

O-350-09

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2420184B  
BY ISHTIAQ HUSSAIN ESQ. TO REGISTER THE TRADE MARKS**

**DUCCIO  
Duccio**

**IN CLASSES 9, 14 AND 25**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 94909  
BY GUCCIO GUCCI S.P.A.**

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By Guccio Gucci S.p.A.**

### **BACKGROUND**

1) On 11 April 2006, Ishtiaq Hussain Esq. of 9 Kelfield Avenue, Harborne, Birmingham B17 0QN applied under the Trade Marks Act 1994 ("the Act") for registration of the following series of two marks:

**DUCCIO  
Duccio**

2) The application was subsequently divided with the part B element of the application (hereafter referred to as "the application") proceeding in respect of the following goods:

Class 09:

*Optical apparatus; sunglasses, spectacles, frames for sunglasses and spectacles, cases for sunglasses and spectacles; crash helmets, crash helmets for cyclists, crash helmets for motorcyclists, articles of leather clothing for protection against accident or injury, articles of clothing, footwear and headgear for protection against accident or injury; articles of leather clothing for wear by cyclists and motorcyclists for protection against accident or injury, helmet cases of leather specifically adapted to contain helmets, leather belt kidney protectors for motorcyclists for prevention of accident or injury parts and fittings for the aforesaid goods.*

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; jewellery, precious stones;*

*horological and chronometric instruments; candlesticks; broaches; jewellery cases; clocks, watches, stop watches; rings, ear rings, ear-studs, nose studs, nose rings, eyebrow, face and body rings, belly button rings, belly button studs, nipple rings and nipple studs and nipple bars; body jewellery being studs, bars, piercing and rings; items of intimate body jewellery, being studs, bars, piercing and rings; finger rings, bracelets; necklaces, precious stones; key fobs coated with precious metal; key rings; key rings of precious metals; parts and fittings for all the aforesaid goods.*

Class 25:

*Clothing, footwear, headgear; boxer shorts; camisoles; caps being headwear; jackets; jackets of leather, gilets of leather, waistcoats of leather, trousers of leather, shirts of leather; shorts of leather, skirts of leather, blousons of leather, mini skirts of leather, overcoats of leather, coats of leather, hats of leather, caps of leather, gloves of leather, aprons of leather; jackets of denim, gilets of denim, waistcoats of denim, trousers of denim, shirts of denim; shorts of denim, skirts of denim, blousons of denim, mini skirts of denim, overcoats of denim, coats of denim, hats of denim, caps of denim, gloves of denim, aprons of denim; knitwear; mittens; neckties; pullovers; scarves; shirts; ski hats; slippers; socks; sports jerseys; swimwear; tee-shirts; underclothing, gilets, jackets, overcoats, coats, jerseys, jumpers, tops, sweaters, cardigans, pullovers, ponchos, corsetry, scarves, shawls, mufflers, pashminas, wraparounds, wraps, gloves, socks, swimming costumes, one piece swimming costumes, bikini swimming costumes, tankinis, tops, thongs, pants, bras, bodyshapers, beachwear, sarongs, leisure wear, blouses, shorts, shirts; jeans, denim jackets, denim trousers, ties, lounge suits, waist coats, trousers, articles of lingerie, articles of underwear, dressing gowns, bath robes, beach robes, articles of beachwear, beach clothing, beach dresses, beach shorts, beach wraps, sportswear, boxer's shorts and vests, sports bras, sports panties, sports briefs, and jock straps, sports pants, sports shorts, sports t-shirts, sports crop-tops, sports vests, trackpants, track suits, jogging suits, warm-up suits, running shorts, running vests, running tops, running pants; bicycling shorts, soccer shirts, soccer shorts, soccer socks, football shirts, football shorts and football socks, rugby shirts, rugby shorts and rugby socks, sweat shirts, hooded tops; swimming suits being wetsuits, wet suits for surface water-sports, wetsuits for surfing; wet suits for water-skiing; wet suits for windsurfing; dry suits; footwear, shoes, boots, trainers, flip-flops, sandals, Wellington boots, beach shoes, shoes for windsurfing and water sports; headgear, woolly hats, caps, bobble hats, ski hats, baseball caps, cricket hats, sunhats, sun-visors, swimming caps; parts and fittings for all the aforesaid goods.*

3) On 15 January 2007, Guccio Gucci S.p.A. (“Gucci”) of Via Tornabuoni, 73/R, 50123 Firenze, Italy filed notice of opposition to the application. The grounds of opposition are in summary:

