

O-615-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3166119  
IN THE NAME OF ISRAEL IMARNI

AND

OPPOSITION THERETO UNDER NO 407419  
BY MARNI GROUP S.R.L.

## Background

1. Application No 3166119 has a filing date of 23 May 2016 (“the relevant date”), stands in the name of Israel Imarni (“the applicant”) and seeks registration of the following trade mark in Class 25 for *Clothing, footwear and headgear*:

The trade mark consists of the words 'ISY' and 'IMARNI' in a tall, thin, sans-serif font. The letters are widely spaced, and the 'I' in 'IMARNI' is particularly tall. The text is enclosed in a thin vertical rectangular border on the right side.

2. Following publication in the *Trade Marks Journal* on 17 June 2016, a notice of opposition was filed by Marni Group S.R.L. (“the opponent”). There are two grounds of opposition:

- Under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) in support of which the opponent relies on its European Union trade mark (“EUTM”) 1756048, MARNI, which has a filing date of 14 July 2000 and was entered in the register on 3 January 2008. The opponent relies on this EUTM insofar as it is registered for *Clothing, footwear, headgear*;
- Under section 5(4)(a) of the Act based on use in the UK since November 2001 in respect of clothing, footwear and headgear of the following mark:

The trade mark consists of the word 'MARNI' in a bold, sans-serif font. The letters are widely spaced, and the 'I' is particularly tall. The text is enclosed in a thin vertical rectangular border on the right side.

3. The applicant filed a counterstatement in which she neither denied nor admitted any particular point but in which she referred to a number of differences between the respective marks. I proceed on the basis that she denies each of the claims made.

4. Both parties filed evidence which I have read and will refer to as necessary in this decision. A hearing took place before me on 9 November 2017. The opponent neither attended nor was represented at that hearing nor did it file written submissions in lieu of attendance. The applicant attended in person. Following the hearing, the applicant emailed the Tribunal (16<sup>th</sup> and 23<sup>rd</sup> of November) with further submissions and attached documents. Whilst it appears she copied this material to the opponent’s professional representatives, they have not commented upon it. I

have reviewed the material de bene esse but I have not taken this material into account. This is because the applicant did not seek leave to file any additional evidence and because the hearing afforded her the opportunity to put forward any final submissions over and above those already made during the course of proceedings. I would point out, however, that had I taken the contents of her emails into account, it would have made no material difference to my decision.

### **The objection under section 5(2)(b) of the Act**

5. Section 5(2)(b) of the Act states as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

6. As can be seen from the respective dates set out above, the opponent’s EUTM relied upon under this ground is an earlier one within the meaning of section 6 of the Act. Despite its having been registered for more than five years at the date of publication of the application, the applicant did not put the opponent to proof of use of its earlier EUTM. The opponent is therefore entitled to rely on it in respect of each of the goods as set out in its notice of opposition.

7. In determining whether there is a likelihood of confusion, I note the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

## **The principles**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the respective goods**

8. The respective specifications of goods are each for *clothing, footwear and headgear* and thus the respective goods are identical.

### **The average consumer and the nature of the purchasing process**

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade.

10. The opponent submits that its goods are ““high end” expensive fashion wear which have been available at prestigious stores...” however, this is of no relevance to my consideration of who the average consumer might be. As the General Court (“GC”) stated in *Bang & Olufsen A/S v OHIM*, Case T-460/05:

“According to the case-law, the price of the product concerned is also immaterial as regards the definition of the relevant public, since price will also not be the subject of the registration (Joined Cases T-324/01 and T-110/02 *Axions and Belce v OHIM* (Brown cigar shape and gold ingot shape) [2003] ECR II-1897, paragraph 36).”

11. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12. In its decision in *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, the GC stated:

“50. The applicant has not mentioned any particular conditions under which the goods are marketed. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

13. The goods at issue are clothing, footwear and headgear. The average consumer of these goods is a member of the general public. As such goods, for the most part, will be obtained by self-selection i.e. from the shelves of a bricks and mortar retail outlet or from the equivalent pages of a website or catalogue, visual considerations are likely to dominate the selection process. That said, as such goods may also be the subject of, for example, word-of-mouth recommendations or oral requests to sales assistants, aural considerations must not be forgotten. As to the degree of care the average consumer will display when selecting such goods, the cost of the goods can vary considerably, however, as the average consumer will be alive to factors

such as cost, size, colour, material and compatibility with other items of clothing, they will pay at least a normal degree of attention to their selection.

**Comparison of the respective marks**

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

15. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

The earlier EUTM	The application
MARNI	SY  MARNI

16. The EUTM relied upon by the opponent consists of the single word MARNI. Presented as it is as a single word in plain block capitals, its distinctiveness rests in its whole.

17. The mark applied for consists of the two words ISY and IMARNI presented in upper case letters with the initial letter “I” of each word in elongated form. The overall impression the mark conveys, and its distinctiveness, lie in the unit the combination the two words create with the elongation of the initial letters of each word adding slightly to that distinctiveness.

18. There are some visual similarities between the respective marks in that the five letters that make up the opponent’s mark appear in the same order as the last five of the six letters which make up the second word in the applicant’s mark. There are also some visual differences in that the first word of the application has no equivalent in the opponent’s mark and the second word starts with a letter I. The initial letters of each word making up the applicant’s mark are also elongated which has no equivalent in the opponent’s mark. In relation to this, the opponent submits:

“...the visual presentation of the elongated initial “I” in IMARNI places more emphasis on the remaining letters MARNI.”

19. For her part the applicant submits:

“The visual representation of the elongated “I” places more emphasis on the “I” alone and not the “m” as the opponent suggests. A distant view would have the two “II” initials emphasised above all other text.”

20. It is not unusual for initial letters of words to be bigger than the remaining letters of which the word is composed, though perhaps it is less common where each letter is capitalised as is the case here. In this case, however, it is the initial letters of both words making up the applicant’s mark that have been elongated. This adds to the cohesiveness of the mark as a whole and points away from the emphasis the opponent has put forward.

21. When considered as wholes, I find the respective marks have a medium degree of visual similarity.

22. In its notice of opposition, the opponent submits:



“In the combination of ISY and IMARNI, the effect of the letter “Y” in the Applicant’s sign when spoken is to render the initial letter “I” of IMARNI silent.

23. In her counterstatement, the applicant submits:

“The letter “Y” does NOT render the “I” in Imarni silent, it acts on the contrary to give additional accentuation to this “I”. The “Y” sound at the end of “Isy” forces a pause and therefore accentuates the following “I” above the remaining letters in the surname.”

24. The opponent’s mark is made up of two syllables which will be pronounced MAR-NEE. The applicant’s is made up of five syllables which will be pronounced IS-EE-I-MAR-NEE. I therefore disagree with the opponent when it says the initial letter of the word IMARNI will be silent and agree with the applicant to the extent that the fact the first word ends in a “Y” and the second starts with an “I” “forces a pause”. Taking the respective marks as wholes and recognising that the elongation of the initial letters of the two words making up the application will not affect its pronunciation, I find they also have a medium degree of aural similarity. Again, this stems from the commonality of the letters M-A-R-N-I in the same order within each mark.

25. As to the conceptual position, in his witness statement, Sig. Ubaldo Minelli, the opponent’s Chief Executive Officer, submits:

“The name MARNI conveys the impression to the average British person of being an Italian surname (compare other well-known Italian surnames ending in “I”: ...)”

