

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No 2275699
By Rosco Clothing Limited to register the trade
mark FUTTI in Class 25**

**AND IN THE MATTER OF Opposition thereto
under No 80464 by Fuzzi S.p.A.**

Decision

1. On the 11 December 2002, I heard an opposition by Fuzzi S.p.A. to the registration of the trade mark FUTTI in the name of Rosco Clothing Limited.

2. The full details of the opposition, and my reasons for rejecting it, are included in the decision I gave at the conclusion of the hearing, which is set out in the attached approved transcript.

3. The opposition having failed, the applicant is entitled to a contribution towards its costs. Accordingly, I order the opponent to pay the applicant the sum of £1100. This sum to be paid within 7 days of the end of the period allowed for appeal or, in the event of an unsuccessful appeal, within 7 days of the final determination of the matter.

Dated this 18 Day of December 2002

**Allan James
For the Registrar**

THE PATENT OFFICE

**Tribunal Room 1
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.**

Wednesday, 11th December, 2002

Before:

**THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(Mr. A. James)**

(Sitting for the Comptroller-General of Patents, etc.)

In the Matter of the TRADE MARKS ACT 1994

and

In the Matter of Application No. 2275699 in
the name of Rosco Clothing Limited

- and-

In the Matter of an Opposition thereto by
Fuzzi SpA under Opposition No. 80464

(Transcript of the shorthand notes of
Marten Walsh Cherer
Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-7405-5010. Fax No: 020-7405-5026).

MR. M. EDENBOROUGH (instructed by Marks & Clerk)
appeared as counsel on behalf of the Applicant.

MS. I. MOYER (RGC Jenkins & Co.) appeared as agent
on behalf of the Opponent.

D E C I S I O N
(As Approved)

THE HEARING OFFICER: On 20th July, 2001 Rosco Clothing Limited applied for the registration of the mark FUTTI in Class 25 in respect of 'articles of outer clothing, articles of under clothing, hosiery and footwear'. The application was accepted by the Registrar and published for opposition purposes in the Trade Marks Journal.

Opposition to the registration of the trade mark was subsequently filed by Fuzzi SpA, which is an Italian company. The grounds of opposition are that the opponent is the registered proprietor of UK Trade Mark Registration No. 1355713 for the mark FUZZI which is registered in respect of knitted articles of outer clothing, articles of outer clothing made from knitted material and pullovers, shirts, trousers and skirts, all included in Class 25.

The opponent contends that the application ought to be refused in its entirety under the terms of section 5(2)(b) of the Trade Marks Act 1994, having regard to the earlier trade mark, on the basis that the mark applied for is similar to the opponent's mark, the goods concerned are identical or similar to the goods for which the opponent's mark is registered, and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association.

There was originally a further ground of opposition based upon section 5(4)(a) of the Act. This turned upon the opponent's claim to have made use of the mark FUZZI in the UK since 1991. However, in the absence of any evidence to support that submission the ground of opposition was subsequently struck out, and I need say no more about it.

The applicant filed a counterstatement, essentially denying all the grounds of opposition. Both sides ask for a contribution towards their costs.

The opponent subsequently filed evidence in the form of a witness statement by Mr. Timothy George Pendered, who is the opponent's UK trade mark agent. His witness statement simply exhibits details of the earlier trade mark upon which the opposition is based. These details correspond with the description given in the notice of opposition.

It is common ground that the opponent's mark is an "earlier trade mark" for the purposes of section 6(1) of the Act.

Section 5(2) of the Act is as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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."

The opponent's arguments, which were presented by Ms. I. Moyer who appeared for the opponent today, are that:

(1) the goods are partly identical in so far as both specifications cover articles of outer clothing and that the respective goods are otherwise similar;

(2) that the respective trade marks are similar in that they share the same two first letters, the same final last letter, and that they also share a double consonant in the middle of the respective words;

(3) the result of these points of similarity is said to be that the marks share a similar pattern;

(4) neither mark is an English mark with a recognisable meaning, and the absence of a recognisable meaning will operate against the average consumer being able satisfactorily to distinguish the marks in use, particularly with regard to defective recollection of the earlier trade mark;

(5) because the respective word marks both end in "I", which is rare in the English language, the marks may be taken as Italian words; in Italian, the opponent's mark is likely to be pronounced with a long vowel sound for the "U" and a "TZ" or a "DZ" sound for the double consonant as in "foodsie" or "footsie";

(6) the mark applied for is also likely to be

pronounced in Italian with a long "U" vowel sound as in "footie": the Italian pronunciation of the two words is thus said to be very close, and certainly close enough to cause confusion;

(7) English speakers are accustomed to pronouncing what look like Italian words having a double "Z" as "TZ", as in the well known word "pizza".