- a) Mr Hussain’s application offends under Section 5(2) (b) of the Act because his marks are similar to two of Gucci’s earlier marks and all the goods claimed are identical or similar to Gucci’s goods. The two earlier marks relied upon by Gucci are:

<b>Number and filing dates</b>	<b>Mark</b>	<b>Use claimed in respect of:</b>
1179954 Filing date: 10 August 1982	GUCCI	Class 9: Spectacle glasses, spectacle frames, sunglasses
1328849 Filing date: 4 December 1987	GUCCI	Class 25: Articles of outer-clothing; knitted articles of clothing; shirts; T-shirts, skirts, blouses, scarves, cravats, hats; ties, socks, belts; boots, shoes and slippers

- b) Mr Hussain’s application offends under Section 5(3) of the Act because it is similar to the two earlier marks detailed above and, in addition, to the two following marks, all of which have a reputation:

<b>Number and relevant dates</b>	<b>Mark</b>	<b>Use claimed in respect of:</b>
1108182 Filing date: 24 January 1979	GUCCI	Class 14: Watches, clocks, jewellery in gold and silver, precious stones
1108184 Filing date: 24 January 1979	GUCCI	Class 25: Articles of outer-clothing for men and women

4) Mr Hussain subsequently filed a counterstatement denying Gucci’s claims and stating that the respective marks are phonetically, visually and conceptually dissimilar. The applicant is specifically asked, at point 5 of the form TM8 (counterstatement), “[d]o you want the opponent to provide proof of use?”. Mr Hussain answered “no” to this question.

5) Both parties filed evidence in these proceedings. Both sides asked for an award of costs. The matter came to be heard on 14 October 2009 when Gucci was represented by Mr Simon Malynicz of Counsel appointed by Addleshaw Goddard LLP. Mr Hussain represented himself.

### **Opponent's Evidence**

6) This consists of a witness statement, dated 8 January 2008, by Mr Vanni Volpi, Intellectual Property Counsel of Gucci Group. He has responsibility for the trade mark portfolio of Gucci. He states that Gucci is the owner of international goodwill and reputation in respect of the mark GUCCI and that this has existed for more than eighty years. He states that this reputation is in respect of clothing and fashion products, including handbags and other leather goods, shoes, cosmetics, skin care, jewellery, eyewear and watches. A copy of an article that appeared in Time magazine, dated 9 April 2001, detailing the history of the Gucci Group is provided at Exhibit VV-1. Here the group of companies is described as "a \$8 billion powerhouse". It talks about Gucci's stock market value in the year 2000 and discusses its rivalry with Louis Vuitton, another luxury goods trader. The article recounts that in 1994, GUCCI was a "rather down-on-its-luck brand", but that only five years later, the fortunes of the company had improved to such an extent that it was valued at \$8 billion. At the time the article was written, it was recognised that Gucci was the number one competitor of Louis Vuitton and it records that the company was "sitting on \$3 billion cash, has next to no debt and its shares are worth \$9 billion." It also mentions that Gucci had also acquired other brands such as Yves Saint Laurent but that, despite the acquisition of these other brands, "the firm's line of [Gucci] shoes, handbags and ready-to-wear is still far and away its dominant business, with \$1.5 billion sales and \$404 million operating profit last year. The No. 2 earner, YSL Beauté, contributed just \$43 million to the bottom line."

7) Mr Volpi states that the GUCCI mark has been known in the UK since the 1950s and that a GUCCI store was opened in London in the 1960s, where GUCCI branded goods were sold. He also states that, today, GUCCI branded products are sold throughout the UK in GUCCI stores and concessions in famous department stores such as Harrods and Selfridges. A list of seven of these stores or concessions, in London, is provided at Exhibit VV-2.

8) Mr Volpi states that Gucci has built up a considerable reputation in relation to the goods covered by its earlier marks and in support of this, he provides a copy of an article that appeared in Business Week Online listing the top one hundred brands in 2006, as calculated by a company named Interbrand. GUCCI appears at number 46, up from number 49 the year before. The comment alongside the entry for GUCCI includes the phrase "...sales of apparel and leather accessories are growing nicely". The methodology used in calculating the position of a given brand is explained. This methodology includes financial considerations, that the

brand must be recognisable outside of its customer base, and the strength of the brand by looking at factors such as market leadership, stability and global reach, and the ability to cross both geographic and cultural borders.

