

O-369-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2320799
BY NATASHA JULIE PHILLIPS TO REGISTER A
TRADE MARK IN CLASS 9**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 92710 BY MONSOON ACCESSORIZE LIMITED**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2320799
by Natasha Julie Phillips to register a
trade mark in Class 9**

and

**IN THE MATTER OF Opposition thereto
under No. 92710 by Monsoon Accessorize Limited**

BACKGROUND

1. On 15 January 2003, Natasha Julie Phillips applied to register a series of two trade marks for a range of goods identified as falling within Class 9. Following examination, the application was accepted and published for the trade mark **ACCESSOREYES** for the following goods in Class 9:

“Parts for spectacles; nose pads, bridge pads, bridges, temple tips, curled sides, all being parts for spectacles; chains and cords for spectacles, sports bands for spectacles, magnetic strips, leather cords for spectacles.”

2. On 11 August 2004, Chancery Trade Marks acting as agents for Monsoon Accessorize Limited filed a notice of opposition. The grounds of opposition are, in summary:

That the Opponent is the owner of the following earlier trade marks:

United Kingdom Trade Mark No: 2221813 for the mark **ACCESSORIZE** which was applied for on 9 February 2000 and registered on 16 March 2001 in respect of, *inter alia*, the following goods in Class 9:

“Sunglasses, spectacles; frames, lenses, cords and cases all for spectacles and sunglasses; cameras, optical apparatus and instruments, audio and video apparatus and instruments, televisions, computers and computer software; videos, CDs, DVDs and tapes; cassettes.”

and Community Trade Mark No. 2758027 also for the mark **ACCESSORIZE** which was applied for on 28 June 2002 and registered on 2 June 2004 in respect of, *inter alia*, the following goods in Class 9:

“Sunglasses, spectacles, frames and lenses; cords and cases all for sunglasses and spectacles; cameras, optical apparatus and instruments, audio and video apparatus and instruments, televisions, computers and computer software; videos, CDs, DVDs, tapes and cassettes.”

3. In their Statement of Grounds the Opponent comments:

“2. The Opponent has used the trade mark ACCESSORIZE for over 20 years in relation to fashion accessories and clothing which are sold through some 110 “Accessorize” stores spread throughout the major cities in the United Kingdom. The Opponent first used the ACCESSORIZE trade mark in relation to sunglasses since at least the year 1993 and have also used the said trade mark on, inter alia, cords and cases for sunglasses and for spectacles. Use of the said trade mark upon these goods has been substantial and continuous from that time up to the present.

3. The trade mark ACCESSOREYES.....is confusingly similar to the Opponent’s trade mark as it is virtually identical from a phonetic viewpoint and similar from a visual viewpoint...

4. The specification of the trade mark applied for is identical to the specification covered by the Opponent’s trade mark in so far as it concerns “cords and leather cords”. It can be appreciated that the parts for spectacles listed in the specification of the trade mark applied [for] are very similar to the “sunglasses, spectacles, frames, lenses and cases all for spectacles and sunglasses” within the specification of the Opponent’s trade mark.”

Stemming from the above, objection is said to arise under sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

4. On 15 December 2004, Saunders & Dolleymore acting as agents for the Applicant filed a counterstatement, in which they comment, *inter alia*, as follows:

“1. The applicant has used the mark “ACCESSOREYES” in respect of “parts for spectacles; nose pads, bridge pads, bridges, temple tips, curled sides, all being parts of spectacles; chains and cords for spectacles, sports bands for spectacles, magnetic strips, leather cords for spectacles” since at least July 1999 to the present day.

2. During that period there has been no evidence that the marks ACCESSOREYES and ACCESSORIZE have been confused or associated in any way.

3. The opponent’s mark is used in relation to “fashion accessories and clothing”....which are sold through “retail stores”..... The applicant’s goods are sold to opticians and optometrists not to the general public. They are therefore sold through different trade channels, for different purposes, have different uses and users and are of a different nature. These goods are therefore not similar to those of the opponents.

