

IN THE MATTER OF APPLICATION NO. 2372279 IN THE NAME OF
CAROLINE KAVANAGH

AND IN THE MATTER OF OPPOSITION NO. 93139 THERETO BY EMILIO
PUCCI SRL

DECISION

Introduction

1. On 1 September 2004 Caroline Kavanagh applied to register the trade mark set out below in respect of “Cosmetics, shampoos and materials for grooming of pets” in Class 3 and “Leather and imitation leather goods, clothing and accessories for pets” in Class 18. I should say at the outset that it is clear and undisputed that the words “of pets” and “for pets” are intended to qualify the whole of the respective specifications.



2. The application was opposed by Emilio Pucci SRL on grounds raised under sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994. In support of its opposition the opponent relied upon its earlier UK registered trade mark No. 898920 EMILIO PUCCI registered in respect of “articles of outerclotthing for women, being for sale in England and Scotland” in Class 25.

3. Both sides filed evidence and written submissions but neither requested a hearing. George Salthouse acting for the Registrar dismissed the opposition in a written decision dated 11 September 2006 (O/256/06). The opponent now appeals. On the appeal the opponent has concentrated upon its objections under sections 5(2)(b) and 5(3) of the 1994 Act.

Relevant provisions of the Trade Marks Act 1994

4. Section 5 of the 1994 Act provided at the relevant time in relevant parts as follows:

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

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier 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

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(3) A trade mark which is identical with or similar to an earlier trade mark 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.

5. These provisions implement Articles 4(1)(b), 4(3) and 4(4) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks.

The hearing officer's decision

6. Having summarised the evidence, the hearing officer first considered the objection under section 5(2)(b). He began by setting out the Registrar's standard summary of the guidance provided by the Court of Justice of the

European Communities in Case C-251/95 *SABEL BV v Puma AG* [1997] ECR I-6191, Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507, Case C-342/97 *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* [1999] ECR I-3819 and Case C-425/98 *Marca Mode CV v Adidas AG* [2000] ECR I-4881.

7. The hearing officer considered that the opponent's trade mark was inherently distinctive. As to whether it had acquired a reputation through use, he held as follows:

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 £1 million 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.

8. So far as the comparison between the respective goods was concerned, the hearing officer's assessment was as follows:

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.

9. As to the respective marks, the hearing officer's view, having referred to *Croom's Trade Mark Application* [2005] RPC 2, Case C-120/04 *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* [2005] ECR I-8551 and Case T-385/03 *Miles Handelsgesellschaft International mbH v Office for Harmonisation in the Internal Market* [2005] ECR II-2665, was as follows:

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.

10. The hearing officer found that the average consumer of both parties' goods was a member of the general public who would not purchase the goods "without some consideration".
11. Taking all these factors into account, the hearing officer's conclusion was that there was no likelihood of confusion.

12. As to section 5(3), the hearing officer referred to *General Motors Corp v Yplon SA* [2000] RPC 572, *Premier Brands UK Ltd v Typhoon Europe Ltd* [2000] RPC 767, *DaimlerChrysler AG v Alavi* [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's Trade Mark Application* [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines Ltd* (O/455/00), *Mastercard International Inc v Hitachi Credit (UK) plc* [2004] EWHC 1623 (Ch), [2005] ETMR 10 and *Electrocoin Automatics Ltd v Coinworld Ltd* [2004] EWHC 1498 (Ch), [2005] FSR 7.
13. So far as the question of reputation was concerned, the hearing officer held as follows:

This test [sc. that laid down in *General Motors*] 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.

14. The hearing officer accordingly dismissed the objection under section 5(3) on the ground that the opponent's evidence did not establish that the opponent's trade mark had the requisite reputation. In case he was wrong, however, he went to consider the opponent's case on detriment and held as follows:

43. ... 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.

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 consumer's economic behaviour or damage the opponents' mark by tarnishing or blurring. The opposition under Section 5(3) of the Act fails.

Standard of review

15. This appeal is a review of the hearing officer's decision. Counsel for the opponent accepted that the hearing officer's decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind to which the approach set out by Robert Walker LJ in *REEF Trade Mark* [2002] EWCA Civ 763, [2003] RPC 5 at [28] applies:

In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

A decision does not contain an error of principle merely because it could have been better expressed.

Grounds of appeal

16. In its statement of grounds of appeal the opponent contended that the hearing officer had erred in principle in four main respects. First, his assessment of the reputation of the opponent's trade mark was flawed because he considered the

wrong market. Secondly, in considering the similarity of the respective goods, he misconstrued the applicant's specifications of goods. Thirdly, he misdirected himself when considering the similarity of the respective trade marks. Fourthly, he considered the question of detriment on the wrong basis since he failed to take into account the fact that the applicant's specification covered all types of class 3 and class 18 goods for pets, including fashion items, sold through all types of outlet, including fashion stores. At the hearing before me counsel for the opponent also advanced two further grounds of appeal. The first of these was that the hearing officer had failed to consider the evidence as a whole and in particular had ignored certain important admissions by the applicant. The second was the hearing officer was predisposed against the opponent's case.