He lists a number of such surnames including Marconi, da Vinci and Tonioli but gives no indication of how he reaches his view of what the average consumer would make of the mark. That there may be a number of Italian surnames which end in the letter “I” does not mean, of itself, that any word ending in that letter will be taken, by the average UK consumer, to be an Italian surname. For example, the words “antipasti” and “graffiti” are of Italian origin and have been adopted into English usage but

would not be recognised as surnames. And surnames from many other countries may also end in the letter “l” e.g. Doshi, Mori. Additionally, I am aware that Marni is a female forename e.g. Marni Nixon though, without evidence on the point, I do not accept, as the applicant submitted at the hearing, that it is a common one. In her counterstatement, the applicant makes various submissions regarding surnames and/or forenames and combinations thereof but does not dispute the opponent’s claim that Marni would be seen as a surname. Indeed, at the hearing she accepted that it would be seen as a surname though did not accept it was or would be seen as an Italian surname. She submitted that ISY was used as an abbreviated form of her forename and I am aware that is also used in the same way for the female forename Isabel and its alternate spellings. As the use of names is not uncommon in the clothing etc. trade, I proceed on the basis that the opponent’s mark is most likely to be seen as a surname of foreign origin whilst the applicant’s mark will be understood as consisting of a full name referring to a specific individual.

#### **The distinctiveness of the earlier mark**

26. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

27. Sig. Minelli has provided evidence of the use of the earlier mark. From this evidence, the following facts emerge:

- The mark was first used in the UK in 2000 and use has been continuous since that date;

- By the filing date of the application, goods under the mark were available from four London outlets (Marni Sloane St, Marni Mount St, Selfridges Oxford St and Harvey Nichols Knightsbridge) as well as other suppliers such as Bicester Village, Kurt Geiger, Liberty Retail Ltd, The Conran Shop Ltd and Net-a-Porter Group Ltd;
- UK sales figures for clothing bearing the mark for the years 2013-2016 (most of the latter year will post-date the relevant date) range between £5.2m (2014) and £7.8m (2015);
- The mark was promoted in various UK publications between 2000 and 2016. Examples are shown in Exhibit UM3 and include advertising material in magazines such as *Vogue*, *Red* and *Esquire* as well as in supplements to newspapers such as *The Guardian* and *The Sunday Times*. Though primarily advertising clothing etc. for women, they also advertise such goods for men (e.g. pp92 and 143);
- Advertising spend is given as approx. £140k in 2015 and £229k in 2016. How much of the latter figure relates to the period before the relevant date is not detailed. The applicant casts doubt on these figures, submitting that they are not substantiated and much of the extracts shown at UM3 “only show free editorials”, however, at the hearing, she accepted that the opponent’s goods had been promoted under its mark in various magazines and newspaper supplements;
- Exhibited at UM4 are sample invoices. These all bear the earlier trade mark, date from between 2000 and 2016 and list various items of clothing including underwear, outerwear and swimsuits as well as boots, shoes, sandals and hats.

28. The opponent’s trade under the mark in the UK is not insignificant of itself but there is no evidence which shows the size of the relevant market in the UK (which is likely to be huge) or the opponent’s position within it (which is likely to be very small). The earlier mark has an average degree of inherent distinctive character but I am unable to say that it will have been enhanced to any material degree through its use.

### **The likelihood of confusion**

29. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependence principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As indicated above, I must also keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must rely instead upon the imperfect picture of them he or she has retained in mind. Earlier in this decision I found:

- The respective goods are identical;
- The average consumer is a member of the general public who will select the goods at issue predominantly by visual means whilst paying a normal degree of attention during the selection process;
- The overall impression conveyed by the opponent's trade mark, and its distinctiveness, lie in the word itself;
- The overall impression conveyed by the applicant's trade mark, and its distinctiveness, primarily lie in the unit created by the combination of the two words of which it is composed;
- The competing trade marks are visually and aurally similar to a medium degree;
- The opponent's trade mark will be seen as a surname of foreign origin whereas the applicant's trade mark will be understood as a reference to a specific individual;
- The opponent's trade mark is possessed of an average degree of inherent distinctive character which has not been shown to have been enhanced through use to any material degree.