4. It is therefore denied that the application should be refused under Section 5(2)(b).... The marks and goods are not so similar that confusion or association is likely, or alternatively the goods are different.”

The grounds based on sections 5(3) and 5(4)(a) of the Act are also denied.

5. Both sides filed evidence and both ask for an award of costs in their favour. The parties were invited to say whether they wished to be heard; neither indicated a wish to do so, but written

submissions have been received on behalf of the Applicant from Saunders & Dolleymore (their letter of 22 February 2006 refers). At this point, I should mention that following the conclusion of the evidence rounds, the parties jointly approached the Trade Marks Registry with a request that these proceedings be stayed to await the outcome of settlement negotiations. This was agreed but, in the event, these negotiations failed to achieve an amicable resolution of the dispute, a position confirmed in Saunders & Dolleymore's letter of 22 November 2006 to the Trade Marks Registry. That being the case, and acting on behalf of the Registrar, I now give this decision.

EVIDENCE

Opponent's Evidence

6. This consists of a statutory declaration dated 6 May 2005 by Charles Henry Edward Jennings. Mr Jennings explains that he is the trade mark attorney representing the Opponent in these proceedings, adding that he has represented the Opponent in trade mark matters for over twenty five years. He states that he is fully conversant with their trade marks and the use that has been made of them, and, by virtue of a special power of attorney, he has been appointed to prepare and execute all documents relating to the trade mark affairs of the Opponent.

7. He states that the Opponent has used the trade mark ACCESSORIZE in the United Kingdom for over twenty years in relation to clothing and fashion accessories, which are and have been continuously sold through their ACCESSORIZE retail stores of which there are in excess of two hundred located in the high streets of most major cities in the United Kingdom and Northern Ireland. He adds that the Opponent has used its ACCESSORIZE trade mark upon and in relation to sunglasses since at least 1993 and that the mark has also been used in relation to cords and cases for sunglasses and for spectacles. The annual retail sales of these goods between 1999 and 2004 are as follows:

Year	Retail Sales (£)
1999	0.5m
2000	1.25m
2001	1.75m
2002	2m
2003	2.5m
2004	2.5m

8. Mr Jennings explains that exhibits CJ1 to CJ3 are as follows. Exhibit CJ1 consists of specimen invoices said to show the sale of ACCESSORIZE sunglasses etc. I note that the exhibit contains invoices to the Opponent from Blue Gem (Sunglasses) Limited (dated 7 and 20 June 02 and 4 January 2003), Keith Roberts and Co Ltd (dated 6 June 2002, 11 December 2002 and 22 January 2003) and Anglo Accessories (dated 7 May 2002). All of the invoices appear to be in respect of sunglasses and all bear a paid and date stamp. Exhibit CJ2 consists of a list of the Opponent's retail stores where Mr Jennings says ACCESSORIZE branded products including sunglasses, spectacle cords and cases are sold. I note that the listing provided includes the headings "Branch Address List, Monsoon Accessorize (both words being presented in a stylised

typescript and with the word Accessorize accompanied by a device of a crown appearing above the letter “i” in Accessorize) and Retail Operations November 2004. This listing which appears to originate from after the material date in these proceedings, shows a large number of stores located throughout the United Kingdom. Mr Jennings states that ACCESSORIZE sunglasses have featured and have been the subject of advertisements in all major newspapers and fashion and women’s magazines published in the United Kingdom. Exhibit CJ3 is said to consist of specimen advertisements showing the use of the ACCESSORIZE trade mark in relation to sunglasses. A number of the advertisements appear to originate from after the material date in these proceedings and are of no assistance. Others, namely: The Daily Express (7 April 2001), InStyle UK (May 2001) and The Sunday Mirror (20 May 2001) make reference to sunglasses and glasses sold under the ACCESSORIZE trade mark.

