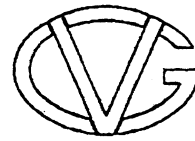


Application No. 14619 of 1996

IN THE MATTER of the Trade Marks  
Ordinance (Cap. 43)

AND

IN THE MATTER of an application by  
Florence Fashions (Jersey) Limited to  
register the mark



**GIOVANNI VALENTINO**

in Part A of the Register in Class 14

AND

IN THE MATTER of an opposition  
thereto by Valentino S.p.A.

**DECISION  
OF**

Ms. Fanny Shuk Fan Pang acting for the Registrar of Trade Marks after a hearing on  
1 and 2 June 2009.

Appearing : Mr Ling Chun Wai and Mr Gary Lam instructed by Messrs. Chan,  
Tang & Kwok for the applicant.

Mr Paul Carolan instructed by Messrs. Deacons for the opponent.

## **Application for Registration**

1. On 19 November 1996 (“the application date”), Florence Fashions (Jersey) Limited (“the applicant”) applied to register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 (“the Ordinance”), in Part A of the register in Class 14, the trade mark, a representation of which appears below :




**GIOVANNI VALENTINO**

(“the suit mark”).

2. The goods intended to be covered by the registration were “watches, jewellery; all included in Class 14” (“the specified goods”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part A of the register. The application was advertised in the Government of the Hong Kong Special Administrative Region Gazette on 22 November 2002.

## **Pleadings and evidence**

3. On 22 January 2003, Valentino Globe B.V. filed notice of opposition to the application. Valentino S.p.A. (“the opponent”) was granted leave to substitute as the opponent on 19 February 2005. The grounds of opposition state that the opponent is a corporation organized and existing under the laws of the Kingdom of the Netherlands. The opponent is the proprietor of the housemark “VALENTINO” and associated trade variations such as “VALENTINO GARAVANI”, “VALENTINO COUTURE” and the device “ ” and so on (“the opponent’s marks”). The opponent uses the opponent’s marks extensively in various jurisdictions worldwide including Hong Kong in respect of prestigious luxury goods including, *inter alia*, clothing, footwear, headgear, knitwear, polo shirts and T-shirts, sweaters, blouses, raincoats, outer clothing, trousers, top coats, sports wear, swimwear, ties, gloves, scarves, hosiery, shoes, boots, slippers, sports shoes; leather and imitations of leather,

animal skin, hides, leather goods, leather accessories, trunks, travelling bags, belts, bags, purses, handbags, wallets, attaché cases, brief cases, card cases, pocket wallets, umbrellas, parasols, walking sticks, whips, harness, saddlery; soaps, perfumery and cosmetic products; optical apparatus and instruments, spectacles and sunglasses and their parts and fittings; precious metals and their alloys and goods in precious metals or coated therewith, gold and silverware; jewellery, costume jewellery, precious stones, horological and chronometric apparatus and instruments and parts and fittings therefor; fashion accessories, smokers' articles, textiles, towels, bed and table covers, bathroom and other ceramic tiles, furniture, glassware, porcelain, wallpaper, and other luxury products and accessories.

4. The opponent claims that it is the proprietor of a number of trade marks registered in various classes including 3, 5, 9, 12, 14, 16, 18, 19, 20, 21, 24, 25, 26, 27, 30 and 34 in Hong Kong, details of which are set out in the grounds of opposition. The housemark "VALENTINO" was first used in 1959 by the designer Valentino Garavani and then by the opponent in 1969. The opponent first used this mark in Hong Kong in as early as 1980. The opponent avers that it has achieved widespread and substantial sales of its products under the opponent's marks worldwide. By reason of the opponent's long and extensive use and promotion of the opponent's marks, the opponent's marks (either alone or in conjunction with the opponent's other registered and unregistered trade marks) obtain instant recognition by members of the public within Hong Kong as unique to identify the opponent's goods.

5. The opponent asserts that the word "VALENTINO" in the suit mark is identical to the opponent's housemark. Coupled with the "GV logo", the suit mark is very similar to the opponent's marks. Potential and current retail customers of the applicant's goods are likely to be misled into thinking or perceiving that the applicant's goods are associated or connected in the course of trade with the opponent and the opponent's goods. The likelihood of confusion between the applicant's goods bearing the suit mark and the opponent's goods bearing the opponent's marks is substantial. The grounds of opposition comprise sections 2, 9, 10, 12(1), 13(1), 13(2), 20 and 23 of the Ordinance.

6. In the counter-statement, save and except that the opponent's and applicant's incorporation status and the applicant's own application for registration of the suit mark are admitted, the applicant either denies or avers that it has no knowledge of the remaining allegations in the grounds of opposition and the opponent

is put to strict proof thereof.

7. Trade Marks Rules, Cap. 43, Sub. Leg. (“Rule/s”) 25 evidence consists of a statutory declaration from Michele Norsa, the managing director of the opponent, together with exhibits, which was declared on 22 November 2004 (“Norsa’s first statutory declaration”) and another statutory declaration by the same Michele Norsa just to rectify a clerical error in relation to “Exhibit 28” to her first statutory declaration made on 8 February 2005. Under Rule 26, the applicant filed a statutory declaration of Annabella Immacolata Norris, the sales manager of the applicant, together with exhibits, which was declared on 22 January 2007. Under Rule 27, the opponent filed a statutory declaration in reply declared by Antonella Andrioli, the legal counsel of the opponent, together with exhibits, on 13 November 2008. Under Rule 28, leave was granted to the opponent to file a statutory declaration from the same Antonella Andrioli declared on 26 May 2009 to clarify that the annual sales figures given in paragraph 11 of Norsa’s first statutory declaration should be the worldwide sales figures, not the Hong Kong sales figures.