9) Mr Volpi provides the following sales figures for the mark GUCCI in the UK:

<b>€ million</b>	<b>2001</b>	<b>2002</b>	<b>2003</b>	<b>2004</b>	<b>2005</b>	<b>2006</b>
<b>Ladies' &amp; men's shoes</b>	14.093	15.067	15.509	15.394	16.089	16.906
<b>Ladies' &amp; men's ready-to-wear</b>	12.687	9.836	11.73	13.123	14.206	17.193
<b>Jewellery</b>	5.433	7.526	10.7	12.241	9.607	8.983
<b>Watches</b>	31.054	33.722	27.312	26.043	20.985	25.219
<b>Eyewear</b>	0.741	0.639	0.469	0.399	0.544	0.939
<b>Other products</b>	27.365	27.185	31.242	33.746	36.241	43.572
<b>Total</b>	91.374	93.976	96.962	101.125	97.672	112.811

10) He also provides the following advertising expenditure in the UK:

<b>£ sterling</b>	<b>2004</b>	<b>2005</b>	<b>2006</b>
<b>Fashion</b>	896,986	1,197,532	1,281,599
<b>Eyewear</b>	376,982	301,322	321,077
<b>Jewellery</b>	131,358	252,384	413,528
<b>Timepieces</b>	363,160	317,547	280,060
<b>Total</b>	1,768,486	2,068,785	2,296,264

11) GUCCI products are advertised and reported in national publications and newspapers in the UK including all major fashion magazines such as Vogue, Tatler and Elle. Mr Volpi supports this by providing copies of advertisements and reports at Exhibit VV-4. The first of these is a report that appeared in the Financial Times on 4 June 2007, and describes GUCCI as being "one of luxury's most valuable brands" and described the Gucci group as "being one of the three largest luxury conglomerates in the world" and that GUCCI is "the star brand of the group". The second is an article that appeared in the Sunday Times on 15 July 2007. This article records that, in 2006, sales exceeded £1.5 billion for the first time. The inference is that this figure relates to worldwide sales. The other extracts are of advertisements for jewellery, clothes and bags, glasses and sunglasses that appeared in the magazines Tatler (two examples, both with indiscernible dates), Harpers Bazaar (one date indiscernible, another dated April 2007), Arena (dated April 2007), Marie Claire (two examples, both with the date indiscernible), GQ (date indiscernible), Elle (dated October 2007). Mr Volpi does not comment on whether these advertisements relate to the relevant period.

## **Applicant's Evidence**

12) This takes the form of two witness statement by Mr Hussain. In the first of these, dated 11 April 2008, he states that his company has a reputation in the mark DUCCIO extending back seven years in respect of clothing and fashion items. He provides numerous exhibits to support this statement. He states that there is no evidence of confusion between the respective marks.

13) The second witness statement is dated 24 February 2009. This also has the words "amended witness statement 13<sup>th</sup> April 2009" typed upon it. It is not clear to me what amendments this refers to, but I have taken note of the contents before me. Mr Hussain asks for consideration of thirteen further exhibits that relate, firstly, to alleged negligent behaviour of his previous representative and secondly, to support his statement that he has used the mark DUCCIO for seven years.

14) Mr Hussain also makes a number of submissions that I will refer to, as appropriate, later in my decision.

## **Opponent's Evidence in reply**

15) This is in the form of a further witness statement by Mr Volpi and is filed in response to Mr Hussain's evidence of 11 April 2008. He states the view of Gucci that it seriously doubts that Mr Hussain has made genuine use of the mark DUCCIO and he states further, that none of the evidence filed by Mr Hussain collaborates this "bold assertion".

16) In response to Mr Hussain's point there there is no evidence of confusion, Mr Volpi provides further evidence in an attempt to illustrate that use of DUCCIO would result in the marks being linked by the consumer. At Exhibit VV-6, Mr Volpi provides further evidence of the strength of the GUCCI brand. This is a copy of a report and accompanying press release by a company called Neilson. The report states that Neilson Company is a global information and media company and is dated April 2008. The press release notes that the report, entitled "Consumer and Designer Brands", concluded that "Gucci...is the world's most coveted luxury brand" and "...one in five global consumers said they would choose to buy Gucci (over any other luxury brand) if money was no option [sic]".

17) Exhibit VV-7 is a copy of a French language decision issued by OHIM, the European trade mark office. Mr Volpi has provided an English translation. The decision appears to relate to an opposition by Gucci to a third party's Community trade mark application. The decision notes that "it emerges [from a study of the evidence] with the greatest clarity, that the earlier trade mark "GUCCI" does in fact enjoy considerable renown in various countries within the Community, and in particular in....Great Britain..."

18) To further support his view that Gucci enjoys significant goodwill and that use of DUCCIO would result in the marks being linked by the consumer, at Exhibit VV-8, Mr Volpi provides undated screenshots of pages of the GUCCI website illustrating the mark being used in respect of sunglasses, jewellery, watches, hats, footwear, key fobs and also clothing that is indicated as belonging to Gucci's Fall/Winter collection 2008.

