

**O/0868/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK TRADE MARK APPLICATION NUMBER 4036065**

**BY YEONG SEOK LEE AND JU HUN YANG  
TO REGISTER THE FOLLOWING TRADE MARK:**

**LUCIER**

**IN CLASS 9**

**AND**

**IN THE OPPOSITION THERETO**

**UNDER NUMBER 448802**

**BY DITA, INC.**

## **BACKGROUND & PLEADINGS**

1. On 8 April 2024, Yeong Seok Lee and Ju Hun Yang (“the applicants”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom (“the contested mark”). The contested mark was published for opposition purposes in the Trade Marks Journal on 26 April 2024 in respect of the following goods:

**Class 9:** Spectacles; spectacle lenses; parts for spectacles; spectacle cases; spectacle frames; carrying bags for spectacles; sunglasses; goggles for sports; contact lenses; cleaning apparatus especially adapted for contact lenses.

2. On 26 July 2024, the contested mark was opposed by Dita, Inc. (“the opponent”). The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The opponent relies upon the National UK trade mark number UK00801076007 of the word LANCIER (“the earlier mark”), which was filed on 13 April 2011 and entered onto the register on 11 April 2012, and on all of the goods for which it is registered, namely:<sup>1</sup>

**Class 9:** Eyeglasses, namely, sunglasses, spectacles, prescription eyewear, anti glare glasses, eyeglass cases, sport goggles for use in skiing, swimming, motorcycling and parachuting, and their parts and accessories, namely, eyeglass chains, eyeglass frames, eyeglass lenses, and nose pieces for the aforementioned products; cases and holders specially adapted for spectacles and sunglasses and spectacle frames.

4. The opponent submits that the contested mark and the earlier mark “are visually and phonetically highly similar”, “with neither conveying a conceptual meaning”,

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<sup>1</sup> The earlier mark is a comparable mark based on an International Registration designating the EU (“IREU”). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing IREU. These comparable marks enjoy the same filing and registration dates as their European counterparts.

and therefore being “confusingly similar overall”. The opponent also submits that the goods in issue “are identical and/or similar”.

5. The applicants filed a counterstatement denying the claims made against them. Specifically, the applicants deny that there is a likelihood of confusion between the marks in issue as they are “phonetically dissimilar”. Whilst the applicants admit that the goods in issue are identical, the applicants submit that “this is a moot point due to the dissimilarity between the marks”. The applicants therefore request that the opposition be dismissed, that the contested mark be allowed to proceed to registration, and that an award of costs be made in their favour.

## **REPRESENTATION**

6. The opponent is represented by Baker & McKenzie LLP.
7. The applicants are represented by Stobbs IP Limited.

## **EVIDENCE AND SUBMISSIONS**

8. Only the opponent filed evidence in the form of the witness statement of Peter Kim, dated 20 December 2024, which is accompanied by seven exhibits (exhibits PK1 to PK7), and which I have discussed in further detail in paragraphs 20 to 27 below. Peter Kim provided the witness statement in his capacity as Chief Financial Officer for the Opponent, a position he has held since June 2024.
9. No hearing was requested, but both parties filed written submissions in lieu of a hearing. This decision is therefore taken following a careful consideration of all of the papers that have been filed by the parties, which will not be summarised but will be referred to as and where appropriate during this decision.
10. I was also provided with a copy of the decision of the EUIPO in relation to equivalent proceedings taking place in Europe. I have taken that decision into consideration and will refer to it below.

## **DECISION**

11. 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.
  
12. An earlier trade mark 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 registered trade mark or international trade mark (UK) 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.
  
13. The mark identified in paragraph 3 qualifies as an earlier trade mark under the above provisions. As the earlier mark had completed its registration process more than 5 years prior to the filing date of the application in issue, it is subject to the use provisions in section 6A of the Act. Consequently, I will begin by assessing whether the earlier mark has been put to genuine use by the opponent during the relevant period.

### **Proof of Use**

14. The relevant statutory provisions are as follows:

“6(1) This section applies where:

- (a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5)-(5A) [Repealed]

(6) 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.”

15. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. The relevant period for assessing genuine use is the five-year period ending with the filing date of the application in issue, i.e. 9 April 2019 to 8 April 2024.

17. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

18. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.
19. As the earlier mark is a comparable mark, the opponent is entitled to rely upon use in both the UK and the EU up to and including IP Completion Day (31

December 2020).<sup>2</sup> After IP Completion Day, only use in the UK is relevant. However, in this case, I note that the opponent has only filed evidence of use in the UK in relation to the entirety of the relevant period.

20. As outlined above, the opponent provided evidence of its use of the earlier mark in the United Kingdom (“UK”) during the relevant period in the form of a witness statement signed by Peter Kim on 20 December 2024 (the “witness statement”).
21. In summary, the witness statement explains that the opponent has made “extensive and longstanding use” of the earlier mark within the UK during the relevant period. Specifically, Peter Kim states that the Opponent was founded in 1995 as a “luxury eyewear company” and that the Opponent opened its first retail location in Europe, in London, in Brompton Road in October 2022.
22. It is noted that the witness statement contains a number of conflicting statements regarding the sale of the opponent’s goods containing the earlier mark (its “LANCIER Collection”). Firstly, as outlined above, Peter Kim states that the opponent opened its first retail location in Europe in October 2022,<sup>3</sup> which was its London store. However, Peter Kim also states that the opponent’s LANCIER Collection was first made available in its flagship UK store on 16 May 2019.<sup>4</sup>
23. Secondly, Peter Kim states that the opponent’s first sale on record in the UK of its LANCIER Collection was on 29 August 2022<sup>5</sup>. However, Peter Kim’s witness statement provides net sale figures for its LANCIER Collection between 2019 and 2024 in the UK, albeit it is noted that these figures are provided in US dollars, rather than in sterling. Specifically, Peter Kim gives evidence of the following sales:

<b>Year</b>	<b>Net Sales (USD)</b>
2019	\$68,925
2020	\$25,333

<sup>2</sup> See paragraph 7 of Part 1, Schedule 2A of the Act.

<sup>3</sup> Paragraph 13 of Peter Kim’s Witness Statement

<sup>4</sup> Paragraph 18 of Peter Kim’s Witness Statement

<sup>5</sup> Paragraph 20 of Peter Kim’s Witness Statement

2021	\$90,268
2022	\$48,507
2023	\$78,731
2024	\$105,902

24. Whilst the witness statement does contain conflicting evidence regarding the sale of the opponent's goods from the LANCIER Collection in the UK, the opponent has also provided a small selection of 10 invoices<sup>6</sup> which evidence its sales within the UK. It is also noted that it is Peter Kim's unchallenged evidence that these invoices evidence the sale of goods in the LANCIER Collection.<sup>7</sup> This is supported by the fact that the product codes that appear in the invoices are the same, or follow the same format, as the product codes given for LANCIER products in Mr Kim's evidence.<sup>8</sup> The total sum of the invoices filed is £9,192.03, and the invoices evidence sales in Glasgow and Guernsey, and throughout England (in Greater Manchester, Surrey, London and Northamptonshire).
25. In addition to the above, the witness statement exhibits screenshots from the opponent's Instagram page with the handle "ditalancier",<sup>9</sup> which as at the date the screenshot was taken had 9,300 followers, and which contains three presentational combinations of the words "dita" and "lancier", namely:

- (i) "DITA  
Lancier"
- (ii) "DITA-Lancier"
- (iii) "ditalancier"

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<sup>6</sup> PK5

<sup>7</sup> Specifically, Lancier accessories, including Lancier Counter Cards, a Lancier Display Riser and a Lancier Screwkit (pages 83 and 99 of the Exhibit PK5)

