

O-544-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3191091
BY CHERRYANDJERRYLIMITED
TO REGISTER AS A TRADE MARK**

DG Fashion

IN CLASS 25

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 408954
BY DOLCE & GABBANA TRADEMARKS S.R.L.**

Background and pleadings

1. On 13 October 2016, cherryandjerrylimited (“the applicant”) applied to register **DG Fashion** as a trade mark. The application was published on 6 January 2017 (“the publication date”) in respect of a range of goods in class 25. Following separate opposition proceedings, which resulted in the partial refusal of the application, the specification now reads:

Class 25: Paper aprons; Paper clothing.

2. The application is opposed by Dolce & Gabbana Trademarks S.R.L. (“the opponent”). The opposition is brought under ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under each of these grounds, the opposition is directed against all of the goods in the application.

3. Under ss. 5(2)(b) and 5(3), the opponent relies upon the following trade marks and all of the goods for which they are registered:

- i) European Union trade mark (“EUTM”) 452359 (“the 359 mark”)

The logo consists of the letters 'D' and 'G' in a bold, black, sans-serif font. The 'D' and 'G' are connected at the top and bottom, with an ampersand (&) between them.

Filing date: 10 September 1996; date of entry in register: 22 February 1999.

Registered in classes 3, 9, 18 and 25 (see appendix).

- ii) International Registration (UK) 845608 (“the 608 mark”)

The logo consists of the letters 'D' and 'G' in a white, outlined, sans-serif font. The 'D' and 'G' are connected at the top and bottom, with an ampersand (&) between them.

International registration and designation date: 10 February 2005; date of protection in the UK: 24 March 2006.

Priority claimed from 19 October 2004 (Italy).

Registered in classes 3, 9, 14, 18 and 25 (see appendix).

4. Given their dates of filing, both of the above marks qualify as earlier marks in accordance with s. 6 of the Act. They are also subject to the proof of use provisions contained in s. 6A. In its notice of opposition, the opponent states that it has used both marks for all of the goods for which they are registered.

5. The claims under s. 5(2)(b), identical for both marks, are that the mark applied for is highly similar to the earlier marks and that the goods are identical or similar. The opponent claims that this will lead to a likelihood of confusion, including the likelihood of association.

6. Under s. 5(3), the opponent claims that its marks have a reputation in the UK such that use of the mark applied for would cause the relevant public to believe that there is an economic connection between the applicant and the opponent, where no such connection exists. It claims that the applicant would gain an unfair advantage as it would be able to free-ride on the reputation of the opponent's marks and "benefit from arousing an association in the mind of consumers with the Opponent's mark on the basis of the Opponent's investment in marketing and promoting its mark". The opponent also claims that the earlier marks enjoy a reputation for the quality of the goods provided under the marks and that poor-quality goods produced by the applicant could damage the reputation of the opponent. Further, the opponent claims that use of the application would dilute the distinctive character of the earlier marks, which would lead to consumers being less likely to purchase the opponent's goods.

7. The opponent further claims under s. 5(4)(a) of the Act that the signs **DG** and **D&G** have been used throughout the UK since 1996 in respect of: clothing; footwear; headgear; bags; articles of luggage; leather and imitation leather goods; accessories; glasses; sunglasses; watches; jewellery; cosmetics and perfumery. All of the goods in the application are opposed under this ground. The opponent claims that it has acquired

goodwill under the signs and that use of the mark applied for would amount to a misrepresentation to the relevant public, resulting in damage to the opponent's goodwill.

8. The applicant filed a counterstatement denying the grounds of opposition and putting the opponent to proof of its claims. It denies that there is any visual or aural similarity between the application and the 359 mark. In relation to the 608 mark, it notes the existence of another registered trade mark for the letters "DG" and requests that the opponent provide examples of actual confusion. The applicant also denies that the goods are similar, claiming that the opponent's goods are "high-end", which will not be the case for the applicant's goods. It requires the opponent to provide evidence of use of both of its marks for the goods relied upon in class 25.

9. The applicant denies the opponent's claims under s. 5(3). I note that the applicant's position is slightly contradictory as, despite requiring proof of use in class 25 for both marks, the applicant concedes that the 639 mark has a reputation. It does not, however, say to which goods this concession refers. The applicant denies that the 608 mark has any reputation.