19) Finally, Mr Volpi identifies many goods, such as products for motorcyclists and cyclists, jock straps and flip flops, that are the subject of Mr Hussain's application. He states that Gucci would probably never affix the mark GUCCI to such goods, as to do so would downgrade the cache and aspirational nature of the brand. Use of DUCCIO on such goods would have a serious and damaging affect on the integrity and value of the GUCCI brand.

20) Mr Volpi also makes a number of further submissions that I will refer to, as appropriate, later.

## **DECISION**

### **The Hearing**

21) Mr Hussain made reference to, and annexed to his skeleton argument, a copy of a without prejudice letter from Gucci. At the hearing, I explained to Mr Hussain that such documents had no place at the hearing because the author of such a document should be free to explore negotiations and a settlement without running the risk that the papers will be put forward in relation to the relative strengths and weaknesses of their case. Nevertheless, Mr Malynicz informed me that Gucci were content to proceed and, as he requested, I can confirm that the contents of this document or Mr Hussain's comments on this issue will have no bearing upon my considerations in these proceedings.

### **Section 5(2) (b)**

22) Section 5(2) (b) reads:

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

(a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”



23) An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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.”

24) Of potential relevance to a ground of opposition under Section 5(2) (and Section 5(3)) are the provisions that relate to proof of use. These state that the applicant shall not be refused registration because of an earlier trade mark unless the use conditions are met. These use conditions require the proprietor of the earlier trade mark, where requested, to provide proof of use where the registration date of the earlier right is more than five years before the publication date of the application at issue.

25) Gucci relies upon two earlier marks (plus two more in respect of the Section 5(3) grounds). All qualify as earlier marks as defined by Section 6 of the Act. All have completed registration procedures that predate, by more than five years, the publication of Mr Hussain’s trade mark (the relevant date). However, as I have already noted, Mr Hussain has not put Gucci to proof of use and, as such, I do not need to explore the issue in respect to the earlier rights. I will therefore consider the likelihood of confusion based upon the relevant goods as I identified in paragraph 3. Such relevant goods correspond to Gucci’s statement of use in its Notice of Opposition.

26) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between

marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(I) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

### ***The average consumer***

27) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue. The goods covered by the respective specifications cover a wide range of goods, most of which appear to be targeted at the general public. The average consumer will, therefore, be a member of the general public. Whilst I acknowledge the potential for price variations between the various goods, none will involve the highest degree of consideration at the point of purchase. I therefore find that it is the reasonably observant and circumspect average consumer (see *Lloyd Schuhfabrik Meyer & Co, GmmbH v. Klijsen Handel B.V.* paragraph 27) that will be the one to consider in these proceedings.

28) In respect of the purchasing act itself, most of the respective goods will be self- selected from a shelf, online, or from a catalogue, so making the act predominantly a visual one. This is certainly the case in respect of clothing (*New Look Ltd. V. OHIM* Joined cases T-117/03 to T-119/03 and T-171/03). This means that, potentially, any degree of visual similarity/dissimilarity may play a more significant role in the assessment of a likelihood of confusion than oral similarity/dissimilarity.

Other goods may have slightly different considerations, for example, a watch may be selected from a shelf or it may be located behind a counter so requiring an oral request. Here the visual and oral aspects or similarity/dissimilarity will have an equal role to play.

### ***Comparison of goods***

29) In assessing the similarity of goods, it is necessary to apply the approach advocated by case law and all relevant factors relating to the respective goods and services should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23:

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

30) Other factors may also be taken into account as identified in *British Sugar Plc v James Robertson & Sons Limited (TREAT)* [1996] R.P.C. 281, such as the trade channels of the goods concerned.

31) In considering my analysis of the goods, I am mindful of the Courts comments in *Canon Kabushiki Kaisha v MGM Inc* Case C-39/97 [1999] RPC 117 at para. 22 where it states:

“It is however important to stress that....., even where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods and services covered.....”

32) In these proceedings, I do not have the benefit of evidence from either party on this matter and neither do I have submissions on the issue beyond Mr Hussain’s comment that the scope of his specifications goes wider than those of Gucci’s earlier registrations. Nevertheless, I am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary and the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public. I will proceed on this basis.

### **Mr Hussain’s Class 9 goods**

33) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05, at paragraph 29, the Court of First Instance (CFI) stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark. Bearing this in mind, it is self evident that [*optical apparatus; sunglasses, spectacles* are identical to Gucci’s *spectacle glasses and sunglasses*. Further, Mr Hussain’s *frames for sunglasses and spectacles* are identical to Gucci’s *spectacle frames* or, in the case of *frames for sunglasses*, if not identical to *spectacle frames*, they are the highest end of similarity.

