

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No 2016569  
BY CHAPMAN & SMITH LTD  
TO REGISTER A SERIES OF TWO TRADE MARKS  
**SAFIR EUROPA / SAFIREUROPA**  
IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO  
by SAFILO SOCIETA AZIONARIA FABRICA ITALIANA LAVORAZIONE  
OCCHIALI S.p.A.(Safilo)

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5 TO REGISTER A SERIES OF TWO TRADE MARKS IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NUMBER 45399 BY SAFILO SOCIETA AZIONARIA FABRICA ITALIANA  
LAVORAZIONE OCCHIALI S.p.A.

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## DECISION

### BACKGROUND

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On 5 April 1995, Chapman & Smith Ltd of Safir Works, East Hoathly, Nr Lewes, East Sussex, BN8 6EW applied under the Trade Marks Act 1994 for registration of a series of two trade marks **SAFIR EUROPA / SAFIREUROPA** in respect of the following goods in class 9:

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“Respirative and breathing apparatus, none for artificial respiration, dust masks, ear defenders and ear plugs; cartridge filters for the aforesaid respirators; protective face masks, protective face shields; protective helmets; protective visors; face protectors, flame retardant clothing for welders or for working environments where fire is a hazard; respiratory masks; life saving apparatus and equipment; protective gloves, gauntlets used in industrial applications; protective headgear; all used in a working environment; ear defenders with in built speech communicator; protective spectacles and hearing protection apparatus; protective goggles and frames therefor; eye shields; air supplied respirators and air filter units; fall arrest equipment; safety harnesses and lanyards being parts of safety harnesses; slings and cables therefore; cables, winches and tripods therefore; harness straps and harness tracers; communication apparatus allowing communication between two or more people in areas of high noise; rope installers being parts and fittings for safety apparatus; descent control equipment; parts and fittings for all the aforesaid goods.”

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On the 12 September 1996 Societa Azionaria Fabrica Italiana Lavorazione Occhiali S.p.A.. (Safilo) filed notice of opposition to the application. The grounds of opposition are:

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i) the application is objected to under Section 3 of the Trade Marks Act 1994. Particularly, although not exclusively, the application is objected to under Section 3(3)(b)

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ii) The application is objected to under Section 5 of the Trade Marks Act 1994. Particularly, although not exclusively, the application is objected to under Sections 5(2)(b), 5(3) and 5(4) of the Act.

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iii) The opponents are the proprietors of the Trade Mark SAFILO. This is registered in the United Kingdom under number 991,765 and is a very well know trade Mark in the United Kingdom and internationally, by virtue of long-standing and substantial use.

The opponents further requested that the Registrar refuse application number 2016569 in the

exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as he did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects. The applicants filed a counterstatement denying all the grounds of opposition, other than agreeing that the opponents are the registered proprietors of the trade mark as claimed. Both sides asked for an award of costs. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings and the evidence filed.

#### OPPONENTS' EVIDENCE

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This takes the form of a statutory declaration by Giannino Lorenzon, dated 26 November 1997. Mr Lorenzon is the Managing Director of Safilo. He provides a brief background to the company, explaining that it was established in 1934 and has expanded with a network of subsidiaries and distributors in over 100 countries. The Safilo group is, he claims, one of the world's leading manufacturers and distributors of ophthalmic frames, sports goggles and sunglasses. Their range of products is shown at exhibit GL2. This shows a wide range of products all with the name SAFILO prominently used along with a sub-brand, as in SAFILO TEAM, SAFILO ELASTA, SAFILO TITANIUM etc.

Mr Lorenzon states that "the trade mark SAFILO which also characterizes the trade name of the company, has been used by SAFILO S.p.A. since 1934 without interruption and it has had a world-wide diffusion including the UK." He also claims that the company has regularly participated at major optical trade fairs around the world.

Mr Lorenzon provides turnover figures in relation to goods sold in the UK and also advertising figures. The turnover figures were provided in Italian Lira and I have converted them into approximate Sterling equivalents.

YEAR	TURNOVER £	ADVERTISING £
1991	1,500,000	
1992	1,500,000	
1993	1,400,000	22,000
1994	1,000,000	34,000
1995	2,400,000	200,000
1996	2,200,000	200,000

The promotion of the SAFILO brand in the UK is said to have included advertisements on television, in national newspapers and magazines, via exhibitions and also point of sale advertising. Examples of such advertising are provided at exhibits GL3 & GL4. These show a large number of advertisements with the SAFILO name being prominent, usually followed with the name of a particular frame/sub-brand such as Blue Bay, Kids etc.