9. Mr Jennings states that approximately £100k per annum is spent on advertising ACCESSORIZE products of which sunglasses will form part, although it is not possible to break the figures down further because the Opponent’s advertisements frequently feature several of their products in combination.

Applicant’s Evidence

10. This consists of a witness statement dated 20 September 2005 by Janice Margaret Trebble. Ms Trebble is the Applicant’s trade mark attorney; she confirms that she is authorised to make her statement on the Applicant’s behalf.

11. Exhibit JMT1 consists of a statutory declaration from the Applicant Natasha Julie Phillips dated 5 August 2003 which was originally filed during the ex parte examination phase. Ms Phillips explains that the information in her declaration comes from business records and her own knowledge. She explains that the trade marks ACCESSOREYES and ACCESSOREYES and device were first used by her in July 1999 and that the marks have been used continuously since that date. She states that the marks were initially used in relation to accessories, parts and fittings for spectacles and eyeglasses and adds that her range of goods quickly expanded to cover other accessories, parts and fittings, tools for repairing spectacles, eyeglasses and contact lenses, chemicals used in relation to spectacles, eyeglasses and contact lenses and consultation, and technical and advisory services relating to these goods. Exhibit NJP1 (which I note has not been sworn) consists of samples of Ms Phillip’s business card and stationery including stickers applied to the packaging of goods sent to her customers together with price lists indicating the range of goods sold by her. I note that the documentation provided bears the word accessoreyes in lower case above or to the side of which appears a device of a pair of eyes. The word also appears as part of the address details and in the Applicant’s e-mail and web address. Price lists are provided for 2003, together with brochures indicated as being from 2001, 2002 and 2003. Turnover and promotion figures since July 1999 are as follows:

Period	Turnover (£)
August 99-July 00	49, 524
August 00 – July 01	59, 481
August 01 – July 02	51, 900
August 02 – 15 January 03	54, 725

Year	Promotion (£)
2000	7430
2001	4975
2002	9545

12. Ms Phillips explains that the promotion of the goods has been by way of mail shots to customers and potential customers, production of brochures and leaflets and maintenance of a website. She adds that her customers include, Vision Express, Specsavers and Dolland & Aichison all of which have branches through the United Kingdom, together with many smaller chains and individual optician practices and retail outlets throughout the United Kingdom. She confirms that she has a significant number of customers in Northern Ireland, Scotland, Wales and England not only in the major cities but in smaller towns as well.

13. Exhibits JMT2 and JMT3 consist of: a search conducted on the Internet on 9 May 2005 to establish how the word ACCESSORIZE is used, and copies of the official files for the trade marks on which the Opponent relies in these proceedings.

14. That concludes my summary of the evidence filed in so far as I consider it necessary.

The Applicant's written submissions

15. The main points emerging from the Applicant's written submissions are as follows:

- that the goods in the Applicant's trade mark are identical to frames, lenses, cords and cases all for spectacles and sunglasses in Class 9 of the Opponent's trade marks, but are different from all the other goods in the Opponent's trade marks;
- that the Opponent's registrations predate the filing date of the application in suit;
- that by reference to the wording of Section 7 of the Act, the Applicant says that the application was correctly accepted at examination stage, and that the task now when considering which party has an earlier right is to take into account the evidence provided by the parties. I should mention here despite the Applicant's comment, the application was not accepted by the Trade Marks Registry on the basis of honest concurrent use;
- the Applicant then contrasts the evidence filed by the Opponent with that of the Applicant, concluding that it is the Applicant who has established the earlier right;
- turning to the likelihood of confusion, the average consumer for the respective trade marks is different. For the Opponent it is the fashion conscious general public and for the Applicant it is opticians and optometrists;
- that visually and conceptually the marks ACCESSORIZE and ACCESSOREYES are different, whilst phonetically they are the same. In the Applicant's opinion, the trade mark ACCESSORIZE brings to mind fashion accessories in this context, whereas the trade mark ACCESSOREYES conjures up an image of eyes having access to sight. The suffix –eyes is,

it is said, a strong image producer which differentiates the trade marks and leads the mind and the eye to disassociate the two trade marks;

