two witness statements. The first, dated 7 September 2005, is by Jill Matchett the opponent’s Trade Mark Attorney. She provides a number of exhibits which are detailed below:

JLM2: Various mentions of Pucci from websites such as *Vogue* which reports the appointment of the designer Christian Lacroix as “Artistic Director of Pucci” in April and May 2002 and two further mentions in 2004 prior to the relevant date. In 2002 an article in the on-line version of *The Guardian* mentions “nestling between P (for Pucci) and R (for Ralph Lauren)”, similar from the website of *The Scotsman* newspaper; an extract from www.fashioncapital.co.uk mentioning the London store. There are also mentions of PUCCI in the websites of *The Times*, *The Telegraph*, *Now*

magazine, and the BBC programme *Woman's Hour*. However, the items from *fashioncapital*, *The Telegraph* and *Now* are all after the relevant date.

JLM3: This consists of extracts from the websites of the Victoria and Albert museum and the Gallery of Costume in Manchester. These are dated after the relevant date, but refer to PUCCI and also mention that designers put their labels on a large number of goods such as mobile phones to sportsbags.

JLM4: This consists of print outs from websites of retailers, such as *Cricket* (a shop in Liverpool), *net-a porter* (an online retailer), *Browns* (a shop in London), and *Harvey Nichols* (three department stores). All of these printouts are dated after the relevant date.

JLM5: Print outs from the website of *millie + george* an on-line retailer which describes itself as “pet couture”. They offer items of clothing, jewellery and skin care for dogs and cats as well as more traditional items such as leads, collars etc.

JLM6: Copies of printouts showing that companies such as *Burberry* offer accessories for dogs such as tartan leads and coats (dated 2004); *Gucci* offering leads, collars, coats, carry bags and dog bowls (dated 2005); an article from *The Telegraph* 2001 which indicates that designers now will attach their label to anything; also attached are two articles from websites *petplanet.co.uk* dated 2001 and *parkvets* dated 2002 which give further evidence of designer label items for pets.

7) The second witness statement, dated 12 September 2005, is by Carlotta Fea the Intellectual Property Manager of LVMH Fashion Group S.A. which is responsible for the Emilio Pucci brand. She states that her company owns many well-known trade marks/ brands. At exhibit CF2 she provides a company profile and also a copy of a book about the designer published in 1991. This shows that the mark EMILIO PUCCI has been used since the 1950s and would appear to have been at its zenith in the period 1960-1980. Ms Fea states that the mark is referred to in both its full version and also simply as PUCCI. She states that since LVMH acquired the mark in 2000 it has set out to expand the mark. She states that world wide sales in 2004 were approximately 44.5 million Euros. She also provides UK based wholesale figures split into seasons which span years. I have divided the Fall/Winter figures equally and added half to each of the two years. Ms Fea notes that the following figures do not reflect any cancellations of orders:

Year	Sales Euros
2002	337,750
2003	501,034
2004 up to and incl spring/summer	1,012,395

8) Ms Fea also provides sales of goods in the London store which opened in September 2003 which show sales of £489,000 in 2003 and £1,419,000 in 2004. Ms Fea states that EMILIO PUCCI goods have been available in the UK since the late 1970s/1980s.

9) At exhibit CF3 Ms Fea provides copies of pages from a variety of magazines such as, inter alia, *Marie Claire*, *In-Style*, *Harpers & Queen*, *Tatler*, *Vogue*, *Elle* and *Vanity Fair* which show either advertisements for the opponent's products or photographs of so called celebrities wearing clothes identified as being made by the opponent. Ms Fea states that the mark is used in the UK on women's clothing and accessories, sunglasses, ties, men's shirts, swim wear, and home furnishings such as pillows, blankets, chairs etc. She also states that other fashion brands use their trade marks on items such as bags for carrying dogs. At exhibit CF4 she provides a copy of pages from a LOUIS VUITTON catalogue which she states shows such an item. However, the catalogue is dated 2004 and is in French. It simply shows three bags none of which have a dog in them.

APPLICANT'S EVIDENCE

10) The applicant's witness statement, dated 2 December 2005, by Ms Kavanagh the Managing Director of Innovation Works Worldwide. She states that the mark in suit has a bone device as the final letter "i" as she intends to sell a range of canine accessories through a website and catalogue. She states that:

"The name was chosen with the famous fashion house Gucci in mind, to suggest "fashion for dogs" in a simple graphic Mark."

