

O-376-03
TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION
No. 748241 AND A REQUEST BY DI GIO' S.r.l.
TO PROTECT THE TRADE MARK DI GIO' IN CLASS 25

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER No. 70625 BY GA MODEFINE SA

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**IN THE MATTER OF International Registration
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**IN THE MATTER OF Opposition thereto under
No. 70625 by GA Modefine SA**

Background

1. On 16 November 2000 Di Gio' S.r.l., on the basis of an Italian registration, requested protection in the United Kingdom for the mark DI GIO' in respect of:

Bridal gowns, formal dress and clothing of all kinds; shoes and clothing accessories, namely gloves, belts, neckties, hats and special headwear, scarves, pocket handkerchiefs and foulards. (Class 25)

The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

2. On 28 June 2001 GA Modefine SA filed notice of opposition to the conferring of protection on this international registration. They are the proprietor of the following Community Trade Marks:

No.	Mark	Class	Specification
505669	ACQUA DI GIO'	03	Perfumery, essential oils, cosmetics, hair lotions; dentifrices, soaps for personal use and other preparations for personal use.
		25	Articles of clothing, footwear and headgear.
505636	GIO'	03	Perfumery, essential oils, cosmetics, hair lotions; dentifrices, soaps for personal use and other preparations for personal use.
		25	Articles of clothing, footwear and headgear.

No. 505669 is a registered mark. No. 505636 is a pending application.

3. Additionally or alternatively, the opponents say that GIO' is synonymous with Giorgio Armani and that the names GIO' and Giorgio Armani are world famous in relation to clothing and luxury items such as perfumery, cosmetics and related goods. Thus, it is said, GIO' is a well-known mark in the UK and entitled to protection accordingly. Reference is also made to an International Trade Mark Registration No. 668974 for the mark GIO'. The details given for this registration suggest that it may exist under the Madrid Agreement rather than the Protocol (the UK is a signatory to the latter but not the former). Alternatively, if it is a registration under the Protocol, the UK is not one of the countries designated.

4. The opponents say they have used the above-mentioned marks in the UK and throughout the world since at least 1992 especially in relation to perfumery, essential oils, cosmetics, soaps and similar goods and have a resulting reputation and goodwill.

5. The opponents go on to say that:

“The provenance of the Opponent’s earlier Marks is that GIO' is an abbreviation of Giorgio (Armani), with the apostrophe indicating that GIO is an abbreviation. Whilst it is grammatically correct in Italian to use an apostrophe to indicate the shortened version of a name, modern practice is to omit the apostrophe. It is thus apparent that the apostrophe is as important an element in the earlier Marks as the word GIO. Thus the Mark applied for comprises the Opponent’s earlier Application GIO', and the distinctive elements of the Opponent’s earlier Registration ACQUA DI GIO'. The Mark applied for is thus identical to GIO' and/or ACQUA DI GIO', and/or confusingly similar to GIO' and/or ACQUA DI GIO'.”

6. On the basis of the above facts and circumstances the opponents raise objection under Sections 5(1), 5(2)(a), 5(2)(b), 5(3) and 5(4)(a) of the Act.

7. The international registration holders (applicants hereafter) filed a counterstatement denying that the mark GIO' is synonymous with Giorgio Armani and putting the opponents to proof of their claims. They say there has only been use of ACQUA DI GIO' and GIO' in respect of perfumery and cosmetics.

8. The applicants say they have used their mark in the UK since 1995. They claim to have advertised their products in VOGUE SPOSA magazine which is distributed throughout Europe including the UK.

9. They deny that GIO' is an abbreviation of Giorgio Armani. Rather they say it is an abbreviation of the first name only. Furthermore they say that GIO is mainly used in respect of the Italian names Giovanni or Giovanna. The applicants' trade mark DI GIO' is said to originate from their company name Di Gio' S.r.l. and is also the abbreviation of the female name Giovanna, being the name of one of the De Capitani sisters, connected with the bridal wear business.