- that by reference to exhibit JMT2, the Opponent's ACCESSORIZE trade mark is not distinctive for sunglasses; it does not contain a misspelling to add distinctiveness. In the Applicant's opinion, the trade mark describes the nature and purpose of the Opponent's goods;
- that the trade mark ACCESSOREYES is a clever play on words which is not descriptive of the Applicant's goods and that it is unlikely that the respective trade marks will be confused or associated with each other;
- that no evidence of confusion has been provided despite the Opponent's claim that the respective trade marks have co-existed since 1999;
- that in relation to the ground based on Section 5(3) of the Act, the evidence provided by the Opponent is not sufficiently detailed and is not independently supported;
- that there is no evidence to support any allegation that the Applicant is taking unfair advantage of the Opponent's reputation or that the use of the Applicant's trade mark is detrimental to the repute of the trade mark or its distinctive character;
- that in relation to the ground based on Section 5(4)(a) of the Act and applying the test mentioned in *Wild Child Trade Mark* [1998] RPC 455, the Opponent has not made out a case for possessing goodwill, that there is no likelihood of confusion (and no evidence provided to show that confusion has occurred) and there is no claim of damages nor any evidence to support such a claim.

DECISION

16. The first ground of opposition is based on section 5(2)(b) of the Act. This reads:

“5.-(2) A trade mark shall not be registered if because -

(a)

(b) it is similar to an earlier 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.”

An earlier right 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) 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,”

Both of the trade marks on which the Opponent’s relies are “earlier trade marks” as defined by Section 6(1) of the Act.

17. In reaching a decision I take into account the well established guidance provided by the European Court of Justice (ECJ) in: *Sabel BV v. Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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* paragraph 27;

(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*, paragraph 23;

(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*, paragraph 23;

(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*, paragraph 17;

(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*, paragraph 24;

(g) 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*, paragraph 26;

(h) 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 + Adidas Benelux BV*, paragraph 41;

(i) 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*, paragraph 29.

18. In essence, the test under Section 5(2) is whether there are similarities in trade marks and goods/services which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the trade marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

Comparison of goods

19. For ease of reference, the application in suit was published for the following range of goods in Class 9:

“Parts for spectacles; nose pads, bridge pads, bridges, temple tips, curled sides, all being parts for spectacles; chains and cords for spectacles, sports bands for spectacles, magnetic strips, leather cords for spectacles.”

The Opponent is the owner of two earlier trade marks both for the word ACCESSORIZE presented in block capital letters and both registered in a range of Classes. For the purpose of these proceedings, it is specific goods in the Class 9 element of the registrations that are relevant and which I have highlighted below. As both are cast in near identical terms, I will, in the remainder of this decision, refer to the specification contained in Class 9 of United Kingdom registration No. 2221813. This reads as follows:

“**Sunglasses, spectacles; frames, lenses, cords and cases all for spectacles and sunglasses**; cameras, optical apparatus and instruments, audio and video apparatus and instruments, televisions, computers and computer software; videos, CDs, DVDs and tapes; cassettes”.

20. In their written submissions the Applicant says:

“The goods in UK 2320799 are identical to “frames, lenses, cords and cases all for spectacles and sunglasses” in Class 9 of the opponent’s marks, but are different from all the other goods in the opponent’s marks.”

Whilst I note that concession (and agree in so far as the Opponent’s earlier trade marks are registered in Classes 3, 14, 18, 25 and 26 and for the remainder of the goods in Class 9), in my view, the goods contained in the application, being as they are all either parts of spectacles or

items for use with spectacles, are also either identical or if not identical are highly similar and complementary to the sunglasses and spectacles which also appear in the Class 9 element of the Opponent's earlier trade mark. Finally, I note that neither parties' specifications are limited in any way. Consequently, I must consider the respective specifications on the basis of notional and fair use.