### **Decision**

8. Though, by 1 and 2 June 2009, the dates the matter was heard, the Trade Marks Ordinance Cap. 559 had come into operation, by virtue of section 10(1) and (2) of Schedule 5, oppositions to registrations still pending as of 4 April 2003 are to be determined under the provisions of the repealed Ordinance, Cap. 43.

9. Although a number of grounds were pleaded in the grounds of opposition, Mr Carolan for the opponent indicated at the hearing that the opposition is based primarily on section 20 of the Ordinance and section 12(1) is also relied on.



#### Under section 20(1)

10. At the application date, section 20(1) of the Ordinance, insofar as it relates to goods, provided :

“(1) Except as provided by section 22, no trade mark relating to goods shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a trade mark belonging to a different proprietor and already on the register in respect of –

- (a) the same goods;
- (b) the same description of goods; or
- (c) services or a description of services which are associated with those goods or goods of that description.”

11. The following registered marks are relied on by the opponent in mounting the opposition under section 20(1) :

| Trade Mark  | Registration No. | Date of Registration | Class                  | Goods   |
|---|------------------|----------------------|------------------------|---|
| VALENTINO GARAVANI<br>(Registration of this trade mark shall give no right to the exclusive use of the word “VALENTINO”)  | B3408AA of 1989  | 25.2.1987            | 14<br><br>16<br><br>34 | lighters other than cigarette lighters of precious metals or coated therewith<br><br>pens and writing instruments<br><br>lighters for smokers |
| valentino<br>  | 8441 of 2001     | 5.3.1991             | 14                     | jewellery, watches  |
| <br>(Registration of this trade mark shall give no right to the exclusive use of the word “COUTURE”) | 604 of 2005      | 1.10.1992            | 14                     | watches, jewellery  |

12. Under section 20(1), the two issues for my determination are, whether the goods for which the suit mark is sought to be registered, the same goods or description of goods as those of the opponent’s registered marks; and if so whether the suit mark so nearly resembles the opponent’s registered marks as to be likely to

deceive or cause confusion.

13. Section 2(4) of the Ordinance, which is relevant to the definition of “nearly resembles”, provides a near resemblance of marks is a resemblance “so near as to be likely to deceive or cause confusion”.

*The opponent’s mark of registration no. B3408AA of 1989 – class 14*

14. For clarity sake, I would point out that the opponent’s mark of registration no. B3408AA of 1989 consists of originally three registrations of the same mark “VALENTINO GARAVANI” in three classes, namely 14, 16 and 34 which were merged under section 51 of the Trade Marks Ordinance Cap. 559 on 25 February 2008.

15. So far as the registration in relation to class 14 is concerned, I have to first consider whether the goods covered by the opponent’s registered mark “lighters other than cigarette lighters of precious metals or coated therewith” are goods of the same description as the specified goods which are “watches, jewellery”. Before dwelling on the issue, the very first matter that I have to ascertain is what exact goods are covered by the opponent’s registered mark in class 14. Mr Ling submitted that lighters of precious metals or coated therewith are excluded from the specification in class 14 by virtue of the wording “other than cigarette lighters of precious metals or coated therewith”. I do not agree with him.

16. The date of registration of the opponent’s registered mark is 25 February 1987. According to the 5<sup>th</sup> Edition of Nice Classification which was then in force, class 14 should include “mainly precious metals, goods in precious metals and, in general jewellery, clocks and watches”. Further, in the explanatory note to class 34, it is stated, inter alia, that “certain smokers’ articles in precious metal” should be in class 14 whereas smokers’ articles of non-precious metal should fall within class 34. In the circumstances, I consider that the exclusion in the specification of class 14 is in relation to “cigarette lighters” rather than “precious metals or coated therewith”. In other words, I take the view that the exact goods covered by class 14 are “lighters of precious metals or coated therewith but excluding cigarette lighters”.

17. Turning back to the first issue, I have to decide whether lighters of precious metals or coated therewith (excluding cigarette lighters) are goods of the

same description as watches and jewellery. The question whether goods are “of the same description” is one of fact. Although the suit mark and the opponent’s registered mark both fall within class 14, the question cannot be decided merely by reference to the internationally recognized class for registration of marks (see *Australian Wine Importer’s Trade Mark* 6 RPC 311).

18. Instead, various matters have to be taken into account according to the well recognized test promulgated by Romer J. in *Jellinek* (1946) 63 RPC 59. They include the nature and composition of the goods, the respective uses of the articles and the trade channels through which the commodities respectively are bought and sold. This test was approved by the House of Lords in *Daiquiri Rum Trade Marks* [1969] RPC 600 at page 620 with the caveat that there may, as business patterns change, be other relevant considerations. I shall deal with each of the various factors in turn.

*The nature and composition of the goods*

19. Mr Ling submitted that the specified goods of the applicant are items of adornment for decoration purpose whereas lighters are items of practical utility. To my mind, the nature of jewellery is that it is an item of personal ornamentation such as a bracelet, ring, necklace, or brooch which is made from precious metals, semi-precious metals or gemstones. A watch is a portable or wearable timepiece such as a wristwatch or a pocketwatch which is driven by a non-electric or electric mechanism with mechanical or quartz movements to measure the passage of time. A lighter is a small portable device for creating a flame to light a cigarette, cigar, or pipe. It always consists of a metal or plastic container filled with a flammable fluid or pressurized liquid gas as a means of ignition and some provision for extinguishing the flame. In view of the restriction in the specification of the opponent’s registered mark in class 14, we talk about lighters for lighting a cigar or pipe which are made of precious metals or coated therewith.

