

Application No. 14626 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 9

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 and written submissions filed by the applicant on 8 June 2009 and by the opponent on 15 June 2009 at the Registrar's direction made at the hearing.

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 9, 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 “electric, photographic, optical, weighing, measuring apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; recording discs; calculating machines; data processing equipment and computers; all included in Class 9” (“the specified goods”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part A of the register subject to a disclaimer of the letter “V”. The application was advertised in the Government of the Hong Kong Special Administrative Region Gazette on 18 August 2000

Pleadings and evidence

3. On 12 April 2001, 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 uses the mark “Valentino” extensively in various jurisdictions worldwide including Hong Kong in respect of prestigious luxury goods including, *inter alia*, leather and imitations of leather, animal skin, hides, trunks and travelling bags, umbrellas, parasols, walking sticks, whips, harness and saddlery; clothing, knitwear, footwear, headgear, hosiery, swimwear, belts, ties, sports wear, top coats, sports shoes, gloves, scarves, costumes; 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; bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrice; shoes, boots and slippers; polo shirts and T-shirts, sweaters, blouses, raincoats; purses, handbags and wallets; outer clothing; attache cases, brief cases, card cases, pocket wallets; scientific, nautical, surveying, electric, photographic, cinematographic, optical, weighting, measuring, signalling, checking (supervision); life-saving and teaching apparatus.

4. The opponent claims that it is the proprietor of a number of trade marks registered in various classes in Hong Kong, details of which are set out in Annexure I to the grounds of opposition. The “Valentino” mark was first used by the designer Valentino Garavani in 1959 and then by the opponent in 1969. The opponent avers that it has achieved widespread and substantial sales of its products under the “Valentino” mark worldwide. The annual wholesale turnover of products bearing the “Valentino” mark owned by the Valentino Group of companies is in excess of US\$500,000,000. By reason of the opponent’s long and extensive use and promotion of the “Valentino” mark, the “Valentino” mark (either alone or in conjunction with the opponent’s other registered and unregistered trade marks) obtains instant recognition by members of the public within Hong Kong as unique to identify the opponent’s goods.

5. The opponent asserts that the suit mark is very similar to the “Valentino” mark. 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 “Valentino” mark is substantial. The likelihood is increased given the applicant’s graphic logo of a lateral “oval” intersected by the letter “V” is almost identical to the logo which has been used by the opponent since 1979. The similarity between the two devices has caused confusion in other jurisdictions which has been or is likely to be paralleled within the jurisdiction of Hong Kong. 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 applicant’s own

application for registration of the suit mark is 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 George Frederik Nicolaï, the director of the opponent, together with exhibits, which was declared on 5 September 2002 (“Nicolaï’s statutory declaration”). 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 3 November 2006 (“Norris’ statutory declaration”). 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 10 of Nicolaï’s 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 only made submissions on the ground under section 20 of the Ordinance for the present opposition proceedings.


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 mark is relied on by the opponent in mounting the opposition under section 20(1) :-

Trade Mark	Registration No.	Date of Registration	Class	Goods
 <p>(Registration of this trade mark shall give no right to the exclusive use of the letter “V”)</p>	2861 of 1993	5.3.1991	9	optical apparatus and instruments; spectacles and sunglasses; lenses, frames and cases for spectacles and sunglasses; parts and fittings for all the aforesaid goods; all included in Class 9.

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 mark; and if so whether the suit mark so nearly resembles the opponent’s registered mark 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”.

14. So far as the first issue is concerned, Mr Ling for the applicant conceded that as clearly some of the goods covered by the opponent’s registered mark are the same as those included in the proposed registration, namely, optical apparatus and instruments, the opponent is able to overcome the first limb of section 20(1). The only question is the likelihood of confusion under notional use by each side of its respective mark.

15. 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 mark “ valentino garavani ” in a normal and fair manner for any of the goods covered by the registration, 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



“ *Cioppami Valentino* ” normally and fairly in respect of any goods covered by its proposed registration?”

16. 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*, 12th Edition, paragraph 17-03).

Comparison of marks

17. Before proceeding to the comparison of the marks, I would mention that as stated in the table in paragraph 11 above, the registration of the opponent's mark is subject to a disclaimer that there is no right to the exclusive use of the letter “V”. As mentioned in paragraph 2 above, similarly, the suit mark was accepted for registration subject to a disclaimer of the letter “V”. 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.