10. They offer submissions in relation to the marks themselves which I will deal with below.

11. They deny all the grounds of opposition.

12. Both sides ask for an award of costs in their favour.

13. Additionally, I note the applicants say that the opposition was filed without their being offered an opportunity to withdraw the UK designation. It is requested that this factor be taken into account when considering costs.

14. On completion of the evidence rounds the papers were reviewed by a Registry Hearing Officer who indicated that he did not consider an oral hearing was necessary. The parties were, nevertheless, reminded of their right to be heard or to offer written submissions. Neither side has asked for a hearing. Written submissions have been received from Murgitroyd & Company on behalf of the opponents (under cover of their letter of 7 October 2003). Acting on behalf of the Registrar and with the above material in mind I give this decision.

15. This is one of two cases involving the parties. The other involves the mark LE SPOSE DI GIO' (Opposition No. 70681). The grounds in that case are slightly different though the evidence is in substance the same. The cases have not been consolidated. In view of this and the fact that the marks give rise to slightly different issues I propose to issue individual decisions.

Opponents' evidence

16. The opponents filed witness statements by Jacqueline McKay and Antonio Aita. Ms McKay is an attorney with Murgitroyd & Company. Her witness statement consists of submissions. I will take these into account in my decision below.

17. Mr Aita is the Administrative and Financial Manager of GA Modefine SA. The company is part of the Armani Group founded by the designer Giorgio Armani. Mr Aita's evidence initially deals in general terms with the activities and turnover etc of the Group and the range of marks employed in their businesses. Exhibit GA1 confirms the substantial scale of the Group's business, its diversified nature covering apparel (52%), fragrances and cosmetics (24%) and accessories and others (24%) and the wide geographical spread of activities. I do not need to record further details but will instead review the position pertaining to the UK. The marks GIO' DE GIORGIO ARMANI and ACQUA DI GIO' have been used in relation to ranges of fragrances. The names were chosen to make a strong association with Giorgio Armani. Bearing in mind the material date of 16 November 2000 the only relevant figures are as follows:

ACQUA DI GIO'

Year	2000			
Figure	Units	Net Turnover (Euros)	Publication Expenditure (Euros)	Other Media Expenditure (Euros)
UK	128,200	2,300,000	200,000	-

ACQUA DI GIO' POUR HOMME

Year	2000			
Figure	Units	Net Turnover (Euros)	Publication Expenditure (Euros)	Other Media Expenditure (Euros)
UK	115,800	2,700,000	1,000,000	700,000

GIO' DE GIORGIO ARMANI

Year	2000			
Figure	Units	Net Turnover (Euros)	Publication Expenditure (Euros)	Other Media Expenditure (Euros)
UK	28,200	500,000	-	-

18. Separately, unit sales and value figures are given for 1999 as follows – ACQUA DI GIO 238,579 units at a value of 4,465,368 Euros and GIO DE GIORGIO ARMANI, 39,942 units at a value of 721,284 Euros.

19. In support of this are exhibited:

GA2 - photocopied examples of fragrance containers. I note that one refers to ACQUA DI GIO GIORGIO ARMANI (with GIO picked out in significantly large type) and two show GIO DE GIORGIO ARMANI (with GIO picked out in something akin to a handwritten style of presentation). In each case there is a mark or accent over the letter O.

GA3 - 4 examples of current advertising from Esquire (2), GQ and Men's Health magazines. All four examples are drawn from 2001 editions of the magazine and so are not directly relevant to the case before me.

20. Finally Mr Aita comments to the affect that:

“Perfumery and clothing are intrinsically linked in the undertakings of the Armani Group and its competitors such as Calvin Klein, Ralph Lauren, Tommy Hilfiger, Versace, etc. The majority of top fashion houses work in the field of clothing lines and perfumery lines such that the goodwill and reputation in one area instantly extends to the other.”

Applicants' evidence

21. This is in the form of a witness statement by Erminio Gatti, the sole Director of Di Gio' S.r.l.. He says that his company commenced use of the Trade Mark DI GIO in association with wedding dresses in Italy in 1975. The trade mark derives from the name of one of the two founders of Di Gio' S.r.l., namely Giovanna De Capitani. Her nickname was “GIO” which is

said to be a well-known short form for many popular Italian names including Giovanni (male) and Giovanna (female).