11) Ms Kavanagh states that, at the time of applying for the mark in suit, she had never heard of the designer Emilio Pucci and that searches of the Trade Marks Database revealed only an Italian sanitary engineering firm in Class 11 and another in Class 10. She states that the opponent's sales figures indicate a low sales volume and therefore low visibility in the UK.

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

DECISION

13) The first ground of opposition is under section 5(2)(b) which reads:

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

(a)....

(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."

14) An "earlier trade mark" is defined in section 6, the relevant part of which states:

"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.”

15) The opponent is relying upon its UK Trade Mark No. 898920 which has an effective date of 1 September 1966 and is clearly an earlier trade mark.

16) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas Benelux 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*;

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*;

(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*;

(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*;

(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-Mayer Inc.*;

(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*;

(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*;

(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 Benelux AG*;

(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-Mayer Inc.*

17) In essence the test under section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. Furthermore, I must compare the applicant's mark and the mark relied upon by the opponent on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

18) The effect of reputation on the global consideration of a likelihood of confusion under Section 5(2)(b) of the Act was considered by David Kitchin Q.C. sitting as the Appointed Person in *Steelco Trade Mark* (BL O/268/04). Mr Kitchin concluded at paragraph 17 of his decision:

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion. As observed recently by Jacob L.J. in *Reed Executive & Ors v Reed Business Information Ltd & Ors*, EWCA Civ 159, this may be particularly important in the case of marks which contain an element descriptive of the goods or services for which they have been registered. In the case of marks which are descriptive, the average consumer will expect others to use similar descriptive marks and thus be alert for details which would differentiate one mark from another. Where a mark has become distinctive through use then this may cease to be such an important consideration. But all must depend upon the circumstances of each individual case.”

19) I also have to consider whether the mark that the opponent is relying upon has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent's mark consists of the name of the founder of the opponent company, EMILIO PUCCI. The opponent claims that the mark is well known in the UK and even seeks protection under Section 56 as a well known mark. The opponent has filed evidence of wholesale sales in the UK in Euros and direct sales in Pounds Sterling. Adding the two figures together allowing that one Euro is worth approximately £0.69 the total sales amount to approximately £835,000 in 2003. A world wide figure of approximately £31 million is also provided. It is stated that in the UK the mark is used upon women's clothing, accessories, sunglasses, ties, men's shirts, swim wear and home furnishings. No figures are given

to indicate the size of each of these markets or the opponent's market share. However, even if all the sales were achieved in clothing alone, a total of less than £1million whilst quite respectable is not adequate to achieve enhanced protection given the size of the clothing market and the absence of any other evidence such as from the trade to back up the claims of reputation. The evidence that celebrities have been photographed wearing the opponent's clothes and that the clothes have been identified in captions along with the photographs does not overcome the other deficiencies in the opponent's evidence. The opponent cannot benefit from an enhanced level of protection due to reputation.

20) I also have to consider whether the opponent's mark is inherently distinctive. The mark is registered for goods in Class 25. The applicant has claimed that there are other PUCCI marks on the register. However, they have shown only two such marks and therefore it would appear that the name PUCCI is not common. When the forename is added the combination would appear to be inherently distinctive.

21) I shall first consider the specifications of both parties. For ease of reference these are as follows:

Applicant's specification	Opponent's specification
Class 3: Cosmetics, shampoos and materials for grooming of pets.	Class 25: Articles of outerclothing for women, being for sale in England and Scotland.
Class 18: Leather and imitation leather goods, clothing and accessories for pets.	

22) In carrying out the comparison of the specifications of the two parties I take into account the factors referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

23) Clearly, the applicant's goods in class 3 are different to the opponent's goods. The opponent contends that its competitors produce pet items as part of their range and that the opponent has used its mark on a variety of goods. They therefore claim that it would be “an obvious addition to the line”. They also claim that the goods of both parties would be seen as fashion goods. I do not accept their contentions. The test under this section is a direct comparison of the goods for which each parties mark is registered. Nor do I accept that the applicant's goods would be seen as fashion items. Pets need to be kept clean by washing and grooming. Such items are not fashion items. Equally leather goods for pets would cover the standard type of lead and/or collar. Dog coats have been around in the most simplistic form for some considerable time and have been sold as protection against the elements, particularly suitable for older pets. Pet carriers have also been in existence for many years, albeit somewhat utilitarian in nature. I do not deny that such items can be viewed as fashion items but

they are not necessarily viewed as such, especially by those of a more level headed disposition.

