

**TRADE MARKS ACT 1994 & TRADE MARKS (INTERNATIONAL
REGISTRATION) ORDER 1996**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 496835
DESIGNATING THE UNITED KINGDOM
IN THE NAME OF TUZZI FASHION GMBH**

**AND IN THE MATTER OF OPPOSITION NO. 71537 THERETO
BY EL CORTE INGLÉS S.A.**

**OPPONENT'S APPEAL TO AN APPOINTED PERSON FROM THE DECISION
OF MR M. FOLEY DATED 28 OCTOBER 2009**

DECISION

Introduction

1. This is an appeal under section 76 of the Trade Marks Act 1994 (“**the Act**”) against a decision of the Registrar’s hearing officer, Mr Mike Foley, to reject an opposition against the conferring of protection in the United Kingdom for international trade mark registration no. 496835 (“**the IR**”). The IR is registered for the mark TUZZI (“**the Mark**”) in respect of “clothing” in Class 25 and is held by Tuzzi Fashion GmbH (“**the Applicant**”).
2. The opposition was filed by El Corte Inglés S.A. (“**the Opponent**”) on 19 December 2007, based on an objection under section 5(2)(b) of the Act. The Opponent contends that the IR should not be protected in the United Kingdom because the Mark is similar to the Opponent’s earlier Community trade mark (“**CTM**”) application no. 3679594 and its earlier international trade mark registration no. 868994, and protection is sought in respect of “clothing”, which is included in the specifications for both of the earlier marks (among other goods and services), and the use of the Mark in respect of such goods would give rise to a likelihood of confusion. The Opponent’s earlier marks are shown below:

CTM 3679594

Euridio Tuzzi

IR(UK) 868994

A black rectangular box containing a handwritten signature in white ink that reads "Euridio Tuzzi".

3. The Applicant defended both limbs of the opposition by Notice of defence and counterstatement (Form TM8) filed on 25 March 2008. It admitted that “clothing” for which protection is sought for the Mark is identical to “clothing” in the specifications for each of the Opponent’s earlier marks, but denied that the Mark is similar to either of the said marks or that there is any likelihood of confusion.
4. No evidence was filed and the parties chose to have the opposition determined without a hearing. The decision in favour of the Applicant was issued by Mr Foley on 28 October 2009 (O/337/09 – “**the Decision**”).
5. The Opponent filed its notice of appeal to an Appointed Person on 25 November 2009. The matter came on for hearing before me on 22 April 2010. The Opponent/Appellant was represented by Counsel, Mr Simon Malynicz, instructed by Fry Heath Spence LLP. The Applicant/Respondent was not represented at the hearing, but it filed written submissions in advance through Reddie & Grose.

Relevant legislation

6. Section 5(2)(b) of the Act provides as follows:

(2) A trade mark shall not be registered if because –

(a) ...

(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 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.

7. An “earlier trade mark” is defined in section 6 of the Act as including:

(1)(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks, ...

and the section goes on to say:

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.

8. These provisions reflect articles 4(1)(b) and 4(2)(a) and (c) of Directive 2008/95/EC of 22 October 2008 to approximate the laws of the Member States relating to trade marks (“**the Directive**”) and are brought into play for international registrations designating the United Kingdom by article 3 of the Trade Marks (International Registration) Order 1996. Parallel provisions are found in article 8(1)(b) and 8(2)(a)

and (b) of Council Regulation (EC) No. 207/2009 on the Community trade mark (“**the Regulation**”).