34) In respect of *cases for sunglasses and spectacles*, these are different in nature to *sunglasses and spectacles* themselves, one being a container for the other. As such, their uses are also different in that one is for improving or protecting the wearers’ eyes, the other is for transporting its contents safely. Nevertheless, there will be some overlap in terms of trade channels, if only in that they will be sold in the same specialist outlets or in close proximity in larger, less specialist, outlets. Spectacles and sunglasses are also complementary to the

respective cases in the sense that they are indispensable or important for the use of the other in such a way that customers may think that the responsibility for the production of those goods lies with the same undertaking: *Sergio Rossi SpA v OHIM (SISSI ROSSI)*, Case T-169/03. It is, therefore, self evident that there is a reasonable level of similarity between these respective goods.

35) In respect of Mr Hussain's *crash helmets, crash helmets for cyclists and crash helmets for motorcyclists and helmet cases of leather specifically adapted to contain helmets* it is not obvious that there is any similarity with any of Gucci's goods. The highpoint of Gucci's case may be that they are a form of outer-clothing or containers for such. However, their intended purpose is that of protection from injury as opposed to merely covering the body, and their nature is that of a hard, protective covering as opposed to soft fabric or other soft material. The users will therefore be limited to motorcycle riders who will purchase them from specialist outlets. There is no obvious complementarity in the sense expressed by the court in *SISSI ROSSI*. As such, I find there is no similarity between these goods and any of Gucci's goods.

36) Finally, I turn to consider Mr Hussain's *articles of leather clothing for protection against accident or injury, articles of clothing, footwear and headgear for protection against accident or injury; articles of leather clothing for wear by cyclists and motorcyclists for protection against accident or injury, leather belt kidney protectors for motorcyclists for prevention of accident or injury parts and fittings for the aforesaid goods*. These can all be described as clothing, and in that respect are similar in their nature to Gucci's outer-clothing, but to some extent, they have different purposes, as Mr Hussain's goods are designed to protect against injury as well as to wear. It follows that their intended purposes will also be different. Similarly, as with crash helmets, protective clothing is sold through specialist retail outlets whereas fashion clothing is available in more general retail outlets. There is no obvious complementarity. Taking all these factors into account I find that they are similar, but only to a lowish degree.

#### **Mr Hussain's Class 14 goods**

37) In this ground of opposition, Gucci has not relied upon its registration no. 1108182 in respect of Class 14 goods. As such, it must rely upon its Class 9 and/or Class 25 goods being considered similar to Mr Hussain's Class 14 goods. In this respect, there is nothing that is self-evidently similar to Gucci's goods. Mr Hussain's goods can be paraphrased as being jewellery, goods for making jewellery, watches, clocks and stopwatches, key fobs, key rings and candlesticks. All these goods have a different nature to either spectacles or clothing, their purpose is different and as such they have different users. Trade channels are different as the manufacture of these goods requires different skills and equipment when compared to the manufacture of clothing and spectacles. They are sold from different retail outlets and even where they may occur in the same outlet, for example, a department store, they will appear in different

locations within the store. Finally, there is no complementarity in the sense expressed in *SERGIO ROSSI*. As such, I find there is no similarity.

### **Mr Hussain's Class 25 goods**

38) Gucci claims use in respect of [*a*]rticles of outer-clothing; knitted articles of clothing; shirts; T-shirts, skirts, blouses, scarves, cravats, hats; ties, socks, belts; boots, shoes and slippers. Some of Mr Hussain's are self evidently identical to Gucci's goods as the respective specifications include identical terms. Further, it is well established that goods can be considered identical when those covered by an earlier mark are included in a wider term of a later mark (and vice versa); see *G rard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T- 133/05*. It follows that many other of Mr Hussain's goods are identical in the sense that they are covered by the term *articles of outer-clothing* in Gucci's specification. Therefore, I find that the following list of Mr Hussain's goods are identical to Gucci's goods:

*Clothing, footwear, headgear; caps being headwear; jackets; jackets of leather, gilets of leather, waistcoats of leather, trousers of leather, shirts of leather; shorts of leather, skirts of leather, blousons of leather, mini skirts of leather, overcoats of leather, coats of leather, hats of leather, caps of leather, gloves of leather, aprons of leather; jackets of denim, gilets of denim, waistcoats of denim, trousers of denim, shirts of denim; shorts of denim, skirts of denim, blousons of denim, mini skirts of denim, overcoats of denim, coats of denim, hats of denim, caps of denim, gloves of denim, aprons of denim; knitwear; mittens; neckties; pullovers; scarves; shirts; ski hats; slippers; socks; sports jerseys; tee-shirts; gilets, jackets, overcoats, coats, jerseys, jumpers, tops, sweaters, cardigans, pullovers, ponchos, scarves, shawls, mufflers, pashminas, wraparounds, wraps, gloves, tankinis, tops, beachwear, sarongs, leisure wear, blouses, shorts, shirts; jeans, denim jackets, denim trousers, ties, lounge suits, waist coats, trousers, dressing gowns, bath robes, beach robes, articles of beachwear, beach clothing, beach dresses, beach shorts, beach wraps, sportswear, boxer's shorts and vests, sports pants, sports shorts, sports t-shirts, sports crop-tops, sports vests, trackpants, track suits, jogging suits, warm-up suits, running shorts, running vests, running tops, running pants; bicycling shorts, soccer shirts, soccer shorts, soccer socks, football shirts, football shorts and football socks, rugby shirts, rugby shorts and rugby socks, sweat shirts, hooded tops; footwear, shoes, boots, trainers, flip-flops, sandals, Wellington boots, beach shoes, shoes for windsurfing and water sports; headgear, woolly hats, caps, bobble hats, ski hats, baseball caps, cricket hats, sunhats, sun-visors, swimming caps; parts and fittings for all the aforesaid goods.*

39) Mr Hussain's specification also includes the terms *boxer shorts; camisoles, swimwear; underclothing, swimming costumes, one piece swimming costumes,*

*bikini, swimming costumes, bodyshapers, corsetry, thongs, pants, bras, bodyshapers, articles of lingerie, articles of underwear, boxer's shorts and vests, sports bras, sports panties, sports briefs, and jock straps, swimming caps.* These goods are either underwear or swimwear. Clearly, underwear cannot be covered by the term articles of outer-clothing, or by any of the specific terms in Gucci's specification. Similarly, as swim wear is self evidently worn against the skin, such goods are akin to underwear (although, they are for a different purpose) and would not be categorised as outer-wear. Having concluded this, it is none the less self evident that all these goods are similar in nature to Gucci's goods, being items of clothing that may be made from the same fabrics as outer-clothing. They are all worn as either functional fashion items and therefore share the same intended purpose as outer-clothing. Their trade channels are likely to be the same taking account of the fact that they are manufactured in the same way as outer-clothing and can be sold through the same general clothing retail outlets. They therefore share a high level of similarity.

40) In respect to Mr Hussain's *swimming suits being wetsuits, wet suits for surface water-sports, wetsuits for surfing; wet suits for water-skiing; wet suits for windsurfing; dry suits*, these are all specialist types of apparel designed for water sports, made from specialist materials and for the purpose of keeping the wearer warm during these specialist activities. They are also usually sold in stores specialising in sports articles and where they may be purchased from larger retail outlets, they are displayed in a different part of the store to outer-clothing. As such, I find that there is only a low level of similarity between these goods and Gucci's goods.

41) Finally, Mr Hussain's specification also covers *parts and fittings for all the aforesaid goods*. It is not clear what such parts and fitting may be, but it is self evident that they are not identical to the clothing and footwear itself. Without knowing what such parts and fitting may be, I am unable to make a finding regarding the level of similarity between these and Gucci's goods, but as Gucci's best case lies with where I have found identical goods to be involved, I will go on to consider its case from this position.

**Comparison of marks**

42) For ease of reference, the respective marks are:

<b>Gucci's earlier marks</b>	<b>Mr Hussain's mark</b>
GUCCI	DUCCIO

43) When assessing the extent of similarity, if any, between the respective marks, I must do so with reference to their visual, aural and conceptual similarities bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). Beginning with the visual comparison, both marks are in ordinary typeface and share the same four letters "UCCI". In the earlier marks,

these four letters are preceded by the letter “G” to make a five letter word. In Mr Hussain’s mark, these letters are preceded by the letter “D” and followed by the letter “O” to make a six letter word. The different first and last letter in Mr Hussain’s mark puts some distance between his and Gucci’s marks. Taking these similarities and differences together, I find that the respective marks share some, but not a high level, of similarity.

