

O-337-09

**TRADE MARKS ACT 1994  
and  
THE TRADE MARKS (INTERNATIONAL REGISTRATION) ORDER 1996**

**IN THE MATTER OF DESIGNATION NO. 496835  
IN THE NAME OF TUZZI FASHION GMBH**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 71537 IN THE NAME OF  
EL CORTE INGLES SA**

**Trade marks Act 1994 and**

**The Trade Marks (International Registration) Order 1996**

**IN THE MATTER OF Designation No. 496835  
in the name of TUZZI Fashion GmbH**

**And**

**IN THE MATTER OF Opposition thereto under No. 71537  
in the name of El Corte Ingles S.A.**

**Background**

1. On 20 March 2007, TUZZI Fashion GmbH sought to extend protection of their International Registration No 496835 for the mark TUZZI to the UK under the provisions of the Madrid Protocol. The designation is registered for the following specification of goods in Class 25:

Clothing.

2. On 19 December 2007, El Corte Ingles S.A. filed notice of opposition to the designation, the ground being in summary:

**Under Section 5(2)(b)** because the mark applied for is similar to, and is sought to be registered in respect of goods that are identical or similar to the opponent's earlier Community Trade Mark (CTM) No. 3679594 and their International Trade Mark No. 868994 such that there exists a likelihood of confusion.

3. Details of the earlier marks relied upon by the opponents can be found as an annex to this decision.

4. The applicants filed a Counterstatement in which they admit that "clothing" contained within the specifications of Class 25 of the earlier marks is the same as the goods for which they seek registration, but deny that the other goods in that class of the earlier marks are the same or similar.

5. No evidence was filed and no request was made to be heard, both parties electing instead to have the matter determined from the papers. I now go on to give my decision.

**Decision**

6. The opponents rely on two earlier marks, a Community Trade Mark (CTM) No. 3679594 and an International Trade Mark No. 868994.

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means –

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.”

8. The opposition is founded under Section 5(2)(b). That section reads as follows:

“5(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 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.”

9. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] FSR. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] ETMR 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(f) 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; *Sabel BV v Puma AG*,

(g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM (LIMONCELLO)*

10. The opponents cite two earlier marks, one CTM and an International registration under the Madrid Protocol. As the CTM has not, as yet achieved registration, under the provisions of Section 6(2) of the Act it will not constitute an earlier mark unless it achieves registration. Consequently, any decision is preliminary pending the fate of that application. The representations of the marks are as follows:

**CTM**

**International**

*Eumidio Tucci*



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.

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.

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.

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.

18. The applicants are seeking to register their mark in Class 25 in respect of “clothing”. The opponent’s earlier marks also include Class 25 and specifically mention “clothing” so there is no need to consider whether there is similarity in the respective goods; self-evidently they are identical. 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. There is nothing in the wording of any of the respective specifications that would separate them in the market or course of trade. Accordingly, I must notionally assume that they operate in the same sector, and share the same channels of trade, from manufacture to retail. I can see no reason why the consumer of the respective goods should be any different.

19. As there is no evidence that the opponents have used their marks I cannot make any judgement on the reputation, if any, that they possess, and as a result, whether their mark is deserving of a wider protection.

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.

21. The opposition having failed, the applicants are entitled to a contribution towards their costs. I therefore order that the opponents pay the applicants the sum of £500 towards their costs. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 28<sup>th</sup> day of October 2009**

**Mike Foley  
For the Registrar  
The Comptroller-General**

## Community Trade Mark E3679594

Mark



**Mark text:** Emidio Tucci

### STATUS

**UK case status:** New application

**Original language:** Spanish

**Second language:** English

### Classes:

01, 02, 03, 04, 05, 06, 07, 08, 09, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34, 35, 36, 37, 38, 39, 40, 41, 42, 43, 44, 45

### RELEVANT DATES

**Filing date:** 20 February 2004

**Publication date:** 20 December 2004

### SENIORITY DETAILS

**Seniority date:** 30 May 1984

**Country:** Spain

**Reference:** 855782

### List of goods or services

**Class 1** Chemicals used in industry, science and photography, as well as in agriculture, horticulture and forestry; unprocessed artificial resins and plastics; manures; extinguishing compounds; tempering and soldering preparations; chemicals substances for preserving foodstuffs; tanning materials; adhesives for industry



- Class 2**      Paints, varnishes, lacquers; preservatives against rust and against deterioration of wood; dyestuffs; mordents; raw natural resins; metals in foil and powder form for painters, decorators, printers and artists.
- Class 3**      Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; (abrasive preparations) soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.
- Class 4**      Industrial oils and greases; lubricants; dust absorbing, wetting and binding compositions; fuels (including motor spirit) and illuminants; candles, wicks (lighting).
- Class 5**      Pharmaceutical and veterinary preparations; sanitary preparations for medical purposes; dietetic substances adapted for medical use, food for babies; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; preparations for destroying vermin; fungicides, herbicides.
- Class 6**      Common metal and their alloys; metal building materials; transportable buildings of metal; metallic materials for railroads; non-electric cables and wires of common metal; ironmongery, small items of metal hardware; pipes of metal; safes; goods of common metal not included in other classes; ores.
- Class 7**      Machines and machines tools; motors and engines, except for land vehicles; machine coupling and transmission components except for land vehicles; agricultural implements other than hand operated; incubators for eggs.
- Class 8**      Hand tools and implement (hand operated); Cutlery; knives; shavers.
- Class 9**      Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life saving and teaching apparatus and instruments; apparatus and instruments for conducting, distribution, transformation, storage, regulation or control of electricity, apparatus for recording, transmission, reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin operated apparatus; cash register, calculating machines, data processing equipment; extinguishers
- Class 10**      Surgical, medical, dental and veterinary apparatus and instruments, artificial limbs, eyes and teeth; orthopaedic articles; suture materials.
- Class 11**      Apparatus for lighting, heating, steam generating, cooking, refrigerating, drying, ventilating, water supply, and sanitary purposes.