24) I now turn to consider the marks of the two parties, which are as follows:

Applicant's mark	Opponent's mark
	EMILIO PUCCI

25) I take into account the comments expressed by Mr Hobbs Q.C. acting as the Appointed Person in *Crooms* application (BL O/120/04) where he said:

“37. The finding that the distinctive character of the mark **ALEXANDER McQUEEN** resided in the forename/surname combination necessarily recognised that the word **ALEXANDER** contributed to the distinctiveness of the mark as a whole. By not addressing the significance of its presence in the Opponent's mark and its absence from the Applicant's mark, the Hearing Officer effectively excised it from the earlier trade mark.

38. The evidence on file clearly showed abbreviation of **ALEXANDER McQUEEN** to **McQUEEN** in the context of journalistic material which identified the Opponent by his full name. However, I do not see a sufficient basis in the evidence for the further proposition that **McQUEEN** simpliciter would have been interpreted as a reference to **ALEXANDER McQUEEN** by the average consumer of the goods concerned at the date of the opposed application for registration. I do not accept that in order to be honestly and fairly identified by reference to the designation **McQUEEN** it was necessary, at that date, for such goods to have been connected in the course of trade with the Opponent. On the basis that use of **McQUEEN** was not tantamount to use of **ALEXANDER McQUEEN**, I consider that concurrent use of the marks **ALEXANDER McQUEEN** and **McQUEEN CLOTHING Co** in relation to goods of the kind for which they were respectively registered and proposed to be registered would have involved use of the surname **McQUEEN** with additions sufficient to allow the marks to co-exist in the marketplace without giving rise to a likelihood of confusion.

39. For these reasons I consider that the Hearing Officer should not have upheld the objection to registration based on Community Trade Mark No. 565796.”

26) I also take into account the ECJ's comments in *Case-120/04 Medion AG v Thompson Multimedia Sales Germany & Austria GmbH*, and the comments of the Court of First Instance in the *Miles/Biker Miles* case (T-385/03). In my view even though I believe that the average consumer will recognise the device in the applicant's mark as a bone they will also see the fact that it works as a letter “I”. Therefore, visually and aurally the marks share a common element. Equally clearly, there is a difference in that the opponent's mark has the word “Emilio” at its start. Conceptually the opponent's mark will be seen as a man's name, whereas the applicant's mark will, I believe, be seen as a play on the word “pooch” which is a recognised slang term for

a dog. As the applicant's goods are all for pets of which dogs are amongst the most common I see this as a reasonable inference. In my opinion, the opponent's mark does not have a dominant element. Both elements are of equal status. The opponent has shown that in certain press articles "Pucci" *simpliciter* is used. However, there is no evidence of the opponent using its mark in this way, nor that the general public would view the surname alone as indicating the opponent. Viewed overall I believe that the differences in the marks outweigh the similarities.

27) I must also consider the average consumer for the types of goods covered by the specifications of both parties. In my opinion, they would be the general public (men do purchase women's clothing) who are reasonably well informed and reasonably circumspect and observant. In my view, items of clothing whether for a person or a pet are not purchased without some consideration, nor would grooming products for pets be purchased without due consideration. Although I must take into account the concept of imperfect recollection.

28) Taking account of all of the above when considering the marks globally, I believe that there is not a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. The opposition under Section 5(2)(b) therefore fails.

29) I next turn to the ground of opposition under Section 5(4)(a) which reads:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

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

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

30) It is well accepted that in deciding whether the mark in question offends against this section, the views set out by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455 should be followed.

31) I also take into account the views expressed by Pumfrey J. in *South Cone Inc. v. Jack Bessant, Dominic Greensmith, Kenwyn House, Gary Stringer (a partnership)* [2002] RPC 19 when considering an appeal from a decision of the Registrar to reject an opposition under Section 5(4)(a) said:

"27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's*

Application (OVAX) [1946] 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus, the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date.”

32) This cannot be interpreted in a prescriptive fashion. There will be occasions when the evidence does not fall within the above parameters but still establishes goodwill for passing off purposes - see the decision of Professor Annand, sitting as the Appointed Person, in *Loaded* BL 0/191/02.

33) Earlier in this decision I found that use of the mark in suit, actual or on a fair and notional basis would not result in confusion with the opponent’s mark. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

34) I next consider the ground of opposition under Section 56 of the Act which reads:

“56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or
- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

35) A likelihood of confusion is a pre-requisite under this ground and in view of my earlier findings in relation to the marks at issue, the opponent is in no stronger position on this ground. The opposition with regard to Section 56 of the Act also fails.

