

O-313-06

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 2378412  
FOR REGISTRATION OF A TRADE MARK  
BY i eyewear LTD

AND

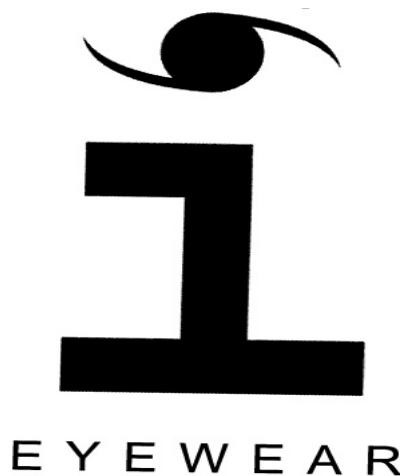
OPPOSITION THERETO UNDER NO. 93333  
BY BRILMIJ GROEP BV

## TRADE MARKS ACT 1994

IN THE MATTER OF  
an application under No. 2378412  
for registration of a trade mark by  
i eyewear Ltd and opposition  
thereto under No. 93333 by  
Brilmij Groep BV

### **Background**

1. On 18 November 2004, i eyewear Ltd applied under No. 2378412 for registration of the following trade mark:



in respect of: *Spectacles, spectacle frames, spectacle glasses, spectacle lens, optical apparatus, optical frames, optical glasses, optical lens, contact lens, apparatus for correcting and improving vision.*

2. Following publication of the application in the Trade Marks Journal, notice of opposition was filed on 7 April 2005 on behalf of Brilmij Groep BV. The single ground of opposition is an objection under section 5(2)(b) of the Act based on an earlier Community Trade Mark No. 1477751.

3. The applicant filed a counter-statement denying any similarity between the respective trade marks. It requested the opposition be dismissed with an award of costs being made in its favour.

4. Only the opponent filed evidence. Neither party requested to be heard. I therefore give this decision after a careful consideration of all the papers, including written submissions which were received from the opponent.

### **Opponent's evidence**

5. This takes the form of a statutory declaration of Mr Gerrit van de Weerdhof dated 27 February 2006. Mr van de Weerdhof says he is the Chief Executive Officer of the opponent company which itself is part of the Pearle Europe Group of companies. Mr

van de Weerdhof says he has held this position since October 2005 and is authorised to give evidence on behalf of his company. He confirms he has a good understanding of the English language and that the evidence he gives is taken from his own knowledge or his company's records to which he has full access.

6. Mr van de Weerdhof states that his company is the registered proprietor of CTM 1477751 and he exhibits a copy of the registration certificate for that mark. The exhibit shows CTM 1477751 to be registered in the name of Pearle Trust BV. This is not the opponent company. I will return to this later in this decision. He confirms that at the date of his statutory declaration his company had used the mark extensively throughout the European Union although it had made no use of the mark in the UK. He exhibits a variety of material which he says shows use of the mark in various countries, however, as the use does not relate to the UK I do not intend to set it out in detail.

7. Mr van de Weerdhof states that he is not aware of any instances of actual confusion between the respective marks presuming this is because his company is not yet operating in the UK but he concludes that he expects great confusion in the near future when his company enters the UK market.

8. No further evidence was filed by either party.

### **Decision**

9. Section 5(2) of the Act reads:

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

10. The term “earlier trade mark” is defined in section 6 of the Act as follows:

- “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,”

11. As I indicated earlier, Community Trade Mark No. 1477751 is registered in the name of Pearle Trust BV. This is not the opponent company. It may or may not be a

sister company, part of the Pearle Europe Group of companies referred to by Mr van de Weerdhof. I have no evidence on the point. Nevertheless, the registration is an earlier trade mark within the definition of Section 6 of the Act and can therefore be relied on by the opponent in these proceedings.


12. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77 and *Marca Mode CV v Adidas AG* [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 relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen 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 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*, 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.

13. In essence the test under Section 5(2) is whether there are similarities in marks and goods 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 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.

14. For ease of reference I set out below the respective trade marks:

Applicant's trade mark	Opponent's trade mark
	<p>iWear</p>
<p>Class 9: Spectacles, spectacle frames, spectacle glasses, spectacle lens, optical apparatus, optical frames, optical glasses, optical lens, contact lens, apparatus for correcting and improving vision</p>	<p>Class 5: Pharmaceutical and sanitary preparations; contact lens cleaning preparations; solutions for use with contact lenses; preserving, cleaning, storage, disinfecting, sterilisation and other liquids for contact lenses.</p> <p>Class 9: Contact lenses</p>

15. A straight comparison of the respective specifications of goods shows that identical goods are involved in that both include the term contact lenses. I regard the remaining goods for which registration is sought as being at least highly similar to contact lenses.

16. The applicant's mark consists of the letter "i" with a stylised superscript dot above the word "eyewear". Whilst the letter "i" in the applicant's mark has a degree of visual impact, I bear in mind the long established principle that "words speak louder than devices". Despite its greater size I do not consider the stylised letter "i" to be of greater visual dominance than the word "eyewear". The opponent's mark consists of the word "iWear". The words "eyewear" and "iwear" are aurally identical. Whilst there are some visual differences between the respective marks, there are also visual similarities in that both contain the letter "i" and the word "wear". Whilst the opponent's mark appears to be an invented word, conceptually, both marks suggest goods for wear in or on the eye(s).

17. The goods involved are everyday items but are likely to be bought with some care. Whilst I'm aware that contact lenses are available for cosmetic purposes, I believe most are bought as an aid to better sight. The need for a person to wear contact lenses is often identified by an optician or similar ocular specialist following a face to face consultation and discussion. I consider that in relation to these goods, oral/aural considerations are of particular importance.

18. Despite having filed evidence, the opponent admits that it has not used the earlier mark in the UK nor has any evidence been provided to show any use within the UK by any other person and therefore the mark can have no enhanced reputation. I consider the mark to have an average distinctive character.

19. Taking all factors into account, including the fact that the average consumer rarely has the opportunity to compare marks side by side but has to rely on the imperfect picture he has of them, I consider there to be a likelihood of confusion. The application under section 5(2)(b) succeeds.

### **Costs**

20. Although the opponent did not request an award of costs in its notice of opposition, it did so in its written submissions. The opponent having succeeded is entitled to an award of costs. I bear in mind that this decision has been reached without a hearing having taken place and with no evidence having been filed by the applicant. I also bear in mind that the evidence filed by the opponent, whilst not extensive, related principally to the position outside the UK. In all the circumstances, I order the applicant to pay the opponent the sum of £750 as a contribution towards its costs. This sum is 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 6th day of November 2006**

**Ann Corbett  
For the Registrar  
The Comptroller-General**