44) From an aural perspective, the earlier marks will be pronounced with a “hard” G and as GOO-CHEE. On the other hand, Mr Hussain’s mark will be pronounced as DOO-CHEE-O. As such, the marks are similar to the extent that they share the syllable pronounced CHEE. There is also some similarity between the respective first syllables, pronounced GOO and DOO. Mr Malynicz also argued at the hearing that the letter “O” at the end of DUCCIO is likely to be lost, pointing to how English speakers tend to slur the endings of words. I am not persuaded on this point. Mr Malynicz’s argument may hold good where the ending of a word forms part of a syllable with earlier elements in the mark, for example if Mr Hussain’s mark was DUCCIES, I could accept that the addition of the “ES” may be somewhat lost in pronunciation. But in the current case, the letter “O” in DUCCIO forms a distinct syllable that requires deliberate pronunciation and serves as a distinct aural difference when comparing the respective marks. When taking account of these similarities and differences, I find that, to a large extent, the differences override the similarities and that the respective marks only share a low level of aural similarity.

45) In respect of the conceptual similarity, Mr Malynicz contended that the respective marks are similar insofar as they are both Italianate names. Even if I accept this point, it only identifies similarity at a very low level of generality. Names, Italian or otherwise, serve the function of differentiating individuals and as such, consumers are used to perceiving small differences in names in a way that differentiates between them. Therefore, insofar that there may be any conceptual similarity this is only at the most general of levels and does not improve Gucci’s case in these proceedings.

46) In summary, taking the above findings into account, I find that the marks share only a low level of similarity.

***Distinctive character of the earlier trade mark***

47) Mr Malynicz contends that Gucci’s mark consists of an Italianate name and this is borne out in Gucci’s full company name that refers to the individual Guccio Gucci. As a surname, it does not benefit from the highest level of inherent distinctive character, such that a made up word may enjoy. Nevertheless, it does possess a level of distinctiveness that is above average when viewed by the relevant UK consumer, given that it is not a common surname.



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

“The global assessment of the likelihood of confusion must therefore be based on all the circumstances. These include an assessment of the distinctive character of the earlier mark. When the mark has been used on a significant scale that distinctiveness will depend upon a combination of its inherent nature and its factual distinctiveness. I do not detect in the principles established by the European Court of Justice any intention to limit the assessment of distinctiveness acquired through use to those marks which have become household names. Accordingly, I believe the observations of Mr. Thorley Q.C in *DUONEBS* should not be seen as of general application irrespective of the circumstances of the case. The recognition of the earlier trade mark in the market is one of the factors which must be taken into account in making the overall global assessment of the likelihood of confusion...”

49) In this respect, Gucci argue strongly that its mark enjoys a significantly enhanced reputation in the UK by virtue of use extending back to the 1960s and its position as one of the world’s leading luxury goods brands. It is clear from the evidence that it does enjoy a significant enhanced distinctive character that results from its longstanding use and reputation in the UK. Mr Malynicz reminded me that marks with a high level of distinctive character enjoy a greater penumbra of protection. I will bear this in mind when I consider whether there exists a likelihood of confusion.

### ***Likelihood of confusion***

50) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

51) I have found that the respective marks share some visual similarity, low aural similarity and conceptual similarity only at the most general level. I also found that some of the respective goods were identical, while others were only similar and in some cases dissimilar. At the hearing, Mr Malynicz reminded me of Ms Amanda Michael’s comments, whilst sitting as the Appointed Person in *Technica Trade Mark* BL O-131-09, where she commented that one should not treat Simon Thorley QC’s comments on the purchasing act, in respect of clothing, in *React Trade Mark* [2000] R.P.C. 285 as laying down a rule giving such importance to the purely visual aspect of a mark used on clothing so as to ignore the other relevant factors. To this end, I remain mindful of my finding in respect of both the aural and conceptual similarities and differences also.

52) I therefore take all of the above into account, including the facts that the consumer relies upon imperfect recollection and the enhanced level of distinctive character enjoyed by the mark GUCCI. Nevertheless, even taking account of the enhanced distinctive character of the GUCCI mark, I find that the differences between the respective marks outweigh any similarity so that, even in respect of identical goods, the consumer would not confuse the marks in the sense that one mark will be mistaken for the other (“direct confusion”). Further, I also find that the differences are such that the consumer would not believe that goods provided under the respective marks originate from the same trade source (“indirect confusion”).

53) In summary, therefore, as there is no confusion between the respective marks, Gucci’s opposition fails in respect of its grounds based upon Section 5(2) (b) of the Act.

### **Section 5(3)**

54) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

(a) 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 or international trade mark (EC), 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.”

55) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA) [2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited and Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42.

56) The applicable legal principles arising from these cases are as follows:

a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122).