Additional background

9. Shortly before the hearing, I checked the on-line CTM database published by the Office for Harmonisation in the Internal Market (“**OHIM**”) to see if the Opponent’s CTM had been registered since the Decision. It was still recorded as a pending application, and had two oppositions recorded against it, one of which was filed by the Applicant. In that opposition (no. 817595), the Applicant argued that the Opponent’s CTM should be refused under article 8(1)(b) of the Regulation for “clothing, footwear and headgear” because there was a likelihood of confusion with *inter alia* an earlier German trade mark registration and an International trade mark registration with effect in Austria, France, the Benelux and Poland, each registered for the word mark TUZZI in respect of “clothing”. The Opponent (being the CTM applicant) defended the opposition, strenuously denying that there was a likelihood of confusion. In other words, the roles and arguments of the parties were the opposite of those in the present opposition.
10. It is not unprecedented for parties to run contrary arguments in different tribunals, and I accept the point made to me by Mr Malynicz in oral submission, when I raised the existence of the CTM opposition, that the relevant average consumer in the countries under consideration could not be assumed to have the same attributes as for the average UK consumer. Differences in language and pronunciation, as well as market differences, could easily lead to a different outcome. However, I was surprised that neither party had drawn the existence of the CTM opposition to my attention, particularly given the fact that there had not only been a first instance decision (issued 2 August 2007) but also a decision of the Second Board of Appeal of OHIM (R 1561/2007-2 of 23 September 2008), and that the latter decision is under appeal to the General Court (Case T-535/08 *Tuzzi fashion v OHIM - El Corte Inglés (EMIDIO TUCCI)*).
11. I do not suggest that any form of *res judicata* or estoppel arises, but I do accept the Applicant’s submission that – if I were minded to uphold the appeal based on the CTM – the Mark should not be rejected unless and until the CTM were to be registered.
12. I also consider it appropriate to record that the opposition was rejected by both the Opposition Division and the Board of Appeal, both of which concluded that there was no likelihood of confusion between the Applicant’s TUZZI trade marks and the EMIDIO TUCCI signature mark of the CTM in any of the countries under consideration.

The Decision

13. After setting out the essential details of the parties' respective marks and the case history, the hearing officer summarised the approach that he would take in assessing the likelihood of confusion and listed the relevant authorities, from *Sabel BV v Puma AG* Case C-251/95, [1998] RPC 199 to *Shaker di L. Laudato & C. Sas v. OHIM (LIMONCELLO)* Case C-334/05 P, [2007] ECR I-4529. The Opponent takes no issue with this aspect of the Decision (at paragraph 9), which has been well-rehearsed in other cases, and so it is unnecessary reproduce it here.
14. The hearing officer identified the relevant "average consumer", through whose eyes the similarity of marks and goods and the likelihood of confusion must be assessed, as being the public at large (paragraph 14). Since both the Applicant's and Opponent's trade mark specifications listed "clothing", he held that there was no difference between the parties' respective market sectors or channels of trade or between the consumers of the parties' respective goods (paragraph 18). As the hearing officer stated: "Such goods notionally range from the cheap and simple that will be selected with minimal attention to the brand, to the expensive and exclusive where the purchaser will be well informed and circumspect in all aspects of the selection."
15. The hearing officer prefaced his assessment of similarity between the marks with the following additional guidance from previous cases:
 11. The goods at issue here are articles of clothing. In his decision sitting as the Appointed Person in the *React* trade mark case [2000] R.P.C. 285, Mr Simon Thorley stated:

"There is no evidence to support Ms Clark's submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon."
 12. The decisions in *Claudia Oberhauser v OHIM (Fifties)* [2003] E.T.M.R. 58, and *Criminal Clothing Ltd v Aytan's Manufacturing (UK) Ltd*, [2005] EWHC 1303 indicate that the circumstances in which the relevant goods and the trade marks are encountered by the consumer, particularly at the point at which the purchase is made, is an important consideration. That said, the matter must be considered by applying an assessment of all relevant factors. This should be balanced by the decision of the CFI in *Devinlec Développement Innovation Leclerc SA v OHIM* (Case T- 147/03) in which they stated that a conceptual difference between the marks at issue may be such as to counteract to a large

extent any visual and aural similarities between the signs. However, this requires at least one of the marks to have a clear and specific meaning so that the public is capable of grasping it immediately, which for the record I do not consider to be the case here.

16. In relation to visual similarity, the hearing officer said:

13. Both earlier marks are stylised in appearance but are recorded as being the words EMIDIO TUCCI. I do not know whether this was stated in the application, but I have to say that I would not have been at all certain about this from the representation. In the CTM, the consonant stated to be the letter M in EMIDIO is very similar in its appearance to the letter U in TUCCI. The construction in the International mark is even less clear and without being guided by the version in plain font I do not consider it at all likely that it would be seen as the words EMIDIO or TUCCI. I therefore propose to consider the matter based on the CTM, for if they do not succeed in respect of this mark they will be in no better a position in respect of the International mark.

