

**TRADE MARKS ACT 1938 (as amended)**

**IN THE MATTER of application no. 1555004  
by JOHNSON PUBLISHING COMPANY INC  
to Register a Trade Mark in Class 3**

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**15 DECISION AND GROUNDS OF DECISION**

On 29 November 1993, Johnson Publishing Company Inc, 820 South Michigan Avenue, Chicago, Illinois, 60605, United States of America, applied under the Trade Marks Act 1938 (as amended) for registration of the trade mark “ZAHRA” in Class 3 in respect of “Perfumery, essential oils, cosmetics, hair lotions; all included in Class 3, but not including any such goods for the removal of unwanted body hair.”

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Objections were taken under Sections 12(1) and 12(3) of the Act in respect of a number of registered and pending trade marks.

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At a Hearing at which the applicant company was represented by Mr W J Sykes of Baker & McKenzie, their trade mark agents, the objections under Section 12 were waived on the basis of the more limited specification shown above, with the exception of the marks detailed below:

**30 SECTION 12(1)**

MARK	NUMBER	CLASS	SPECIFICATION
	1240123	3	Non-medicated preparations and substances, all for the care of the body; preparations and substances, all for the hair; cosmetics; perfumes; toilet soaps; essential oils; anti-perspirants; eau de cologne; non-medicated toilet preparations in cream form; dentifrices.

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ZARA

1548916

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Soaps, perfumery, essential oils and cosmetics; toilet preparations; preparations for the hair; antiperspirants and deodorants; all included in Class 3.

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10 It was agreed at the Hearing that the remaining citations could be waived if the owners of those marks provided letters of consent to the Registration of the applicant's mark. A period of time was allowed in order for the applicants to pursue this matter. In the event, letters of consent were not forthcoming and the application was eventually refused.

15 I am now asked under Section 17(4) of the Act and Rule 35 of the Trade Marks and Service Marks Rules 1986 to state in writing the grounds of my decision and the materials used in arriving at it.

20 No evidence of use of the mark prior to the date of filing of the application has been placed before me and no special circumstances have been drawn to my attention.

20 Section 12(1) of the Act (as amended) reads as follows:-

25 "Subject to the provisions of subsection (2) of this Section, no mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the Register and in respect of:

- (a) the same goods
- (b) the same description of goods, or
- (c) services or a description of services which are associated with those goods or goods of that description"

35 Section 68(2B) of the 1938 Act (as amended) states:-

Reference in this Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

40 Dealing first of all with the conflict between the goods of this application and those of the cited registrations, it is immediately apparent that the goods of this application are included within the specifications of the registered marks. Therefore, in this case, the goods to be covered by the respective marks are identical.

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

In addressing the degree of resemblance between the applicant's mark and the registered marks I adopt the test propounded by Parker J in Pianotist Co's application (1906) 23 RPC 774 at page 777 line 26 et seq:-

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

15            I also bear in mind the test outlined by L J Luxmoore, which was quoted with approval in the  
20            House of Lords in the Aristoc Limited v Rysta Limited case, RPC at page 72, line 46 to page 73,  
25            line 4, which makes it clear that, so far as the marks alone are concerned, the test of confusability  
30            is one of first impression, making due allowance for imperfect recollection.

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

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

35            Firstly, I consider citation 1240123 (ZAHRA and device). In comparing these marks as wholes,  
40            as I must, it is clear that while they are not identical they are very similar. The cited mark  
45            contains a word identical to the applicant's mark and which is placed prominently in the centre  
50            of the device. It is, in my view, the "significant" detail by which the mark will be remembered  
55            and referred to.

40            Secondly, I consider citation 1548916 (ZARA). Again, while it is clear that the marks are not  
45            identical they are very similar. The cited mark consists of a word phonetically identical to the  
50            applicant's mark. I also take account of the fact that both words are invented or may,  
55            alternatively, be taken to be variants of the common girl's names SARAH/SARA and therefore  
60            do not convey a different meaning by which they may be distinguished.

It seems to me therefore, that if the goods were ordered by telephone or referred to orally there are good grounds for arriving at a finding that both of the cited marks are confusingly similar with the applicant's mark. Furthermore, when taking imperfect recollection into account the marks are likely to be confused visually, as well as orally. I also bear in mind that the goods at issue include everyday items which may be relatively inexpensive to buy. They are likely to be bought by a wide range of the public, including parents with young children who may not have the opportunity to study the respective marks closely. Indeed the goods may be recommended by friends and, with imperfect recollection and in the general haste of modern shopping, I am convinced that a busy shopper could easily be confused as to the origin of the respective goods.

In spite of my concerns as expressed above I offered, at the Hearing, to consider the matter further if the consent of the registered proprietors to the registration of this mark was provided. Had consent been forthcoming it would have provided evidence that the similarity between the marks was not one which would be regarded by people trading in the goods at issue as leading to deception or confusion. Additionally, or alternatively, it might have indicated that the registered mark is not, in fact, used in connection with the type of goods for which the proposed mark is intended to be used, with the result that the possibility of deception or confusion could be decreased (see the comments of Buckley J in the case of Radiant Color Company's application supra). As mentioned earlier in this decision, consent from the registered proprietors of the cited registration was not apparently forthcoming. Certainly no consent was filed. Therefore I consider the prior registrations to be fatal barriers to the progress of this application.

In this decision I have considered all of the documents filed by the applicant and all the arguments submitted to me in relation to this application and, for the reasons given, the mark is refused under the terms of Section 17(2) of the Act because it falls within the prohibition of Section 12(1) of the Act.

Dated this 8<sup>th</sup> day of May 1998.

**R A JONES**  
**for the Registrar**  
**the Comptroller General**