- Class 12** Vehicles; vehicles for locomotion by air, land or water.
- Class 13** Firearms; ammunition and projectiles; explosives; pyrotechnic materials.
- Class 14** Precious metals and their alloys and goods in precious metals or coated therewith not included in other classes; jewellery, costume jewellery, precious stones; horological and chronometric instruments.
- Class 15** Musical instruments.
- Class 16** Paper, cardboard and goods made from these materials, not in other classes; printing materials; bookbinding material; photographs; stationery; adhesives for stationary or household purposes; artists material; paint brushes; typewriters and office requisites (except furniture); instruction and teaching material (except apparatus); plastic materials for packing (not included in other classes); printing types; printing blocks.
- Class 17** Rubber, gutta-percha, gum, asbestos, mica and goods made from these materials and not included in other classes; plastics in extruded form for use in manufacture; packing, stopping, insulating materials; non-metallic hoses.
- Class 18** Leather and imitations of leather, and goods made of these materials (not included in other classes); animal skins; trunks and travelling bags; umbrellas, parasols, canes and walking sticks; whips, harness and saddlery.
- Class 19** Building materials, not of metal; non-metallic rigid piping for building; asphalt, pitch and bitumen; non-metallic transportable structures; monuments, not of metal.
- Class 20** Furniture, mirrors, picture frames; goods (not included in other classes) of wood, cork, reed, cane, wicker, horn, bone ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and substitutes for all these materials, or of plastics.
- Class 21** Household or kitchen utensils and containers (not of precious metal or coated therewith); combs and sponges; brushes (except paint brushes); brush-making materials; materials for cleaning purposes; steel wool; unworked or semi-worked glass (except glass used in building); glassware, porcelain and earthenware (not included in other classes).

- Class 22** Ropes, string, nets, tents, awnings, tarpaulins, sails, sacks and bags (not included in other classes); padding and stuffing materials (except of rubber or plastics); raw fibrous textile materials.
- Class 23** Yarns and threads, for textile use.
- Class 24** Woven and textile products not included in other classes; bed and table covers.
- Class 25** Clothing, footwear and headgear.
- Class 26** Lace and embroidery, ribbons and braids; buttons, hooks and eyes, pins and needles; artificial flowers.
- Class 27** Carpets, rugs, mats, matting, linoleum and other materials for covering existing floors; wall hangings (non textile).
- Class 28** Games, playthings; gymnastic and sporting articles (not included in other classes); decorations for Christmas trees.
- Class 29** Meat, fish, poultry and games; meat extracts; preserved, dried and cooked vegetables and fruits; jellies, jams, fruit sauces; eggs, milk and milk products; edible fats and oils.
- Class 30** Coffee, tea, cocoa, sugar, rice, tapioca, sago coffee substitutes; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacles; yeast baking-powder; salt, mustard; vinegar sauces (condiments); relish; ice.
- Class 31** Agricultural, horticultural and forestry products and grains( not included in other classes); live animals; fresh vegetables and fruits; seeds, natural plants and flowers; animal feed, malt.
- Class 32** Beers; mineral and aerated water and other non-alcoholic drinks; fruit drinks, fruit juices; syrups and other preparations for making drinks.
- Class 33** Alcoholic beverages (except beers).
- Class 34** Tobacco; smokers' requisites; matches.

- Class 35**      Publicity; commercial business management; commercial administration; office work; rearrangement of various goods (except transport) for third parties, to enable consumers to examine and purchase these goods conveniently.
- Class 36**      Insurance; financial business; monetary affairs; real-estate affairs.
- Class 37**      Building construction; repair; Repair and maintenance.
- Class 38**      Telecommunications.
- Class 39**      Transportation; packaging and storage of goods; arranging travel tours.
- Class 40**      Treatment of materials.
- Class 41**      Providing of education; providing of training; entertainment; cultural and sporting activities.
- Class 42**      Scientific and technological services and research and design relating thereto; industrial analysis and research services; design and development of computers and computer programs (software); consultancy and legal assistance.
- Class 43**      Restaurant services (food); temporary accommodation.
- Class 44**      Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.
- Class 45**      Personal and social services rendered by others to meet the needs of individuals; security services

# International Madrid(UK) Trade Mark 868994

Mark



**Mark text:** Emidio Tucci

## STATUS

**UK case status:** Protected

**Classes:** 03, 25

## RELEVANT DATES

**Date of international registration:** 12 May 2005

**Date of designation in UK:** 12 May 2005

**Next renewal date:** 12 May 2015

## OFFICE OF ORIGIN DETAILS

**Office of origin:** Spain

Basic application or registration number	Filing or registration date
855782	30 May 1984
1.908.876	05 December 1994

**PUBLICATION IN TRADE MARKS JOURNAL**

**First advert: Journal: 6650**

**Publication date: 15 September 2006**

**List of goods or services**

**Class 3**      Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices.

**Class 25**      Clothing, including boots, shoes and slippers.