

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
APPLICATION NO: 2111058  
BY ANUCCI INCORPORATED  
TO REGISTER A TRADE MARK IN CLASS 3**

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### DECISION AND GROUNDS OF DECISION

On 24 September 1996 Anucci Incorporated of 3860 Del Amo Boulevard, Suite 402, Torrance, California 90503, USA applied under the Trade Marks Act 1994 to register the trade mark shown below in Class 3 in respect of "Fragrances, perfumery, cosmetics, soaps".



Objection was raised under Section 5(2)(b) of the Act in respect of the following registered trade marks:-

| <b>Registration No.</b> | <b>Mark</b> | <b>Class</b> | <b>Specification</b>   |
|-------------------------|-------------|--------------|--|
| 1454443                 | Yanucci     | 3            | Perfumes; toilet waters; eau de colognes; essential oils; cosmetics; toilet preparations; soaps; antiperspirants; deodorants; preparations for the hair; all included in Class 3 |
| 2009642                 | Anucci      | 21           | Cosmetic utensils; cosmetic bags; brushes, combs and sponges; shaving brushes; cosmetic bottles; perfume sprayers, vapourisers and atomisers                                     |

Notwithstanding arguments put forward in correspondence by the applicant's former trade mark agents S J Berwin & Co, the objection was maintained and following refusal of the application, I am now asked under Section 76 of the Act and Rule 56(2) of the Trade Marks Rules 1994 to state in writing the grounds of the decision and the materials used in arriving at it.

No evidence of use has been submitted, I have, therefore, only the prima facie case to consider.

Section 5(2)(b) of the Act reads as follows:-

(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.

Dealing first with the question of whether a conflict of goods exists, it is apparent that the goods of the application are included in the specification of citation number 1454443. That there is a clear conflict of identical goods cannot, therefore, be in dispute.

However, the goods of citation number 2009642 are not identical to those of the application and so I need to consider whether or not they are similar. In correspondence, the applicant's former agent argued that the Registry's manual "Guide to the Cross Searching of Trade Marks in the United Kingdom" does not state that there is a conflict between the applicant's goods and those included in the Class 21 specification of citation number 2009642. This is not disputed but as the title implies, the manual is a guide only. The view of the Registry is that each case must be considered on its own merits.

In addressing the question of whether or not the goods are similar, I bear in mind comments made by Jacob J in the TREAT trade mark case (1996 RPC 281) at page 296, line 25 et seq :-

"I think the sort of considerations the court must have in mind are similar to those arising under the old Act in relation to goods of the same description. I do not say this because I believe there is any intention to take over that conception directly. There plainly is not. But the purpose of conception in the old Act was to prevent marks from conflicting not only for their respective actual goods but for a penumbra also. And the purpose of similar goods in the Directive and Act is to provide protection and separation for a similar sort of penumbra. Thus I think the following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors”.

It appears to me that there can be no doubt that the users of the goods of the application are the same as for at least some of those contained in Class 21 of citation number 2009642. Members of the public who purchase goods such as perfumery and cosmetics are, in my view, equally likely to buy cosmetic utensils.

I am also of the opinion that the respective channels of trade are likely to be the same. Further, cosmetics, such as blushers or eye shadow, are commonly sold at the same counter in, say, a department store, as cosmetic brushes. In addition, cosmetics are often sold at the same counter as cosmetic bags which themselves often contain cosmetics.

It seems to me that stockists of such goods are likely to display them to the public side by side. I regard the matter as marginal but I find that the respective goods are similar.

Turning to the respective marks, since these are not identical, I must decide whether the mark of the application so nearly resembles the cited marks as to be likely to deceive or cause confusion.

In addressing the degree of resemblance between the applicant's mark and the cited marks, I adopt the test propounded by Parker J in the *PIANOTIST* trade mark case (1906) 23 RPC 774 at page 777, line 26 et seq:-

“You must take the two words. You must judge of them, both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case”.

I have also borne in mind the well established principle that although two marks, placed side by side, may exhibit many and various differences, the main idea left to the mind by both of them might be the same. As Lord Radcliffe stated in the case of *De Cordova and others versus Vick Chemical Company* (1951) 68 RPC 103 at page 106, lines 17-23:-

“The likelihood of confusion or deception in such cases is not disproved by placing the two marks side by side and demonstrating how small is the chance of error in any customer who places his order for goods with both the marks clearly before him, for orders are not placed, or are often not placed, under such conditions. It is more useful to observe that in most persons the eye is not an accurate recorder of visual detail, and that marks are remembered rather by general impressions or by some significant detail than by any photographic recollection of the whole”.

It seems to me that the mark of citation 1454443 is visually and phonetically similar to that of the application.

Although the mark of the application incorporates a highly stylised letter “A”, the word “Anucci” is extremely prominent and in my view is extremely similar visually to the word “Yanucci” being the cited mark. Clearly the only differences between the two words is the letter “Y” being the first letter of “Yanucci” and the slight stylisation of the word “Anucci” (which I consider to be insignificant) in the mark of the application. In correspondence, the applicant’s former agent argued that the addition of the “Y” totally changes the nature of the mark and eliminates any likelihood of confusion. Although I accept that the first letter of a word can, in some cases, clearly distinguish it from that of another word otherwise containing the same letters, I do not consider that to be the case here. Furthermore, it seems to me likely that the public would assume that the stylised “A” was included in the mark of the application merely because “A” is the first letter of the word “Anucci”. Consequently, in my view, the mark would be seen as being essentially an “Anucci” mark and that with imperfect recollection, the public could easily be confused as to the origin of the respective goods, which as I have already noted are identical.

It also appears to me that the two marks are phonetically very similar. I consider the “Y” at the beginning of “Yanucci” to be a soft sounding letter making it extremely difficult to phonetically distinguish the words “Anucci” and “Yanucci”. I conclude that the degree of resemblance of the marks is such that, if used on identical goods, there is a likelihood of confusion.

Turning now to cited trade mark 2009642, it is clear that the only differences between the two marks is the slight stylisation of the word “Anucci” (which as I have already said, I consider to be insignificant) and the inclusion of a highly stylised “A” in the mark of the application. In this regard I would re-iterate my comments made in relation to citation number 1454443. As mentioned earlier the word “Anucci” is extremely prominent and, in view of this, I am in no doubt that this mark is very likely to be confused with that of citation number 2009642.

I further find that the degree of resemblance between citation number 2009642 and the applicant’s mark is so great, that even though the goods are at the margins of similarity, there is a real risk of public confusion.

In this decision I have considered all the documents filed by the applicant and all the arguments submitted in relation to this application and, for the reasons given, it is refused under the terms of Section 5(2) of the Act.

Dated this 10th day of February 1998

J. D. HAMILTON-JONES  
For the Registrar  
The Comptroller General