

Application No. 13032 of 1997

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

AND

IN THE MATTER of an application by  
Valentino S.p.A. to register the mark

**VALENTINO**

in Part A of the Register in Class 3

AND

IN THE MATTER of an opposition  
thereto by Florence Fashions (Jersey)  
Limited

**DECISION  
OF**

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

Appearing : Mr Paul Carolan instructed by Messrs. Deacons for the applicant.

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

## **Application for Registration**

1. On 11 September 1997 (“the application date”), Valentino Globe B.V. applied to register, pursuant to the provisions of the Trade Marks Ordinance Cap. 43 (“the Ordinance”), in Part A of the register in Class 3, the trade mark, a representation of which appears below :

**VALENTINO**

(“the suit mark”).

2. Valentino S.p.A. (“the applicant”) was granted leave to substitute as the applicant on 17 January 2005. The goods intended to be covered by the registration were “soaps; perfumes, colognes, eau de toilette, essential oils, cosmetics; non-medicated toilet preparations; skin creams and lotions, preparations for the bath and shower, talcum powders; preparations for the hair, dentifrices; anti-perspirants, deodorants for personal use” (“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 20 April 2001.

## **Pleadings and evidence**

3. On 20 August 2001, Florence Fashions (Jersey) Limited (“the opponent”) filed notice of opposition to the application. The grounds of opposition state that the opponent is a corporation organised and existing under the laws of Channel Islands. The opponent is the proprietor of the trade marks “GIOVANNI VALENTINO”, “GIANNI VALENTINO”, “華倫天奴” and/or other trade marks including the word “VALENTINO” and/or the Chinese characters “華倫天奴” which have been used in Hong Kong and elsewhere in respect of, *inter alia*, products falling in class 3 but not limited to cosmetics, soaps, perfumes, perfumery, essential oils, hair lotions and hair products (“the opponent’s goods”). The opponent and its predecessor-in-title have used the aforesaid opponent’s marks in Hong Kong for over ten years in respect of the opponent’s goods. The opponent has used and/or registered and/or applied for registration of the opponent’s marks in various countries worldwide in respect of the opponent’s goods and/or goods of similar descriptions and/or services other than those

falling in class 3. The opponent asserts that by virtue of such extensive use, registrations, sales and promotions, as well as the high standard of quality maintained by the opponent for the goods marketed and services provided under the opponent's marks, they have become distinctive of the opponent and have come to be identified exclusively with the opponent and its goods and/or services.

4. It is the opponent's case that the suit mark is both visually and phonetically identical to or so nearly resembles the opponent's marks that its use would be likely to deceive or cause confusion and/or would be disentitled to protection in a court of justice. The grounds of opposition comprise sections 2(1), 9, 10, 12(1), 13 and 23 of the Ordinance.

5. In the counter-statement, save and except that the opponent'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.

6. Trade Marks Rules, Cap. 43, Sub. Leg. ("Rule/s") 25 evidence consists of a statutory declaration from Annabella Immacolata Norris, the sales manager of the opponent, together with exhibits, which was declared on 5 May 2003 ("Norris' statutory declaration"). Under Rule 26, the applicant filed a statutory declaration of Michele Norsa, the managing director of the applicant, together with exhibits, which was declared on 30 March 2005. Under Rule 27, the opponent filed two statutory declarations in reply declared by the same Annabella Immacolata Norris on 30 June and 12 September 2006 respectively. Under Rule 28, leave was granted to the applicant to file a statutory declaration from Antonella Andrioli, the general counsel of the applicant, declared on 26 May 2009.

## **Decision**

7. Though, by 1 June 2009, the date 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.

8. Although a number of grounds were pleaded in the grounds of

opposition, Mr Ling for the opponent indicated at the hearing that the opponent only relies on the grounds under section 12(1) of the Ordinance for the present opposition proceedings.

Under section 12(1)

9. Section 12(1) of the Ordinance provides that it shall not be lawful to register the trade mark or part of a trade mark any matter the use of which would be likely to deceive or would be disentitled to protection in a court of justice.

10. Before an opponent can invoke section 12(1), it must establish a certain degree of reputation in Hong Kong of its mark. At its very highest, it is a question of a substantial proportion of the interested public being aware of its mark, and at its very lowest, the question relates to the significance of the numbers in relation to the market for particular goods. In any event, the reputation of the opponent must be something more than *de minimis* (*Re Da Vinci Trade Mark* [1980] 9 RPC 237). The date at which this reputation in its mark or marks is to be established is the date of the application to register the suit mark, namely 11 September 1997 – *NOVA Trade Mark* [1918] RPC 357 at 360.

11. Mr Carolan for the applicant submitted that although in paragraph 8 of Norris' statutory declaration, Ms Norris asserts use of the trade marks "GIOVANNI VALENTINO", "GIANNI VALENTINO" and/or other trade marks of and containing or incorporating the word "VALENTINO" on class 3 goods in Hong Kong since 1991, the materials exhibited do not support the assertion. Mr Carolan pointed out that exhibit "AIN-4" to Norris' statutory declaration contains the Hong Kong sales invoices relied on by the opponent. The earliest one dates back to April 1994, not 1991. For all the invoices dated from 1994 to 1998, there is no indication showing that any of the goods referred to in the invoices bore any of the opponent's marks. They are simply sales invoices with no identifying trade mark in relation to the goods. There is no corroborating evidence in the form of documents relating to the goods themselves or packagings of the goods which show the use of the opponent's marks.