22. Use of the trade mark in the UK is said to have commenced in 1990. It is used in association with wedding dresses and their accessories sold via the Company's websites (these were created around December 1999). Examples of such usage are exhibited at EG1. Copies of e-mail enquiries generated as a result are exhibited at EG2.

23. Mr Gatti says that the company has advertised its products in Vogue Sposa magazine which is distributed throughout Europe including the UK. The company also advertises in other magazines including Domina Sposa, Collezioni Sposa and In Style Wedding which are also circulated in the UK. Examples are exhibited at EG3. Group advertising expenditure, worldwide trade mark registrations and Group turnover are exhibited at EG4 to 6 but the figures are not broken down by country so it is not possible to say what activity has taken place in this country. The remainder of Mr Gatti's witness statement is largely by way of submissions. The main points are that:

- the opponents' marks have been used in relation to perfumery and cosmetics but not clothing;
- in commercial use the opponents use a curved accent over the letter O rather than an apostrophe after it;
- the applicants use a horizontal line over their O;
- the ACQUA DI element of the opponents' mark cannot be discounted;
- the applicants' goods are sold through bridal wear shops and thus reach the market by different channels of trade to the opponents';
- in response to Mr Aita's final point clothes designers will often use a different trade mark for their perfume ranges (he cites Eternity as being a fragrance produced by Calvin Klein);
- CTM No. 505636 has been opposed by the current applicants. It would appear that the applicants have been successful but the matter is now the subject of an appeal.

Opponents' evidence in reply

24. Mr Aita has submitted reply evidence on behalf of the opponents. The main points are:

- the applicants' website are ".it" or ".com" and do not appear to specifically target the UK;
- the outlets referred to are not in the UK;

- no specific UK sales figures are given and the number of enquiries appears to be insignificant in the context of the bridal wear market as a whole;
- the magazines referred to are almost exclusively in Italian. One is in English but has a lire price.

25. That completes my review of the evidence.

26. I have for completeness sake summarised that part of the opponents' evidence that deals with their trade in the UK under the marks ACQUA DI GIO' and GIO'. I take it that the evidence is intended to support a claim to an enhanced distinctive character for Section 5(2) purposes; a reputation sufficient to underpin a case under Section 5(3); goodwill for Section 5(4)(a) purposes; and the claim to be the proprietor of a well known mark. The evidence falls well short of supporting most of these claims. My main reasons for reaching this preliminary finding are as follows:

- the marks are invariably used as part of composite marks incorporating the words GIORGIO ARMANI or at least in close association with those words;
- the impact on, and recognition by, consumers of the marks ACQUA DI GIO' and GIO' on their own is not clear;
- use appears to be restricted to fragrance products;
- all the advertising material is after the relevant date and no date is ascribed to the pictures of containers (and one of the items bears mainly French descriptive text);
- turnover figures are only given for the years 1999 and 2000 (and later years). There is insufficient supporting material to put these figures into context within what must be a very large market for fragrances;
- no information is given on sales outlets or geographical spread of sales etc.

27. I thus find that the evidence is insufficient to support any claim to an enhanced degree of distinctive character for the marks relied on in support of the Section 5(2) ground. It fails to establish the sort of reputation set down in *General Motors v Yplon* [1999] ETMR 950 (paragraph 23 to 27) as a requirement for the ground based on Section 5(3). On a generous view of the evidence it might be said that the opponents can claim a goodwill for Section 5(4)(a) purposes but I cannot see that such a finding in relation to fragrance products is likely to put them in a stronger position than their case under Section 5(1) and 5(2) based on their applied for and registered marks. Finally the well known mark claim based on the mark GIO' is unsustainable as is the claim that GIO' is synonymous with Giorgio Armani. The result is that this matter effectively falls to be decided under Section 5(1) and (2). These read:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

28. The meaning of the term “earlier trade mark” is set out in Section 6(1) of the Act. Section 6(1) needs to be read in the context of Section 6(2). The relevant parts read:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b)
- (c)

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

29. The opponents rely on two marks – ACQUA DI GIO’ (No. 505669) and GIO’ (No. 505636). The first of these is a registered CTM with an earlier filing date. It is, therefore, an earlier trade mark within the meaning of Section 6(1)(a). No. 505636 has an earlier filing date but is as yet not registered and is in fact opposed by the current applicants. It will become an earlier trade mark “subject to its being so registered”. To the extent that any decision, or any appeal therefrom, is dependent upon No. 505636, it will be a provisional one subject to the final determination of that application.

