O/0670/24

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001665507

DESIGNATING THE UK

BY EYESPECS INTERNATIONAL LLC

IN CLASS 35

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY

UNDER NO. 505703

BY OUT OF SITE LTD

BACKGROUND AND PLEADINGS

1. International trade mark 1665507 ("the IR") consists of the sign shown on the cover page of this decision. The holder is Eyespecs International LLC. The IR is registered with effect from 7 May 2022. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The date of protection of the IR in the UK is 10 December 2022 for the following services:

Class 35 Retail store services in relation to eyewear, eyeglasses and sunglasses; on-line retail store services in relation to eyewear, eyeglasses and sunglasses.

2. On 11 January 2023, Out of Site Ltd ("the applicant") applied to have the IR declared invalid under section 47 of the Trade Marks Act 1994 ("the Act"). The application is based upon section 5(2)(b) of the Act, and the applicant relies upon the following trade marks:

eye-spec

UK registration no. UK00003469933
Filing date 25 February 2020.
Registration date 9 August 2020.
("The First Earlier Mark")

eye-spec

UK registration no. UK00003781536
Filing date 26 April 2022.
Registration date 22 July 2022.
("The Second Earlier Mark")

3. The applicant relies upon all of the goods and services, for which its marks are registered, as contained in the Annex to this decision.

4. The applicant claims there is a likelihood of confusion because the services are identical, the goods and services are highly similar, and its marks and the IR are highly similar.

5. The holder filed a counterstatement admitting that the parties' class 35 services are identical but denied that the applicant's class 9 goods are highly similar to its services and denied the high similarity of the respective marks.

6. The applicant is represented by Sipara Limited and the holder is represented by Dehns. Neither party filed evidence nor requested a hearing, but both parties filed submissions in lieu of a hearing. I have taken all of the submissions into account in reaching this decision, referring to them as necessary.

RELEVANCE OF EU LAW

7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

8. Section 5(2)(b) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D)-(2DA) [Repealed]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on

the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) […]

(4) […]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed."

Section 5(2)(b)

9. Section 5(2)(b) 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."

10. Due to their earlier filing dates, the trade marks upon which the applicant relies qualify as earlier trade marks pursuant to section 6 of the Act. The earlier marks have not completed their registration process more than five years before the relevant date (the filing date of the holder's IR). Accordingly, the use provisions at section 47(2A) of the Act do not apply. The applicant may rely on all of the goods and services it has identified without demonstrating that it has used the marks.

Section 5(2)(b) - case law

11. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

12. As noted in paragraph 5 above, the holder has admitted that its services are identical to the Second Earlier Mark's services.

13. On the basis that the First and Second Earlier Marks are identical "eye-spec" word marks, I will procced with the rest of my decision based on the Second Earlier Mark only, as it is the applicant's strongest case.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

> "60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

"average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

15. The average consumer for the services will be members of the general public, including those who require corrective eyewear. The holder submits that the average consumer of the goods which are subject of the class 35 services (that being eyewear, eyeglasses and sunglasses), will pay a high degree of attention as they are expensive goods, which are not everyday purchases. I agree that using retail services for prescription eyewear is more likely to be infrequent, and can be expensive, however, on balance the cost of the eyewear prescription goods/services are not likely to be relatively high. Moreover, not all retail services for eyewear, eyeglasses and sunglasses are for prescription goods, for example, reading glasses and sunglasses can be non-prescribed, relatively frequent and low-cost purchases. Regardless, the consumer is likely to take various factors into consideration, such as the location, cost, type of services offered and the suitability of these services for the consumer's needs. I therefore consider that a medium degree of attention will be paid during the purchasing process.

16. The services which provide prescription eyewear are likely to be obtained from specialist optical retailers and their online equivalents. However, non-prescription eyewear can be obtained from general retail stores. Alternatively, the services may be purchased following perusal of advertisements or signage on physical premises. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase of the services given that they may be booked over the telephone or online, or via recommendations may have been given through word-of-mouth.