10. As regards the claims under s. 5(4)(a), the applicant's position is again somewhat unclear. It refers to the registered trade marks rather than the signs relied upon, accepting goodwill in the 639 mark but putting the opponent to strict proof of any goodwill in relation to the goods specified, for both marks. I note that an apparent concession is made in its final submissions regarding goodwill in the 639 mark. However, given the lack of clarity in the pleadings and that its submissions also refer to a registered trade mark, I am not persuaded that it would be safe to treat this submission as an unqualified concession on the point. I proceed on the basis that evidence of goodwill was required for both signs and all goods.

11. Both parties filed evidence, which I will summarise only to the extent I consider necessary. The applicant also filed written submissions during the evidence rounds. Neither party requested a hearing but both filed written submissions in lieu, which I will

bear in mind. The applicant is represented by C.M. Atif & Co. Solicitors, the opponent by Marks & Clerk LLP. This decision is taken following a careful reading of all of the papers.

Evidence

Opponent's evidence

12. The opponent's evidence consists of two witness statements of Alfonso Dolce, the Managing Director of the opponent. Mr Dolce explains that the opponent was formed in 1985 in Italy, initially producing women's clothing but later expanding its clothing lines as well as developing other products, such as perfumes and watches.¹ A print from the opponent's website is exhibited which details the history of the company.² I note that there are references to, for example, "D&G" boutiques (pp. 12, 14), "D&G Time", "D&G Jewels" and "D&G Junior" (p. 12). However, the print itself is not dated, apart from the printing date of October 2017.

13. Although the company's name is Dolce & Gabbana, Mr Dolce states that the opponent also uses the trade marks "D&G" and "DG", which have become synonymous with the company.³ A separate product line is said to have been offered under the trade mark "D&G" between 1994 and 2012; whilst there has been no "independent" line under the mark "D&G" since 2012, Mr Dolce states that the mark "D&G" continues to be used on the opponent's products.⁴

14. Approximate UK sales figures in Euros are provided as follows:⁵

¹ §4.

² Exhibit 1.

³ §5.

⁴ Ibid.

⁵ Exhibit 9.

[REDACTED]

The sales figures are said to relate to the opponent's "DOLCE & GABBANA", "D&G" and "DG" marks. Eleven invoices to addresses in the UK and dated between June 2012 and 2016 are also provided.⁶ The amounts invoiced vary from €460 to almost €29,012. Mr Dolce states that the invoices concern sales under the "DOLCE & GABBANA", "D&G" and "DG" marks, though the only mark visible is "DOLCE & GABBANA". The goods listed in the invoices are dresses, cardigans, shorts, trousers, t-shirts, bras, boxers, suits and ties.

15. On pages exhibited from the WayBack Machine internet archive dated between 2014 and 2016, "DG" is shown applied to goods as follows:

Handbags:⁷



⁶ Exhibit 10.

⁷ Exhibit 6, pp. 106, 115.

Glasses/sunglasses:⁸



Necklace:⁹



Although there are other examples of “DG” appearing on jewellery, only the example above is priced in sterling, the other instances being in dollars.

T-shirt and a vest top:¹⁰



⁸ Idem, pp. 109, 117.

⁹ Idem, p. 110.

¹⁰ Idem, pp. 113-114

There are multiple examples of “DG” on belts, one of which is shown below:¹¹



The same exhibit contains further prints which show the opponent's goods for sale on websites, with the letters “DG” visible, with varying degrees of stylisation, on bags and wallets. The prices are in sterling but these prints are not dated, save for the printing date (October 2017).

16. Mr Dolce also exhibits pages from the website <http://issuu.com/dolcegabbanaoofficial> which contain images from catalogues which are said to have targeted the UK.¹² Many of the images post-date the publication date or do not show any of the marks relied upon. However, the following is visible on a jacket, dated July 2016:¹³



Logos featuring the letters “DG” in the same stylised typeface, also dated July 2016 but with different surrounding material, are shown on a coat, jumper and slippers.¹⁴

17. Images dated 2015 show the letters “DG”, as reproduced below, on jackets:¹⁵

¹¹ p. 116.

¹² Exhibit 13.

¹³ p. 343.

¹⁴ pp. 344-345.

¹⁵ pp. 347-348.



18. The plain or minimally stylised letters “DG” also feature on trainers (2014) and watches, including in the combination “DG7” for the latter (2015), as well as on a rucksack, in an image dated 2015.¹⁶ I note that “#dgfamily” is present on a rucksack in an image dated 2016.

19. Exhibit 7 provides examples of the opponent’s goods, including some on which the letters “DG” are visible or which are identified as “DG” goods. Although priced in sterling, none of these pages is dated, save for the printing date in October 2017.