The reputation of the opponent's trade mark

17. The opponent argues that the hearing officer should have considered its reputation in the designer clothing market rather than in the market for clothing generally and that, if he had done so, he ought to have concluded that it did have a significant reputation in that market. The opponent says that its claim to reputation in that market is supported by the evidence it filed, and in particular a bundle of copies of articles from magazines and newspapers.
18. I accept that the opponent's evidence, and in particular the magazine and newspaper articles relied on, shows that its trade mark had a reputation as at the relevant date. If one was dealing with an earlier trade mark that was not inherently distinctive, that might well be important: compare *Oska's Trade Mark Application* [2005] RPC 20. The hearing officer accepted, however, that the opponent's trade mark was inherently distinctive. Furthermore, he did not hold that it had no reputation. On the contrary, when it came to the section 5(3) case, he expressly held that it did have a reputation in relation to the women's clothing. Consistently with this, he did not dismiss the opponent's section 5(4)(a) case for want of reputation and goodwill, but on the ground that there was no likelihood of misrepresentation. What the hearing officer held was that the opponent's evidence did not establish that the opponent's

trade mark had a sufficient reputation at the relevant date to justify either an enhanced scope of protection under section 5(2)(b) beyond that justified by its inherent distinctiveness or protection under section 5(3). That was an assessment which the hearing officer was entitled to make and I see no error of principle in the hearing officer's approach. In particular, I do not think that he erred in his characterisation of the relevant market. The magazine and newspapers relied upon by the opponent are mainly directed at a general readership interested in women's clothing, including publications such as *Marie Claire*, *New Woman*, *Harpers & Queen* and *Tatler*, and not just customers for designer clothing. Consistently with this, the opponent's specification of goods is not restricted to *haute couture* clothing. This is for the very good reason that it is difficult to demarcate such clothing from clothing sold in high street shops.

Comparison between the respective goods

19. It has to be said that in the paragraph of his decision which I have quoted in paragraph 8 above, the hearing officer did not clearly articulate his conclusion as to the degree of similarity or otherwise of the respective goods. Indeed, he began by saying that the applicant's class 3 goods are different to the opponent's goods, and that statement appears to underlie his reference to "the goods which are dissimilar" in paragraph [46] of his decision; yet his reasoning both here and later appears to acknowledge that there is an affinity between Class 3 and Class 18 goods on the one hand and Class 25 goods on the other hand, at least for humans, since it is common for fashion houses to market goods in all three classes. Furthermore, the hearing officer did not base his ultimate conclusion in relation to section 5(2)(b) purely upon a lack of similarity between the respective goods. Reading the decision as a whole, therefore, it seems to me that the hearing officer's assessment was that the degree of similarity between the applicant's goods and those of the opponent was low, particularly so far as the Class 3 goods were concerned; but not so low as by itself to preclude a likelihood of conclusion. I see no error of principle in that approach. On the contrary, it avoids the error identified in *James' Application* (O/079/05) (and cf. *Home-Tek International Ltd's*

Applications (O/144/05), *Sugarman's Application* (O/305/05) *CITYBOND Trade Mark* [2007] RPC 13 and *Hyundai Mobis Co Ltd's Application* (O/020/07)).

20. The opponent argues that hearing officer effectively acknowledged that the applicant's specification was broad enough to encompass fashion items and that he was in error in dismissing this similarity. In my judgment the opponent is right to say that the hearing officer effectively acknowledged this possibility, but to my mind that merely emphasises that he did not conclude that the respective goods were wholly dissimilar.

Comparison between the respective marks

21. The opponent contends that the hearing officer's analysis was erroneous because, although he referred to the judgment of the European Court of Justice in *Medion*, he failed to apply it. The opponent argues that the hearing officer should have held that the word PUCCI had an independent distinctive role in its trade mark and accordingly that there was sufficient similarity between the respective marks to give rise to a likelihood of confusion.
22. I do not accept this argument. The ECJ has repeatedly held that the assessment of the visual, aural and conceptual similarities between trade marks must be based on the overall impression given by each trade mark considered as a whole. The correct legal position has just been re-iterated by the ECJ in Case C-3334/05P *Office for Harmonisation in the Internal Market v Shaker di L. Laudato & C. Sas* (unreported, 12 June 2007) in the following terms:
 33. In this regard, it is settled case-law 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 8(1)(b) of Regulation No 40/94 (see First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1); Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 17; and Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 26).