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

d) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

57) To these, I would also add the following legal principles that have arisen from the recent ECJ judgement in *Intel Corporation Inc. v CPM United Kingdom Ltd (INTEL) C-252/07*:

a) Whether there is a link, within the meaning of *Adidas-Salomon and Adidas Benelux*, between the earlier trade mark with a reputation and the later trade mark must be assessed globally, taking into account all factors relevant to the circumstances of the case.

b) The fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark calls the earlier mark with a reputation to mind is tantamount to the existence of such a link between the conflicting trade marks, within the meaning of *Adidas-Salomon and Adidas Benelux*.

c) Whether use of the later trade mark takes or would take unfair advantage of, or is or would be detrimental to, the distinctive character or the repute of the earlier mark, must be assessed globally, taking into account all factors relevant to the circumstances of the case.

d) The use of the later mark may be detrimental to the distinctive character of the earlier mark with a reputation even if that mark is not unique; a first use of the later mark may suffice to be detrimental to the distinctive

character of the earlier mark; proof that the use of the later mark is or would be detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future.

### **Reputation**

58) The evidence leaves me in little doubt that there is a strong reputation enjoyed by the mark GUCCI in respect of luxury goods. Evidence of this includes the Financial Times describing GUCCI as being “one of luxury’s most valuable brands” and describing the Gucci group as “being one of the three largest luxury conglomerates in the world” and where GUCCI is “the star brand of the group”. However, it is less clear precisely what goods this reputation extends to in the UK. There are exhibits that demonstrate use in respect of articles of outer-clothing and there is also corresponding turnover in the UK during the relevant period ranging between €25 million to €34 million. As such, at the very least, I accept that there is a reputation in respect of the mark GUCCI in respect of these goods. These are identical to many of Mr Hussain’s goods. As Gucci’s best case lies with its goods that are identical, I will not go on to identify the full range of goods in which Gucci has demonstrated a reputation, but rather I will limit my considerations to Gucci’s best case. If it cannot succeed here, it follows that it cannot succeed in respect of any wider list of goods.

### **The Link**

59) Having established the existence and scope of a reputation, I need to go on to consider the existence of the necessary link. I am mindful of the recent comments of the ECJ in *INTEL* that it is sufficient for the later trade mark to bring the earlier trade mark with a reputation to mind for the link, within the meaning of *Adidas-Salomon and Adidas Benelux*, to be established. The ECJ also set out the factors to take into account when considering if the necessary link exists:

“41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case (see, in respect of Article 5(2) of the Directive, *Adidas-Salomon and Adidas Benelux*, paragraph 30, and *Adidas and Adidas Benelux*, paragraph 42).

42. Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;

- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public.”

60) I have already found that the respective marks share only a low level of similarity. Whilst they share the four letters “UCCI”, Mr Hussain’s mark begins with a different letter and has the additional letter “O” at the end. These differences have the effect of giving both marks their own distinct identities with GUCCI being seen as an Italianate name. DUCGIO also will be seen as an Italianate name, but a distinctly different one. As I have already said, names serve the function of differentiating individuals and, as such, consumers are used to perceiving small differences in names in a way that differentiates between them. Here, taking the marks as a whole, I do not find the differences to be small.

61) I have already concluded that GUCCI enjoys a strong reputation in respect to luxury goods and that this results in the mark enjoying an enhanced level of distinctive character in the UK. Nevertheless, even taking this into account, I still found that there was no likelihood of confusion.

62) Taking all these factors into account, I find that the mark DUCGIO will not be linked to GUCCI by the relevant consumer. The differences are such that it does not bring the GUCCI mark to mind.

63) In light of these finding, it follows that as no link has been established, there can be no detriment to the distinctive character or repute of Gucci’s marks nor can there be any unfair advantage to its distinctive character or repute. As such, Gucci’s opposition based upon Section 5(3) of the Act also fails.

## **COSTS**

64) The opposition having failed, Mr Hussain is entitled to a contribution towards his costs. I take account of the fact that Mr Hussain was professionally represented in the proceedings up to the end of the formal evidence rounds, but that, after this time, he filed additional evidence himself and at the hearing he represented himself. It is Registry practice that where a party is unrepresented, they receive costs at fifty percent of what would otherwise have been rewarded. I therefore take this into account when considering the award insofar as it relates to preparation and attendance at the hearing itself.

65) I, therefore, award costs on the following basis:

Considering Notice of Opposition and statement	£200
Statement of case in reply	£300

Preparing and filing evidence	£400
Considering evidence	£200
Preparation for, and attendance at Hearing	£250
<b>TOTAL</b>	<b>£1350</b>

66) I order Guccio Gucci S.p.A. to pay Ishtiaq Hussain Esq. the sum of £1350. This 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 10<sup>th</sup> day of November 2009**

**Mark Bryant  
For the Registrar,  
the Comptroller-General**