20. Exhibit 8 contains images of holograms which are said to have been used on the opponent’s goods since 2007. One of the holograms is said still to be present on stock in the marketplace, though precisely which image is meant is not clear. An example is reproduced below:



21. Mr Dolce provides UK advertising and marketing figures of at least 1.5 million Euros annually between 2010 and 2016.¹⁷ These are said to relate to products sold under the opponent’s “DOLCE & GABBANA”, “D&G” and “DG” marks. Prints of advertising campaigns between 2014 and 2016 are provided, which are said to have been placed in UK publications.¹⁸ These show models wearing a range of clothing and footwear; various bags are also visible. “DOLCE & GABBANA” features prominently on all of them. “#DGFAMILY” is visible in a small font at the bottom of one advert in *Brummel*

¹⁶ pp. 350, 346, 353, 349.

¹⁷ §18.

¹⁸ §19 and exhibit 11.

and two in *Esquire*, dated autumn/September-October 2015.¹⁹ “#DGMAMMA” appears in two adverts from *Elle* (elleuk.com is just visible on the cover), dated September and October 2015.²⁰

22. Mr Dolce provides a number of images of what he says are advertising and editorials.²¹ The magazines featured are UK publications, dating between 2012 and August 2017. Mr Dolce indicates that “[some] of these editorials feature the branding “DG” or “D&G” on the clothing shown”.²² I cannot see either of these marks in the advertising/editorial material itself.

23. A number of UK press articles are included, six of which are dated in the relevant period (the others being after the publication date).²³ I note the following:

- Melania Trump is described as a “DG Woman” (*Hello!*, 3 January 2017);
- The hashtag “#dgfamily” was used on Instagram by the opponent in the run-up to a Milan fashion show in 2015 (*Guardian*, 19 January 2015);
- A reference to “D&G’s latest collection” in an article about the opponent’s offering at Milan fashion week (*Marie Claire*, 22 September 2014);
- An article about an advertising campaign of the opponent (InStyle.co.uk, 23 June 2014), in which “D&G” is used synonymously for “Dolce & Gabbana”;
- The hashtag “#DGmamma”, used in connection with the opponent’s show at Milan fashion week. This article also describes the opponent as one of the 10 most successful Italian brands (*Guardian*, 1 March 2015);
- An article about the opponent’s Milan fashion week offering. The 359 mark is visible on t-shirts worn on the catwalk. There is also reference to slippers embroidered with “D&G luxury hotel” (*FT*, 25 September 2016).

¹⁹ pp. 254, 291, 292.

²⁰ pp. 268-269.

²¹ Exhibit 12.

²² §20.

²³ Exhibit 2.

24. Various articles are exhibited discussing the opponent's clothing.²⁴ Most are dated after the publication date. However, I note that an article from the *Telegraph* dated August 2016 refers to the “#DGTulips’ line”.²⁵ A further article from the *Telegraph*, dated 5 January 2017, shows a number of images from an advertising campaign of the opponent.²⁶ The images are said to be named “#DGMillennials” and have a follower count of over 50 million; the images feature the hashtag “#DGCAPRI”. I note that there are screen grabs from October 2016 which show the hashtags “#dgcampaign” and “#dgmillennials”.

25. An article from the British *GQ* magazine dated October 2012 refers to the entry of the opponent into the “quality-timepiece” market.²⁷ Only the mark “Dolce & Gabbana” is visible.

26. Mr Dolce also exhibits an article entitled “Top 10 Most Popular Luxury Brands On Instagram: H1 2015”.²⁸ The ranking is said to be based on the number of followers, which are not broken down by territory. The terms “#dgeditorials” and “#dgwomen” are visible on what appears to be a screenshot of the opponent's page on the site. Several of the opponent's social media sites are presented at exhibit 3.2. They are either not clearly dated or are dated after the relevant date. Pages from some of the opponent's social media accounts are provided at exhibit 14. Although “DG” and “D&G” are visible in various guises, the prints appear to be dated 2017, though I note that the hashtags “#DGStraps”, “#DGwomen” and “#DGDOLCERADIOBAG” are visible in connection with bags, in images that appear to date from June/July 2016.²⁹

²⁴ Exhibit 15.

²⁵ pp. 399-403.

²⁶ pp. 407-412.

²⁷ Exhibit 4.

²⁸ Exhibit 3.1.

²⁹ p. 368.

27. Web prints are included which show “DG” used at the left of the browser address and to locate stores on the opponent’s website.³⁰ The font is only very slightly stylised; the prints are not dated.

