

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 2160590A  
BY ASDA STORES LIMITED TO REGISTER A SERIES OF THREE TRADE  
MARKS IN CLASS 3

AND IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 46549  
BY GIORGIO BEVERLY HILLS INC.

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**DECISION**

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Introduction

1. This is an appeal from a decision of Mr. George Salthouse dated the 14<sup>th</sup> of March 2002 concerning an application by Asda Stores Limited (“the Applicant”) to register a series of three trade marks comprising the word GEORGE in respect of a range of goods, including perfumery and cosmetics, in Class 3.
2. The application was opposed by Giorgio Beverly Hills Inc. (“the Opponent”). It was contended that registration of the trade mark would offend against the provisions of section 5(2)(b) of the Trade Marks Act 1994 in the light of three earlier trade marks comprising the word GIORGIO registered in respect of a similar range of goods, including perfumery and cosmetics, in Class 3.
3. The Hearing Officer concluded that there was no likelihood of confusion at the relevant date and that consequently the opposition under section 5(2) failed.

### The Appeal

4. On the 11<sup>th</sup> April 2002 the Opponent gave notice of appeal to an Appointed Person. At the hearing of the appeal the Opponent was represented by Mr. John Baldwin QC, instructed by D. Young & Co. The Applicant was represented by Mr. Iain Purvis, instructed by Appleyard Lees.
  
5. The parties were agreed as to the approach which this tribunal should adopt in relation to this appeal. The Hearing Officer had to make what has been described as a multi-factorial comparison, evaluating the similarities between the marks and all other relevant factors in order to reach his conclusion about the likelihood of confusion. Moreover he is unquestionably experienced in this field. In the circumstances an appellate court should show a real reluctance, but not the very highest degree of reluctance, to interfere with his decision in the absence of a distinct or material error of principle. Such is clear from the decision of the Court of Appeal in *Bessant v. South Cone Inc* [2002] EWCA Civ 763. I must also have in mind that, as Robert Walker L.J. said in that case, an appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed. The duty to give reasons must not be turned into an intolerable burden.

### Section 5(2) – The likelihood of confusion

6. It was accepted on behalf of the Opponent that the Hearing Officer correctly identified certain principles which may be derived from the decisions of the

European Court of Justice in *Sabel BV v. Puma AG* [1998] RPC 199; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] RPC 117; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. It was submitted, however, that the Hearing Officer fell into error in failing to apply those principles properly in this case. A number of criticisms were made of his reasoning.

7. First of all my attention was drawn to the consideration given by the Hearing Officer to the visual similarities between the marks. In paragraph 26 of the decision the Hearing Officer said:

“Visually the marks differ only in that the second letter of the applicant’s mark is an “E” compared to an “I” in the opponent’s mark, and the applicant’s mark ends with an “E” whereas the opponent’s mark ends in “IO”. Clearly in relatively short marks differences are more noticeable, particularly when at least one of the marks is a recognised forename.”

It was submitted that this reasoning was flawed because in the present case it was common ground that the respective marks were different language versions of the same name. The Hearing Officer wrongly proceeded on the basis that only one of the marks was a recognised forename when he ought to have proceeded on the basis that they would be recognised as different language versions of the same forename. Similarly it was submitted that the Hearing Officer forgot to take into account the conceptual identity of the marks in this part of his reasoning.

8. After some hesitation I have come to the conclusion that I must reject this submission. To my mind the Hearing Officer was simply pointing out that

whilst the marks differed only in two respects which he identified, he had also to take into account that the marks were relatively short and that differences were therefore more noticeable. This seems to me to be a perfectly reasonable approach. He also took into account, and I believe properly took into account, the fact that GEORGE is a very well known forename. It is true that in this paragraph he does not expressly mention that GEORGE and GIORGIO are different language versions of the same name. But I believe that it is clear from paragraph 28 of the decision that this was a matter which the Hearing Officer also had well in mind. He said there:

“It was common ground that the marks are the same name, the opponent’s mark being the Italian version while the applicant’s mark is the English version.”

9. Next it was submitted that in considering the aural similarity between the marks the Hearing Officer identified the similarities but then failed to take them into account. I do not accept this submission. In paragraph 27 of the decision the Hearing Officer specifically identified the extent of the aural similarities between the marks in saying:

“The opponent contended that the marks were very similar phonetically, in that the applicant’s mark is a single syllable name “GEORGE” whereas the opponent’s mark is a two syllable name “GEORGE-IO”. Mr. Baldwin contended that the initial syllable was therefore identical. The only difference was in the endings of the names.”

True it is that the Hearing Officer does not expressly say here that he is accepting the submission. Nevertheless, I believe it is clear that it is one of the matters that he has taken into account in arriving at his conclusion.

10. The Hearing Officer then turned to consider the nature of the goods in issue and the average consumer. He noted that perfume and cosmetic products are not chosen without some consideration and that such products tend to be rather expensive and consumers of such products are very “brand aware” due to the cachet believed to be associated with certain brand names. He concluded that the average consumer of such products would exercise some care in the selection of such products but that even so, allowance must be made for the notion of imperfect recollection.
  