18. Mr Ling submitted that both marks consist of two words and a device. The word element, that is, the personal name, is more important as it is likely to form the basis for verbal identification of the mark. The forename and surname in the suit

mark are “Giovanni” and “Valentino” whereas those of the opponent’s registered mark are “Valentino” and “Garavani”. Although both marks look like personal names, the pronunciation of the names is markedly different. Moreover, as “Valentino” is a fairly common Italian name, the focus of attention is likely on the other word.

19. 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.

20. 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.

21. Regarding the words of the respective marks, Mr Carolan submitted that the word “Garavani” in the opponent’s mark is confusingly similar to the word “Giovanni” in the suit mark to the Hong Kong purchasers especially when each of them is used in conjunction with the common word “Valentino”.

22. 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). To my mind, their overall arrangement and structure are the same in that both of them contain a letter-like device above two words of the same length, one of them being the common word “Valentino”.

23. 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”.

24. 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, I agree with Mr Carolan that 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 is likely to 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.

25. It is trite to say that words speak louder than devices. In the present case, I am of the view that the resemblance between the words in the marks is considerably closer than the devices that helps to tip the balance. Both the words “Giovanni Valentino” in the suit mark and “VALENTINO GARAVANI” in the opponent’s registered mark look like Italian names suggesting an Italian derivation. Even if, as submitted by Mr Ling, more attention is paid to the words “Giovanni” and “Garavani” since the common “Valentino” is, undisputed by the parties, a fairly ordinary Italian name known in Hong Kong, I do consider that the word “Giovanni” in the suit mark is confusingly similar to the word “Garavani” in the opponent’s registered mark. The words are of the same length consisting of eight letters starting with the letter “G” and the ending parts are “vanni” and “vani” respectively. Having taken into account the principle of imperfect recollection that the marks are not to be placed side by side for critical comparison, I consider the net impression given by

each set of words is “Valentino” plus another Italian word starting with “G” and ending with “vani”. I have come to the conclusion that conceptually and visually, the respective marks are confusingly similar.

26. Whilst I have found above that both the devices in the respective marks are likely to 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 GARAVANI” rather than by the devices in speech when they refer to or request for the parties’ goods. Both the words “Giovanni” and “Garavani” comprise four syllables. The third and fourth syllables of the respective marks are pronounced the same as “vani”. Notwithstanding the first and second syllables are pronounced differently as “gio” and “gara”, I find that in pronouncing “Giovanni” and “Garavani”, the stress is likely to fall on the third and fourth syllables. To an ordinary consumer in Hong Kong who is not conversant with Italian, in my view, the overall impression is that the two words do sound similar. The two sets of words “Giovanni Valentino” and “VALENTINO GARAVANI” as a whole are phonetically similar. I do not think that the difference in the positioning of the word “Valentino” in the respective marks would assist in counter-balancing the phonetical similarity.

Likelihood of confusion and deception

27. As part of the specified goods and goods of the opponent’s registration overlap with one another, the goods can be sold and purchased through same trade channels to the same class of purchasers paying the same price. The degree of care and attention of likely purchasers is to be considered in relation to the inherent nature of the goods. The parties’ goods are optical apparatus and instruments which are generally purchased with normal care and attention, and purchasers will make no more than averagely intelligent examination of the marks.

28. Having taken into account all the above, I conclude that there is a real tangible risk that the purchasing public would be confused into believing the goods of the parties come from the same source or at least wonder whether or not that might be so if the marks are applied to the same goods.

Under section 22 – honest concurrent use

29. Section 20(1) of the Ordinance makes express reference to the exception

provided by section 22. As evidence was filed by the applicant that the suit mark was used in Hong Kong, it is necessary for me to consider section 22 to see whether it can assist the applicant.

Whether “optical apparatus” covers “spectacles and sunglasses” (“the issue”)

30. It is the applicant’s case that there was honest concurrent use in respect of spectacles and sunglasses. However, the exact description of “spectacles and sunglasses” is not found in the specification of the present application. The specification of the present application consists exclusively of goods appearing as class headings under the Nice Classification. The most relevant class heading within the specification is “optical apparatus”. The issue that whether spectacles and sunglasses are encompassed by the heading “optical apparatus” arose in the course of the hearing. I directed the parties to file written submissions on the issue after the hearing. Written submissions were filed by the applicant and the opponent on 8 and 15 June 2009 respectively.