Applicant’s evidence

28. Two witness statements were furnished by the applicant, that of Mohammed Amjad, who states that he is an assistant at the applicant company, and that of Chaudhry Salman Atif, the applicant’s legal representative.

29. Mr Amjad’s evidence is brief, with no exhibits. He states that the applicant intends only to trade online under the “DG Fashion” trade mark. He states that the applicant’s goods will be clearly marked that “products and brand are in no way similar or affiliated with Dolce & Gabbana/D&G”.³¹ He further states that, whilst the applicant’s goods will be high quality, “they will not be considered high-end/designer goods and thus will not be in competition with the Opponent’s goods”.³² Mr Amjad indicates that he chose the trade mark “because it stands for Deal on Goods Fashion”.³³

30. Mr Atif provides evidence of three other registered or protected trade marks in class 25 which contain the letters “DG”.³⁴ The exhibit also includes prints from websites which show these trade marks in use.

31. Exhibit CSA02 shows the results of searches on Twitter, Google+ and YouTube for “#DG” and “D&G”. The results of search algorithms do not assist in showing either how the marks are used or how they are perceived by the relevant public.

³⁰ Exhibit 5.

³¹ §2.

³² §3.

³³ §4.

³⁴ CSA01.

32. At exhibit CSA03 is evidence of two other trade marks which contain the word “fashion” and which are registered in class 25. Website pages featuring these marks are also provided.

33. Exhibit CSA04 includes an extract from an undated report entitled “The Value of the UK Fashion Industry”. The report categorises spending into “value, mid-market, high-end and designer”.³⁵ There is also an extract from a report entitled “High-end & Designer Manufacturing” as well as an article from the British Fashion Council website, dated March 2015, about the report.

Opponent’s evidence in reply

34. This consists of a second statement by Mr Dolce, with eight exhibits. I have read it all; I note in particular the exhibits outlined below.

35. Exhibit AD2 shows a range of advertisements for clothing and glasses bearing the letters “DG”. These advertisements are said to date from before the filing date of the application; whilst some show dates between 2004 and 2006, no more specific information is provided. It is not clear which publications featured these advertisements: the only visible text is in German.

36. Further examples of belts and wallets/purses, as well as one cuff (p. 34), bearing the letters “DG” with minimal stylisation are included at AD3. These are said to date from before the application date but no more specific information is provided. There is no indication of the territories in which they were sold. I also note that there are various images of shoes in this exhibit but the images are of poor quality and none of the marks relied upon is clearly visible.

37. At exhibit AD4 are multiple photographs of the opponent’s stores, in which the letters “DG” are visible on, for example, exterior doors and displayed alongside the goods (bags, clothing, footwear, hats, jewellery) inside. Mr Dolce indicates that these

³⁵ p. 41.

images date from before the filing date; on one, which shows a London shop, the date 2009 is visible.³⁶

38. Various opposition decisions in other jurisdictions are included at AG5. It must be said that the quality of the translation is very poor, which limits any potential usefulness. The decisions, at least in their translated state, do not show with sufficient clarity which mark(s) were found to have the required reputation, whilst the dates appear different from those in the instant proceedings and there is no way for me to tell what evidence was before the decision-makers in those cases. In any event, the decisions in other opposition proceedings are not binding on me, nor of particularly persuasive value.

39. AD6 comprises undated prints from Instagram, which are said to be the results of a search for “#dg” which returns results for the opponent’s goods. Similar undated Google search results are included at AD7. For the same reasons as for the applicant’s search evidence, they do not assist. There is also a Wikipedia page dated February 2018 (i.e. well after the dates relevant to these proceedings). However, I note that there is a print from the WayBack Machine dated 2007 which lists what “DG” may stand for: Dolce & Gabbana is included in that list.³⁷

40. That concludes my summary of the evidence.

Section 5(4)(a)

41. It is convenient to begin with the opponent’s claim under s. 5(4)(a). I will focus first on the sign “DG”, as it is the closer of the two to the applied-for mark. Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

³⁶ p. 53.

³⁷ AD8.

(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

(b) [.....]

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”.

42. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court stated that:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21)”.

43. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11, Daniel Alexander QC, sitting as the Appointed Person, considered the matter of the relevant date in a passing off case. He said:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”.

44. There is no evidence that the contested mark was in use prior to the date of application. That being the case, the relevant date is 13 October 2016.

Goodwill

45. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start”.

46. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of 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. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur”.

47. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application”.

48. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation”.