20. In the light of the aforesaid account of the nature and composition of the various goods under consideration, I do not find that lighters (excluding cigarette lighters) of precious metals or coated therewith are of similar nature or composition with watches and jewellery. I do not overlook that lighters for cigars or pipes in question are of precious metals or coated therewith in the sense that they may contain precious metals and/or with coatings of precious metals. That, however, does not

make them of the same or similar nature with jewellery. Many items can be made of or coated with precious metals such as vases, paintings or statues but none of them could be regarded as being of the same or similar nature as jewellery.

*The respective uses of the articles*

21. Mr Ling submitted that watches and jewellery are for personal adornment whereas lighters are for lighting up cigars or cigarettes. In my judgment, while I agree with Mr Ling that jewellery items are articles of personal adornment that are worn by a person to increase one's beauty or distinction, I do not share his submission that watches are such items as well. I am aware that apart from the time, modern watches often display the day, date, month and year and electronic watches may have many other functions. Some really expensive watches in the upper end are in fact more valued for their workmanship and aesthetic appeal than for timekeeping. Nevertheless, I am of the view that when considering the respective uses of the goods, it is the primary rather than the secondary use to which I should have regard. The primary use of watches is for timekeeping to provide the time of day, giving at least the hour and minute, and usually the second. As regards lighters, they are for lighting up cigars and pipes (cigarette lighters are excluded from the specification of the opponent's registered mark in class 14). It seems clear to me that all the three articles in question including watches, jewellery and lighters are of different uses.

*The trade channels through which the commodities respectively are bought and sold*

22. Mr Ling conceded at the hearing that the trade channels for the respective articles could be the same as there are shops that sell lighters and jewellery and may be watches as well.

23. I am able to find some legal authorities on the point. In *J. Lyons & Co Ltd's Application for Rectification* (1959) RPC 1920 at 127, it was decided that of the three characteristics referred to in *Jellink*, one, but not always the same one, may have greater significance or emphasis than the others in different cases. In *J.J. Colman Ltd's Application* (1929) 46 RPC 126, Eve J. found that even though mustard and semolina were sold side by side in the same shops and both could be properly treated as articles of food, both being used in cookery, their real nature was different.

24. Having carefully weighed all the factors including the differences in the

nature, composition and the use of the respective goods, I have come to the conclusion they are not the same description of goods.

25. As I have found that the opponent's goods covered by the registration in class 14 are not the same description of goods as those specified by the applicant, the opponent is not able to overcome the first limb of section 20 and there is therefore no need for me to consider whether the marks nearly resemble each other as to be likely to deceive or cause confusion.

*The opponent's mark of registration no. B3408AA of 1989 – class 16*

26. Moving on to the registration of the opponent's mark "VALENTINO GARAVANI" in class 16, similarly, the first question for my determination is whether the goods covered by the opponent's registered mark "pens and writing instruments" are goods of the same description as the specified goods which are "watches, jewellery". There is no need for me to repeat the legal principles above but I have to apply those legal principles to these two sets of goods once again to determine the issue. A pen is an implement for writing or drawing using ink such as ball point, roller ball and fountain pens. A writing instrument is an object used to produce writing. It is broader than pens in scope which could include not only pens but also chalk, pencils or brushes for Chinese writing. Speaking for myself, I do not consider that the nature and composition of pens and writing instruments are the same or similar to those of watches and jewellery. It goes without saying that the primary use of pens and writing instruments is for writing which is different from the use of watches and jewellery. With respect to trade channels, save and except that there may be an overlap of trade channels for those high end and luxury pens which are collectible items, the trade channels in the main should be different. You would not find or expect the same shop selling ordinary pens, pencils, chalk and brushes together with watches and jewellery. In sum, I do not feel myself able to find that pens and writing instruments on the one hand and watches and jewellery on the other hand are goods of the same description. It follows that the opponent is not able to reach the threshold for further determination of whether the marks are confusingly similar.

*The opponent's mark of registration no. B3408AA of 1989 – class 34*

27. The opponent's registered mark "VALENTINO GARAVANI" in class



34 covers “lighters for smokers”. The difference between the class 14 registration referred to above and the present one is that the lighters in class 14 are of precious metals or coated therewith but the lighters for smokers in class 34 are not. I think my reasoning in deciding that the respective goods are not of the same description in relation to the class 14 registration equally applies to the present registration and, in fact, with greater force as the lighters in class 34 are not made of precious metals or coated therewith. It follows that it is not necessary for me to proceed to consider whether the respective marks are confusingly similar as the opponent is not able to overcome the first limb of section 20(1).

*The opponent’s marks of registration nos. 8441 of 2001 and 604 of 2005 both in class 14*

28. To recap, under section 20(1), the first question for me is whether the goods for which the suit mark is sought to be registered, the same goods or description of goods as those of the opponent’s registered marks. So far as these two opponent’s registered marks are concerned, the answer to this question must be positive as the specifications of the opponent’s registered marks and the suit mark cover exactly the same goods namely, jewellery and watches. The opponent is therefore able to overcome the first limb of section 20(1).