It is claimed that the opponents sell their products to the major optical chains such as Dolland & Aitchison, Boots Opticians, & Vision Express as well as 4,900 other opticians throughout the UK.

Mr Lorenzon claims that the mark is also known around the world and a list of worldwide registrations is given at exhibit GL5 and shows applications or registrations in eighty-one countries. He also provides figures for sales and advertising of the SAFILO brand worldwide. Again the figures were provided in Italian Lira and have been converted into approximate Sterling equivalents.

Year	Turnover £	Advertising £
1991	29,000,000	2,800,000
1992	31,000,000	1,600,000
1993	29,000,000	2,000,000
1994	32,000,000	1,300,000
1995	55,000,000	1,500,000
1996	53,000,000	1,500,000

#### APPLICANTS' EVIDENCE

This consists of a statutory declaration, dated 17 March 1998, by Mr Maurice Arthur Smith a cofounder of Chapman & Smith and the current Chairman of Directors.

Mr Smith states that the mark SA-FIR was first used in the UK in 1950 in respect of dust masks. The mark was a hyphenated word derived from the words "Safety First". He states that the mark was used until the early 1970's when the mark SAFIR was adopted as one word and was registered under the number 1200487, for:

"Respirators and breathing apparatus, none for artificial respiration; dust masks; ear defenders and ear plugs, all included in Class 9; cartridge filters for the aforesaid respirators; parts and fittings included in Class 9 for all the aforesaid goods".

At exhibit MAS/2 is a catalogue from 1984 which shows that the SAFIR mark by that time was being used on items such as eyewash and lens cleaning stations and eye protection products. The mark is used together with the word "protection". Mr Smith claims that his company "has sold industrial goggles and protective eyewear of other manufacturers since 1951 and such goods would have been associated with my company and its house mark SAFIR or SA-FIR".

Mr Smith states that the SAFIR eyewash stations have been extensively advertised in trade journals. At exhibit MAS/3 he provides examples between June 1993 and September 1997 which show use of the SAFIR brand in advertisements for the eye wash station and goggles. Only two of these advertisements are before the relevant date. There are also other advertisements which are prior to the relevant date but it is not clear which magazine / newspaper they appeared in. Mr

Smith also states that the company attends exhibitions and provides an example of a press release for the ROSPA exhibition in 1987, which shows the name SAFIR in a label at the top of the page, together with the word “protection”.

5 Mr Smith states that his company sells, in the main, to industrial users. It does not sell to the optical trade, nor does it supply products to opticians directly. He continues, “as far as I am aware none of my company’s wholesalers or distributors supply my company’s products to opticians or optometrists”. Mr Smith points out that the products sold under the SAFIR mark are exclusively for the protection of workers. He also claims that the SAFIR mark “has become wholly distinctive of my company’s merchandise and I verily believe that within that industry the said trade mark would indicate my company’s merchandise exclusively”. This point is backed up with an extract from “Index to trade names” taken from the ISPEMA reference book dated 1990/91 which shows ten entries for various SAFIR products. Safir sometimes being used together with a lesser brand name such as “junior” or “standard”.

15 Mr Smith states that the turnover in SAFIR eye wash and lens cleaning stations and eye protection products have been approx. £75,000 per annum. He also refers to the series of marks that the company have registered; SAFIR GLADIATOR, SAFIR HARLEQUIN and SAFIR. However, only SAFIR GLADIATOR and SAFIR HARLEQUIN have protective spectacles and goggles listed amongst their specifications. The address of the company since 1960 has been “Safir works”.

20 Regarding the opponents’ evidence Mr Smith comments that there is a difference in the goods of the two parties and also between the marks. He draws attention to the accent above the “A” in the opponents’ mark which he claims makes it phonetically different to his mark. The opponents’ mark is reproduced below for ease of reference.



35 EVIDENCE IN REPLY

40 This consists of a statutory declaration by Mr Anthony Paul Brierley, dated 29 June 1998. Mr Brierley is a Chartered Patent Attorney, European Patent Attorney, Registered Trade Mark Agent and Partner in the firm of Appleyard Lees the trade mark agents for SAFILO. At exhibit APB2 is a copy of a statutory declaration by Mr Brierley, dated 29 June 1998. In this declaration Mr Brierley comments that the first four letters of the two marks are the same (SAFI) and would, in his opinion, be pronounced in the same way.

45 At exhibit APB1 is a statutory declaration dated, 12 June 1998, by Mr Richard Waddington a trade mark agent working for Appleyard Lees. Mr Waddington refutes the applicants’ claim that the products of the two parties are not sold by the same outlets. He says he telephoned a number of opticians and asked to purchase safety glasses and safety goggles. The majority of those contacted

either stocked or could supply safety glasses or goggles. This, Mr Waddington claims, proves that the products of the two companies are offered for sale “side by side”.