49. The evidence the opponent has filed is anything but compelling. The lack of specificity in the evidence as to (i) the signs under which the sales have been made and (ii) the goods in relation to which the signs are distinctive is a cause for concern. Much of the evidence dates from after the relevant date which, whilst it may help me in building a picture if there is also evidence from prior to the application date, is of less assistance the more limited the evidence from the relevant period. I inevitably wonder why, with a claim of consistently high sales figures, the opponent has been unable to produce more convincing evidence.

50. Having said that, Mr Dolce’s evidence of very substantial UK advertising and sales figures, which are said to relate to three signs (“DOLCE & GABBANA”, “D&G” and “DG”), is unchallenged. The overwhelming impression from the evidence is that “DOLCE & GABBANA” is the sign used with the greatest frequency and consistency by the opponent. I cannot but conclude that any sales attributable to the “DG” sign are

likely to be a small portion of the overall figure. However, there is also unchallenged invoice evidence which is said to relate to the “DG” sign, among others. Further, I take into account the evidence relating to the various “#DG...” hashtags. Whilst I have already explained why search results are irrelevant, there is evidence that the opponent promoted hashtags such as “#DGTulips”, “#DGmamma” and “#dgmillennials” in relation to specific lines or seasons of clothing, both in print advertising and through its social media platforms, before the relevant date. “DG” is clearly an important part of these labels which identify the opponent’s business and/or goods.

51. With the exception of t-shirts, none of the goods listed on the invoices is shown elsewhere in the evidence bearing either of the signs relied upon. There is, however, some evidence that the sign “DG” was applied to bags, glasses, a necklace, t-shirts/vests and belts before the relevant date and in the UK.³⁸ There is also evidence of “DG” being applied to goods such as jackets and slippers. I accept that some of these examples are heavily stylised. I note that the use of “DG” as reproduced below, dated 2015,³⁹ corresponds to uses shown at exhibit 7 (undated save for the printing date in 2017):



52. I am satisfied that the opponent’s business had a protectable goodwill in the field of clothing at the relevant date. In terms of the sign associated with the goodwill, although some of the uses of “DG” are in a heavily stylised typeface, I am satisfied that there are sufficient examples of “DG” in plain or minimally stylised form that the letters “DG” were distinctive of the opponent’s business at the date of application.

³⁸ Dolce 1, Exhibit 6.

³⁹ Exhibit 13, pp. 247-248.

53. Whilst the opponent has claimed turnover in relation to “non-apparel”, as no invoice evidence is given apart from in relation to clothing, there is no way for me to determine with precision which goods are covered by this term. The evidence of stores featuring the sign “DG” can only be dated to 2009, some seven years before the relevant date, and is not instructive of the way in which the signs may have been used in shops in more recent times. Having said that, there is some limited evidence of use of the sign in relation to belts, bags, footwear, glasses/sunglasses and jewellery/watches by the relevant date. Despite the absence of invoice evidence, and whilst I bear in mind the lack of specificity in the turnover figures, these goods are closely allied to clothing and, on the balance of probability, the opponent’s goodwill will have spilled over into these goods, though on a smaller scale.

Misrepresentation

54. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148* . The necessity for a substantial number is brought out also

in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101”.

And later in the same judgment:

“[...] for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion”.

55. Whilst there is no evidence that the opponent produces paper clothing or aprons, the goods at issue clearly fall within the same field of activity. I note the applicant's assertion that it does not intend to manufacture high-end or designer clothing. However, the specification applied for covers goods across the market sectors, including high-end or designer goods. The marks in issue are highly similar, visually and aurally, being either composed of or dominated by the identical element “DG”. That element has no clear conceptual meaning and it would certainly not be perceived as “Deal on Goods Fashion”. I note the applicant's submissions to the effect that “fashion” is distinctive in relation to clothing. That proposition is, in my view, untenable: “fashion” is either a style of clothing or the area of business relating to clothing. Inherently, the word is non-distinctive for clothing goods and is incapable of distinguishing the applicant's mark from the earlier sign. The evidence of other marks filed by the applicant does not support its submission, as all of the other marks shown include other, distinctive matter. I also dismiss the applicant's submission that “DG” is non-distinctive: I can see no reason why “DG” would not serve to indicate the origin of the goods. I am satisfied that the use of “DG Fashion” in October 2016 was likely to amount to a misrepresentation to the public.