29. It follows that the second issue for my determination is whether the suit mark so nearly resembles the opponent’s registered marks as to be likely to deceive or cause confusion.

30. The accepted test to be applied under section 20 of the Ordinance is that stated by Evershed J. in *Smith Hayden & Co.’s Application* [1946] 63 RPC 97. Adapted to the matter in hand, the test may be expressed as follows :

“Assuming user by the opponent of its marks “  ” and “  ” in a normal and fair manner for any of the goods covered by the registrations, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if the applicant also uses its mark



“ GIOVANNI VALENTINO ” normally and fairly in respect of any goods covered by its proposed registration?”


31. The onus is on the applicant to satisfy the Registrar that the trade mark applied for is not reasonably likely to deceive or cause confusion. In cases where the tribunal considers that there is doubt as to whether deception is likely the application should be refused (*Kerly’s Law of Trade Marks and Trade Names*, 12<sup>th</sup> edition, paragraph 17-03).

32. Before proceeding to the comparison of the marks, I have to mention that as stated in the table in paragraph 11 above, the opponent’s mark of registration no. 604 of 2005 in class 14 is subject to a disclaimer that there is no right to the exclusive use of the word “COUTURE”. In my judgment, a disclaimer does not affect the significance which a mark conveys to others when used in the course of trade. Disclaimers do not go into the market place and the public generally has no notice of them. Therefore, a matter which is disclaimed is not disregarded when questions of possible confusion or deception of the public are to be determined (*GRANADA Trade Mark* [1979] RPC 303 at 308). I would therefore determine the questions without having regard to the disclaimer.



Comparison between the suit mark GIOVANNI VALENTINO and the opponent’s mark of registration no. 8441 of 2001



33. Mr Ling submitted that aurally, the opponent’s mark “  ” is likely to be pronounced as “VALENTINO” whereas the full name “GIOVANNI VALENTINO” will be enunciated when referring to the suit mark. Visually, the reversed vertical juxtaposition of the logo and the word in the opponent’s mark leaves a fairly different impression from that of the mark applied for. Furthermore, in the suit mark, there are two words not just one.



34. As far as the device elements in the respective marks are concerned, Mr Ling contended that the suit mark is a skilful combination of the two letters “G-V” forming an oval, whereas the opponent’s mark is a letter “V” enclosed in an ellipse. Moreover, while the device in the opponent’s mark is represented in dark solid lines, the device in the suit mark is represented in blank lines like an outline. Visually and verbally, they may be identified as the “GV” device and “V” device respectively.

35. By way of counter-argument, Mr Carolan criticized that Mr Ling had undertaken a side by side comparison of the respective marks. Whilst the oval shape in the device of the suit mark may represent the letter “G”, it is not in the same shape that one normally writes the letter “G”. He argued that the letter “V” situated within the ovalised “G” is in fact very similar to the “V” logo in the opponent’s registered mark. The difference in the solid and blank lines of the devices is not sufficient to distinguish between the two. As the letter “V” is the centre piece which attracts the attention of the consumers, it is likely that the consumers will only recognise the device in the suit mark as a letter “V” within an oval shape.

36. In my judgment, it is not in dispute that both the suit mark and the opponent’s registered mark are composite marks. There may be differences in the parts of each mark, but it is important to consider the mode in which the parts are put together and to judge whether the dissimilarity of the part or parts is enough to make the whole dissimilar (*Kerly’s*, supra, paragraph 17-11).

37. Side by side comparison is not the test. In *Sadow (1914)* 31 RPC 1 96 at 205 it was said “the question is not whether if a person is looking at two trade marks side by side there would be a possibility of confusion; the question is whether the person who sees the proposed trade mark in the absence of the other trade mark, and in view only of his general recollection of what the nature of the other trade mark was, would be liable to be deceived and to think that the trade mark before him is the same as the other, of which he has a general recollection”.

38. Turning to the devices of the marks, I think that upon a closer look at the components of the device in the suit mark, one may recognize the ovalised “G” as the letter “G” and the whole device as a “GV” device especially when one associates the letter-like device with the initials of the words “Giovanni Valentino”. However, on first impression, as the letter “V” is the centre piece which attracts the attention of the consumers and the ovalised “G” is not in an ordinary format because of the stylized

representation, the device in the suit mark may be recalled as a letter “V” within an oval shape. As to the device of the opponent’s registered mark, undoubtedly, it will be recognized and memorized by the consumers as the letter “V”. On the one hand, I take the view that the device in the suit mark is similar to that of the opponent’s registered mark in the sense that they may both represent the letter “V”. On the other hand, I have not overlooked that the overall visual impact conveyed by the respective devices is somewhat different. I think that the similarity between the devices of the respective marks is a finely balanced consideration.

39. It is trite to say that words speak louder than devices. In the present case, the suit mark and the opponent’s mark comprise the words “GIOVANNI VALENTINO” and “VALENTINO” respectively.