Applicant’s written submissions on the issue

31. The applicant filed a half-page submission putting forward a very simplistic argument. The applicant pointed out that as at the application date of 19 November 1996, the International Classification that was in force was the Nice Classification, the 6th Edition. Under the then prevailing classification, Class 9 read as follows :

“Scientific, nautical, surveying, electric, photographic, cinematographic, **optical**, weighing, measuring signalling, checking (supervision), life-saving and teaching **apparatus** and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus” (emphasis added)

32. The applicant contended that “spectacles and sunglasses” were not separately listed in Class 9 or any other classes. If one were to adopt the language of the Nice Classification, the only description available for such goods was “optical apparatus” in Class 9. It must follow that “spectacles and sunglasses” are included

in the specification of the present application.

Opponent's written submissions on the issue

33. The opponent's written submissions on the issue are much more extensive. In summary, the opponent's position is that class headings in general do not cover all goods classified under that class. This is particularly the case for Class 9 as it covers an exceptionally broad and wide scope of goods. Precise and clear wordings must be included in the specification to indicate what goods are intended under an application. In case coverage of an item in the specification is in question, one should examine the ordinary meaning of the word or item. In support of its submissions, the opponent referred me to the unreported decision of the Registrar in *First Choice Trade Mark*, Maria Ng, dated 12 May 2005. It was found that the indications of goods or services appearing in the class headings are general indications relating to the fields to which, in principle, the goods or services belong. It follows that class headings do not necessarily cover all the goods and services listed in the Nice Classification.

34. In a decision made by the United Kingdom Registrar (0-219-08, G W Salthouse, 4 August 2008) in respect of application no. 2430094 filed by Elkparts Limited in classes 25 and 35, the opponent in that case argued that "the use of all the general indications listed in the class heading of a particular class constitutes a claim to all the goods or services falling within this particular class" and therefore its class 35 registration covered all services classified under international class 35. The hearing officer disagreed relying on the UK Trade Marks Registry's Work Manual which provided that "when a class heading is used as a specification, it loses its capacity to function as a class heading and becomes part of an application or registration as a statement of goods or services. It follows that the question of what a class heading includes or does not include is irrelevant and interpretation of the statement of goods or services may only be made by reference to the goods or services included in that statement".

35. My attention was also drawn to a decision made by the Registrar of Australia (*NEC Trade Mark*, Frances Aarnio, 11 April 2002) in the application for registration of the mark "NEC" by NEC Corporation under application no. 787798. Extensive analysis on the scope of a claim comprising a class heading was made in this case. The argument that a class heading should be considered as covering all

goods or services in a class was expressly rejected. It was found that an application which claims a class heading covers only the goods or services actually specified in the heading, or clearly encompassed by the heading.

Findings on the issue

36. It is common ground between the parties that as of the application date of 19 November 1996 in the present case, the International Classification of goods and services that was in force was the Nice Classification, the 6th Edition.

37. The following is set out at page 1 of Nice Classification (6th Edition), Part I, List of Goods and Services in Alphabetical Order:

Guidance for the user

1. The indications of goods or services appearing in the List of Classes are general indications relating to the areas to which the goods or services in principle belong.

... ..

6. For the purposes of the registration of marks, it is highly recommended to use terms appearing in the Alphabetical List as indications of goods or services, with the exception of general terms which are not further qualified.

And at page 5:

General Remarks

The indications of goods or services appearing in the List of Classes are general indications relating to the field to which, in principle, the goods or services belong. The Alphabetical List should therefore be consulted in order to make sure of the classification of each specific product or service.

38. It is clear from the above that the class headings are general indications only. Although the legal authorities referred to by the opponent involve the interpretation of the 7th and 8th editions of the Nice Classification, I find them of

assistance to me in interpreting the Nice Classification, the 6th Edition which is similar to the 7th and 8th editions so far as the issue in question is concerned. I accept the opponent's submissions that class headings in a class do not cover all goods which can be classified under that class. An application which specifies a class heading only claims protection in respect of the goods expressly stated, or that may be clearly encompassed by the heading. In the present case, as pointed out by me earlier, the goods "spectacles and sunglasses" are not expressly stated in the applicant's specification which consists of class headings. The next question is whether "spectacles and sunglasses" may be clearly encompassed by the class heading "optical apparatus".