Damage

56. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697, Millett L.J. described the requirements for damage in passing off cases like this:

“In the classic case of passing off, where the defendant represents his goods or business as the goods or business of the plaintiff, there is an obvious risk of damage to the plaintiff's business by substitution. Customers and potential customers will be lost to the plaintiff if they transfer their custom to the defendant in the belief that they are dealing with the plaintiff. But this is not the only kind of damage which may be caused to the plaintiff's goodwill by the deception of the public. Where the parties are not in competition with each other, the plaintiff's reputation and goodwill may be damaged without any corresponding gain to the defendant. In the *Lego* case, for example, a customer who was dissatisfied with the defendant's plastic irrigation equipment might be dissuaded from buying one of the plaintiff's plastic toy construction kits for his children if he believed that it was made by the defendant. The danger in such a case is that the plaintiff loses control over his own reputation”.

57. In *Ewing v Buttercup Margarine Company, Limited*, [1917] 2 Ch. 1 (COA), Warrington L.J. stated that:

“To induce the belief that my business is a branch of another man's business may do that other man damage in various ways. The quality of goods I sell, the kind of business I do, the credit or otherwise which I enjoy are all things which may injure the other man who is assumed wrongly to be associated with me”.

58. In a case such as this involving the use of highly similar signs in the same field of activity, damage to the opponent's business through diversion of sales or loss of control of the opponent's reputation is easily foreseeable. Damage is made out.

Conclusion

59. The opposition succeeds in full under s. 5(4)(a).

Other grounds

60. Given my findings above, and considering the chronic deficiencies in the opponent's evidence, the opponent's position would not be materially improved if I were to consider the remaining grounds. I decline to do so.

Costs

61. The opponent has been successful and is entitled to an award of costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice ("TPN") 2/2016. Bearing that scale in mind but making a reduced award in relation to the evidence, much of which was not relevant, I award costs to the opponent as follows:

| | |
|---|------|
| Official fee: | £200 |
| Preparing the notice of opposition and considering the counterstatement: | £200 |
| Filing evidence and considering the other side's evidence: | £300 |
| Written submissions: | £300 |

Total: £1,000

62. I order cherryandjerrylimited to pay Dolce & Gabbana Trademarks S.R.L. the sum of **£1,000**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 31st day of August 2018

**Heather Harrison
For the Registrar**

Appendix

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Class 3: Cosmetics in general, including: face creams; mascara; eye liner; eyeshadows; make-up pencils; face clays; lipsticks; foundation; body lotions; nail varnishes; nail strengtheners; acetone; cosmetic kits; perfumery, including perfumes; solid perfumes; deodorants; essential oils; soaps; liquid soaps; cakes of toilet soap; foam bath; talcum powder; dentifrices; shampoos; hair lotions; Permanent waving and setting preparations for the hair; gel; hair dyes; sun-tanning oils and lotions; depilatory preparations; detergents; bleach; fabric softeners [for laundry use]; soaps; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring, scraping and abrasive preparations.

Class 9: Spectacles; sunglasses; spectacle frames; contact lenses; containers and cases for contact lenses; apparatus for recording, transmission or reproduction of sound or images; sound recording discs; scientific, nautical, surveying and electric apparatus and instruments; photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; coin or counter-operated apparatus; cash registers.

Class 18: Bags; handbags; sports bags; gent's handbags; pocket wallets; coin purses; purses; travelling bags; trunks; rucksacks; briefcases; document holders; key cases (leatherware); vanity cases (not fitted); skins, hide and leatherware; leather and goods made of leather; imitations of skins and leather and goods made of these materials; parasols; parasols; umbrellas; walking-sticks; whips; harness and saddlery.

Class 25: Clothing for gentlemen, ladies and children in general, including, clothing in leather; shirts; jumpers [shirt fronts]; skirts; suits; jackets [clothing]; trousers; shorts; sports jerseys; T-shirts; pyjamas; stockings; singlets; corsets [underclothing]; suspenders; pants; brassieres; underwear; hats; headscarves; neckties; waterproof

clothing; overcoats; topcoats; swimsuits; tracksuits; windcheaters; ski trousers; belts; furs; sashes for wear; gloves; dressing gowns; footwear in general, including, slippers, shoes, sports shoes, boots and sandals.

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Class 3: Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

Class 9: Spectacles; sunglasses; spectacle frames; spectacle glasses; spectacle cases; optical apparatus and instruments

Class 14: Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, precious stones; horological and chronometric instruments.

Class 18: Leather and imitations of leather, and goods made of these materials and not included in other classes; animal skins and hides; trunks and suitcases; umbrellas, parasols and walking sticks; whips, harness and saddlery.

Class 25: Clothing, footwear, headgear.