40. Mr Carolan for the opponent has quoted an unreported decision of the Registrar in *DOMINIQUE ARPELS Trade Mark*, M.W. Fox, 21 April 1992 in his list of authorities. In this case, the applicant applied to register her own name “DOMINIQUE ARPELS” in respect of jewellery and watches. The opponent successfully opposed the application for registration on the basis of the use and registration of the mark “VAN CLEEF & ARPELS” under sections 12(1) and 20 of the Ordinance. It was decided the fact that the mark was the applicant’s name was irrelevant to considerations of the reasonable probability of deception and confusion between the marks under the sections which I agree. The Registrar had the following observations in deciding that the mark applied for and the opponent’s mark were similar, visually and phonetically : -

“The suit mark conveys the idea of an individual forenamed DOMINIQUE and surnamed ARPELS. DOMINIQUE is a forename, much as any other. I see no reason though why it should be omitted from the suit mark and I cannot agree with Mr Rogers that this has happened in the trade mark sense. DOMINIQUE however is subservient to the ARPELS part of the mark. ARPELS, a very unusual surname, is the dominant feature of the suit mark.

The opponent’s mark gives the impression of the surnames of two individuals, one VAN CLEEF and the other ARPELS linked together by an ampersand, an and. VAN CLEEF is a very unusual surname too.

Both marks are long marks, each having five syllables. DOMINIQUE is a

nine-letter forename. VAN CLEEF is an eight-letter surname, visually split into two parts.

The Parker-Knoll case shows the first name of a two-name mark is not necessarily the significant feature of the mark. The evidence shows there is an occasional tendency to abbreviate the Opponent's mark into VAN CLEEF alone or misspell ARPELS. To that extent, which must not be exaggerated, VAN CLEEF may have a slightly greater significance in the Opponent's mark. However because both VAN CLEEF and ARPELS are very unusual surnames I prefer Mr Rogers view that essentially VAN CLEEF does not outshine ARPELS and ARPELS does not outshine VAN CLEEF. ARPELS retains sufficient significance on its own account in the Opponent's mark to cause that mark to be recognized and remembered as much by ARPELS as by VAN CLEEF. Both VAN CLEEF and ARPELS, both names of two syllables, make an impression in the Opponent's mark and neither is likely to be forgotten even having regard to imperfection of memory.

Because ARPELS in the suit mark stands out so significantly both visually and phonetically and DOMINIQUE therein is an indistinctive, relatively common forename, I do not consider it appropriate in the particular circumstances of this case (following Parker-Knoll) to pay more regard to the parts of the marks that are not common to them both. ARPELS, the common part of both marks, is the significant feature of the suit mark and an equally (with VAN CLEEF) significant feature of the Opponent's mark."

41. I think the facts of the present case are distinguishable from those in *DOMINIQUE ARPELS*. First, the marks under comparison are composite marks, not merely word marks. The overall structure and arrangement of the two marks are different. The opponent's mark consists of a single word "VALENTINO" above a "V" device whereas the suit mark consists of a "V" or, less probably, a "GV" device above two words "GIOVANNI VALENTINO".

42. In the *DOMINIQUE ARPELS* case, the Registrar found the marks confusingly similar because he considered that the dominant feature in the applicant's mark being ARPELS is the same as one of the two significant features (VAN CLEEF and ARPELS) in the opponent's mark. The word "ARPELS" in the applicant's mark immediately stands out so significantly both visually and phonetically and is so unusual and distinctive that a viewer or hearer of it will be alerted to the probability of

a connection with VAN CLEEF & ARPELS or at least be caused to wonder whether or not that is so.

43. Turning back to the present case, the words “GIOVANNI VALENTINO” in the suit mark convey the idea of the name of an individual with “GIOVANNI” as the forename and “VALENTINO” as the surname. There is no reason or evidence suggesting that when the suit mark is put to normal and fair use, the whole personal name would be abbreviated to “VALENTINO” only. In fact, to my mind, as “VALENTINO” is a very common Italian name known to an average Hong Kong consumer, “GIOVANNI”, being a very uncommon and unusual name and occupying the frontal part of the whole name, is the significant or dominant feature of the word part of the suit mark which is memorable. “VALENTINO” would be outshined by “GIOVANNI”. Coupled with the reversed positioning of and the different visual impact conveyed by the respective devices in the suit mark and the opponent’s mark, on the whole, I do not find the suit mark and the opponent’s mark as composite marks similar visually.

44. Although I have found above that both the devices in the respective marks may be recalled as the letter “V” devices, I consider that the consumers are likely to refer to the marks by the words “GIOVANNI VALENTINO” or “VALENTINO” rather than by the devices in speech when they refer to or request for the parties’ goods. I consider that “GIOVANNI VALENTINO” and “VALENTINO” as a whole are not phonetically similar.

45. I conclude that the marks are not visually and phonetically similar.



*Comparison between the suit mark* GIOVANNI VALENTINO *and the opponent’s mark*



46. Both the suit mark and the opponent’s mark are composite marks. The device part in the present opponent’s mark is the same as that of the opponent’s mark of registration no. 8441 of 2001. By the same token, I find that, on the one hand, the device in the suit mark is similar to that of the opponent’s registered mark in the sense that they may both represent the letter “V”. On the other hand, it seems to me that the overall appearances of the respective devices are to a certain extent different.

47. Both the suit mark and the opponent's mark consist of two words being "GIOVANNI VALENTINO" in the suit mark and "VALENTINO COUTURE" in the opponent's mark. So far as the opponent's mark is concerned, "VALENTINO" is a commonly known Italian name in Hong Kong whereas "COUTURE" is a French word in origin but adopted in the English language meaning high fashion designing and dressmaking (*Collins English Dictionary*, the 3<sup>rd</sup> Edition). The opponent's mark denotes high fashion designing and dressmaking of "VALENTINO". As regards the suit mark, the connotation is that of a personal name with "GIOVANNI" as the forename and "VALENTINO" as the surname. To my mind, the marks are conceptually distinguishable.

