

O-124-04

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2270311 BY FASHION WEAR SERVICES LIMITED TO REGISTER THE TRADE MARK FOUR EYEZ IN CLASSES 5 AND 9

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 90757 BY FOR EYES OPTICAL COMPANY

DECISION

Introduction

1. On the 17th May 2001 Fashion Wear Services Limited (the “Applicant”) applied to register the mark FOUR EYEZ under No. 2270311 in respect of the following goods:

Class 05:

Ophthalmic preparations and solutions; preparations, fluids and solutions for contact lenses; preparations, fluids and solutions for storing and/or cleaning contact lenses.

Class 09:

Optical apparatus and instruments; lenses and contact lenses; coloured contact lenses; patterned contact lenses; containers for the cleaning and storage of contact lenses; parts and fittings for all the aforesaid goods.

2. On the 26th June 2002 the application was opposed by For Eyes Optical Company (“the Opponent”) under section 5(2) of the Trade Marks Act 1994. The opposition was based upon the earlier Community trade mark No. 2182467 set out below:



and registered in respect of the following goods:

Class 09:

Optical apparatus and instruments; spectacles; spectacle frames and lenses; sunglasses; cases, chains and cords for spectacles and sunglasses; contact lenses; parts and fittings for all the aforesaid goods.

Class 35:

Retail optical store services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail optical store.

Class 42:

Opticians services; advisory, consultancy and information services relating to the aforesaid services.

The decision of the Hearing Officer

3. The opposition was decided by Mr. M. Reynolds, the Hearing Officer acting on behalf of the Registrar. By a written decision dated the 21st October 2003 he dismissed the opposition.
4. The Hearing Officer approached the issue in a conventional way. First, he addressed the similarity of the goods and services of each of the specifications before him. He identified a number of identical goods, such as “optical apparatus and instruments”, “contact lenses” and “parts and fittings”. He concluded that the other goods and services were similar.
5. He then considered the distinctive character of the respective marks. He concluded that the earlier trade mark contained a not particularly oblique

reference to the nature and purpose of the protected goods and services and had a low level of distinctive character. The mark applied for played on the well known slang term for someone who wears glasses and had a slightly greater degree of distinctive character, aided by the unusual use of the letter “z” at the end of the second word.

6. Turning to the similarity of the marks, the Hearing Officer noted that the visual, aural and conceptual similarities between the marks must be assessed by reference to the overall impressions which they create. The Hearing Officer took as his starting point the average consumer. He said, in paragraph 20 of his decision:

"... the average consumer of the goods/services at issue is likely to be the public at large. The market for optical apparatus and instruments is also likely to extend to companies and trade customers. Such goods are chosen with some care. Spectacles and contact lenses are both important to correct the eyesight and to an extent are fashion accessories."

7. Considered through the eyes of the average consumer, the Hearing Officer concluded that there was a relatively low degree of visual similarity between the respective marks. Conceptually he also considered they were rather different in that the words of each mark had their own obvious but different meanings. He found that the only conceptual similarity between the marks related to their descriptive reference to goods suitable for use in relation to eyes. From an aural perspective, however, the Hearing Officer recognised that the two marks were almost indistinguishable.

8. Finally, the Hearing Officer turned to consider the likelihood of confusion. He assessed this globally and specifically took into account the identity or close similarity of the goods and services, and the fact that from an aural perspective the marks were almost indistinguishable. Nevertheless he concluded that visual considerations were likely to be paramount in the circumstances of the trade in issue. In paragraph 25 of his decision he concluded as follows:

"According to *Canon v. MGM* a lesser degree of similarity between marks may be offset by a greater degree of similarity

between the goods and vice versa. *Canon*, therefore, acknowledges the principle of interdependency. In the opponents' favour is the identity/close similarity between the goods and very close phonetic similarity between the marks. In the applicants' favour is the low level of distinctive character attaching to the opponent's mark, the visual and conceptual difference between the marks and the fact that, absent evidence to the contrary, I take the view that visual considerations are likely to be the overriding ones in relation to the goods at issue. Weighing these factors in the balance I am not persuaded that it can be said there is a likelihood of confusion or that consumers would make any relevant association between the marks within the meaning of *Canon v. MGM* (paragraph 29). Nor is this a case where allowance for imperfect recollection might produce a different result. The marks are made up of common dictionary words which each have their own distinct meanings in relation to the goods. Imperfect recollection is unlikely to blur or offset that distinction. The opposition fails on the only ground on which it was brought. "