30. The opponents’ written submissions do not deal with Section 5(1) and 5(2)(a) but I cannot see that those grounds have been specifically given up. I will deal with them briefly.

31. The opponents' case under Section 5(1) and 5(2)(a) turns on my finding that the parties' marks are identical. The opponents' position is not clear. They say in relation to both Section 5(1) and 5(2)(a) that the applied for mark is identical to their mark or marks. I infer that they are seeking to leave the door open for a finding that the opposed mark is identical to either or both of their marks.

32. There is now guidance from the European Court of Justice on the question of what constitutes identity in *LTJ Diffusion SA and Sadas Vertboudet SA*, Case C-291/00. The following passages are relevant:

“The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.

However, the perception of identity between the sign and the trade mark must be assessed globally with respect to an average consumer who is deemed to be reasonably well informed, reasonably observant and circumspect. The sign produces an overall impression on such a consumer. That consumer only rarely has the chance to make a direct comparison between signs and trade marks and must place his trust in the imperfect picture of them that he has kept in his mind. Moreover, his level of attention is likely to vary according to the category of goods or services in question (see, to that effect, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26).

Since the perception of identity between the sign and the trade mark is not the result of a direct comparison of all the characteristics of the elements compared, insignificant differences between the sign and the trade mark may go unnoticed by an average consumer.”

33. In the light of the strict criteria laid down by the ECJ it is inconceivable that ACQUA DI GIO' can be considered identical to DI GIO'. It may be true as has been argued by the parties that “ACQUA DI” means “water of” and has some significance in relation to Class 3 goods. I do not think the same can be said in relation to clothing in Class 25 (which is the goods area of particular relevance in this case). The word ACQUA must in any case make a sufficient contribution to the mark ACQUA DI GIO' that it cannot be said to be an insignificant difference that would go unnoticed by the average consumer.

34. The position may be slightly less clear cut when comparing the marks GIO' and DI GIO'. I do not think it is disputed that DI means ‘of’. Whether it would be understood or taken as such in this country is not clear. But again the test is a strict one. Does the applied for mark reproduce

the opponents' mark without any modification or addition or contain differences so insignificant that they would go unnoticed by the average consumer? That question must, in my view, be answered in the negative. An element has been added and it will not go unnoticed by the consumer. On that basis the opponents must fail under Section 5(1) and Section 5(2)(a).

35. For the purpose of 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] R.P.C 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

36. The question that I have to answer is whether there are similarities in the marks and goods which combine to create a likelihood of confusion.

37. There can be little doubt that, taking the notional breadth of the specifications of the opponents' registration and application into account, identical goods are in play. The applicants' more specific list of goods is for practical purposes a sub-set of the broad terms "articles of clothing, footwear and headgear". Although the applicants point to the specialist channels of trade involved in the sale of their goods that is a marketing circumstance which is external to the trade mark application. The latter contains no restriction as to the manner or circumstances in which the goods are to be sold and which may, of course, change over time (cf *Daimler Chrysler AG v OHIM*, Case T-356/00 at paragraph 46 albeit in relation to the descriptive character of the mark in that case).

38. Turning to the marks themselves, I must have regard to their distinctive and dominant components. For the reasons given earlier I am not persuaded that the opponents have made out a case for any enhanced degree of distinctive character as a result of use. I approach their marks on the basis of their inherent qualities.