(8) there is therefore a good chance that ordinary members of the public in the UK will, even without a knowledge of Italian, pronounce the opponent's mark as "footsie", again bringing it very close to the sound of the mark applied for.

Having made these points, the opponent accepts that clothing is primarily selected in the UK by visual means and that aural similarity is therefore of a secondary order of importance compared to the visual similarities between the two trade marks.

The applicant's arguments, which were presented by Mr. Edenborough of counsel on their behalf, are that whilst accepting that there is a partial identity between the respective goods in so far as 'outer clothing' in the application and 'knitted articles of outer clothing' in the earlier trade mark are identical goods, there is not complete identity between the respective goods.

In particular, it is said that 'footwear' and 'hosiery' are sufficiently distant from the goods for which

the earlier trade mark is protected as to be dissimilar goods and therefore outside the scope of section 5(2)(b) of the Act.

As far as the marks are concerned, Mr. Edenborough says that a similar pattern between the respective trade marks is not sufficient, that a difference of two letters in a short word has a greater impact than would be the case in a longer word; that a double "T" and a double "Z" look different and would look different regardless of the font or the form of presentation; that I cannot assume that the marks will be taken as Italian. In this respect he points out that there are a number of well known English words which contain a double "Z" in the middle of them, such as "dizzy" and "mizzen", and further that there are a number of well known English words which end in the letter "I". By way of example he suggests "broccoli", "taxi" and "bikini".

He reminded me that the average UK consumer's appreciation of foreign languages is not very high.

Mr. Edenborough submitted that the earlier trade mark FUZZI will be pronounced by reference to the English word "fuzzy", whereas the later trade mark FUTTI will be approximated to the English slang word for football, being "footie". He submitted that these associated conceptual meanings, which are likely to be attached to the respective marks, will help to avoid confusion, either directly or

through imperfect recollection.

I remind myself of the guidance given by the European Court of Justice in the well known cases of **Sabel BV v. Puma AG, Rudolf Dassler Sport** [1998] RPC 199, **Canon v. MGM** [1999] RPC 117, and **Lloyd Schuhfabrik Meyer & Co. v. Klijsen Handel BV** [2000] FSR 77. It is apparent from these cases that the likelihood of confusion must be appreciated globally, taking account of all the relevant factors. Further, that the matter must be judged through the eyes of the average consumer of the goods in question. This consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but this consumer rarely has the chance to make direct comparisons between the trade marks and must instead rely upon the imperfect picture of them he or she has kept in his or her mind.

Moreover the average consumer normally perceives the mark as a whole and does not proceed to analyse its various details.

In making the comparison between the trade marks I must examine their visual, aural and conceptual similarities and compare the marks by reference to the overall impression that they create.

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.

Furthermore there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it.

Considering first the respective goods, it has been conceded that at least in part they are identical. I will proceed in the first instance to examine the case for the opponent based upon the assumption that the goods are identical.

Both marks are invented words, and invented words have a high inherently distinctive character as trade marks. As far as the visual similarities between the trade marks are concerned, I note that they are of equal length, both consisting of five letters, and, as is obvious, the first two and the last letter of each of the marks is the same. They also contain a double consonant in the centre of the words.

However, in my view, the change of the double consonant does make a striking impression when it appears within short words. This is not a case where the respective consonants resemble each other and might be confused through poor handwriting, or help create a similar overall impression because of their visual appearance.

I conclude there is some degree of similarity between the respective trade marks, but not a very high degree of

similarity.

As far as the aural comparison of the marks is concerned, I take the view that the average UK consumer would have no reason to assume that the respective trade marks were of Italian origin, or should be pronounced according to the rules of the Italian language. Even if that is wrong, the average consumer in the UK is notorious for his or her poor grasp of foreign languages, and I doubt whether Italian is spoken to a more significant extent in the UK than other continental languages.