The Appeal

9. On the 18th November 2003 the Opponent gave notice of appeal to an Appointed Person. On the hearing of the appeal the Opponent was represented by Mr. A. Roughton, instructed by Forrester Ketley & Co, and the Applicant was represented by Mr. B. Brandreth, instructed by Appleyard Lees. Both parties agreed that I should be guided by the principles explained by the Court of Appeal in *REEF Trade Mark* [2003] RPC 5.
10. Mr. Roughton argued that the Hearing Officer fell into error at the outset in that he failed to consider the matter from the perspective of the average consumer and wrongly considered that the consumers in issue were likely to be circumspect and careful.
11. I am unable to accept this criticism. In paragraph 20 of his decision, which I have set out above, the Hearing Officer directed himself correctly that he should take as his starting point the average consumer of the goods and services in issue. He considered that such an average consumer was likely to be a member of the public at large, although the market was likely to extend to companies and trade customers. Having identified the average consumer, the Hearing Officer then set out to assess the likelihood of confusion as a matter

of global appreciation and taking into account all factors relevant to the circumstances of the case. In making that assessment, appropriate account must be taken of the category of goods or services in question: *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV* [1999] ECR I-3819, at paragraph 26. Clearly customers will take a greater degree of care in selecting certain categories of goods and services than others. In the present case the Hearing Officer considered that the average consumer would choose the goods or services in issue with some care. It seems to me that this was a conclusion that he was perfectly entitled to reach. Indeed it is one with which I agree.

12. Secondly, it was argued that the Hearing Officer fell into error because he sought to dissect the marks in issue and failed to consider them as a whole. Again, I reject this criticism. It is clearly established that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v. Puma AG* [1997] ECR I-6191, at paragraph 23. Nevertheless the global appreciation of the similarity of the marks must be based on the overall impression given by the marks, but bearing in mind their distinctive and dominant components.
13. The earlier trade mark consists of the word FOR in black on a white background and the word EYES in white on a black background. The words themselves are descriptive of the general purpose of the goods and services the subject of the registration. Overall, however, the mark does have a degree of visual distinctiveness, although I agree with the Hearing Officer that it is at the lower end of the scale. The Applicant's mark on the other hand is a play on the expression "four eyes" which is often used in a rather disparaging way to refer to persons who wear glasses. It too alludes to the use of the various goods the subject of the application but, as the Hearing Officer considered, it is slightly more distinctive than the earlier mark. Overall I believe that the Hearing Officer approached the matter correctly. He did consider the marks as a whole, but nevertheless had regard to their distinctive and dominant components.

14. Finally, it was argued that the Hearing Officer gave undue prominence to the visual aspects of the marks and failed to give due account to the aural and conceptual similarities between them. In particular it was said that the goods in issue were often likely to be ordered by telephone or bought by one person on behalf of another and that in such circumstances there was a real possibility of confusion arising. Further, it was suggested that conceptually the two marks in fact had the same meanings in that each conveyed both the same rather derogatory reference to a person who wears glasses and also an oblique reference to the goods or services as being suitable for use in connection with eyes.

15. To my mind these are not criticisms of the approach which the Hearing Officer has adopted, but rather of the conclusion that he has come to. I do not think it can be said that he made an error of principle or was plainly wrong to come to the conclusion which he did. The Hearing Officer recognised that the marks were almost indistinguishable to the ear but reached the conclusion that not only were the goods in issue likely to be chosen with some care, but also that they would normally be purchased on the basis of some sort of visual inspection of and appreciation of the goods and marks on them and that accordingly the visual similarities of the marks in issue were the most important ones. I believe that this was a reasonable conclusion for him to have come to. Moreover, particularly when considered from a visual perspective, I agree with the Hearing Officer that the particular words the subject of each mark have their own but rather different meanings.

16. In all the circumstances the appeal must be dismissed. I direct that the Opponent pay to the Applicant a further sum of £1,200 by way of a contribution to costs. The sum is to be paid on a like basis to that ordered by the Hearing Officer.

David Kitchin QC

5th May 2004