14. Setting aside my reservations on how the earlier marks will be perceived, I will start from the position that the relevant consumer of clothing, which I take to be the public at large, will see the earlier mark as the words EMIDIO TUCCI. The mark for which protection is sought is the word TUZZI. Self-evidently, if there is any similarity between this and the earlier mark it subsists in the TUCCI element. TUCCI and TUZZI are identical in respect of their length and the use of the letters “TU**I”, the difference being in the use of the letters “ZZ” as opposed to “CC”. Differences of one or two letters in the body of words can sometimes be overlooked, most likely when the words are long and identical in other respects. However, in short words such as these, minor differences have a disproportionately large effect on the appearance, and in this case the difference is much more than minor. I do not consider TUCCI and TUZZI to be similar. Factor in the other element of the earlier mark and the difference is more apparent and the marks even further apart. I do not think the stylisation counters any of the differences. In my view it is unlikely that the style of representation of TUCCI could be misconstrued as TUZZI, or that TUZZI written in a similar script could be taken as TUCCI; the letter formation does not lend itself to this.

17. Turning to aural similarity, the hearing officer said:

15. The letters “CC” in English can have a hard sound akin to that of the letter “K”, for example in words such as “occasion” and “occult”. If viewed by the consumer in this way the word TUCCI will sound quite different to any way in which TUZZI may be spoken. Whilst I will come to the conceptual value of these words next, how words are regarded can have an influence on how the beholder will attempt to enunciate them. The UK has a multi-cultural population with a significant component originating from countries such as Italy and Spain. Foreign travel has also brought consumers into contact with other languages, as has international trade. It is my view that consumers coming into contact with the respective marks will connect them to some foreign language, and in the case of the opponent’s will most probably pronounce the second element as “tootchi”. The combination of “zzi” in the applicant’s mark may create the sound of “zee” as in “fuzzy”, and TUZZI as a whole as “tuzzee”. There is also a possibility of it being pronounced as “tutzee” which with the tendency to slur elements means that there is potential for TUCCI and TUZZI to sound similar. However, this does not take into account that the opponent’s earlier mark has another element,

the word EMIDIO, This has strong syllables and being the first element will be more clearly spoken. As a whole the respective marks are not aurally similar.

18. And, finally, with regard to conceptual similarity, the hearing officer had this to say:

16. I have already touched on the issue of conceptual similarity. As I have said, and again just looking at TUCCI v TUZZI in isolation, I consider it likely that the relevant consumer will see these as words from a non-English language, most probably as invented words. However, it is also possible that they may be taken as a family name, particularly in the case of the opponent's marks which have the prefix EMIDIO and being represented in a handwritten script having the appearance of a signature. So whilst there is potential for the relevant consumer to see some conceptual similarity, I do not consider the respective marks to be conceptually similar.

17. As far as I am aware (and there is no evidence to the contrary) TUZZI, EMIDIO and TUCCI are not words from the English language. In fact I have no evidence that they are words in any language. In my consideration of the meanings that they might convey to a consumer I posed the possibility of them being viewed as invented words, as given names, and in the opponent's case, as a full name. I am aware that names are often used as a mark of origin in the clothing industry, and understandably so at the designer end of the market. It is for this reason that commonplace names are not generally regarded as highly distinctive. However, if TUZZI and EMIDIO TUCCI are names they are anything but commonplace. If they are not names they are not words with any obvious or direct reference to the product and should be regarded as distinctive. That is the case in respect of EMIDIO and TUCCI, both collectively and individually.

19. The hearing officer pointed out that, in the absence of any evidence of use by the Opponent of its earlier marks, there was no basis for concluding that they had any reputation or were thereby deserving of enhanced protection. He concluded his decision as follows:

20. Taking account of all of the factors and adopting a "global" approach, I take the view that whilst there is identity in respect of the goods, and consequently also in the notional circumstances of the manufacture and market, the differences in the respective marks are such that use of the mark applied for will not lead to confusion. The opposition under Section 5(2)(b) therefore fails.

The appeal

20. As Mr Malynicz stated in his skeleton argument, this appeal does not raise any novel points of law. The basis for the appeal is simply that the hearing officer made errors of law as he went through his analysis of each type of similarity between the marks: visual, aural and conceptual. I deal with the specific errors alleged in turn below.

21. Mr Malynicz accepted that it was only if he could persuade me that such an error had taken place that I would be able to look again at the issue of likelihood of confusion and substitute my own assessment of the matter. The proper approach in an appeal from the Registrar is well-established and is conveniently summarised in

the decision of Daniel Alexander QC (sitting as a Deputy High Court Judge) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] EWHC 3371 (Ch), [2008] Bus. L.R. 1621 at [5] - [6], as follows:

5. ... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

"...an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance to interfere in the absence of a distinct and material error of principle" (Reef, para. 28)

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer's decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge's evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.