In summary, I have concluded that all of the goods of the application are either identical, or if not identical are highly similar and complementary to sunglasses, spectacles, frames, lenses, cords and cases all for spectacles and sunglasses appearing in the Opponent's earlier trade mark.

Comparison of marks

21. For the sake of convenience, the respective trade marks at issue in these proceedings are reproduced below:

Opponent's trade mark:

Applicant's trade mark:

ACCESSORIZE

ACCESSOREYES

22. The reputation of a trade mark is an important consideration when making a determination under Section 5(2) of the Act, as it may enhance the distinctive character of the earlier trade mark and in so doing widen the penumbra of protection. In their written submissions, the Applicant says:

“The opponents' mark ACCESSORIZE is not distinctive for sunglasses. In the Witness Statement of Janice Trebble, Exhibit JMT2 contains a definition of the word ACCESSORIZE and examples of use which demonstrate that defined meaning. The mark ACCESSORIZE does not even contain a mis-spelling to add a scintilla of distinctiveness. The mark simply describes the nature and purpose of the opponent's goods.”

Firstly, I note that all of the pages of the exhibit mentioned bear the date 9 May 2005; this is, I presume, the date that the Internet was interrogated and the pages printed. It is of course a little under two a half years after the material date in these proceedings; in addition, it appears that a number of the references originate from the United States or are, arguably, use as a trade mark. Consequently, I must approach the exhibit with some caution. The first page of the exhibit contains a definition obtained from freesearch which reads:

“accessorize, UK USUALLY accessorise
verb (T) MAINLY US
to add an accessory or accessories to something:
-She was wearing a little black dress, accessorized simply with a silver necklace”

The remainder of the exhibit shows the word ACCESSORIZE used in a range of different contexts. Indicative examples of this use are as follows: “How to Accessorize Your Work Wardrobe – Women”, “Accessorize Your Casual Wardrobe”, “Accessorize Formal Evening

Wear”, “accessorize-with-sandra.com”, “Citroen C2 – Accessorize All Areas”, “Accessorize with Douwe Egberts!” and “accessorize your Ipod”.

23. From this information one can reasonably conclude that the word ACCESSORIZE is one which other traders appear to wish to use in relation to a disparate range of goods. This view is supported by the information contained in exhibit JMT3, which contains, *inter alia*, a copy of the official file for UK trade mark registration No. 2221813. I note that an initial objection was taken to that application on the basis that:

“...there is an objection under Section 3(1)(b) and (c) of the Act because the mark consists exclusively of the dictionary word “Accessorize” being a sign which other traders may wish to use in relation to goods that provide or complement a garment.”

24. However, I also note that to overcome this *prima facie* objection to its trade mark, the Applicant (the Opponent in these proceedings) filed evidence of use, and that the application was subsequently accepted by the Trade Marks Registry and published on the basis of acquired distinctiveness. In short, the Trade Marks Registry were satisfied at that time that the evidence provided established that in relation to the objectionable goods i.e. sunglasses, spectacles; frames, lenses, cords and cases all for spectacles and sunglasses, the word ACCESSORIZE had through use come to function as a trade mark of the Opponent. The trade mark was subsequently published for opposition purposes and no opposition was filed. Upon registration the trade mark benefits from the provision of Section 72 of the Act i.e. that registration is *prima facie* evidence of its validity.

