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THE PATENT OFFICE

Harmsworth House
13-15 Bouverie Street
London EC4Y 3DP

Wednesday, 18th June 2003

Before:

MR. S. J. THORLEY, QC
(Sitting as the Appointed Person)

In the Matter of the Trade Marks Act 1994

and

In the Matter of UK Trade Mark Application
No. 2275699 in the name of
ROSCO CLOTHING LIMITED

and

Opposition No. 80464 thereto by
FUZZI SpA

Appeal of Opponent from the decision of Mr. Allan James,
acting on behalf of the Registrar, dated 11th December 2002.

(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 Messrs. Mark & Clerk)
appeared on behalf of the Applicant/Respondent.

MR. M. TAPPIN (instructed by Messrs. RGC Jenkins & Co)
appeared on behalf of the Opponent/Appellant.

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

1 THE APPOINTED PERSON: This is an appeal to the Appointed Person
2 from a decision of Mr. Allan James, the officer acting on
3 behalf of the Registrar, dated 11th December 2002.

4 The decision arose in an opposition by an Italian
5 company, FUZZI SpA. I am told by Mr. Tappin, who appears on
6 their behalf, that the correct prononciation of its name is
7 "Footsie".

8 FUZZI SpA opposed the registration of the trade mark
9 FUTTI in class 25 in respect of various items of clothing.
10 They did so on the basis of section 5(2)(b) of the Trade
11 Marks Act 1994, having regard to their earlier registration
12 of the trade mark FUZZI (No. 1355713) which is registered in
13 respect of knitted articles of outer clothing, articles of
14 outer clothing made from knitted materials, pullovers,
15 shirts, trousers, and skirts, all included in class 25.

16 There was no dispute that this was an earlier mark
17 within the meaning of the Act and that it was registered in
18 some respects in relation to identical goods. The sole
19 question, therefore, that arose in relation to the opposition
20 under section 5(2)(b) was whether or not the similarity
21 between the marks would cause there to be the relevant
22 likelihood of confusion on the part of the public, which
23 includes the likelihood of association.

24 Mr. James concluded that there was no such likelihood
25 of confusion and gave his reasons in an extemporary judgment

1 at the end of the hearing.

2 FUZZI SpA appeal, as is their right, and Mr. Tappin
3 accepted that the correct approach on an appeal on the issue
4 of likelihood of confusion was that set out in REEF TM [2003]
5 RPC 5 at paras. 26-28. The approach there, set out in the
6 judgment of Robert Walker LJ, was that there should be a real
7 reluctance, but not the very highest degree of reluctance, to
8 interfere with the hearing officer's decision in the absence
9 of a distinct material error of principle. Mr. Tappin,
10 however, submitted that in this case there had been a
11 distinct and material error of principle.

12 In considering whether or not there is an error of
13 principle, one must take care not to conclude that an error
14 of principle exists merely because the appellate tribunal may
15 consider that the decision of the tribunal appealed from was
16 in some respects surprising. In a later appeal, which
17 Mr. Edenborough who appeared on behalf of the applicants drew
18 to my attention, Bud and Budweiser Budbräu [2003] RPC 25, at
19 page 477, Lord Walker of Gestingthorpe (as he had by then
20 become) made the point in this respect in paragraphs 48, and
21 52-54 of his Judgment where he stated: "48. The hearing
22 officer concluded that the distinctive character of the
23 Budweiser Budbräu mark resided in those two words (just as if
24 the mark were a plain word mark) and that: 'the different
25 fonts and the underlining do not detract from or add anything

1 to, the central message.' I have to say that I have found
2 that conclusion surprising, so much so that I have had to ask
3 myself whether it can only be an indication that the hearing
4 officer failed to carry out the sort of comprehensive review
5 which he should have undertaken.

6 52: Ultimately the issue on the first appeal is whether
7 the deputy judge was right to discern two errors of principle
8 in the hearing officer's approach, so opening the way for the
9 deputy judge to substitute his own view. For the reasons
10 which I have explained, I do not think that the hearing
11 officer did make any significant error of principle which
12 appears from his written decision. I do find his conclusion
13 surprising and if this court had a free choice between the
14 hearing officer's decision and that of the deputy judge I
15 would unhesitatingly choose the latter.

16 53: However this court does not have a free choice, as
17 Sir Martin Nourse has explained in his judgment. As Buxton
18 LJ said in *Norowzian v Arks Ltd (No.2)* [2000] FSR 363 at 370:
19 '....where it is not suggested that the judge has made an
20 error of principle a party should not come to the Court of
21 Appeal simply in the hope that the impression formed by the
22 judges in this court, or at least by two of them, will be
23 different from that of the trial judge.'

24 54: The same principle applies to an appeal from a
25 hearing officer to a judge of the Chancery Division.