39. The opponent submitted that in determining whether "optical apparatus" covers "spectacles and sunglasses", one must look at the clear apparent meaning attached to the general item "optical apparatus". To ascertain the clear apparent meaning of the term "optical apparatus", the opponent has quoted the different meanings of the word "apparatus" found in multiple dictionaries downloaded from the internet in June 2009. The opponent contended that the definitions from the dictionaries and websites show that "apparatus" are "equipment" designed for a particular purpose. The examples given relate to laboratory or scientific equipment or apparatus, and none of the definitions relates to spectacles and sunglasses.

40. As a general usage, the opponent contended that the class heading description "optical apparatus" (光學用具) is ambiguous and vague and may cover a wide range of products which cannot be apparently determined and ascertained by a reasonable consumer. The list of goods could include optical lenses, telescopes, cameras, lenses, magnifying glasses and so on. The general item of "optical apparatus" is therefore wholly undesirable and should not be interpreted to cover the specific items of "spectacles and sunglasses". Even if the Registrar were to conclude that the word "apparatus" covers "spectacles and sunglasses" (which the opponent disagrees), the inclusion of "spectacles and sunglasses" in the present application must be restricted to only include those with optical lenses.

41. In interpreting a specification of goods, terms are to be given their ordinary and natural meaning (*Ofrex v Rapesco* [1963] RPC 169). The opponent has quoted various meanings of "apparatus" in different dictionaries but it has not elaborated on the meaning of "optical" in its written submissions. I find from the *Collins English Dictionary*, the 3rd Edition (the relevant edition at the application

date), that “optical” can mean, amongst others, “of or relating to the eye or to the sense of sight; optic”. Adopting the meaning of “apparatus” quoted by the opponent, it means an equipment designed for a particular purpose. I consider that the term “optical apparatus” as a whole encompasses different types of equipment relating to the eye or to the sense of sight designed for a particular purpose which should include spectacles and sunglasses. *Collins*, supra, defines “spectacles” as “a pair of glasses for correcting defective vision” and “sunglasses” as “glasses with darkened or polarizing lenses that protect the eyes from the sun’s glare”.

Conclusion on the issue

42. In conclusion, I find that although the goods “spectacles and sunglasses” are not expressly stated in the applicant’s specification, they may be clearly encompassed by the heading, namely, optical apparatus having taken into account the ordinary meaning of the term.

Factors to be taken into account under section 22

43. I now move on to consider whether my discretion should be exercised under section 22 to allow registration of the suit mark on the basis of honest concurrent use. The principal matters to be taken into consideration in considering section 22 are established in the leading case *Alexander Pirie & Sons Application* (1933) 50 RPC 147. They are :

- (1) The extent of use in time and quantity, and the area of the trade;
- (2) The degree of confusion likely to ensue from the resemblance of the marks, which is to a large extent indicative of the measure of public inconvenience;
- (3) Whether any instances of confusion have in fact been proved;
- (4) The honesty of the concurrent use; and
- (5) The relative inconvenience which would be caused if the mark in suit

was registered, subject if necessary to any conditions and limitations.

Honesty of the concurrent use

44. In *Bali Trade Mark (No. 2)* [1978] FSR 193, the “honesty” of the concurrent use was said to be a prerequisite to the application of the section. *Bali* was applied in *Lam Soon Marketing Services Ltd v Lam Mei Hing* [1994] AIPR 317. The onus is on the applicant. Honesty cannot simply be assumed.

45. The opponent has not made any allegation that the suit mark was copied from any of the opponent’s marks in the grounds of opposition or the opponent’s evidence. Ms Norris, the sales manager of the applicant, explains in paragraphs 4 and 5 of her statutory declaration that the applicant is the proprietor of the mark “GV GIOVANNI VALENTINO” and the applicant is owned by Mr Giovanni Valentino. The word parts of the suit mark “Giovanni Valentino” are the personal names of Mr Giovanni Valentino who created the “Giovanni Valentino” fashion brand using his own name. I am satisfied that the applicant has established the necessary honesty of the use of the suit mark.