25. The Opponent has also filed evidence in these proceedings. I note that in their written submissions the Applicant comments, *inter alia*:

“The opponents claim to have used their mark in respect of sunglasses, cords and cases since 1993. This is a claim by an attorney in private practice who does not identify the source of his information...”,

Had the Applicant been concerned with the source of the Opponent’s information, the appropriate time to challenge that evidence would have been in their own evidence in chief; this would have given the Opponent an opportunity to respond to the criticism in their evidence in reply. However, the Applicant did not take this point in their own evidence and it is not, in my view, appropriate for them to take this point now. I note that in Mr Jennings’s statutory declaration he mentions that he has represented the Opponent for over twenty five years and is fully conversant with their trade marks and the use that has been made of them; he also mentions that he has a special power of attorney to prepare and execute all documents on the Opponent’s behalf. Although it would have been desirable for him to have explicitly stated the source of the information in his declaration, it may well be that in his view that explanation was sufficient. That point aside, it emerges from his declaration that the Opponent has used the ACCESSORIZE trade mark since at least 1993 in relation to sunglasses and that the trade mark has also been used in relation to cords and cases for sunglasses and spectacles. Retail sales of these goods amounted to some £8m in the period 1999-2003; a figure of £2.5m has been provided for 2003, but given the material date in these proceedings is 15 January 2003 it is doubtful that a significant portion

of these sales were achieved before that date. In exhibit CJ1 Mr Jennings provides sample invoices (all but one of which appears to be prior to the material date) from what appear to be suppliers of sunglasses to the Opponent. These goods are, it is said, then sold throughout the United Kingdom through the Opponent's retail stores (exhibit CJ2) with exhibit CJ3 consisting of a number of specimen advertisements some of which are prior to the material date and which show use of the ACCESSORIZE trade mark principally in relation to sunglasses. I note that the goods are not promoted individually.

26. Whilst I accept that in relation to the objectionable goods in Class 9 the word ACCESSORIZE may not be acceptable prima facie, the use that the Opponent has made of the trade mark was sufficient to satisfy the Trade Marks Registry in October 2000 that the word had acquired distinctiveness through its use and was capable of acting as an indication of origin. The evidence filed in these proceedings has not, in my view, improved the Opponent's position to any great extent. However, taking all of the above factors into account, the Opponent's ACCESSORIZE trade mark is, in my view, deserving of a reasonable penumbra of protection.

27. With these observations on the distinctive character of the Opponent's trade mark in mind, I now go on to compare the respective parties' trade marks from the visual, oral/aural and conceptual standpoints.

28. In their written submissions, the Applicant concede that the respective parties' trade marks are orally/aurally the same; that is a sensible concession and one with which I agree. However, they argue that from the visual and conceptual standpoints the trade marks are different. In the Applicant's opinion the Opponent's ACCESSORIZE trade mark brings to mind fashion accessories whereas the Applicant's trade mark conjures up an image of eyes having access to sight. They also say that the Applicant's ACCESSOREYES trade mark is a clever play on words.

29. Starting with the visual comparison, the marks are eleven and twelve letter long respectively, and the first eight letters of each trade mark are identical; they differ only in their suffix elements i.e. –"IZE" and –"EYES"; that being the case, they must, at the very least, share a reasonable degree of visual similarity. In so far as conceptual similarity is concerned, in my view, both trade marks can trace their origins back to the word ACCESSORY, a fact that is unlikely in my view to be lost on the average consumer of the goods in question, who, at this point in my decision, I think I should say a little more about. In their written submission, the Applicant says:

“...the mark ACCESSORIZE has been used by the opponent in relation to clothing and fashion accessories sold through their own high street retail stores (i.e. to fashion conscious general public).....The applicant's evidence shows that her market is opticians and optometrists who use the goods to adjust, repair and maintain eyewear for customers. This is a specialised market and the goods are not asked for by name by the customers of the opticians and optometrists.”

30. I have reproduced the respective specifications above and as mentioned earlier in this decision note that neither specification is limited in any way. Notionally then both the Applicant and Opponent can target the same consumers at any level in the chain of supply. In my view

therefore the average consumer for both parties' goods could potentially be the same. It could be, for example, a member of the general public wishing to purchase sunglasses or spectacles or parts and fittings or accessories for such goods, or an optician wishing to source such goods for onward sale to the end consumer. The traits of the average consumer are listed at (b) above and are well known. In my view the average consumer wishing to purchase sunglasses or spectacles or parts and accessories for these goods will pay a high level of attention to their purchase as the goods are likely to be selected on the basis of a range of factors, for example, price, fit, comfort, physical composition, suitability as replacements, appearance and suitability for use.