1 Although the hearing officer's decision is one which I find
2 surprising, I do not consider that it can be described as
3 clearly wrong. Therefore I agree (although possibly with
4 more hesitation than my lords) that the first appeal should
5 be allowed."

6 The same principles plainly apply to this tribunal
7 sitting as an appellate tribunal on appeal from the Registry.
8 The fact that one may be surprised at the outcome is not a
9 decisive factor. The task of this tribunal is to review the
10 way in which the hearing officer reached his conclusion and
11 to seek to decide whether in so doing he made an error of
12 principle or, alternatively, whether his conclusion was
13 plainly wrong.

14 Mr. Tappin suggested, I believe correctly, that the
15 fundamental finding of Mr. James resided in his conclusion as
16 to visual similarity. What Mr. James did was to remind
17 himself of the guidance given by the European Court of
18 Justice in certain well-known cases, which required him to
19 consider the likelihood of confusion on a global basis,
20 taking into account all the relevant factors and judging the
21 matter through the eyes of the average consumer of the goods
22 in question. This was a correct direction in law.

23 He went on: "In making the comparison between the
24 trade marks I must examine their visual, aural and conceptual
25 similarities and compare the marks by reference to the

1 overall impression that they create." Again, this is a
2 correct direction.

3 He then turned to consider the words themselves. He
4 concluded that both were invented words and that "invented
5 words have a high inherently distinctive character as trade
6 marks." He noted that they were of equal length, both
7 consisting of five letters, and as is obvious the first two
8 and the last letter of each of the marks are the same. They
9 also contain a double consonant in the centre of the words.

10 He went on as follows: "However, in my view, the
11 change of the double consonant does make a striking
12 impression when it appears within short words. This is not a
13 case where the respective consonants resemble each other and
14 might be confused through poor handwriting, or help create a
15 similar overall impression because of their visual
16 appearance.

17 I conclude there is some degree of similarity between
18 the respective trade marks, but not a very high degree of
19 similarity."

20 On the basis of that visual similarity, he concluded at
21 the end of his judgment as follows: "The key to the case, in
22 my judgment, is that in short words such as these the
23 difference of two letters in the middle of the mark can make
24 a significant impact, and that is the case here. I believe
25 that impact will be sufficient to avoid not just direct

1 confusion, but also confusion through imperfect recollection
2 of the earlier mark."

3 Mr. Tappin contended that the fundamental error of
4 Mr. James was in not considering the ways in which the two
5 marks could be written. He indicated in his skeleton the way
6 in which the marks could properly be written in various
7 different typescripts, which, he contended, served to elide
8 in some respects the ZZ with the TT. He suggested that the
9 hearing officer had fallen into error in failing to consider
10 the scope of notional and fair use, which he said would
11 include those types of script.

12 In this respect, I have concluded that Mr. Tappin is in
13 substance seeking to re-argue the case. The case was put
14 before Mr. James on the basis of the words as they appear and
15 he reached the conclusion that the change of the double
16 consonant makes a striking impression when it appears with
17 short words. That was a conclusion that was open to him,
18 and, in my judgment, is not a conclusion that was reached by
19 making any error of principle or which is plainly wrong. He
20 directed himself correctly as to the approach he should take
21 and he reached a conclusion on the facts of the case before
22 him. Whether or not I consider the result surprising is
23 irrelevant. I have to ask myself whether he erred and in
24 this respect I do not believe he did err. Different people
25 may have reached different conclusions but that is not

1 pertinent.

2 I believe that conclusion is sufficient to dispose of
3 this appeal. Mr. Tappin accepted that the aural comparison
4 made by Mr. James was a subsidiary matter and although he
5 suggested he had got it wrong he did not suggest, as I
6 understand it, that there was any error of principle, save
7 that he suggested he had failed properly to grapple fully
8 with the question of imperfect recollection.

9 However, it is quite plain that Mr. James had in mind
10 imperfect recollection. He refers to it at the end of his
11 judgment. Again, therefore, I do not believe that any
12 failure to review specifically the question of imperfect
13 recollection on the basis of aural comparison can be said to
14 constitute an error of principle.

15 It will be apparent from the observations I have made
16 in the course of this decision that I do believe the
17 conclusion Mr. James has reached is perhaps not the
18 conclusion that another hearing officer would have reached,
19 or perhaps that I would have reached had I been the hearing
20 officer, but the guidance from the Court of Appeal makes it
21 abundantly clear that that is not a justification for
22 re-opening the entire issue.

23 In my judgment, Mr. James has come to conclusions which
24 were open to him on the facts of this case, he has correctly
25 directed himself as to the law, and it is therefore not for

1 me to interfere with his decision.

2 The appeal accordingly falls to be dismissed.

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