34. Moreover, the existence of a likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (see *SABEL*, paragraph 22; *Lloyd Schuhfabrik Meyer*, paragraph 18; Case C-425/98 *Marca Mode* [2000] ECR I-4861, paragraph 40; order in *Matratzen v OHIM*, paragraph 28; *Medion*, paragraph 27; and Case C-206/04 P *Mülhens v OHIM* [2006] ECR I-2717, paragraph 18).
35. According to further settled case-law, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see *SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; *Medion*, paragraph 28; *Mülhens v OHIM*, paragraph 19; and order in *Matratzen Concord v OHIM*, paragraph 29).
36. It should be added that in order to assess the degree of similarity between the marks concerned, it is necessary to determine the degree of visual, aural or conceptual similarity between them and, where appropriate, to assess the importance to be attached to those various factors, taking account of the category of goods or services in question and the circumstances in which they are marketed (see *Lloyd Schuhfabrik Meyer*, paragraph 27).
- ...
41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).
42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.
23. Accordingly, the hearing officer was correct to assess the similarity between the respective marks by considering the overall impression conveyed by each

of them considered as a whole. He was also correct to recognise that in the case of the opponent's trade mark EMILIO qualifies PUCCI and vice-versa: see *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159, [2004] RPC 40 at [26] and *Croom* at [33]. He was also correct nevertheless to recognise that the two marks share a common element. He was also correct to have regard to the conceptual dimension of the applicant's mark: see Case C-361/04P *Ruiz-Picasso v Office for Harmonisation in the International Market* [2006] ECR I-643. I do not agree with him that there was no evidence of the opponent abbreviating its mark to PUCCI, but more importantly I do agree that the evidence did not establish that at the relevant date the average consumer of women's clothing would view PUCCI alone as indicating the opponent. I am not sure that I share his assessment that the differences between the trade marks outweigh the similarities, but given that there was no error in his approach that assessment was one that was open to him.

The applicant's admissions

24. In her witness statement in response to the opponent's evidence the applicant stated:

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

In her written submissions to the hearing officer the applicant stated

There was certainly never any intention of trading on the name of Emilio Pucci ... but wanted to imply canine fashion by linking the names GUCCI and POOCH. It is interesting to speculate on the far greater similarity and likely confusion in the public mind between the established name of GUCCI and the relatively unknown name of PUCCI.

25. Counsel for the opponent submitted that the statement in the witness statement and the first sentence quoted from the submissions amounted to admissions that (i) the applicant's trade mark was intended to allude to canine fashion and

(ii) there was a connection between canine fashion and human fashion. I think there is some force in this submission, but it does not follow that the hearing officer made any error of principle. The sentence which I have quoted from the applicant's witness statement was quoted by the hearing officer in his decision and it is clear that he took it into account. He did not treat it as determinative and in my judgment he was entitled not to do so.

26. Counsel for the applicant also submitted that the second sentence quoted from the submissions was an admission that, if the opponent had been Gucci, then there would have been a likelihood of confusion and that it followed that there was a likelihood of confusion in the present case. I do not accept this. The submission is referring to use of the marks GUCCI and PUCCI on clothing. Moreover, the whole point of the submission is that GUCCI has a significant reputation while PUCCI does not.
27. As for the more general point that the hearing officer failed to consider the evidence as a whole, as I read his decision, the hearing officer's overall conclusion that there was no likelihood of confusion was based upon the combined effect of what he assessed as the low degree of similarity between the respective goods, bearing in mind that the applicant's goods are all for pets, and what he assessed as the low degree of similarity between the respective marks, bearing in mind in particular the fact that the applicant's mark would be seen as a play on the word POOCH. I consider that that was a conclusion that he was entitled to reach.

Predisposition

28. Counsel for the opponent complained that the hearing officer's decision was "generally suffused with a predisposition to be sceptical, rude and disrespectful of certain persons or classes of persons and of the general contention that there can be 'canine couture'." In my view there is no substance in this complaint.

Detriment

29. Given that I have rejected the opponent's attack on the hearing officer's conclusion with regard to reputation, the opponent's case under section 5(3) does not get off the ground. Accordingly it is unnecessary to consider the opponent's argument on detriment. Nevertheless I will add the following comment. The opponent's case is that the average consumer who was familiar with the opponent's mark and saw the applicant's mark used in relation to pet products would think that the opponent had branched out into that field, a case which the opponent contends is supported by evidence that by the relevant date certain fashion houses had produced some goods for pets. In substance, this is a case of likelihood of confusion. Once the hearing officer had concluded that there was no likelihood of confusion, the opponent's evidence and arguments do not identify any independent basis for an objection under section 5(3).

Conclusion

30. The appeal is dismissed.

Costs

31. The hearing officer ordered the opponent to pay the applicant the sum of £1,500 as a contribution to her costs of the opposition. I shall order the opponent to pay the additional sum of £250 as a contribution to her costs of the appeal.

13 June 2007

RICHARD ARNOLD QC

Denise McFarland, instructed by D. Young & Co, appeared for the opponent (appellant).

The applicant (respondent) appeared in person assisted by Malcolm Victory of 1% Studio.