12. Further, Mr Carolan submitted that all the invoices appear to be issued by the opponent to its client (buyer or consignee) which is either "Foron Company Limited" or "World Pride (HK) Ltd" at the office addresses in Hong Kong. They only serve to prove that sales had been made to the two companies which were in

Hong Kong by the opponent. The two Hong Kong companies do not appear to be retailers. There is no evidence of any retailing activities in Hong Kong. The goods may be sold to the two Hong Kong companies for transshipping to somewhere else, for example, Mainland China. It is important to bear in mind that all the advertising materials concern only Mainland China.

13. Mr Carolan submitted that exhibit “AIN-5” to Norris’ statutory declaration contains sample advertisements and promotional materials said to be issued to the trade and public in Hong Kong which show samples of the goods. Mr Carolan pointed out that these include photos of some hair products with the opponent’s mark “GIOVANNI VALENTINO & device”, a representation of which appears below :



14. Mr Carolan contended that all the advertising materials are in simplified Chinese characters indicating publication and use of the products in Mainland China and not in Hong Kong. In particular, one can discern from the materials that some sort of beauty show was promoted “nationwide” by Guangzhou Television. It is hard to see how any of these materials is supposed to show sales of the opponent’s goods bearing the “GIOVANNI VALENTINO & device” mark in Hong Kong at all.

15. Mr Carolan went on to attack the opponent’s evidence that while the opponent claims significant Hong Kong sales in the years 1994 to 1998 in paragraph 9 of Norris’ statutory declaration, it is unclear whether the figures are limited to class 3 goods or extend to sales of other or all goods with the opponent’s “GIOVANNI VALENTINO & device” mark in Hong Kong. In any event the stated figures are not supported by the opponent’s evidence as produced in exhibits “AIN-4” and “AIN-5” to Norris’ statutory declaration. Similarly there is no material at all to show the sums claimed to have spent on advertising as per paragraph 11 of Norris’ statutory declaration are real. The extent of advertising which may be suggested by the exhibit “AIN-5” evidence is very limited and, as pointed out earlier, concerns only the Mainland China, not Hong Kong. Mr Carolan submitted that if the sales invoices in exhibit “AIN-4” did concern relevant sales in Hong Kong, there should be other Hong

Kong documents showing samples of the goods concerned and advertising and promotional materials circulated within Hong Kong before the application date. Nevertheless, there is nothing of the sort as disclosed in the opponent's evidence. In conclusion, Mr Carolan submitted that the opponent is not able to overcome the threshold to trigger section 12(1) of the Ordinance.

16. By way of background, I should mention that the present opposition was heard together with six other oppositions in which the applicant and the opponent are the relevant parties as per the parties' joint request made in the past. Before making his reply submissions in relation to the present opposition, Mr Ling for the opponent sought to make submissions on the opponent's reputation of its marks in Hong Kong by relying on the evidence filed in the other cases. His request was strongly objected to by Mr Carolan. I refused Mr Ling's request as although the cases are heard together, each of the seven cases is an independent opposition with its own pleadings and evidence. Mr Ling then, after a short adjournment, indicated at the resumed hearing that he would make no submissions in relation to the present opposition and he also asked me to disregard the written submissions filed by him prior to the hearing.

17. Having carefully considered the evidence filed by the opponent including Norris' statutory declaration together with the exhibits and taking a fair appraisal of the same, I agree with Mr Carolan that the sales invoices produced by the opponent only serve to prove that there had been sales to two Hong Kong companies by the opponent in respect of a mixture of goods including but not limited to class 3 goods during the period from 1994 up to the application date. However, the fundamental problem with these sales invoices is that there is no indication from these invoices or any other documents that the goods referred to in the sales invoices were goods bearing any of the opponent's marks. Even taking the opponent's case to its highest and assuming that the sales invoices concern goods bearing any of the opponent's marks, there is no evidence of any retailing sales in Hong Kong and the opponent's marks were only known to two Hong Kong companies in Hong Kong at the application date. The advertising materials in exhibit "AIN-5", as pointed out by Mr Carolan, are all in simplified Chinese characters which do not appear to have been circulated within Hong Kong. Most of them are undated except one which is dated 1999 being post-application date.

18. In my judgment, the evidence which has been submitted by the opponent

to establish an alleged reputation in Hong Kong for any of its marks whether by way of use or advertising goes nowhere to showing such reputation at the application date. It follows that the opponent has not done enough to trigger off section 12(1) of the Ordinance. I therefore hold that the section 12 opposition is defeated.

Under section 13(2)

19. The discretion under section 13(2) arises when the opponent has failed in its opposition under section 12(1) of the Ordinance and the suit mark is registrable under either section 9 or 10 of the Ordinance.

20. 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 reasons can be advanced as to why registration should be refused for a qualifying mark, the exercise of discretion should not be adverse to the applicant. I therefore decline to exercise my discretion adversely to the applicant.

Costs

21. 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.

22. 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