The extent of use in time and quantity, and the area of the trade – the applicant’s case

46. It is the applicant’s case that it had sold spectacles and sunglasses in Hong Kong under the suit mark in the period from 1974 to the date of the application in November 1996. To this end, the applicant adduced copies of sample invoices and catalogues as its evidence. There is a great controversy between the parties in relation to the pre-1991 evidence filed by the applicant. Putting aside the controversy for the time being, I shall first turn to the applicant’s evidence for the most material period from 1992 to 1996, the five years immediately preceding the date of application. The applicant has produced sample invoices in the same period in “AIN-6” to Norris’ statutory declaration. The invoices can be broadly divided into two types. The first type was issued by one “Giovanni Valentino, Inc.” with a New York address to “Tin Ming Optical” with a Hong Kong address for the period from February 1992 to May 1996. The second type covers invoices issued by Florence Fashions or Florence Fashions (Jersey) Limited, the applicant and its predecessor, to Foron Company Ltd or Trans-Pacific Consultant Ltd for the period from January 1992 to October 1996. Ms Norris also attaches the applicant’s catalogues for glasses and sunglasses in the same period of 1992 to 1996 to the

exhibit "AIN-7".

47. At the hearing, Mr Ling produced a table attempting to match the first type of invoices with the catalogues. Mr Carolan urged me not to accept the first type of invoices as they were not issued by the applicant or its predecessor but a New York company, its relationship with the applicant being unknown.

48. Turning to the second type of invoices issued by the applicant or its predecessor, there are altogether 12 written and 34 typed invoices. All the invoices are in relation to glasses and/or sunglasses on their own or together with other types of goods. Although there is no reference to the suit mark in any of the invoices, the style numbers of the glasses and sunglasses are listed on the invoices and I am able to match some of them with the catalogues produced in "AIN-7". For example, in the 1992 catalogue for glasses and accessories, glasses and sunglasses bearing the suit mark with style numbers GL101, GL102, GL103, GL104, GL105, GL106, GL107, GL108, GL109, GL110 and GL111 are featured. At the back cover of the catalogue, the suit mark is shown with the name and address of the applicant, the name and address of the Hong Kong distributor "Foron Company Ltd" at Room 1404, Bonham Commercial Centre, 42A Bonham Strand West, Hong Kong and the name and address of the retail outlet "Tin Ming Optical" at Ground Floor 29, Nga Tsin Wai Road, Kowloon City, Kowloon, Hong Kong. There is also a copyright notice of 1992.

49. A total number of eight invoices are produced in the year 1992 (the date for the eighth one is not shown because of the poor quality of the photocopy attached to the exhibit but it is placed at the end of the whole bunch of 1992 invoices before the 1993 invoices). The style numbers shown in the 1992 catalogue are found in the 1992 invoices including GL102, GL103, GL104, GL105, GL106 and GL107. Except for two invoices which were issued to "Trans-Pacific Consultant Ltd" at 2201, the Centre Mark 287-299, Queen's Road Central, Hong Kong, all the other invoices were issued to the named Hong Kong distributor in the catalogue being "Foron Company Ltd" with the same address.

50. I have added up all the values of the wholesale sales in relation to glasses set out in the 1992 invoices which amounted to about US\$37,334. Although the dollars on the invoices are not stated to be US dollars, I find that the sales figures as given in Norris' statutory declaration are in US dollars. Moreover, for example, in the invoice dated 1 February 1992 amongst the first type of invoices issued to Tin

Ming Optical, the unit prices for “GL104 and GL106 Unisex Glasses” were stated to be US\$123 and US\$124 respectively which correspond with the unit prices given for the same styles of unisex glasses listed in the invoice dated 8 January 1992 amongst the second type of invoices issued to Foron Company Ltd.

51. Copies of catalogues for 1993, 1994, 1995 and 1996 are produced in “AIN-7”. It appears from the back cover of the 1993 catalogue that the address of Foron Company Ltd was then changed to 505-506, Singga Commercial Centre, 148 Connaught Road West, Hong Kong. One can find that the same new address of Foron Company Ltd was shown on the invoices from June 1993 onwards. For all those catalogues, Foron Company Ltd and Tin Ming Optical were respectively said to be the distributor and retail outlet of the applicant in respect of the glasses or sunglasses.