<sup>8</sup> See paragraph 23

<sup>9</sup> Exhibit PK6

26. Peter Kim's witness statement also provides marketing and advertising figures for its LANCIER Collection in the UK which confirms that it spent £24,757 on advertising and marketing in 2022, £19,481 in 2023 and £23,178 in 2024. The witness statement also contains copies of marketing material utilised by the opponent to market its LANCIER collection, including, what appears to be, a catalogue from 2020.<sup>10</sup> These materials show both sunglasses and glasses offered for sale. I also note that the catalogue makes specific reference to the anti-glare quality of the opponent's lenses. It is noted that throughout the catalogue the opponent is utilising the following presentational combinations of the words "dita" and "lancier":

- (i) "DITA Lancier"
- (ii) "Dita – Lancier "
- (iii) "DITA  
Lancier"

27. It is also noted that, save for one image of a box contained in the HypeBeast article from 2 December 2009 (which is therefore outside of the relevant period), all presentations of the words Lancier in the marketing materials, websites or articles contained in the evidence exhibited to the witness statement are as a combination of the words "Dita" and "Lancier". In light of the above, the applicants submit that the opponent has failed to show genuine use of the earlier mark. This is because the applicants submit that the variants of "LANCIER" in combination with "DITA" are differing in distinctive character to the mark as registered.

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<sup>10</sup> Exhibit PK7

## VARIANT USE

28. I keep in mind the judgment of the Court of Justice of the European Union (“the CJEU”) in *Colloseum Holdings AG v Levi Strauss & Co.*,<sup>11</sup> which concerned the use of one mark with, or as part of, another mark, where it found:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestlé, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. (my emphasis)

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive

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<sup>11</sup> Case C-12/12

character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (my emphasis)

29. It is clear from the above guidance that use in conjunction with another mark is use that can support a claim of genuine use. In the current case the applicants submit that, insofar as it shows any use, the opponent’s evidence only shows use of the variants DITA LANCIER, and it claims that this differs in distinctive character to the mark as registered. However, such use is clearly use of the kind envisaged by the court when it commented that genuine use can be in the form of “use as part of another mark taken as a whole or in conjunction with that other mark”. In the current case, I consider that the word LANCIER retains its own distinctive character when used with the separate trade mark DITA. Consequently, I dismiss the applicants’ submission that such use cannot qualify as an example of genuine use.

### **SUFFICIENT USE**

30. Taking all of the evidence above into account, even taking account of the figures starting from 2022 to account for the date on which Peter Kim states that the LANCIER Collection was launched in the UK (and noting that only part of the figures for 2022 would fall after this date and only part of the figures for 2024 would fall within the relevant period), I consider that the opponent has provided sufficient evidence of genuine use of its earlier mark in the UK in relation to glasses and sunglasses.

## **FAIR SPECIFICATION**

31. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon by the opponent. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,<sup>12</sup> Mr Geoffrey Hobbs Q.C. (as he then was) as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

32. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,<sup>13</sup> Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average

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<sup>12</sup> BL O/345/10

<sup>13</sup> [2016] EWHC 3103 (Ch)

consumer would do. For example, in *Pan World Brands v Tripp Ltd (Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("*Asos*") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM (Case T-256/04)* ECR II-449; EU:T:2007:46."

33. As noted above, the opponent has shown use in relation to glasses and sunglasses. It can, therefore, plainly rely upon the term "sunglasses". The terms "spectacles" and "prescription eyewear" also clearly cover the use shown by the opponent. Given the evidence above regarding anti-glare, I am also satisfied that the opponent can retain the term "anti glare glasses". I also consider that the average consumer would anticipate that any pair of glasses or sunglasses they purchase may come with an accompanying glasses case.

34. However, whilst I note that the opponent does sell versions of its glasses/sunglasses with differing frames and lenses,<sup>14</sup> I can see nothing that would evidence that the opponent sells these parts of the glasses/sunglasses as a standalone product. The catalogues exhibited at Exhibit PHK7 only evidence the opponent advertising finished products (i.e., finished glasses and sunglasses) for sale. The opponent has also provided no evidence of use of its marks in relation to “sport goggles for use in skiing, swimming, motorcycling and parachuting”, which I consider to be a distinct category of goods from glasses and sunglasses, nor have they provided any evidence of use of eyeglass accessories (including eyeglass chains). Consequently, I do not consider that the opponent should be entitled to rely on these goods in its specification.