Comparison of the trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant

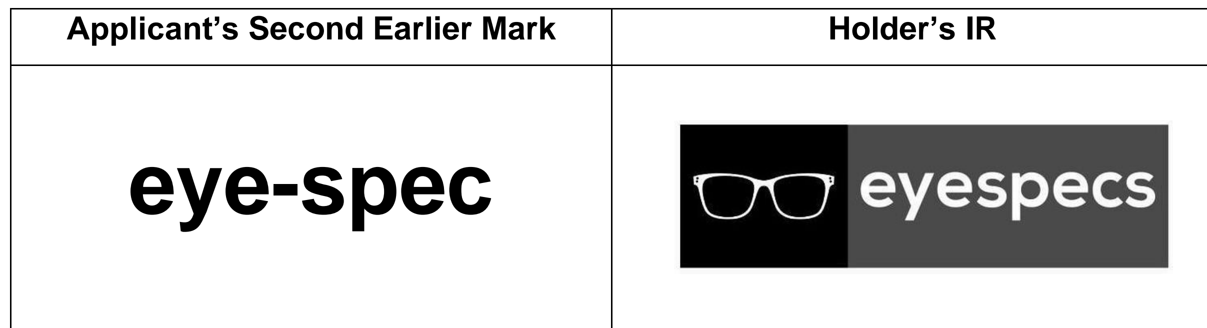
components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

18. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

19. The respective trade marks are shown below:

Applicant's Second Earlier Mark	Holder's IR



20. The applicant's Second Earlier Mark consists of the words "eye" and "spec" joined by a hyphen. I consider that the overall impression lies in the combination of these elements.

21. The holder's IR consists of a white glasses' device presented on a black square background, with the word "eyespecs" presented in white on a rectangular dark grey background next to it. I bear in mind that the eye is naturally drawn to the element of the mark that can be read, and therefore, the word "eyespecs" plays a greater role in the overall impression of the mark, with the glasses device and backgrounds playing a lesser role.

22. Visually, both the Second Earlier Mark and IR consist of, or include the words "eye" and "spec". This acts as a visual point of similarity. However, these words are joined by a hyphen in the applicant's mark, whereas these words are presented together in the holder's IR, which also ends in the letter "s". Moreover, the holder's IR contains the glasses device, and the black and grey background. These act as visual points of difference. However, taking all of the above into account, bearing in mind the word "eyespecs" plays a greater role in the overall impression of the mark, I consider that the Second Earlier Mark and IR are visually similar to between a medium and high degree.

23. Aurally, the glasses device and the background elements in the holder's IR will not be articulated. I also note that whilst the words "eye" and "specs" in the holder's IR is presented without a space between them, I consider that the average consumer will perceive a natural break between them. On this basis, I consider that the applicant's mark will be pronounced as EYE-SPEC whereas the holder's IR will be pronounced as EYE-SPEC<u>S</u>. Thus, as the only differing aural element is the "S" at the end of the holder's IR, the Second Earlier Mark and IR are aurally similar to a high degree.

24. Conceptually, the holder submits that the aural element of its IR will be perceived as "spectacles for the eyes" which is reinforced by the glasses' device. I agree. I also do not consider that the black and grey background will add to the conceptual message of the holder's IR.

25. The holder also submits that the applicant's mark will be seen as a "play on words" for the phrase "high spec", and that whilst this is allusive of the quality of the services, this conceptual message is not present in their mark. Whilst there may be a small proportion (which is not significant) of average consumers who may perceive this, I consider that a significant proportion will view the mark literally (the word eye followed by the shortening of the word <u>spec</u>tacles); and even where a small proportion of average consumers see the play on words, they would also nonetheless perceive the mark in its literal sense. This is because the word "eye" precedes the word "spec", and therefore a significant proportion of average consumers would logically see it as the shortening of the ordinary dictionary word <u>spec</u>tacles, which are worn on the user's eyes, rather than a shortening of the word "specification". I consider this is reinforced

by the hyphen which joins the two words together. Therefore, as a whole, the IR also conveys the conceptual message of "spectacles for the eyes", making the Second Earlier Mark and IR conceptually identical to a significant proportion of average consumers.