5 That concludes my review of the evidence. I now turn to the decision.

## 10 DECISION

10 The opponents have objected to the application under Section three of the Act. In their grounds of opposition they state that “particularly, although not exclusively, the application is objected to under Section 3(3)(b)”. As they have not particularised any other ground other than 3(3)(b) I shall only consider this single aspect of Section 3. In reaching this view I am mindful of the remarks of Geoffrey Hobbs QC sitting as the Appointed Person in the Wild Child case (1998 RPC 455) when referring to the scope of the opposition he said:

20 “In the interests of justice and fairness it is plainly necessary for an objection to registration under Section 5(4) to be framed in terms which: (i) specify whether the objection is raised under sub-section 4(a) or sub-section 4(b); (ii) identify the matters which are said to justify the conclusion that use of the relevant trade mark in the United Kingdom is liable to be prevented by virtue of an “earlier right” entitled to recognition and protection under the relevant sub-section; and (iii) state whether the objection is raised in respect to all or only some (and if so, which) of the goods....”

25 Although these comments were made in relation to an objection under Section 5 of the Act, it is my contention that they are equally valid when considering opposition under any Sections of the Act. The onus is on the opponent to articulate the grounds of opposition and refer to the sub-sections of the Act being relied upon in the opposition.

30 I shall consider the first ground of opposition is under Section 3 (3)(b) which states:

(3) *A trade mark shall not be registered if it is -*

35 (a) ....

(b) *of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).*

40 The opponents contend that the applicants’ marks are likely to deceive the public into thinking that the applicants’ goods originate from them. However, I note that Section 3(3)(b) is intended to apply where the deception alleged arises from the nature of the mark itself. This is consistent with the heading of Section 3 of the Act which is entitled “Absolute grounds for refusal” and is to be contrasted with Section 5 of the Act which deals with the “Relative” rights of the applicant and other parties. Consequently, the opponents cannot succeed under this heading based upon their use of a similar mark. As the opponents have shown no other grounds for refusal under Section 3(3) the opposition under this heading fails.

Next I consider the grounds of opposition under Section 5 (2) (b) which states:

“5.(2) A trade mark shall not be registered if because -  
(b) it is similar to an earlier trade mark and is to be registered for goods or services  
5 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.”*

10 The applicants’ goods in Class 9 are listed earlier in the decision, whilst the opponents goods  
under Class 9 are “spectacles and spectacle cases”.

Of the goods sought to be registered under Class 9 only “protective face shields; protective visors;  
face protectors; protective spectacles; protective goggles and frames therefore; & eye shields”  
15 would appear, ostensibly, to be in any way similar to the applicants’ goods. Of all the goods on  
which registration is sought, the only items singled out by the opponents as being contentious are  
the “protective spectacles and goggles”. Clearly “spectacles” are similar goods to “protective  
spectacles”, they could even be said to be identical goods as the former includes the latter.

20 I must also compare the marks applied for, SAFIR EUROPA / SAFIREUROPA, and the  
opponents’ mark SAFILO.

Visually the trade marks have identical beginnings, sharing the first four letters. There is a  
considerable difference in the overall length of the marks being eleven and six letters respectively,  
25 and in the applicants’ first mark, two words as opposed to one word.

Phonetically the first syllables of each mark are identical. The opponents have suggested that the  
first syllable is pronounced as in SAFari or SAFFron. I agree with this view. The second syllables  
however are, I believe quite different. The opponents’ mark being pronounced as FEE as in filo  
30 pastry, whereas the applicants’ mark would I believe be either FIR as in a fir tree or FEAR. The  
third syllable of the opponent’s mark LO, would be pronounced as in hoe or dough. The  
applicants’ mark has third and fourth syllables EURO being pronounced as in european, then  
finally PA as in papa.

35 Thus the applicants’ mark would, I believe, be pronounced SAF- FEAR EUR-O-PA, or  
SAF-FIR-EUR-O-PA and the opponents’ mark would be pronounced SAF - FEE- LOW. It is  
accepted that ordinarily the initial part of a mark is the most important, however, as the ECJ stated  
in Sabel v Puma, the public normally perceive trade marks as wholes and do not proceed to analyse  
the various details. Even allowing for imperfect recollection and the slurring of word endings,  
40 it is my view that the marks are unlikely to be confused through aural use.

Neither mark implies any conceptual meaning both being made up words.