No evidence has been placed before me which might have assisted me in assessing the average consumer's likely pronunciation of the respective marks, so I must therefore base this upon my own assessment. I do not accept the opponent's contention that the double "Z" in FUZZI would be pronounced as those letters are pronounced in the well known word "pizza". Pizza is a well known Italian word which has entered the language in the UK, and the public have been educated to the correct Italian pronunciation of that word through massive use of the word over a long period of time.

As I have already indicated, there is no evidence that the word FUZZI has been used in the UK as a trade mark or otherwise. In my view, FUZZI would be pronounced as in the English word "fuzzy", whereas the applicant's mark FUTTI is most likely to be pronounced as "footie" or, alternatively,

as "futty", as in the word "putty." In either event I take the view that the differences in the sound of the respective words is immediately perceptible.

As far as the conceptual similarities between the trade marks are concerned, As I have said, I do not accept the opponent's submission that the words would be seen as Italian because of their construction. Indeed these words would have no meaning even to an Italian speaker because they have no meaning in Italian, so this is a very long way from the example given of the word "pizza", which has a well known meaning in Italian which has crept into the English language over a long period of time.

Similarly, however, I reject the applicant's submission that FUZZI would be approximated to the meaning of the English word "fuzzy" and remembered accordingly, and that FUTTI would be approximated to the English slang word "footie" and be remembered in line with that word's meaning. That may be plausible if the FUTTI mark were used in relation to a trade in footwear, but it does not seem to me to be very plausible in relation to the other goods within the applicant's specification.

I remind myself that the average consumer does not analyse trade marks in detail for meanings, and in the light of that I believe that the average consumer would see no conceptual similarity or dissimilarity in these trade marks. In my view they would both be taken as made-up

words without any immediately obvious concept.

I turn then to the likelihood of confusion. In my view, the average consumer of clothing pays at least as much attention to brand names as consumers for most other types of goods. The visual difference between the trade marks is, in my judgment, sufficient to avoid the average consumer mistaking one mark for the other.

Arguably the aural differences between the trade marks are less striking than the visual differences but, as has been accepted, shopping for clothing is primarily a visual act and visual means of distinguishing are therefore more important in this trade. In this respect I am reminded of the finding of Mr. Simon Thorley QC in the case of **React Trade Mark** [2000] RPC 285.

Even making allowance for the highly distinctive character of the earlier trade mark, the partial identity of the goods, and making a reasonable allowance for the average consumer's defective recollection, I have come to the conclusion that there is no likelihood of confusion between the respective trade marks and no likelihood of a relevant association.

The key to the case, in my judgment, is that in short words such as these the difference of two letters in the middle of the mark can make a significant impact, and that is the case here. I believe that impact will be sufficient to avoid not just direct confusion, but also confusion

through imperfect recollection of the earlier mark. If that is my finding where the goods are identical, where for the reasons I have given the opponent's case is strongest, it must follow that this must also be the conclusion where the goods are merely similar. That finding removes the need for me to decide whether 'hosiery' and 'footwear' are similar to 'knitted articles of outer clothing' as the opponent contends and the applicant denies.

In conclusion, the section 5(2) objection fails and with it the opposition.

That brings me to the question of costs. Is there any reason why costs should not follow the event as normal in this case?

MR. EDENBOROUGH: No. We are happy for the normal scale to apply.

THE HEARING OFFICER: Did this opposition start before or after the revised scale of costs was introduced?

MR. EDENBOROUGH: The TM7 is dated 12th December, 2001.

According to the tribunal practice notice which accompanied the TM7 it is under the new costs scale.

THE HEARING OFFICER: I will hear what Ms Moyer has to say on the question of costs, if anything.

MS. MOYER: We do not have anything to say.

THE HEARING OFFICER: In that case costs will be awarded off the normal scale. I will settle at a figure and include it in the written decision. There was no evidence filed in

this case?

MR. EDENBOROUGH: Formally there was, but in substance no.

THE HEARING OFFICER: Indeed, just the details of the earlier trade mark.

MR. EDENBOROUGH: I do not think they really ought to be taken into account.

THE HEARING OFFICER: No. Certainly the applicant did not file any evidence and, as you have won, that cannot count for you anyway. I will reflect in the amount of costs awarded that you did not have the burden of filing evidence.

Thank you very much for your submissions. I will get the written decision to you as soon as I can.