48. Visually, as I have found above, although both the devices in the marks may be recalled as a "V" device, if not a "V" and "GV" device respectively, the look of the devices is different because of the different stylizations in presentation even if I take into account the principle of imperfect recollection. The word parts of the marks being "VALENTINO COUTURE" in two lines and "GIOVANNI VALENTINO" in one line also give distinct visual impressions. When the composite marks are considered as wholes, I find them not visually similar.

49. Phonetically, the oral references of "GIOVANNI VALENTINO" and "VALENTINO COUTURE" do not, in my view, resemble each other.

50. I have come to the conclusion that the marks are not conceptually, visually and phonetically similar.

#### *Overall conclusions*

51. As the goods of the parties overlap, it follows that the nature and kind of purchasers likely to buy the parties' goods are the same. They will be of reasonable intelligence. In view of the nature of jewellery and watches which can be expensive items, they can be expected to exercise something more than normal care and attention.

52. On page 176 of *Shanahan's Australian Law of Trade Marks and Passing Off*, the second edition, the author quoted the case of *Con-Star Industries (Aust.) Pty. Ltd v Consortium Mediterranean de Parfumeire* (1984) AIPC 93-214, whereby the Australian Registry held that purchasers of perfumery and cosmetics, being

accustomed to the use of personal names for such goods, would not confuse “Louise” and “Louis-Philippe”. Similarly, I believe that purchasers of jewellery and watches are also accustomed to the use of personal names as trade marks for such goods. This is a factor which helps to reduce the likelihood of confusion.

53. Having taken into account the differences between the marks and all the circumstances of the trade, I consider that a substantial number of purchasers of the specified goods, with a passing familiarity with the opponent’s marks of registration nos. 8441 of 2001 and 604 of 2005, would not be reasonably likely, upon seeing the suit mark applied to the specified goods, to be caused to wonder whether both come from the same source. It follows that there is no tangible risk of deception or confusion among the consumers. I therefore find that the applicant has discharged its onus to satisfy me that there is no reasonable likelihood of deception or confusion if the suit mark is to proceed to registration. I accordingly find that the opposition under section 20(1) of the Ordinance fails.


Under section 12(1)

54. Section 12(1) of the Ordinance provides that it shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would be likely to deceive.

55. Mr Carolan submitted at the hearing that the section 12(1) ground of opposition is pleaded and made out on the evidence by the opponent. However, he said he did not wish to make submissions on that ground of objection as a separate ground from the primary objection under section 20. He submitted that the comparison exercise to establish whether there is confusing similarity between the marks is, according to the legal authorities, the same under both sections 12(1) and 20. Since the opponent has the benefit of prior conflicting registrations in the present proceedings, he said either the opponent succeeds under section 20 or if it does not, it would not have succeeded under section 12(1) any way even assuming that it is able to establish reputation of its marks under section 12(1).

56. I would look at the opponent’s evidence and see what marks were used by the opponent in Hong Kong before the application date. According to paragraph 5 of Norsa’s first statutory declaration, the opponent is in the business of manufacturing, marketing and distributing a wide range of high quality fashion

products including but not limited to clothing, footwear, headgear, sunglasses, spectacles and optical products, perfumeries, cosmetic products, skincare preparations, leather goods, leather accessories, belts, bags, umbrellas, precious jewellery, custom [sic] jewellery, watches, fashion accessories, smokers' articles, textiles, towels, bed and table covers, bathroom and other ceramic tiles, furniture, glassware, porcelain, wallpaper, and other luxury products and accessories ("the opponent's goods"). She says that the products bearing the trade mark "VALENTINO" and trade variations were designed by the famous designer Mr Valentino Garavani (known throughout the world by his forename "Valentino"). However, the term "trade variations" is never defined in the grounds of opposition or the statutory declaration save and except there is a list of Hong Kong registrations of the mark "VALENTINO" and trade variations in "Exhibit 6".

57. Ms Norsa attests further in paragraph 9 of her first statutory declaration that use of the opponent's trade mark "VALENTINO" and trade variations in Hong Kong began in 1980, and since then they have been used continuously and extensively in Hong Kong in relation to the opponent's goods. Ms Norsa gives the sales figure of the opponent's goods bearing the trade mark "VALENTINO" and trade variations in Hong Kong during the period of 1980 to 1983 which was roughly around US\$1,160,000.00. No breakdowns for the sales figures between different goods bearing the trade mark "VALENTINO" and trade variations are given. A random selection of sales invoices are said to be produced in "Exhibit 9". All the invoices produced are for the years 1980 to 1983 for woven garments, ladies wear and gents wear. It appears that all the invoices are issued to The Swank Shop Limited in Hong Kong. Only the mark "  valentino " is shown in all the invoices.


58. By paragraph 11 of her first statutory declaration, Ms Norsa gives the annual worldwide sales figures for the opponent's goods bearing the opponent's mark "VALENTINO" and trade variations from 1990 to 1996. There are no breakdowns for the Hong Kong sales and among the opponent's goods and marks.


59. "Exhibit 10" contains a further bundle of random selection of sales invoices. Some of the invoices are dated 1997 which are post-application. For those pre-application invoices dated 1992, 1994, 1995 and 1996, not any one of the opponent's marks was shown on most of them and they do not appear to have been issued by the opponent, but by some unknown third parties. On one invoice dated

19 March 1996, I am able to find the remark “Collection VALENTINO MISS V” and the invoice is in respect of ladies wear issued by one GFT Hong Kong Limited for the sum of US\$25,019. On the other two invoices dated 26 July 1995 and 3 August 1995, I see the remark of “VALENTINO COUTURE AS PER ORDER NO....” and the invoices are in relation to belts and cases including jewel, photo, documents, cigar and planning card cases issued by one IPM.