52. From 1993 onwards, I find that the mark used in the catalogue is not



identical to the suit mark. The mark shown to have been used is “ GIOVANNI VALENTINO ”. Mr Ling submitted that I can take evidence of use of this mark with the words “GIOVANNI VALENTINO” in block capitals as evidence of use of the suit mark with the words “*Giovanni Valentino*” in stylized script. He contended that the two marks are essentially the same because the script used in the suit mark is fairly ordinary that does not detract from the identity of “GIOVANNI VALENTINO”. Mr Carolan did not dispute Mr Ling’s submissions and conceded on this point. I accept the submissions of Mr Ling. A notional and fair use of the suit mark gives the applicant’s right to use the suit mark in a different script which includes plain block capitals. The mark in actual use is similar to the suit mark as to be essentially the same mark.

53. Notwithstanding not all the style numbers of the glasses or sunglasses shown in the 1992 to 1996 invoices match exactly with those style numbers found in the catalogues of corresponding years, taking a fair appraisal of all the evidence involved, I am satisfied that so far as the second type of invoices are concerned, they are in relation to the applicant’s sunglasses or glasses bearing the suit mark. I have also added up the wholesale figures for glasses and sunglasses as shown in the

invoices for the period from 1993 to 1996. They amounted to US\$29,684 in 1993; US\$21,350 in 1994; US\$32,149 in 1995 and US\$38,629 in 1996. To recap, it was found by me in paragraph 50 above that the total value of sales for 1992 was US\$37,334. The aggregate values of the applicant's wholesale sales in the five-year period from 1992 to 1996 were about US\$159,000. When the same is converted into Hong Kong dollars, it amounted to a sum in the region of HK\$1.23 million.


54. I mentioned earlier that there is a great controversy between the parties on the applicant's pre-1991 evidence of use. According to Mr Carolan's submissions, the crux of the controversy is that it is clear from "AIN-2" to Norris' statutory declaration, the applicant's own evidence, it was not until 1991 when his father died that Mr Giovanni Valentino decided to create the "GIOVANNI VALENTINO" fashion brand. According to an information sheet found in the middle of "AIN-7", Mr Giovanni Valentino was born in 1956 and graduated in 1978. He was only 18 years old in 1974, the claimed date of first use of the suit mark in Hong Kong. Against that background, Mr Carolan submitted it can easily be inferred that the pre-1991 documents including copies of the handwritten invoices and the catalogues are to be seriously doubted.

55. As I have found that the post-1991 evidence does show a reasonable degree of use of the suit mark by the applicant in respect of glasses and sunglasses in Hong Kong continuously for five years from 1992 to the date of application, there is no need for me to consider the applicant's evidence before 1992.

The extent of use in time and quantity and the area of the trade – the opponent's case

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 4 of Nicolai's 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, 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"). He says that the products bearing the trade mark "VALENTINO" and associated trade variations were designed




by the famous designer Mr Valentino Garavani (known throughout the world by his forename “Valentino”). However, the term “associated 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 associated trade variations in “GFN-6”.



57. Mr Nicolai attests further in paragraph 8 of his statutory declaration that use of the opponent’s trade mark “VALENTINO” and associated 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. Mr Nicolai gives the sales figure of the opponent’s goods bearing the trade mark “VALENTINO” and associated trade variations in Hong Kong during the period of 1980 to 1983 which was roughly around HK\$9,048,000.00. No breakdowns for the sales figures between different goods bearing the trade mark “VALENTINO” and associated trade variations are given. A random selection of sales invoices are said to be produced in exhibit “GFN-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 10 of his statutory declaration, Mr Nicolai gives the annual worldwide sales figures for the opponent’s goods bearing the opponent’s marks from 1990 to 1996. There are no breakdowns for the Hong Kong sales and among the opponent’s goods and marks.

59. Exhibit “GFN-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. Mr Nicolai states in paragraph 12 of his 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 "GFN-11" is said to contain copies of sample opponent's goods bearing the opponent's trade mark "VALENTINO" or associated trade variations and sample labels used both on packaging and labelling of the opponent's goods. The labels were said to be in use prior to the application date. There is no information as to whether the opponent's goods (only perfume, wristwatches and pocketwatches are shown) in exhibit "GFN-11" were ever sold in Hong Kong before the application date.

