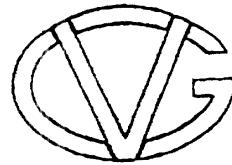


Application No. 4716 of 1997

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 B of the Register in Class 42

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 10 April 1997 (“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 B of the register in Class 42, the trade mark, a representation of which appears below :



**GIOVANNI VALENTINO**

(“the suit mark”).

2. The services intended to be covered by the registration were “retailing of clothing, footwear, headgear, precious metals and their alloys and goods in precious metals or coated therewith, jewellery, precious stones, horological and chronometric instruments, leather and imitation of leather and goods made of these materials, animal skins, hides, trunks and travel bags, umbrellas, parasols and walking sticks, whips, harness and saddlery, electric, photographic, optical, weighing and measuring apparatus for recording, transmission or reproduction of sound or images, recording discs, calculating machines, data processing equipment and computers, bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, textile and textile goods, bed and table covers, carpets, rugs, mats and other materials for covering existing floors, walling hangings (non-textile), tobacco, smokers' articles, matches, hand tools and implements (hand operated), cutlery, side arms, razors, furniture, mirrors, picture frames, goods of wood, cork, reed, cane, wicker, horn, bone, ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics, household or kitchen utensils and containers (not of precious metal or coated therewith), combs and sponges, brushes (except for paint brushes), brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware, games and playthings, gymnastic and sporting articles,

decorations for Christmas trees; all included in Class 42” (“the specified services”). The Registrar of Trade Marks (“the Registrar”) accepted the suit mark for registration in Part B of the register. 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 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. 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. 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.

## **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 grounds under sections 12(1) and 20 of the Ordinance for the present opposition proceedings.

Under section 20(2)

10. At the application date, section 20(2) of the Ordinance, insofar as it relates to services, provided :

“(2) Except as provided by section 22, no trade mark relating to services shall be registered in respect of any services or description of services 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 services;
- (b) the same description of services; or
- (c) goods or a description of goods which are associated with those services or services of that description.”




*Whether the specified services and goods of the opponent's registered marks are associated*

11. Under section 20(2), the two issues for my determination are, whether the services for which the suit mark is sought to be registered, associated with the goods covered by 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.

12. For the first issue, under section 2(3) of the Ordinance, goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business.

13. Mr Ling for the applicant submitted that the opponent does not have a registration for a retail service mark, but he conceded that the opponent has registered a number of marks for goods which can be said to be “associated with” the specified services for the purpose of section 20(2)(c). A number of the opponent's registered

marks would fall into this category, including the following four registrations in classes 9, 14, 18 and 25 :-

| Trade Mark  | Registration No. | Date of Registration | Class | Goods  |
|---|------------------|----------------------|-------|--|
| <br>valentino garavani<br><br>(Registration of this trade mark shall give no right to the exclusive use of the letter “V”) | 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. |
| valentino<br>  | 8441 of 2001     | 5.3.1991             | 14    | jewellery, watches.  |
| <br>valentino garavani<br><br>(Registration of this trade mark shall give no right to the exclusive use of a letter “V”) | 4866 of 1994     | 13.9.1991            | 18    | leather and imitations of leather and goods made of these materials and not included in other classes.   |
| <b>VALENTINO GARAVANI</b>   | B5009 of 1993    | 27.12.1989           | 25    | clothing, footwear, headgear.  |

14. So far as the first issue is concerned, it is sufficient for the “associated with” test if any of the services covered by the application are “associated with” any of the goods covered by a registered mark of the opponent. It does not matter if most of the services covered by the application or most of the goods covered by the prior registered mark are not “associated with” each other if there is a small residue which is (*BENSYL Trade Mark* [1992] RPC 529 at 531 and paragraph 10-11 of *Kerly’s Law of Trade Marks and Trade Names*, 12<sup>th</sup> Edition).

15. Therefore, it suffices for me to consider whether the suit mark is prohibited from registration on the basis of any of the above opponent's registered marks. I shall proceed to consider the opponent's registered mark of registration no. 4866 of 1994 in class 18 only. The second issue for my determination under section 20(2) is whether the suit mark so nearly resembles this opponent's registered mark as to be likely to deceive or cause confusion.

*Comparison between the suit mark and the opponent's mark of registration no. 4866 of 1994*

16. 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



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

17. 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*, supra, paragraph 17-03).

18. Before proceeding to the comparison of the marks, I would mention that as stated in the table in paragraph 13 above, the registration of the opponent's mark in class 18 is subject to a disclaimer that there is no right to the exclusive use of a 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.

19. 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.

20. As far as the device elements 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.

21. 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.

22. 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”.

23. 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".

24. Side by side comparison is not the test. In *Sandow (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".

25. 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.

26. 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.

27. Whilst 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 GARAVANI” rather than by the devices in speech when they refer to or request for the parties’ services and 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*

28. There is no evidence of what the ordinary purchasers in Hong Kong might think if they encounter any of the specified services provided with reference to the suit mark. In the absence of such evidence, I must substitute myself as one who might be a potential customer of the specified services (see *Re GE Trade Marks* [1973] RPC 297 at 321-322). The goods covered by the opponent’s registered mark of registration no. 4866 of 1994 are “leather and imitations of leather and goods made of these materials and not included in other classes” and the specified services in relation to the suit mark include, among other services, “retailing of leather and imitations of

leather and goods made of these materials”. I think the opponent’s goods and the applicant’s services are closely associated as it is quite common for manufacturers of leather goods to diversify into the business of retailing of these goods by opening shops or other retail outlets under the same trade mark or name. The nature, trade channels and target consumers of the goods and services are more or less the same.

29. Having taken into account the similarities between the marks and all the circumstances of the trade, I have come to the view that a substantial number of consumers of the specified services, with a passing familiarity with the opponent’s registered mark, would be reasonably likely, upon seeing the suit mark applied to the specified services, to be caused to wonder whether both come from the same source. It follows that there is a tangible risk of deception or confusion among the consumers of average intelligence taking ordinary care. I therefore find that the applicant has not 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(2) of the Ordinance succeeds.

30. Section 20(2) of the Ordinance makes express reference to the exception provided by section 22 as regards honest concurrent use. Despite evidence has been filed by the applicant under Rule 26 in the present case, Mr Ling for the applicant indicated at the hearing that the applicant does not seek to rely on section 22 in case the opposition succeeds under section 20(2). It follows that there is no need for me to consider section 22.

Under section 12(1)

31. Having decided that the opposition succeeds under section 20(2), I do not think I need to consider the opposition under this section.

Under section 13(2)

32. As the opponent has succeeded in the opposition under section 20(2), the exercise of my discretion under section 13(2) of the Ordinance does not arise.

Costs

33. The opponent 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 applicant pays the costs of these proceedings.

34. 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