30. In his witness statement, Sig. Minelli submits:

"It is commonly known not only by people such as myself experienced in the fashion industry but also by the general public, hat [sic] when an individual

chooses to use his or her own name as a fashion label, it is frequently the case that the individual chooses to use his or her surname without the forename as the label brand. This is usually because a person's surname is more distinctive for fashionwear than is the forename. This being the case, I am concerned that ISY IMARNI would be regarded as a derivative of the established name MARNI, this latter fashion label giving the impression of being use of a surname without the person's forename."

Sig. Minelli goes on to give what he says are "well known examples of fashion labels deriving from an individual's name where the surname is used alone" which include Boss, Hillfiger and Versace. He continues:

"Sometimes....a fashion brand consisting of an individual's name is known by just the forename (particularly where the forename is distinctive)."

31. In her counterstatement, the applicant submits:

"It is not the case that all fashion designers are known by their surname it is for the designer to specify their preference when establishing their brand. It is not uncommon, where abbreviations are made, for the brand to be referred to by their forename. Additionally, a number of brand names are never abbreviated."

32. I see no reason why the applicant's mark would be seen as "a derivative" as submitted by Sig. Minelli and, in any event, I have to consider the likelihood of confusion between the respective marks as registered (the opponent's mark) and applied for (the applicant's mark).

33. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for

which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

34. I have found that the commonality of the combination of letters MARNI in the competing trade marks leads to a medium degree of visual and aural similarity between them. Neither these letters, nor indeed the word IMARNI within the applicant’s trade mark, have a distinctive significance independent of the whole. I do

not consider their mere presence in the “unit” the applicant’s trade mark creates would lead to a likelihood of either direct or indirect confusion. As a consequence, the opposition fails and is dismissed accordingly.

### **The objection under section 5(4)(a) of the Act**

35. The objection under this ground can be dealt with briefly. The mark relied on under this ground consists of the word MARNI in unremarkable capital letters. Given my findings as to the likelihood of confusion based on the opponent’s earlier mark which also consists of the word MARNI in unremarkable capital letters, the opponent cannot be in any better position under this ground than that which I have already considered. There would be no misrepresentation.

### **Summary**

36. The opposition fails.

### **Costs**

37. The applicant has succeeded and is entitled to an award of costs in her favour. She filed a Cost Pro Forma giving details of the time spent defending her application, however, as I pointed out at the hearing, the figures did not appear to add up. I therefore allowed her a period of seven days to resubmit the Pro Forma and copy it to the opponent which I would then take into account should she succeed in defending her application.

38. The form was resubmitted within the period allowed and claims a total of 57 hours’ work. In terms of the forms filed, the applicant claims a total of 19 hours, 7 spent on the notice of opposition, 6 on the notice of defence and 6 on considering “other” forms filed by the opponent. The opponent, however, did not file any forms other than the notice of opposition. The applicant also claims to have spent time reviewing opposition documents and has made two separate entries for 14 and 7 hours respectively. The former appears to relate to the time spent reviewing the opponent’s evidence when filed, the latter to reviewing the documents filed by the opponent as part of her preparation for the hearing. This latter period seems to me to be somewhat excessive. Finally, the applicant claims some 17 hours for “collating”

her defence which again seems to me to be somewhat excessive given the nature of that defence and the content of the evidence filed.

39. Taking all matters into account, I consider the applicant is entitled to an award of costs to reflect a total of 40 hours' work in defending her application.

40. During the course of proceedings, I held a case management conference ("CMC"). That CMC was appointed with a view to ensuring that proceedings continued without undue delay and mindful of costs following the applicant's concerns about the filing of the opponent's evidence. It afforded the opportunity to explain various aspects of practice and procedure to the applicant given that she was not professionally represented. In the circumstances, I do not consider it appropriate to make an award of costs to the applicant in respect of the CMC.

41. Under the Civil Procedure Rules, the amount which may be allowed to a self-represented litigant is set at a rate of £19 per hour. I therefore order Marni Group S.R.L. to pay Israel Imarni the sum of £760. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 1<sup>st</sup> day of December 2017**

**Ann Corbett**

**For the Registrar**

**The Comptroller-General**