45 The opponents claim that their mark is particularly distinctive because of the use made of it before  
the relevant date, 5 April 1995. However, there is no evidence that any such reputation extended  
to protective spectacles and there is no independent evidence of their reputation in respect of  
ordinary spectacles. The sales and advertising figures provided for the UK up until 1995 do not  
appear exceptional given the average cost of the goods concerned.

The purchase of protective spectacles and goggles is not an everyday occurrence. The applicants' goods are specifically designed to provide protection for individuals in the workplace where there is a potential hazard to the eyes by flying detritus. The opponents have pointed to the role of opticians in the testing and fitting of the applicants' safety glasses for those who require spectacles ordinarily. To my mind this acts as an additional barrier to confusion as I deem it unlikely that a professional optician would be confused. I also bear in mind the comments in the LANCER case [1987 RPC 303] at page 316 where Falconer J. said :

*“ I now have to consider the circumstances in which the marks would be used bearing in mind what Parker J. said in the passage which I have just read from the Pianotist case; that is to say whether, having regard to the nature and value of the goods in question - and we are considering motor cars - the likely customers for such goods, how the goods are normally sold and purchased, and what goes on in the marketing of such goods, the degree of phonetic similarity which I found raises that real tangible danger postulated by Lord Upjohn. This is not a case of goods of relatively small value which might be purchased regularly daily or weekly by all kinds of persons, including children, for example the classic example of a bag of sweets or a breakfast cereal or a bar of soap across a counter; we are dealing with motor cars”.*

Although these comments were in regard to a case being considered under the 1938 Act, I consider them to still be relevant. Therefore, having regard to the degree of phonetic similarity which I found and the considerations which I pointed to, namely the nature and value of the goods, the likely purchasers, and how the goods are normally purchased, I have come to the conclusion there is no real tangible danger of confusion between the two marks even postulating use by the applicants of SAFIR EUROPA / SAFIREUROPA on the type of spectacles within the proposed registration. The opposition under Section 5(2) therefore fails.

Next, I turn to the grounds of opposition under Section 5(3) which states:

5 (3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

*shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.*

An earlier right is defined in Section 6, the relevant parts of which state

6.- (1) In this Act an 'earlier trade mark' means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,

(b)...

© a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

I have already decided that the marks are not similar when considering Section 5(2). Therefore the opposition under Section 5(3) fails.

In case I am found to be wrong, I will consider the other ground of opposition under Section 5(4) which states:

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

In deciding whether the mark in question offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

“The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:

*'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:*

5 (1) *that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;*

10 (2) *that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and*

(3) *that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.*

15 *The restatement of the elements of passing off in the form of this classical trinity has been establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:*

20 *To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:*

(1) *that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and*

25 (2) *that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.*

30 *While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.*

35 *In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:*

(a) *the nature and extent of the reputation relied upon;*

(b) *the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;*

40 © *the similarity of the mark, name etc. used by the defendant to that of the plaintiff;*

(d) *the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and*

(e) *the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.*

45 *In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."*

With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision.

5 It is claimed that the public would be confused as to the source of the applicants' goods believing them to originate from the opponents. The opponents state that their products are sold in opticians throughout the UK and that in the period 1991 - 1994 they sold approx. £5.4million, and that during this period approx. £56,000 was spent promoting their products. Therefore, I am persuaded that at the relevant date, 5 April 1995, the opponents had established goodwill under their SAFILO mark for goods in Class 9 (Spectacles and spectacle cases). There is no evidence that the opponents sold protective spectacles and goggles. Although this is not fatal to their case, it has some relevance to the question of whether the use of SAFIR EUROPA / SAFIREUROPA on protective spectacles amounts to misrepresentation.

15 I have already compared the two marks and found the opponents' mark SAFILO is not similar to the applicants' marks SAFIR EUROPA / SAFIREUROPA. In my view the lack of similarity will prevent the public believing that the products of the applicants originate from the opponents. The opposition under Section 5(4) therefore fails.

20 The opponents also claim that their mark is entitled to protection under the Paris Convention as a well-known trade mark. Section 55 of the Trade Marks Act 1994 states:

*The Paris Convention: supplementary provisions*

55. -(1) In this Act-

25 (a) "the Paris Convention" means the Paris Convention for the Protection of Industrial Property of March 20<sup>th</sup> 1883, as revised or amended from time to time, and (b) a "Convention country" means a country, other than the United Kingdom, which is a party to that Convention.

30 In view of my findings under 5(2), 5(3) and 5(4) above, in particular that there is no likelihood of confusion, I do not need to consider this aspect.

The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £435

35 Dated this 8 day of July 1999

40 George W Salthouse  
For the Registrar  
The Comptroller General