

**TRADE MARKS ACT 1938 (AS AMENDED)  
TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATION  
No 1113912 STANDING IN THE NAME OF  
FOR EYES OPTICAL COMPANY**

**AND**

**IN THE MATTER OF AN APPLICATION BY DOLLAND & AITCHISON  
GROUP PLC UNDER No 7671 TO HAVE THE REGISTER RECTIFIED  
BY ITS REMOVAL**

**TRADE MARKS ACT 1938 (AS AMENDED)**

5 **IN THE MATTER OF Trade Mark Registration  
No 1113912 standing in the name of For Eyes  
Optical Company**

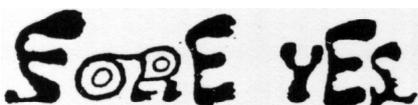
**And**

10 **AN APPLICATION BY Dolland & Aitchison Group PLC  
under No 7671 to have the register rectified by its removal**

15

**DECISION**

20 Registration No 1113912 stands on the register in the name of For Eyes Optical Company of  
Florida, United States of America. The date of registration is 22 September 1982. The trade  
mark in question is shown below

25 

30 and it is registered for a specification of goods which reads as follows:-

"Optical apparatus and instruments; spectacles; sunglasses and parts and fittings  
included in Class 9 for all of the aforesaid goods; contact lenses."

35 On 26 May 1993, Dolland & Aitchison Group PLC of Birmingham, United Kingdom, applied  
for the rectification of the registration on the following grounds:-

40 1. Because the trade mark has not been used in the United Kingdom at any time  
during a continuous period of five years (by the proprietor or a registered user) upon  
or in relation to any of the goods covered by the registration. (Presumably this ground  
falls under Section 26(1) of the Act.)

2. Because the registered proprietor at the date of application had no bona fide  
intention to use the trade mark in relation to the goods covered by the registration.

45 The registered proprietor filed a counterstatement in which they denied the allegations and  
claimed that use of a mark other than the one registered should, under the provisions of

Section 30(1) of the Act, be accepted as sufficient use to support the continuation of the registration in suit.

Both sides sought their costs and filed evidence.

5

The matter came to be heard on 17 November 2000 when the registered proprietor was represented by Mr Robert Onslow of Counsel instructed by Forrester Ketley & Co, their Trade Mark Attorneys. The applicants were not present nor were they represented.

10

By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly, all references in the later parts of this decision are references to the provisions of the old law.

15

## **DECISION**

In his skeleton argument on behalf of the registered proprietor Mr Onslow stated:

20

"It is accepted that the evidence fails to make out use of FORE YES or FOR EYES in the United Kingdom by FOR EYES OPTICAL COMPANY INC. There is therefore a discretion to rectify under Section 26 TMA 1938. As to when the effect of rectification, see below."

25

Section 26(1) of the Act states as follows:-

30

"26.-(1) Subject to the provisions of the next succeeding section, a registered trade mark may be taken off the register in respect of any of the goods in respect of which it is registered on application by any person aggrieved to the Court or, at the option of the applicant and subject to the provisions of section fifty-four of this Act, to the Registrar, on the ground either -

35

(a) that the trade mark was registered without any bona fide intention on the part of the applicant for registration that it should be used in relation to those goods by him, and that there has in fact been no bona fide use of the trade mark in relation to those goods by any proprietor thereof for the time being up to the date one month before the date of the application; or

40

(b) that up to the date one month before the date of the application a continuous period of five years or longer elapsed during which the trade mark was a registered trade mark and during which there was no bona fide use thereof in relation to those goods by any proprietor thereof for the time being;

45

5 Provided that (except where the applicant has been permitted under subsection (2) of section twelve of this Act to register an identical or nearly resembling trade mark in respect of the goods in question or where the tribunal is of opinion that he might properly be permitted so to register such a trade mark) the tribunal may refuse an application made under paragraph (a) or (b) of this subsection in relation to any goods, if it is shown that there has been, before the relevant date or during the relevant period, as the case may be, bona fide use of the mark by the proprietor thereof for the time being in relation to -

10 (i) goods of the same description; or

(ii) services associated with those goods or goods of that description,

15 being goods or, as the case may be, services in respect of which the mark is registered."

20 First of all I am satisfied that the applicant, as required by the above provision, is a person aggrieved. They are applicants for a later filed trade mark and this registration stands in their way. They have therefore the status to pursue the application.

25 Having read the registered proprietor's evidence carefully I agree with Mr Onslow that it does not show use (on any goods covered by the registration) of the registered trade mark or any other trade mark which could be said to be similar to it which might provide a defence under the provisions of Section 30(1) of the Act which states as follows:

30 "30.-(1) Where under the provisions of this Act use of a registered trade mark is required to be proved for any purpose, the tribunal may, if and so far as the tribunal thinks right, accept use of an associated registered trade mark, or of the trade mark with additions or alterations not substantially affecting its identity, as an equivalent for the use required to be proved."

35 In all of the circumstances I am satisfied that the application for the rectification of the register by the removal of this trade mark on the basis of Section 26 of the Act should be acceded to. I therefore order that the trade mark register be rectified by the removal from it of trade mark registration No 1113912.

In accordance with the judgment of Lightman J, in *Second Sight v Novell* [1995] RPC 423 (at 430) the register is rectified with affect from the date of this order.

40 As the applicant for rectification has been successful and the registration is to be revoked, they are entitled to a contribution towards their costs. I therefore order the registered proprietor to pay to them the sum of £400.

45 **Dated this 23 day of January 2001**

50 **M KNIGHT**  
**For the Registrar**  
**the Comptroller-General**