I find that only the marks "  ", "  " and "  " are depicted.

61. Mr Nicolai avers that the opponent's goods are sold in Hong Kong through the opponent's retail shops. Exhibit "GFN-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 "GFN-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. Mr Nicolai says in paragraph 14 of his statutory declaration that the opponent's goods are bought, *inter alia*, by retail shops in Hong Kong for sale within Hong Kong. Exhibit "GFN-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 15 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 "GFN-14" is supposed to contain copies of exemplary sales invoices in relation to the Hong Kong retail shops listed out in exhibit "GFN-13". 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 "  " 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. Mr Nicolai asserts that the opponent's trade marks have been extensively advertised and marketed worldwide including but not limited to in Hong Kong in paragraph 15 of his statutory declaration. The opponent's trade marks are not defined in this paragraph or elsewhere in the statutory declaration. Mr Nicolai 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. Mr Nicolai avers that exhibit "GFN-15" to his 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 Mr Nicolai, the advertisements in exhibit "GFN-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 19 of his statutory declaration, Mr Nicolai avers that copies of multiple examples of advertisements promoting the opponent's "VALENTINO" products classified by international classes of products including sunglasses, spectacles and optical products in Class 9 are attached to exhibit "GFN-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 “GFN-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 “GFN-15”.

66. Mr Nicolai attests that exhibit “GFN-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 “GFN-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. Mr Nicolai 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 “GFN-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 “GFN-20”. Mr Nicolai describes exhibit “GFN-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

“  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 exhibits “GFN-21” and “GFN-22”. Exhibit “GFN-21” is a news clipping from Apple Daily News dated 28 May 1990 advertising the “華倫天奴” and “Valentino” marks and featuring Princess Diana, socialites and movie stars wearing the opponent’s “VALENTINO” evening gowns and fashion accessories. Exhibit “GFN-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. 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 ”,
valentino
“  ”, “  ”, “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. There was, nevertheless, no evidence of the use of the


opponent’s registered mark “ valentino garavani ” in respect of any goods on or

before the application date in Hong Kong.

The degree of confusion likely to ensue from the resemblance of the marks

71. As I have found above, the suit mark and the opponent's registered mark under section 20 are so nearly resembling as to be likely to deceive or cause confusion. However, that should not pose a bar to registration under section 22 of the Ordinance.

72. Lord Hanworth M.R. in *Alex Pirie and Sons Limited's Application* (1932) 49 RPC 195 (CA) observed at 213 as follows :-

“I find that section [22] is a section which does not carry with it a limitation as to there being a slight possibility of deception, for its words indicate that the Registrar may permit the registration of the same trade mark, or of nearly identical trade marks, for the same goods by more than one proprietor. It seems to indicate that the powers of the court (and the Registrar) can be exercised even when there is likely to be confusion between the marks.”

73. In *Buler Trade Mark* [1975] RPC 275 at 289, Graham J. expressed the view that “the degree of likely confusion is relatively unimportant under [section 22] provided the honesty of the applicant is established and it is otherwise just in all the circumstances that this mark should be registered”.

Whether any instances of confusion have in fact been proved

74. No instance of confusion has in fact been proved by the opponent. The fact that there is no known instance of confusion is not of itself conclusive that the marks are not likely to be confused, but it is a factor to be taken into account in exercising my discretion under section 22 of the Ordinance.

Relative inconvenience which would be caused

75. Finally the relative inconvenience to the parties is to be weighed. I have concluded in paragraph 70 above that there was no evidence of the use of the opponent's registered mark in respect of any goods in Hong Kong on or before the application date. The applicant, however, has built up on the suit mark a modest business in respect of spectacles and sunglasses. I consider the applicant would

suffer disproportionately if the subject application for spectacles and sunglasses is refused.

76. In my judgment, the applicant has made out its case of honest concurrent use for spectacles and sunglasses for the purposes of section 22 of the Ordinance. Having taken into consideration of all the factors, I would exercise my discretion under section 22 in favour of the registration of suit mark in respect of spectacles and sunglasses.