Errors in visual comparison

22. The Opponent's first complaint is that, having held at paragraph 13 that there were a number of ways in which the earlier marks could be perceived (stating that he "would not be at all certain" from the registrations that the earlier marks should be read as EMIDIO TUCCI), the hearing officer seemed to forget about this point when he made the visual comparison at paragraph 14 and instead relied on the fact that the Register recorded that the mark should be read as EMIDIO TUCCI. Therefore, rather than judging the matter through the eyes of the average consumer, who would not be sure what the mark said, he judged it based in part on the additional information recorded on the Register.
23. In Mr Malynicz's submission, had the hearing officer followed through his comments about the difficulty in discerning the word EMIDIO, he would have appreciated that the average consumer would have been likely to focus attention on the element that could be made out, being TUCCI. As a result, the similarity between TUZZI and the TUCCI element as it appeared in the earlier CTM would have taken on greater importance. Mr Malynicz argued that all one would have to do to turn the cursive script form of TUCCI to TUZZI was to add two small horizontal lines.

24. I believe that the Opponent does raise a legitimate criticism here in relation to the hearing officer's starting assumption that the relevant consumer would see the earlier CTM as EMIDIO TUCCI, when he had previously correctly identified the difficulty in discerning the word EMIDIO. However, I do not think that this had a significant effect on his analysis since he did in fact look closely at the TUCCI element of the CTM and he made a direct comparison with the word TUZZI, concluding that they were not similar. Given that assessment, it would not have made any difference to his conclusion on lack of visual similarity between TUZZI and the whole CTM if he had made more of the illegibility of the EMIDIO element, and I do not think it is appropriate for me to substitute my own assessment.
25. The Opponent's second objection to the hearing officer's assessment of visual similarity related to his alleged failure to appreciate the significance of the *FIFTIES* and *Criminal Clothing* cases, despite citing them as authority for the proposition that the circumstances at the point of sale are important (see the extract from the Decision set out at paragraph 15 above). The Statement of Grounds states that: *Fifties* is authority for the proposition that there can still be a finding of overall confusion even if there is visual dissimilarity, and even in a clothing case, since words "speak louder" than devices; and *Criminal Clothing* shows that the court may consider, in the context of aural use and even in a clothing case, the combined effect of the aural and conceptual similarities of the words alone even where one of the marks has a complex and distinctive device element.
26. In other words, as Mr Malynicz submitted, these cases were about the balance to be struck between the different aspects of the marks – visual, aural and conceptual – and should have been appreciated by the hearing officer as a counterweight to his reliance on *REACT Trade Mark* [2000] RPC 285 which emphasises the importance of the visual perception of the marks in clothing cases. Mr Malynicz also drew my attention to *LIMONCELLO* (referred to above) at [37] to [41], which he submitted was further authority for the proposition that lack of visual similarity does not automatically 'trump' aural and conceptual similarities. (In fact, I think that those paragraphs warn against the danger of focusing on one particular component of a complex mark, rather than relating to the importance of looking at each of the visual, aural and conceptual aspects of the marks. However, paragraph [36] refers to the need to assess the importance to be attached to the degree of each of the visual, aural and conceptual factors, taking into account the category of goods concerned and the circumstances in which they are marketed.)
27. I believe that the Opponent is wrong to identify an error here. It seems to me that in paragraph 12 of the Decision, the hearing officer was keen to emphasise the precise point made by Mr Malynicz, that "all relevant factors" must be taken into account. His reference to the *Devinlec* case highlighted the fact that he appreciated that there

was a balance to be struck between the various different aspects of the marks, and that his conclusion on lack of visual similarity between the parties' respective marks was not determinative, even in a case about clothing, because aural and conceptual similarity also had to be assessed.

28. I also do not think it would be right to say that an error is made simply because a hearing officer relies on a particular case as authority for only one proposition, when the same case also supports another proposition which is of relevance to the case at hand. There is nothing in the Decision that suggests to me that Mr Foley failed to take into account all three (visual, aural and conceptual) aspects of the parties' marks or that he incorrectly put an undue emphasis on the visual element.
29. It is worth adding that several decisions of the Court of First Instance (now the General Court) since *REACT* have continued to stress the importance of the visual comparison when dealing with trade marks for clothing: see, for example, Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.