39. Dealing firstly with the ACQUA DI GIO' mark it is, and has the appearance of, a foreign phrase. I understand it is in fact Italian. Many people would guess that that was the case. Others may not apprehend what language was involved. There has been some debate about the meaning of ACQUA. The applicants submit that it appears prominently on fragrance bottles; that purchasers would place greater emphasis on the word ACQUA than DI GIO; and that this element cannot be discounted in the mark as a whole. The opponents say that ACQUA (water) is a commonly used word in Class 3 and, therefore, that the distinctive element is DI GIO'. The parties have also engaged in debate about the nature of GIO as an abbreviation and the significance or otherwise of the apostrophe. In relation to the latter it is said that the usage is grammatically correct in Italian but it has become modern practice to omit this apostrophe. Thus the opponents say that GIO' presented in this particular way is unusual and makes a contribution to the distinctive character of the mark.

40. The distinctive character of a mark must be assessed by reference to the goods in relation to which it is to be used and the perceptions of the average consumer (see *Rewe Zentral v OHIM* (Lite) T-79/00). A word or element that is descriptive in one Class may not be in another. The opponents may be right in saying that ACQUA or equivalents (meaning water) are commonly used in Class 3. It has not been shown to be so in relation to Class 25 goods. I, therefore, regard

it as making a full contribution to the character of the mark ACQUA DI GIO'. There may be some, but I suspect not universal, awareness in the UK that DI simply means 'of'. To the extent that there is such awareness, that element may attract less attention. The significance of GIO as an abbreviation may not be apparent to those who are not familiar with Italian forenames. It is not material to engage in debate as to whether it is an abbreviation of Giorgio, Giovanni, Giovanna or some other name. I find it to be a distinctive and important element of the mark aided in small measure at least by the use of 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. I approach the applied for mark in a similar vein.

41. With these preliminary observations in mind I turn to the visual, aural and conceptual similarities between the marks (*Sabel v Puma*, paragraph 23). Visual considerations are generally accepted to be of particular importance in relation to the process of purchasing clothing items (see *REACT* Trade Mark [1999] RPC 529 and, on appeal, [2000] RPC 285). Self-evidently, the applied for mark reproduces the second and third elements of the mark ACQUA DI GIO' including the use of the apostrophe. Equally ACQUA, being the first element of No. 505669, will not be ignored. The position is, therefore, that consumers are unlikely to fail to notice that there are common (distinctive) elements without also noticing that the opponents' mark contains an additional element. Phonetic considerations suggest a similar result.

42. Conceptually, much may depend on the ability of the consumer to understand the mark or discern a meaning in the words. But I bear in mind that the average consumer perceives marks as wholes and does not proceed to analyse their details (*Sabel v Puma*, paragraph 23). For those with some understanding of Italian or other Romance languages the mark will mean 'water of gio' (with the abbreviation standing for any one of a number of forenames). For those without such an understanding the mark and each of its elements presents a meaningless and somewhat impenetrable combination. It cannot be said that for this latter group the mark as a whole creates a concept that is distinct from its parts (unlike, say JOY and COMFORT AND JOY – see Opposition No. 43691).

43. The likelihood of confusion must be appreciated globally, taking account of all relevant factors (*Sabel v Puma*, paragraph 23). A lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and vice versa (*Canon v MGM*, paragraph 17). I also bear in mind that:

“... the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 to 18).”
Canon v MGM, paragraph 29.

44. I have found that identical goods are involved and that the applied for mark reproduces an important element of the opponents' mark. The presence of the additional element ACQUA may be enough to avoid direct confusion in the sense of one mark being taken for the other. However, it is my 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.

45. The opponents are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £1000. I make that award notwithstanding the applicants' claim that the opposition was launched without their being given an opportunity to withdraw the UK designation. Had they done so within a reasonable time after the filing of the opposition they might well have been in a position to argue that they should not be penalised in costs. However, they have elected to contest this case and I can only assume they would have done so even if they had been offered the opportunity to withdraw. In those circumstances I see no reason why they should benefit from a reduction in the award against them on this account. I have, however, apportioned costs between this and the related action to reflect the fact that there have been some 'economies of scale' resulting from largely identical sets of evidence and overlapping pleadings. The above sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of 2003

**M REYNOLDS
for the Registrar
the Comptroller General**