35. With that in mind, I consider a fair specification to be:

**Class 9:** Eyeglasses, namely, sunglasses, spectacles, prescription eyewear, anti glare glasses, eyeglass cases, cases and holders specially adapted for spectacles and sunglasses and spectacle frames.

#### Section 5(2)(b)

36. The opponent’s opposition is based upon section 5(2)(b) of the Act which stipulates the following:

“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 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”.

37. Section 5A of the Act stipulates that where “grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or

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<sup>14</sup> As is evidenced in the catalogues in Exhibit PHK7

services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

38. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,<sup>15</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (“Canon”),<sup>16</sup> *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*,<sup>17</sup> *Marca Mode CV v Adidas AG & Adidas Benelux BV*,<sup>18</sup> *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (“OHIM”),<sup>19</sup> *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,<sup>20</sup> *Shaker di L. Laudato & C. Sas v OHIM*<sup>21</sup> and *Bimbo SA v OHIM*<sup>22</sup>:
- 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 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

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<sup>15</sup> Case C-251/95

<sup>16</sup> Case C-39/97

<sup>17</sup> Case C-342/97

<sup>18</sup> Case C425/98

<sup>19</sup> Case C-3/03

<sup>20</sup> Case C-120/04

<sup>21</sup> Case C-334/05P

<sup>22</sup> Case C-591/12P

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 greater 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 services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of Goods**

39. In light of my findings above, the competing goods are as follows

<b>The opponent's goods</b>	<b>The applicants' goods</b>
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<p><b><u>Class 9</u></b>  Eyeglasses, namely, sunglasses, spectacles, prescription eyewear, anti glare glasses, eyeglass cases; cases and holders specially adapted for spectacles and sunglasses and spectacle frames.</p>	<p><b><u>Class 9</u></b>  Spectacles; spectacle lenses; parts for spectacles; spectacle cases; spectacle frames; carrying bags for spectacles; sunglasses; goggles for sports; contact lenses; cleaning apparatus especially adapted for contact lenses.</p>
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40. The opponent submits that the goods in the contested mark’s specification and the goods in the opponent’s specification are “identical” or “clearly highly similar.” It is also noted that the applicants admit in their submissions that the goods in issue are identical. In the light of this admission, it is not necessary for me to carry out an independent assessment of the similarity between the goods in issue. I will proceed on the acceptance of this submission, that the goods in issue are identical.

**Average consumer and the purchasing act**

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question (see *Lloyd Schuhfabrik Meyer*<sup>23</sup>).

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<sup>23</sup> Case C-342/97

42. 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*,<sup>24</sup> Birss J. held:

“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.”

43. In respect of the goods in issue, I find that the average consumer will be members of the general public. Most of the goods in issue will be sold/accessed in retail outlets or opticians through self-selection or from online equivalents. The purchasing process for the goods in issue will therefore be dominated primarily by visual considerations, but I do not discount that aural considerations will also play a part as advice may be sought from sale assistants or opticians.
44. The goods in issue may vary quite considerably in price, and the frequency of purchase may vary quite considerably. By way of example, spectacles and higher price sunglasses may be purchased less frequently, but lower price sunglasses and cases may be purchased more frequently. In any event, I find that the average consumer will consider factors such as price and suitability during the purchasing process. Further, given that spectacles, sunglasses and contact lenses are to be worn on the face (or in the consumer eyes), and that the cases for those goods are crucial for their maintenance, I am of the view that the average consumer will pay either a medium or high degree of attention during the purchasing process.

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<sup>24</sup> [2014] EWHC 439 (Ch)

## Comparison of marks

45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*,<sup>25</sup> 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.”

46. It would be wrong, therefore, to dissect the trade marks artificially, 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.

47. The respective trade marks are shown below:

Earlier mark	Contested mark
LANCIER	LUCIER

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<sup>25</sup> Case C-591/12P

## **Overall Impression**

48. Both marks are word only marks. There are no other elements in the marks which contribute to their overall impression, so the overall impression lies in the words themselves.