Under section 22 – special circumstances

77. Apart from honest concurrent use, section 22 of the Ordinance provides that the Registrar may permit registration by more than one proprietor, in respect of the same or same description of goods, of trade marks that nearly resemble each other in case of other special circumstances. In *Shanahan, Australian Law of Trade Marks and Passing Off*, 2nd edition, p.207-208, the following succinct account of “special circumstances” is given by the learned author:-

‘..... Generally “special circumstances” have only been something to consider along with use when weighing the case for registration. However, in *Government of West Australia’s Appn* there had been no use of the applicant’s mark “Swandown”, but the application was allowed to proceed in the face of conflicting “Swan” marks on the basis of two “special circumstances”, one being the applicant’s previous and well known use of a black swan device as the State emblem and the other the fact that the respective goods were not identical.

.....

It would seem that a special circumstance might comprise any aspect of the applicant’s use tending to minimise the risk of confusion or showing particular hardship. Thus the following have been recognized as “special circumstances” : the registered mark had been vulnerable to non-use proceedings during most of the period of the applicant’s use; the earlier mark had been revived for the purpose of attacking the applicant’s use rather than from any strictly commercial consideration; the word for which registration was sought was disclaimed in the prior mark; the mark was the name of the applicant; and the proprietor of the prior mark would be unable to prevent the applicant’s use even if registration were refused. In *Maeder’s*

Appn the consent of the earlier party was considered “a circumstance that is deserving of very attentive consideration.”

78. To recap, my finding is that the opponent had never used its registered mark in respect of any goods in Hong Kong on or before the application date. The fact that a registered mark had not been in use throughout the whole of the period of the use of the applied for mark appears to be a special circumstance of which the court should take account (*Electrolux Ltd. v Electrix Ltd and Another* (1953) 70 RPC 127 at 133).

79. In *Holt & Co.'s Application* [1957] RPC 289, it was observed that “special circumstances” includes any circumstance “peculiar to the applicant in relation to the subject matter of the application”, and so includes use by an applicant of his mark before the conflicting mark was registered or used. The present case involves use by the applicant of the suit mark before the opponent’s registered mark was ever put to use in Hong Kong up to the application date.

80. In an unreported decision of the Registrar in *Miss Elaine Trade Mark*, K.S. Kripas, 7 December 2001, it was observed by the hearing officer as follows :

“62. The second circumstance is that the opponent has failed to establish that it has used its registered mark on sleepwear (being the goods of interest to the applicant) before the application date, or at all. That was not a factor I could consider in the context of the section 20(1) opposition, which must be decided on notional use. In the context of the discretionary power which I have, if special circumstances are proved, to allow concurrent registration I have no such fetter. It must be a “special circumstance” that the mark, with which the opponent may block registration, is a mark that was not in use in the period between its registration and the application date.”

81. In my opinion, the same special circumstance exists in the present case in that the opponent’s registered mark, with which the opponent may block registration of the suit mark under section 20, is a mark that was not in use in the period between its registration and the application date whereas the applicant had continuously used the suit mark in respect of spectacles and sunglasses in Hong Kong from 1992 to 1996. I therefore consider that the applicant has established “special

circumstances” within the meaning of section 22 that it would be proper to allow onto the register the suit mark in respect of spectacles and sunglasses in the face of the opponent’s registered mark.

Under section 12(1)

82. The parties have not made any substantial submissions under this ground of opposition. I should say that even if the opponent can overcome the threshold in mounting a section 12(1) opposition by its use of the opponent’s marks in relation to clothing items and accessories (see paragraph 70 above), I do not consider that the suit mark is confusingly similar to any of the opponent’s marks in actual use. Neither do I think that there is a reasonable likelihood of confusion and deception between use of the suit mark in relation to spectacles and sunglasses and the opponent’s marks for clothing items and accessories.

Under section 13(2)

83. 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.

84. 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 so far as spectacles and sunglasses are concerned.

Conclusion

85. I find that the applicant, by virtue of the provisions of section 22 of the Ordinance, has defeated the opposition under section 20 in relation to spectacles and sunglasses. The opponent has succeeded in its opposition under section 20 in relation to the remaining goods covered by the specification of the present application. It follows that the suit mark is acceptable for registration in Part A of the register in Class 9 in respect of spectacles and sunglasses.

86. As each party has succeeded in part, I consider each party should bear its own costs. Accordingly, I make no order as to costs.

Original signed

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