36) Lastly, I turn to the ground of opposition under Section 5(3) of the Act which in its original form reads:

"5-(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier mark is protected,

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

37) By virtue of regulation 7 of the Trade Mark (Proof of Use, etc) Regulations 2004, Section 5(3)(b) has now been repealed. The equivalent provision in Section 10 of the Act dealing with infringement has also been amended. As the explanatory note indicates:

"These amendments implement the decision of the European Court of Justice in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* of 9th January 2003 (C-292/00) which was confirmed by its decision in *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* of 23rd October 2003 (C-408/01). Those decisions determined that Article 5(2) of the Directive, which on the face of it, grants a right to the proprietor of a trade mark to prevent third parties from using an identical or similar trade mark in relation to goods or services which are *not similar* where the earlier trade mark has a reputation and use of that sign takes unfair advantage or is detrimental to the distinctive character of that earlier trade mark, also applies to goods or services which are similar or identical to those for which the earlier trade mark is registered."

38) Notwithstanding the broader interpretation of Section 5(3) (Article 5(2)) that has now been confirmed by the ECJ, the opponents' claim here is based on the fact that the respective goods and services are dissimilar.

39) The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* 2001 [RPC] 42, C.A. *Sheimer (M) Sdn Bhd's TM Application (Visa)* 2000 RPC 484 *Valucci Designs Ltd v IPC Magazines (Loaded)* O/455/00, *Mastercard International Inc and Hitachi Credit (UK)Plc* [2004] EWHC 1623 (Ch) and *Electrocoin Automatics Limited and CoinworldLimited and others* [2004] EWHC 1498 (Ch).

40) In relation to reputation under Section 5(3), *General Motors Corporation v Yplon SA* [2000] RPC 572 paragraphs 26 & 27 indicate the standard that must be reached:-

“26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

41) This test sets out a high threshold, and the onus is upon the opponent to prove that its trade mark enjoys a reputation or public recognition. In the present case whilst I am prepared to accept that there is likely to be some awareness and recognition of the opponent’s trade mark in relation to women’s clothing, I am unable to say with any confidence that the opponent’s EMILIO PUCCI mark is known by a significant part of the public concerned given the size of the potential market for such goods.

42) Taking into account the strict requirements which need to be satisfied under Section 5(3) to expand the parameters of “normal” trade mark protection I cannot find that the opponent has shown reputation in Section 5(3) of the Act and the opposition under Section 5(3) must fail on this basis.

43) However, in case I am wrong on this I will go onto consider the opponent’s contentions regarding detriment. The opponent states in its counterstatement that “UK customers recognise that fashion houses produce a wide range of related accessories including cosmetics, shampoos, leather and imitation leather goods, and also for example items for pets”. They also claim that “the trend has been established (as shown by the evidence filed in these proceedings) for major fashion houses to expand into pet areas (for example Burberry, Louis Vuitton and Gucci as evidenced in the written statements by Jill Matchett). It would be reasonable to expect that EMILIO PUCCI would wish to expand into such an area in the future in line with their competitors, and the public have been educated to expect such expansion”.

44) Whilst I accept that the general public has now been conditioned to accept that “fashion houses” will branch out into other areas it is my view that “other areas” would be expected to be in some way related. Therefore, sunglasses or cosmetics and perfumes for humans are a natural extension. I do not accept the contention that the general public recognises that fashion houses will also produce grooming items for pets such as shampoos or flea powder; and the opponent has shown no evidence to show the state of the public’s mind on this issue. There are an extremely large number of pets in this country and the average consumer of items for pets would be the average member of the public. They will be aware that individuals who have, in common parlance “more money than sense or taste” may seek out diamond studded or fur collars for their favourite lapdog. They will know that establishments such as fashion houses will cater for these individuals, this does not equate to the general public expecting to see such items at their local pet store.

45) I note the following comment from Mr Geoffrey Hobbs Q.C. (sitting as a Deputy Judge) in *Electrocoin Automatics Limited and Coinworld Limited and Others* [2004] EWCH 1498 (Ch):

“ 102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.”

46) It seems to me that the opponents have singularly failed to show that the use of the mark in suit on the goods which are dissimilar to its own would cause detriment. I believe that this is a case where use of the mark in suit on items for pets would not call to mind the opponents’ mark and its claimed reputation for clothing. However, even if it did I do not believe that it would affect the consumers economic behaviour or damage the opponents’ mark by tarnishing or blurring. The opposition under Section 5(3) of the Act fails.

COSTS

47) As the opponent was unsuccessful the applicant is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of £1,500. 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 11th day of September 2006

**George W Salthouse
For the Registrar,
the Comptroller-General**