Likelihood of confusion

31. In reaching a conclusion, I must apply the global approach advocated having assessed the degree of visual, oral/aural and conceptual similarity between the respective trade marks. I must keep in mind the degree of similarity between the specification of goods for which the Opponent's trade mark is registered, and the goods contained in the application. I must also keep in mind the traits of the average consumer of the goods in question.

32. In their written submissions, the Applicant says:

“Given that the opponent's claim (although they have not proved this) that the marks have coexisted for the relevant goods since at least July 1999, they have provided no evidence of confusion. If confusion was likely one would have expected some evidence to be available by now”.

In this regard, I note the comments of Millett LJ in *The European Limited v The Economist Newspaper Limited* [1998] FSR 283 when he said:

“..Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark..”

33. By reference to Section 7 of the Act, the Applicant in their written submissions say:

“The application was therefore correctly accepted at examination stage and the task at hand here, when considering which party has an earlier right is to take into account the evidence provided by the parties in relation to the use of the respective marks.”

The issue of concurrent trading was dealt with by the Hearing Officer in *Codas Trade Mark* [2001] RPC 14. At paragraph 24, the Hearing Officer said, *inter alia*:

“...But in relation to section 5(2) the respective trade marks or respective specifications of goods or services may only be similar and the fact that there has been actual use of the trade mark in suit concurrently with the earlier trade mark, may be relevant in determining whether there is a likelihood of confusion.”

34. It is of course permissible for me to consider the fact of concurrent trading to inform my decision as to whether or not there is a likelihood of confusion. The application in suit was applied for on 15 January 2003. The Applicant began trading in July 1999 and the Opponent in 1993. There are, therefore, only three and a half years of concurrent trading for me to take into account. The Applicant's turnover in that time has risen from £49k in the year 1999/00 to £54k in 2002/03, with promotion rising from approximately £7k in 2000 to £9k in 2002. In use, the Applicant's trade mark is invariably accompanied by a device of a pair of eyes, although it is possible to find use of the trade mark without the device element. In the period 1999-2003 the Opponent's turnover has amounted to some £5.5m. The Opponent's trade mark is often used in a stylised script with an enlarged letter A and a device of a crown appearing above the letter "I" in the word ACCESSORIZE. Notwithstanding the concurrent use that has taken place, in my view, given the nature of the respective trade marks normally used by the parties, an insufficient amount of time has passed for me to be satisfied that the relevant public have been exposed to the trade marks of the respective parties (in the form in which they are applied for and registered) or are able as a result of that exposure to distinguish between them.

35. Having considered all of these interdependent factors, I have concluded that: (i) the respective trade marks share a significant degree of visual similarity, (ii) are identical from an oral/aural standpoint, (iii) share similar conceptual ideas, both originating, in my view, from the word ACCESSORY and (iv) that the average consumer of the goods in question are those I have identified above and would have the characteristics I have described. In a commercial setting I suspect that the visual considerations are likely to be more important than the oral/aural ones, although I do not discount that some of the goods are likely to be the subject of oral recommendations/orders. Finally, I do not consider that the length, extent and nature of the trade marks used during the period of concurrent trading is sufficient to inform my decision on the likelihood of confusion.

Conclusion under Section 5(2)(b)

36. Taking all of the above into consideration, and bearing in mind the well established principle of imperfect recollection, I have come to the clear conclusion that there would be a likelihood of confusion between the respective parties' trade marks and the opposition under Section 5(2)(b) of the Act succeeds accordingly.