60. Ms Norsa states in paragraph 13 of her first statutory declaration that the opponent’s trade marks are applied to the opponent’s goods by way of labels and appear on packaging in which the opponent’s goods are wrapped for sale. “Exhibit 11” is said to contain copies of sample opponent’s goods bearing the opponent’s trade mark “VALENTINO” or trade variations and sample labels used both on packaging and labelling of the opponent’s goods. There is no information as to whether the opponent’s goods (only perfume, wristwatches and pocketwatches are shown) in “Exhibit 11” were ever sold in Hong Kong before the application date. I find that


only the marks “  ”, “  ” and “  ” are depicted.

61. Ms Norsa avers that the opponent’s goods are sold in Hong Kong through the opponent’s retail shops, boutiques, and independent perfumery shops, counters and pharmacies, and counters. “Exhibit 12” is said to contain copies of displays of the opponent’s goods bearing the opponent’s trade marks, taken at the opponent’s retail shops in The Landmark in Central, Mitsukoshi in Tsimshatsui and Mitsukoshi in Causeway Bay. Each of these shops stocked the opponent’s goods bearing the opponent’s trade marks from 1990, 1991 and 1995. The opponent’s trade marks and goods in question are not specified. The retail shops as shown in “Exhibit 12” seem to relate to clothing. Only the marks “  ”, “VALENTINO”

and “  ” are found at the shop fronts of the retail shops as shown in the exhibit.

62. Ms Norsa says in paragraph 15 of her first statutory declaration that the opponent’s goods are bought, *inter alia*, by retail shops in Hong Kong for sale within Hong Kong. “Exhibit 13” is said to contain a list of the opponent’s retail stores clients within Hong Kong. The heading of the list is ““VALENTINO” boutiques and “VALENTINO” shops-in-shops in Hong Kong’ in which 18 retail shops are set out. However, there is no mention of the dates when these shops were open and the sales

took place in Hong Kong. “Exhibit 14” is supposed to contain copies of exemplary sales invoices in relation to the Hong Kong retail shops listed out in “Exhibit 13”. I do find that some invoices bearing the mark “VALENTINO” in “Exhibit 14” were issued by the retail shops in The Place, New World Centre, IFC Mall and Chater House but all of them are post-application date for a number of years for the period of 2002 to 2004. Altogether six sales memos issued to customers in April 1996 are produced. However, nowhere can I find the name of the shop involved and only the

mark “ <sup>valentino</sup> ” is featured on the sales memos. All the sales memos are in respect of clothing items including jacket/blouson, dress, skirt suit and top.

63. Ms Norsa asserts that the opponent’s trade marks have been extensively advertised and marketed worldwide including but not limited to Hong Kong in paragraph 16 of her first statutory declaration. The opponent’s trade marks are not defined in this paragraph or elsewhere in the statutory declaration. Ms Norsa says that during the period of 1993 to 1999, the worldwide advertising expenditure has been well in excess of US\$40 million. It is not however possible to readily allocate advertising expenditure to any individual country. It follows that there is no breakdown for the advertising expenses in Hong Kong.

64. Ms Norsa avers that “Exhibit 15” to her first statutory declaration shows a list and copies of multiple examples of advertisements promoting the opponent’s “VALENTINO” products appearing in international magazines and trade journals which are circulated worldwide including but not limited to Hong Kong between 1979 and 1998. The heading of the list is “Advertisements promoting the “V (logo)” and “VALENTINO” products 1979 – 1998”. The types of products being promoted are not defined. When I look at the advertisements, they in the main appear to relate to fashion clothing. As said by Ms Norsa, the advertisements in “Exhibit 15” are all extracted from international magazines like Vogue UK, Cosmopolitan, Vanity, International Herald Tribune, For Him UK, GQ UK, Elle UK, Marie Claire UK, The New York Times Magazine, Mirabella UK, Vogue Hommes International, W Europe, Tatler UK, Harper’s & Queen UK, Esquire UK and so on. There is no evidence that these international magazines were circulated within Hong Kong before the application date. Even if some of them were circulated within Hong Kong before the application date, there is no information before me as to the extent of circulation in Hong Kong. Simply put, there is no evidence that these magazines have reached the eyes of the local purchasing public. The predominant marks that are shown to be

in use in these magazines are “  VALENTINO ”, “VALENTINO”, “  ” and “VERY VALENTINO”.

65. In paragraph 21 of her first statutory declaration, Ms Norsa avers that copies of multiple examples of advertisements promoting the opponent’s “VALENTINO” products classified by international classes of products are attached to “Exhibit 16”. No information is given as to the nature of the advertisements and whether the advertisements were circulated within Hong Kong before the application date. When I look at the copy advertisements produced in “Exhibit 16”, it appears that many of them were published in sort of European and American magazines such as Allure Gennaio, Elle Italia, Vogue Deutsche, Vogue Paris, Elle France, Elle USA, The New York Times Magazine, Madame Figaro, Marie Claire Francia and so on. Further, some of the advertisements produced are in foreign languages other than English. The predominant marks that are featured in these advertisements are more or less the same as the marks shown in “Exhibit-15”.