Errors in aural comparison

30. The Opponent's statement of grounds argued that Mr Foley's phonetic comparison of the marks was flawed because, even though he correctly identified the fact that it was possible for the marks to be pronounced in different ways, he failed to appreciate that for those consumers who would pronounce the second word in the Opponent's earlier marks as TOO-TCHEE and the Mark as TOO-TSI, there was a high degree of phonetic similarity. This ground was varied in the skeleton argument by adding that the hearing officer made an error in failing to alight on a particular way in which the average consumer would pronounce the Mark. For that reason in particular, Mr Malynicz submitted that I should reach my own view on how the average consumer is likely to pronounce it and look afresh at aural similarity.
31. In the absence of any evidence on how TUZZI and the earlier marks would each be pronounced, the hearing officer only had his own experience of trade marks being used in the clothing industry and the parties' respective submissions to go on. It is not surprising that he concluded that "tootchi" (which I take to indicate the same pronunciation as the Opponent's TOO-TCHEE) was the most likely pronunciation for TUCCI, given the exposure of UK consumers to Italian brand names ending in -UCCI, such as FIORUCCI, PUCCI and, particularly, GUCCI. It is equally unsurprising that he could not be sure how TUZZI would be pronounced, since famous -UZZI brand names do not spring to mind in the same way.

32. Mr Malynicz did not present any authority for the proposition that the hearing officer should have plumped for just one pronunciation of TUZZI and considered the matter only in relation to that, on the basis that there can be only one “average consumer” whose perspective should be taken into account. But I do not have to decide whether he is right because the question in this case is not how the average consumer would pronounce the Mark, but it is how s/he would perceive its aural character when it is used orally in the course of trade. That use might be by representatives of the Applicant or its distributors or retailers or might be in radio or television advertisements or other forms of oral promotion. One would expect such use to be consistent, given that it would be authorised by the Applicant, but no evidence was presented as to which would be the correct pronunciation. In those circumstances, it was entirely appropriate for the hearing officer to consider the most likely possibilities and to assess the average consumer’s likely perception of aural similarity with the earlier marks in each case.
33. The hearing officer took account of the fact that TUZZI could be pronounced as “tutzee”, and said that this had the potential to sound similar to TUCCI (pronounced “tootchi”). But, in his assessment, the presence of the word EMIDIO in front of TUCCI meant that the marks as a whole were not aurally similar. Thus he did consider the phonetic comparison which the Opponent submitted was the closest, and yet was not convinced by it. Having failed to persuade me that the hearing officer made an error in reaching that conclusion, I am also not persuaded that I should revisit this issue afresh.

Errors in conceptual comparison

34. The Opponent asserts that the hearing officer’s analysis of conceptual similarity was flawed because he appeared to accept that there was potential for the relevant consumer to see “some conceptual similarity”, but then said that he did not consider the marks to be conceptually similar – apparently substituting his personal view for that of the average consumer – without giving any further reason (see paragraph 16 of the Decision).
35. I do find this part of the Decision a little strange, in that the hearing officer went through two quite likely ways in which TUZZI and the TUCCI element of the earlier marks might be perceived, concluding that they both could be perceived as invented words from a non-English language, or alternatively as both being family names. In this case, he did not say that the inclusion of the EMIDIO element in the earlier marks detracted from conceptual similarity; in fact, he thought its appearance increased the likelihood that the earlier marks would be perceived as a full name. Given the discussion in the following paragraph (17) about the use of people’s names as marks of origin in the clothing industry, and in the absence of further

explanation for finding a lack of conceptual similarity, it does seem to me that the hearing officer may have fallen into error and that it is appropriate to reconsider the question of conceptual similarity.

36. I believe that the average consumer is likely to perceive the earlier marks to be a person's signature. It is a well-known fact that many Italian fashion designers use their names, some as surnames alone and some as full names, as brand names for clothing. Given the presence on the market and general awareness of UK consumers of a number of high-profile Italian fashion labels containing names ending in I and/ or IO (e.g. GUCCIO GUCCI, GIORGIO ARMANI, SERGIO ROSSI), I also believe that the average consumer would perceive the CTM as an Italian name comprising a first name and surname, likely to be that of the clothing designer.
37. Turning to the Mark, it is much less obvious that TUZZI would be perceived to be an Italian name. Although it is possible that some might perceive TUZZI as a surname, in the absence of evidence to that effect, I think it is more likely that the average consumer would see it as an invented word. I therefore agree with the hearing officer's conclusion of lack of conceptual similarity between the Mark and the earlier trade marks.