## **Visual Comparison**

48. Visually, both marks are one-word marks, with the same first letter (“L”) and final four letters (“cier”). However, the earlier mark is made up of 7 letters, and the contested mark is 6 letters in length. The marks also differ in their second and third letters and I am conscious that the beginnings of marks tend to have more visual and aural impact and that the average consumer will pay most attention the beginning part of the signs.<sup>26</sup> Balancing these factors, I find the marks to be visually similar to a medium degree.

## **Aural Comparison**

49. As outlined above, the marks are both two syllables in length and share the same first letter (“L”) and the final four letters (“cier”), but differ in their second and third letters, with the second and third letters in the earlier mark being “AN” and the second and third letters in the contested mark being “UC”. I consider that because of these differing letters, when pronounced aloud, the marks will sound quite different phonetically. Weighing up these similarities and differences, I consider the marks to be aurally similar to a medium degree.

## **Conceptual Comparison**

50. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC

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<sup>26</sup> Case T-133/05 Meric v OHIM – Arbora & Ausonia (PAM-PIM’s BABY-PROP) [2006] ECR 11-2737, at [51])

and the CJEU, including *Ruiz Picasso v OHIM*.<sup>27</sup> The assessment must, therefore, be made from the point of view of the average consumer.

51. In this instance, I consider that the average consumer would deem “lancier” and “lucier” to be made up words, which are neither descriptive nor allusive of the goods in issue. Consequently, I find the marks to be conceptually neutral.

### **Distinctive character of the earlier trade mark**

52. In *Lloyd Schuhfabrik Meyer* 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 I-0000, 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 promoting 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).”

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<sup>27</sup> [2006] ECR I-643; [2006] E.T.M.R

53. Distinctiveness is a scale along which marks of various types sit. A mark which is allusive of the goods/services will have less distinctive character than one that is not; dictionary words will also be less distinctive than words which are entirely fanciful. However, all will turn on the particular facts. For example, there are “invented” words which are really just composites of two allusive words and only distinctive as a result, and dictionary words which are more or less common than others.
54. In this instance, as acknowledged above, I consider “LANCIER” to be an invented word. It is neither descriptive nor allusive of the opponent’s goods. Consequently, I find that the earlier mark has a high degree of inherent distinctive character.
55. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, and such enhanced distinctiveness may affect the likelihood of confusion between that mark and a later mark including the same, or a similar, element.
56. As discussed in detail above, the opponent filed a witness statement by Peter Kim to evidence its use of the earlier mark in the UK during the relevant period, including a selection of invoices totalling £9,192.03, and evidencing sales in Glasgow and Guernsey, and throughout England (in Greater Manchester, Surrey, London and Northamptonshire). Whilst I have determined that the opponent has provided sufficient evidence that it has used the earlier mark in the UK during the relevant period, I note that the clear inconsistencies in the evidence provided by Peter Kim relating to the number of sales of goods utilising the mark in the UK (as highlighted in paragraphs 22 to 24 above) make it difficult for me to assess whether the scale of the use shown is sufficient for establishing enhanced distinctiveness. On Mr Kim’s own evidence, if use of the mark in the UK did not begin until 2022, then use would not have been particularly long-standing at the relevant date. I also note that the only evidence of marketing costs provided are figures which are labelled as “Total EU Marketing Spend”, and which only span a period of three years (from 2022 to 2024). The only additional evidence of advertising and marketing exhibited to Peter Kim’s witness statement are screen shots from the opponent’s Instagram page (which is a

global platform and do not evidence enhanced distinctiveness in the UK specifically) and one catalogue, with no supportive evidence of distribution of this catalogue. I have no evidence as to market share. As noted, whilst I have found this evidence to be sufficient in respect of genuine use, I do not consider that it goes far enough to establish enhanced distinctiveness.

### **Likelihood Of Confusion**

57. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst 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 goods/services down to the responsible undertakings being the same or related.
  