66. Ms Norsa attests that “Exhibit 17” contains a list and copies of multiple examples of magazines covers in which the opponent’s “VALENTINO” products enjoyed editorial features and coverage. The list in the exhibit is entitled “292 Magazine Covers Featuring Valentino”. I find that “Exhibit 17” contains mainly European magazines covers without any marks shown on most of them. There is no evidence of circulation within Hong Kong before the application date. Most of them are in foreign languages other than English.

67. Ms Norsa states that a copy of a booklet entitled “VALENTINO STORY” and copies of sample seasonal brochures using world famous models and photographers, all being distributed through tens of thousands of sales networks including more than 80 “VALENTINO” boutiques worldwide including but not limited to Hong Kong are produced in “Exhibit 18”. The undated booklet contains some personal information of Valentino and a brief account of his career development. It also contains an interview with him talking about the philosophy of the Valentino empire. However, I find the booklet has nothing to do with the use of the opponent’s marks in Hong Kong. Nearly all the copy brochures produced are undated. There is no information as to when and where the brochures and the booklet were distributed.

68. Eventually, I am able to find some pre-application date Hong Kong publications in “Exhibit 20”. Ms Norsa describes “Exhibit 20” as “copies of sample advertisements promoting the opponent’s “VALENTINO” products published in the “FEMINA” and “STYLE” magazines both with regular and wide circulation in Hong Kong, Singapore and the Asian region in the 1970s to 1980s”. The marks that are shown to be advertised are “華倫天奴”, “VALENTINO” and “<sup>Ⓟ</sup>VALENTINO”. There is also the mention of the Valentino Boutique in the Regent Shopping Arcade, Kowloon which is an associate of The Swank Shop, The Landmark, Hong Kong and Valentino at Joyce Boutique. The advertisements are mainly in relation to clothing items.

69. Some more pre-application date Hong Kong publications are shown in “Exhibit 21” and “Exhibit 22”. “Exhibit 21” is a news clipping from Apple Daily News dated 22 May 1990 advertising the “華倫天奴” and “Valentino” marks and featuring Princess Diana, socialities and movie stars wearing the opponent’s “VALENTINO” evening gowns and fashion accessories. “Exhibit 22” comprises an article dated 2 December 1996 from Forbes Hong Kong entitled “Joyce’s World”. Although the article was issued after the application date which is 19 November 1996 for the subject application, the article mentions that “Ma rode the Italian ready-to-wear wave in the 1970s, stocking her shops with labels like Valentino, Armani, Gucci”.

70. “Exhibit 23” attaches an extract from the South China Morning Post “STYLE” magazine of Spring/Summer 2004. Although the magazine is post-application date, there is an article about David Hong, the managing director of The Swank Shop, a Hong Kong-based retailer. The article states that Mr Hong graduated from business studies in England and joined The Swank Group in 1974 to help his parents to continue revolutionising Hong Kong’s fashion retail. Valentino was among some of the designer labels under the group at that time.

71. I have analyzed the opponent’s evidence at length above. The opponent has filed a very huge bundle of evidence in the present proceedings but I have to say that many of them are not relevant to establishing any reputation of the opponent’s marks in Hong Kong before the application date. Taking a fair appraisal of the relevant evidence that I can extract from the huge bundle, I find that the

opponent has established reputation in respect of its marks “ VALENTINO ”, “ <sup>valentino</sup> V ”, “ V ”, “VALENTINO” and “華倫天奴” for clothing items and accessories in Hong Kong at the application date by reason of its use and advertising of the marks in Hong Kong since the 1970s. I gather from the evidence that the opponent had sold clothing items including accessories in Hong Kong through the retail shops such as the Joyce Boutique, The Swank Shop in The Landmark, the Valentino Boutique in the Regent Shopping Arcade, Mitsukoshi in Tsimshatsui and Causeway Bay in the period from the 1970s to the date of application. The aforesaid marks were also advertised in Hong Kong in the same period in relation to clothing items and accessories.

72. As pointed out by Mr Carolan, the comparison exercise to establish whether there is confusing similarity between the marks is the same under both sections 12(1) and 20. Applying the same reasoning, I do not find the suit mark confusingly and deceptively similar to any of the opponent’s marks in actual use. It follows that the opponent also fails in its opposition under section 12(1) of the Ordinance.

#### Under section 13(2)

73. The discretion under section 13(2) arises when the opponent has failed in its opposition and the suit mark is registrable under either section 9 or 10 of the Ordinance.

74. I remind myself that the register has been created by the Ordinance for the purpose of enabling marks to be entered therein. If no proper evidence can be adduced as to why the registration should be refused for a qualifying mark, the exercise of discretion should not be adverse to the applicant. As no proper evidence has been adduced, I therefore decline to exercise my discretion adversely to the applicant.

#### Costs

75. The applicant has sought costs and there is nothing in the circumstances or conduct of this case which would warrant a departure from the general rule that the

successful party is entitled to its costs. I accordingly order that the opponent pays the costs of these proceedings.

76. Subject to any representations as to the amount of costs or calling for special treatment, which either party makes within one month from the date of this decision, costs will be calculated with reference to the usual scale in Part I of the First Schedule to Order 62 of the Rules of the High Court (Cap. 4A) as applied to trade mark matters, with one counsel certified unless otherwise agreed between the parties.

*Original signed*

(Ms Fanny Pang)  
p. Registrar of Trade Marks  
28 September 2009