Additional errors in assessment of likelihood of confusion

38. The Opponent contended that, while the hearing officer correctly held that the name EMIDIO TUCCI was not commonplace, he failed to appreciate that this meant the mark had a high degree of distinctive character and an enhanced penumbra of protection. I disagree. The hearing officer said at paragraph 17 that, if TUZZI and EMIDIO TUCCI were names, they were "anything but commonplace" and that, if they were not names, they were nevertheless to be "regarded as distinctive" because they had no obvious or direct reference to clothing. My understanding of this paragraph is that the hearing officer recognised that the earlier marks should be considered to be distinctive in either case. He had already cited *SABEL v Puma* as authority for the proposition that distinctive marks have a greater penumbra of protection, and I have no doubt that he took into account this well-known principle when assessing the likelihood of confusion.
39. The final error alleged by the Opponent was that the hearing officer failed to take account of the fact that it is common for fashion brands to be configured in different ways to indicate different product lines and for brand owners who use their names to use them sometimes as just surnames and sometimes as full names (examples given being: CHANEL/COCO CHANEL, PRADA/MIUCCI PRADA, ARMANI/ GIORGIO ARMANI and VERSACE/GIANNI VERSACE). I note that this list is not supported by any evidence. However, I am prepared to accept that, even if the

average consumer of clothing would not be aware of all of the brands and name/surname variations listed here, they would be aware of this branding practice.

40. I do not believe that the hearing officer's failure to deal with this point can properly be said to have been an error of law. What is really being said is that he should have taken judicial notice of a feature of the market in clothing. It does not appear to me that this feature was drawn to his attention at first instance. However, I believe that it is very unlikely to have changed the hearing officer's mind on the question of likelihood of confusion even if it had been, in the light of his prior conclusions of lack of visual, aural and conceptual similarity.
41. To summarise the position so far, I have accepted two of the Opponent's criticisms of the Decision (the starting assumption as to how the earlier marks would be read and the unexplained leap in the assessment of conceptual similarity) and acknowledged that another point (the name/surname point) could have been factored in, but have concluded in each case that these points would have made no difference to the hearing officer's assessment.
42. In the circumstances, I do not think that it is appropriate to substitute my own assessment of the matter. However, in case it might be said that I should have done so, having found some errors in the Decision, I am able to say that I would have reached the same overall conclusion. I would not have gone as far as the hearing officer did in finding no visual or aural similarity, since in my view the average consumer would have perceived some, albeit quite low, visual and aural similarity between the respective marks. However, as indicated above, I would have gone along with the hearing officer's finding of lack of conceptual similarity.
43. In my own view, the combination of these elements results in low overall similarity between the respective marks, just sufficient to justify taking the case on to the next stage of considering the likelihood of confusion. However, in the absence of persuasive evidence to suggest that the relevant public would believe that clothing bearing the mark TUZZI came from the same undertaking as clothing bearing the earlier EMIDIO TUCCI marks, I do not believe that any confusion is likely. The Opponent's argument about name/surname brand names would help if TUZZI looked or sounded the same as, or deceptively close to, TUCCI, but – since there are readily discernible differences – I do not think that consumers would assume that there is a trade connection between the two.
44. I note for the record that both the Cancellation Division and the Second Board of Appeal also reached the same overall conclusion in the OHIM opposition proceedings. Although those proceedings involve different countries and consumers, it is of some comfort that their outcome to date is consistent with the hearing officer's conclusion, with which I also agree.

Conclusion

45. The result is that, despite upholding some of the Opponent's criticisms of specific aspects of the Decision, these do not affect the outcome of the opposition. I therefore dismiss the appeal.
46. The hearing officer ordered the Opponent to pay the Applicant £500 towards their costs. I leave this order in place. Taking into account the guidance in Tribunal Practice Notice 4/2007, and bearing in mind the fact that the Applicant was not represented at the hearing but filed written submissions through its trade mark attorneys, I order the Opponent to pay a further £500 to the Applicant as a contribution to their costs of defending the appeal.

ANNA CARBONI

12th July 2010

The Appellant (Opponent) was represented by Counsel, Mr Simon Malynicz, instructed by Fry Heath Spence LLP.

The Respondent (Applicant) was not represented at the hearing, but filed written submissions through Reddie & Grose.