Distinctive character of the earlier trade mark

26. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51)."

27. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

28. As the applicant has not filed any evidence to show that the distinctiveness of its Second Earlier Mark has been enhanced through use, I only have the inherent position to consider.

29. As highlighted above, the applicant's mark consists of the words "eye" and "spec" joined by a hyphen. As a whole, the mark conveys the concept of spectacles, for the eyes, which is highly allusive of the applicant's services. However, as per *Formula One Licensing BV v OHIM*,[1] the earlier mark must be considered to have at least some distinctive character. Consequently, the Second Earlier Mark is inherently distinctive to a low degree.

Likelihood of confusion

30. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

[1] Case C-196/11P

31. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the Second Earlier Mark and IR to be visually similar to between a medium and high degree.
- I have found the Second Earlier Mark and IR to be aurally similar to a high degree.
- I have found the Second Earlier Mark and IR to be conceptually identical to a significant proportion of consumers.
- I have found the applicant's mark to be inherently distinctive to a low degree.
- I have identified the average consumer for the goods to be members of the general public, including those who require corrective eyewear, who will select the services primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- The holder concedes that the parties' services are identical.

32. I bear in mind the decision of the CJEU in *L'Oréal SA v OHIM*, Case C-235/05 P, in which the court confirmed that weak distinctive character of the earlier trade mark does not preclude a likelihood of confusion.

33. Therefore, taking all of the above into account, considering the principle of imperfect recollection, and bearing in mind that both marks consist of, or include the words "eye" and "spec", I consider that there is a likelihood of direct confusion. I consider that the hyphen in the applicant's mark, and the letter "s" at the end of the holder's IR will be easily overlooked or misremembered by the average consumer paying a medium degree of attention. I also consider that the average consumer would easily overlook the glasses device (which reinforces the conceptual message of the mark) and background of the holder's IR, which plays a lesser role in the overall impression. Furthermore, given that the average consumer rarely has the opportunity to compare marks side-by-side and will instead encounter them in different settings at different times, to my mind, the medium to high degree of visual similarity between the

marks will lead the average consumer to mistake one mark for the other, especially as the purchasing process is predominantly visual. Even where aural considerations apply, the high degree of aural similarity between the Second Earlier Mark and IR will have the same result. I also note that the Second Earlier Mark and IR are conceptually identical to a significant proportion of average consumers, which means there is no conceptual hook to assist in differentiating between them. However, even if they were conceptually dissimilar (which I have concluded they are not), I note that there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences.[2] Consequently, taking all of the above into account, I consider that there is a likelihood of direct confusion.

CONCLUSION

34. The application for invalidation is successful and the holder's IR is hereby declared invalid in respect of all services for which it is registered. Under section 47(6) of the Act, the registration is deemed never to have been made.

COSTS

35. The applicant has been successful and is entitled to a contribution towards its costs based upon the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £700, calculated as follows:

Preparing the application for invalidity and considering the Counterstatement	£200
Filing written submissions in lieu	£300
Official fee	£200
Total	**£700**

[2] *PINKIES* trade mark, BL O/566/19, paragraph 28.

36. I therefore order Eyespecs International LLC to pay Out of Site Ltd the sum of £700. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of July 2024

L FAYTER

For the Registrar

ANNEX

The First Earlier Mark

Class 9

Reading glasses and eye-wear.

The Second Earlier Mark

Class 35

Retail services in the field of reading glasses, lenses, eye-wear, cases for reading glasses and frames for reading glasses.