11. It was submitted that the Hearing Officer here fell into error in two respects. First, it was said that there was no evidence about the prices at which cosmetics were sold and that the Applicant is well known for and makes a feature of its low prices. Secondly, it was said that the Hearing Officer failed to recognise that many cosmetics are bought by persons other than the ultimate consumers, for example as gifts or at the request of the ultimate consumers.
  
12. In my judgment the Hearing Officer here properly addressed his mind to the nature of the goods in issue and the average consumer of them. I believe that the conclusion that he reached that the goods in issue are likely to be chosen with some consideration was a perfectly reasonable one. I also believe it was a reasonable conclusion to reach in respect of such goods sold at relatively low prices. I accept that the Hearing Officer has not expressly referred to the possibility that cosmetics are sometimes bought by persons other than the ultimate consumers. But I do not believe that it is justifiable to suggest that persons who buy perfumes or cosmetics for consumption by others will choose

such products without some consideration. As submitted by the Applicant, it is clear from the *Sabel* case that the matter must be judged through the eyes of the average consumer, who is deemed to be reasonably well informed and reasonably circumspect and observant. It seems to me that whether one is considering the ultimate consumer or a person buying for such a consumer, it is reasonable to suppose that such a person would, in each case, exercise some care in the selection of perfume and cosmetics products.

13. Next it was submitted that the Hearing Officer wrongly failed to conclude that the mark GIORGIO could be regarded as enjoying an above average reputation at the relevant date. In this regard the Hearing Officer noted that no evidence was provided relating specifically to sales of goods in Class 3 nor in relation to the use of the mark GIORGIO as opposed to the mark GIORGIO BEVERLY HILLS. It was submitted that an examination of the retail price lists and of the exhibits showing pictures of goods themselves made it clear that the goods were known as GIORGIO and, moreover, that the evidence made it clear that extensive sales had been made of toiletries and luxury goods generally and that those goods formed a single class in the minds of consumers.

14. I do not feel able to interfere with the decision of the Hearing Officer on this point. No details were provided in the evidence of which luxury goods the mark GIORGIO had been applied to and there was no evidence of the extent of use of the mark GIORGIO in relation to perfumes and cosmetics. As noted by the Hearing Officer, the evidence of use showed that in the year prior to the relevant date, goods bearing the Opponent's marks to the value of

approximately £8,500,000 were sold in the UK. These goods were described generally as toiletries and luxury goods. I do not believe it can be inferred from this general evidence that the Opponent's marks enjoyed an above average reputation at the relevant date in relation to the goods the subject of the application.

15. The Hearing Officer then took note of the following comments of Buckley J. in *Buler* [1966] RPC 141 at 143:

“It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other person than the person to whom one supposes the name to belong.

I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear prima facie to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question.”

The Hearing Officer continued that although these comments were made in a case under the 1938 Act, he believed that the views expressed were still valid under the 1994 Act. He said:

“Similarly, although the learned judge referred to surnames, I believe that his comments would extend to forenames, particularly where one is a very well known and established English forename and the other obviously foreign.”

16. The reliance upon *Buler* was strongly criticised by the Opponent. It was a case which was apparently neither cited to the Hearing Officer nor referred to in argument before him. The Opponent rightly pointed out that *Buler* was a case under the 1938 Act in which the opponent was suggesting that the mark Buler would be perceived as a misspelling of one or other of the surnames Buller or Buhler and that accordingly it should be regarded as a surname and not an invented word. The comments made by Buckley J. and recited by the Hearing Officer were made during a rejection of that contention and had nothing to do with whether there would be confusion between two names accepted to be surnames. Similarly and most importantly, it was submitted that those comments had nothing to do with the likelihood of confusion between two names which were accepted to be the same forename but in different language versions.

17. I believe there is some force in this submission. There is a significant difference between the case of two words, only one of which is a recognised name and the case of two words, both of which are recognised to be the same name, albeit in different language versions. Nevertheless I have come to the conclusion that the submission must be rejected. I do not believe that the Hearing Officer was intending to suggest that the facts and circumstances of this case and *Buler* were the same. The Hearing Officer expressly noted that one of the marks before him was a very well known and established English forename and the other was obviously foreign. In my judgment the Hearing Officer was simply citing the observations of Buckley J. to illustrate what I think was a reasonable point that where one has a very well known name, such



as GEORGE, then the average consumer is likely to be put on enquiry if he or she sees that name spelt in a different way. The Hearing Officer came to the conclusion that the average consumer would distinguish between such a well known and established English forename and a version of that forename which was obviously foreign. I think that was a reasonable conclusion for him to have reached.

18. Overall I have not been able to detect a distinct or material error of principle in the approach of the Hearing Officer in this case. I do not believe that the Hearing Officer was clearly wrong in his conclusion. I accept the submission made on behalf of the Applicant that the decision of the Hearing Officer was one which he was entitled to make on the facts and that there is no basis for overturning it.

### Conclusion

19. In all the circumstances, this appeal must be dismissed. I order the Opponent to pay to the Applicant the sum of £1535 by way of a contribution towards its cost of the appeal, such sum to be paid on a like basis to that ordered by the Hearing Officer.

DAVID KITCHIN, QC

23<sup>rd</sup> September 2002