

Summary

The IPO has upheld an opposition based on s.5(2)(b), 5(3) and 6(1) (c) of the Trade Marks Act 1994 ("the Act") on the basis that the opponent's ARMANI mark possessed a strong reputation and distinctive character, and that the applicant was trying to 'ride on its coat-tails'.

Background

In January 2012 Jacob Armani filed an application to register the following mark ("BA mark") for 'strollers; buggies; safety car seats for children' in class 12 and 'cribs; high chairs; baby walkers; bouncing seats; baby rocking chairs; sleeping bags for baby and children; carry cots' in class 20:



BENJAMIN ARMANI

Giorgio Armani S.p.A. opposed the application under s.5(2)(b) and 5(3) of the Act. The opponent also claimed that its ARMANI mark was a well-known mark under section 56 of the Act, and that the application should be refused under s.5(2)(b) and 6(1)(c).

Under s. 5(2)(b) the opponent relied on the following trade marks for the following respective goods:

- UK designation of WIPO registration ("EA7 ARMANI mark"), covering 'vehicles; apparatus for locomotion by land' in class 12.
- UK trade mark registration of ARMANI covering 'furniture; goods (not included in other classes) of wood or substitutes for this material, or of plastics' and
- UK designation of WIPO registration of ARMANI covering 'vehicles; apparatus for locomotion by land' in class 12 and 'furniture; goods, included in this class, made of wood or substitutes for this material, or of plastics' in class 20.



Under s.5(3) the opponent relied on a CTM registration of ARMANI covering 'clothing, footwear, headgear' in class 25.

The opponent filed a witness statement in support of the opposition. It stated that the company had a turnover of over a billion and a half euros a year, 5,800 direct employees and 12 factories. Numerous other documents were filed in support of the opposition, such as turnover and advertising figures, marketing material and use of the marks.

The IPO found that all the goods covered by the earlier marks were similar to those covered by the application, except for 'sleeping bags for baby and children'.

It found that the average consumer would be a parent or person caring for children, who would only purchase these type of goods occasionally and therefore would pay a reasonably high degree of attention when selecting the goods in question.

In addition, it found that the word mark ARMANI would be seen by the average consumer as a foreign word, and was likely to be recognised as the surname of a famous clothes designer. Therefore, it was viewed as having a reasonably high degree of inherent distinctiveness.

It also viewed the earlier EA7 ARMANI mark as having a high degree of inherent distinctiveness, as the EA7 element was distinctive and the word EMPORIO would be viewed as a foreign word suggestive of the word EMPORIUM. In addition, it contained the distinctive word ARMANI.

The IPO considered that the BA and ARMANI marks were reasonably similar visually, phonetically and conceptually. However, it found that the BA and the EA7 ARMANI marks had a low degree of visual and aural similarity, but a slightly higher degree of conceptual similarity, owing to the fact that both marks contained the name of a person called Armani.

Taking into consideration all the factors, the IPO held that consumers would not directly confuse Mr Armani's mark with the ARMANI word mark or the EA7 ARMANI mark. However, it did consider that the average consumer was likely to believe that the applicant's mark and the opponent's marks came from the same undertaking or from economically linked undertakings on account of the common presence of the unusual surname ARMANI in all marks. Therefore, under section 5(2)(b) the opposition was successful in relation to 'cribs, carrycots, high chairs, baby rocking chairs, bouncing seats, baby walkers, strollers, buggies, and safety car seats for children' but not for 'sleeping bags for baby and children'.

Opposition Under S. 5(3)

As the earlier mark relied on by the opponent under s. 5(3) was a CTM registration, the opponent had to provide evidence of a reputation in the European Community. Numerous documents were submitted in support of this ground, such as The Armani Group Annual Report 2010 which confirmed brand development over the years. In addition, the figures submitted were high. The total turnover in the EU in 2009 was in excess of €608million and the total advertising expenditure in the EU for 2008 was in excess of €37million. The evidence submitted proved the mark ARMANI was being used in a range of sub-brands in advertising across the EU, including the UK, in the period from 2005 to 2010. It was apparent that the proportion of total sales and advertising expenditure accounted for by 'clothing, footwear and headgear' in the EU was substantial. No evidence of market share was provided, but the figures themselves confirmed that the opponent's ARMANI mark possessed a particularly strong reputation for 'clothing, footwear and headgear' among a significant part of the relevant public in the EU.

In addition to having a reputation for clothing, footwear and headgear, the IPO found that the opponent's ARMANI mark would, at the very least, be brought to mind when Mr Armani's mark was encountered, due to the similarities between the marks and the inherent distinctiveness of the earlier mark. Therefore, a link would be made between the respective marks under s.5(3).

The IPO pointed out that consumers were used to designer clothing brands extending use into other markets. In light of the strong reputation and distinctive character of the opponent's mark, the IPO believed that consumers would regard Mr Armani's mark as a sub-brand of the opponent's mark in relation to all goods covered by the application or would believe that the marks originated from the same undertaking or from economically linked undertakings; and that this case was an example of "riding on the coat-tails of a reputable mark", quoting *L'Oréal SA v Bellure NV* [2010] RPC 23 in support of this.

It also cited *Whirlpool Corporation and others v Kenwood Limited* [2009] which confirmed that use which is likely to be confusing would inevitably erode the distinctiveness of the ARMANI mark, and therefore would be detrimental to its distinctive character. As such, the opposition was also successful under section 5(3).

Although Mr Armani did not claim use of his own name as a defence, he referred to everyone's right to be able to use their own name to promote their business. On this point the IPO mentioned that Mr Armani's name was actually JACOB ARMARNI not BENJAMIN ARMANI. The IPO also stated that use of one's own name could only be used as a defence to infringement, and not to the provisions of s.5(3).

As the opposition was successful under s.5(3) no decision was necessary regarding the claim that the earlier mark was well known.

Costs of £1,200 were awarded to the opponent.

Comment

This case indicates the strength of a brand and that once a reputation has been built up and can be proved, it can be a powerful tool to prevent third parties from using a similar mark on both similar and dissimilar goods.

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