58. 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 (see *Sabel*<sup>28</sup>). 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 goods and vice versa (see *Canon*<sup>29</sup>). It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods, 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.
  
59. The parties have both accepted in their submissions that the goods in issue are identical. In my determinations I have found that the marks are visually and aurally similar to a medium degree, conceptually neutral, and that the earlier mark has a high degree of inherent distinctive character.

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<sup>28</sup> C-251/95, para 22

<sup>29</sup> C-39/97, para 17

60. I have also identified that the average consumer of the goods would be members of the general public, and that the average consumer will pay either a medium or a high degree of attention during the purchasing process. I have found that the purchasing process for all of the goods in issue would be primarily visual in nature, although I do not discount aural considerations.
61. I note that both parties have referred to various previous decisions of the Tribunal, the General Court and the European Union Intellectual Property Office which they consider to be similar and therefore applicable to this opposition, including in relation to the equivalent proceedings in the EU. Whilst I have considered all of the case law presented by the parties, it should be noted that each case turns on its particular facts following a “consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal”.<sup>30</sup>
62. I bear in mind that the earlier mark is highly distinctive, which is a factor in favour of the opponent. However, I note that the mere fact that an earlier mark is highly distinctive does not automatically (as a matter of law) mean that a later mark will be more likely to be confusingly similar.<sup>31</sup> Weighing up all of the above, and noting the principle of imperfect recollection, that consumers rarely have the opportunity to compare marks side by side, but that the beginnings of marks tend to have more visual and aural impact and that the average consumer will pay most attention to the beginning part of the signs (which is where the differences in these mark lie)<sup>32</sup>, I am satisfied that the differences between the marks will prevent the average consumer from mistaking one mark for the other. My determination is also bolstered by the fact that I only consider the marks to be aurally and visually similar to a medium degree and that the average consumer will be paying at least a medium (but in some cases high) level of attention during

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<sup>30</sup> See paragraph 33 of the decision of Iain Purvis QC sitting as the Appointed Person in Case No. O-049/17, (*Rochester Trade Mark*)

<sup>31</sup> Please see comments of Daniel Alexander KC sitting as an Appointed Person in paragraph 41 of Case BL O/0860/23

<sup>32</sup> Case T-133/05 Meric v OHIM – Arbora & Ausonia (PAM-PIM's BABY-PROP) [2006] ECR 11-2737, at [51])

the purchasing process. I therefore consider that these differences between the mark will offset the fact that the goods in issue are identical.

63. For completeness, I will also go on to consider whether there is a likelihood of indirect confusion.
64. Indirect confusion was described in the following terms by Iain Purvis QC (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:<sup>33</sup>

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

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<sup>33</sup> BL O/375/10

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

65. As noted above, I do not consider that the average consumer will mistakenly recall or misremember the marks in issue. The common elements of the marks are the first letter "L" and the final four letters "cier". However, these elements are simply part of two differing longer marks. I do not consider that their appearance in both marks would lead the average consumer to see the marks as origination from the same (or connected) undertaking. Taking account of Mr Purvis' comments outlined in paragraph 64 above, I can see nothing that would lead me to find the contested mark to be a logical brand extension of the earlier mark. Whilst I note that Mr Purvis' comments were not intended as an exhaustive list of reasons for a finding of indirect confusion, I can therefore see no basis upon which indirect confusion should be found in this instance.

## **CONCLUSION**

66. The opposition fails, and the contested mark, subject to any successful appeal of my decision, may proceed to registration.

## **COSTS**

67. As the applicants have been successful, they are entitled to a contribution towards their costs, based upon the scale published in Tribunal Practice Note 1/2023. In the circumstances, I award the applicants the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a counterstatement & considering the other side's statement: £250

Considering Evidence: £600

Preparing submissions-in-lieu of a hearing: £350

**Total: £1200**

68. I therefore order Dita, Inc. to pay Yeong Seok Lee and Ju Hun Yang the sum of **£1,200**. This sum should 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 22<sup>nd</sup> day of September 2025**

**B Hartland**

**For the Registrar**