The objections based on Section 5(3) and 5(4)(a) of the Act

37. My decision under Section 5(2)(b) of the Act effectively determines these proceedings in the Opponent's favour. However, in case I am found to be wrong in my principle finding, I can, I think, deal quite briefly with the objections based on Sections 5(3) and 5(4)(a) of the Act. In order to qualify for consideration under section 5(3) of the Act, the Opponent is required to demonstrate that they have a reputation in their trade marks in the United Kingdom; in this regard, see the guidance provided by the Court of Justice in *General Motors Corporation v Yplon SA* [2000] RPC 572. Similarly to succeed under Section 5(4)(a) of the Act, (see the comments of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Wild Child Trade Mark* [1998] RPC 455), I need to be satisfied that the three elements of the tort of passing off i.e. goodwill, misrepresentation and damage are present before a finding in the Opponent's favour is

appropriate. Dealing firstly with the objection based on Section 5(3) of the Act, in their Statement of Grounds the Opponent frames this attack in the following terms:

“In the alternative, the Opponent submits that the trade mark applied for ought to be refused....., since the mark applied for is similar to the Opponent’s trade mark and the goods applied for are not similar to the goods covered by the Opponent’s trade mark and use of the mark applied for, without due cause, would take unfair advantage of, or be detrimental to the distinctive character or repute of the Opponent’s trade mark.”

38. In my view, the evidence provided by the Opponent is insufficient for me to conclude that the Opponent has the necessary reputation to benefit from the provisions of this section of the Act. However, I have already found in paragraph 20 above that the respective parties goods are either identical, or if not identical, are highly similar and complementary. Given that finding, it is not appropriate for me to consider the objection based on section 5(3) of the Act (on the basis it was pleaded) and the opposition on this ground is dismissed accordingly.

39. Finally, in my view the objection based on Section 5(4)(a) of the Act places the Opponent in no better position than its ground based upon Section 5(2)(b); in fact if anything, the Opponent is in a somewhat weaker position under this head. In this regard, I bear in mind the comments of Pumfrey J in *South Cone Inc. v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, namely:

"There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the Registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s 11 of the 1938 Act (see *Smith Hayden (OVAX)* (1946) 63 RPC 97 as qualified by *BALI* [1969] RPC 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date."

40. When taken together, the evidence contained in Mr Jennings’ declaration and the exhibits thereto appears to show the Opponent purchasing from suppliers and then retailing a range of (primarily) sunglasses under the ACCESSORIZE and device trade mark, although I accept that there is some use shown of the word ACCESSORIZE in the form in which it is registered (in for example the extract from the web site dated 1 May 2005 which is after the material date) and in the extracts from the newspapers editorials mentioned above (where one would not, in my view, expect to find the trade mark used in a stylised form accompanied by a device element). However, there does not appear to be any use demonstrated in relation to frames, lenses, cords and cases all for spectacles and sunglasses, and only one example of use in relation to spectacles (*The Daily Express* article of 7 April 2001). In short, the Opponent appears to have used their

trade mark on a narrower range of goods than that for which it is registered, in addition to which, the trade mark appears (in the main) to actually have been used in a more limited graphical form than that in which it is registered. Taking the most generous view of the Opponent's evidence, one may be able to conclude that the Opponent had a protectable goodwill in relation to the ACCESSORIZE (word only) trade mark in relation to sunglasses. However, such a finding does not advance the Opponent's position beyond that under section 5(2)(b) of the Act, and as such, I intend to say no more about the opposition based on this ground.

CONCLUSION

41. The opposition based on Section 5(2)(b) of the Act has been successful; the opposition based on Section 5(3) of the Act (as pleaded) has been dismissed and I have found it unnecessary to reach a concluded view on the opposition based on Section 5(4)(a) of the Act.

COSTS

42. The opposition has succeeded and the Opponent is entitled to a contribution towards their costs. I order the Applicant to pay to the Opponent the sum of £1,000. 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 18th day of December 2006

**C J BOWEN
For the Registrar
The Comptroller-General**