

O-256-15

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2652006
STANDING IN THE NAME OF
VISIONCALL LIMITED**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500223
BY VISION CARE AT HOME LTD**

AND

**IN THE MATTER OF APPLICATION
No. 3032938
BY VISION CARE AT HOME LTD
TO REGISTER THE TRADE MARK**



IN CLASSES 6, 9, 10, 16, 17, 25, 28, 35, 37, 38, 40, 41, 42, 44 & 45

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 401972 BY
VISIONCALL LIMITED**

O-256-15

BACKGROUND

1) The following trade mark is registered in the name of Visioncall Ltd (hereinafter VL):

Mark	Number	Filing & registration date	Class	Specification
EYE D	2652006	12.02.13 19.07.13	9	Data processing software; Databases; Recorded data files.
			16	Printed reports.
			35	Advisory services relating to data processing; Collection of data; Compilation of statistical data relating to medical research; Compilation of statistical data for use in scientific research; Compilation and systematisation of information in databanks; Data entry and data processing; Data management services.
			40	Engraving.
			41	Life coaching (training); Publishing services (including electronic publishing services); Publishing of electronic publications; Publishing of printed matter; Provision of on-line electronic publications.
			42	Computerised analysis of data.
			44	Services for the preparation of medical reports; Provision of medical services; Provision of medical information; Medical analysis services; Maintaining personal medical history records and files; Optical services; Compilation of medical reports; Issuing of medical reports; Preparation of reports relating to health care matters; Preparation of reports relating to medical matters; Provision of reports relating to the medical examination of individuals.
			45	Identification and security marking.

2) By an application dated 2 December 2013 Vision Care At Home Limited (hereinafter VCH) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary:

a) that VCH has, since 25 October 2012, used the following mark:



b) that the above mark has been used upon the following:

Data processing software; databases; recorded data files; printed reports; collection of data; data entry and data processing; engraving; life coaching (training); publishing services (including electronic publishing services);

publishing of electronic publications; publishing of printed matter; provision of online electronic publications; computerised analysis of data; services for the preparation of medical reports; provision of medical services; provision of medical information; medical analysis services; maintaining personal medical history records and files; optical services; compilation of medical reports; issuing of medical reports; preparation of reports relating to health care matters; preparation of reports relating to medical matters; provision of reports relating to the medical examination of individuals; identification and security marking.

c) VCH contends that it has established goodwill in the goods and services provided under the trade mark EYE D since 2012 such that the trade mark is recognised by the public as distinctive specifically of its goods and services. There has been a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods and services offered by VL are the goods and services of VCH. That it has suffered or is likely to suffer damage by reason of erroneous belief engendered by VL's misrepresentation that the source of VL's goods or services is the same as the source of those offered by VCH. The mark in suit therefore offends against section 5(4)(a) of the Act.

d) The application for registration of VL's mark was filed immediately following the market appearance of VCH's mark EYE D (device) at a trade show in Glasgow with the specific intention of trading off of the reputation VCH had established in the EYE D mark and/or to prohibit VCH from registering or further benefitting from its use of its EYE D (device) mark. The mark in suit therefore offends against section 3(6) of the Act.

3) VL provided a counterstatement, dated 3 February 2014, in which it denies the above grounds. In particular, it requests evidence of goodwill and reputation. VL also contend that its mark was created in February 2012 during a brainstorming session with several of its customers. An "eyecare passport" with the mark in suit upon it was developed and used in May 2012. A series of Powerpoint presentations using the mark in suit were undertaken in May 2012 and so a number of customers and potential customers were aware of VL's use of the mark in suit. It points out that it used its mark prior to the use of VCH's mark and, as such, cannot have offended either section 5(4) or 3(6).

4) On 29 November 2013 VCH applied to register the trade mark shown on the front page in respect of the following goods and services:

Class 6: Identification bracelets of metal; identification plates of metal; identification tags of metal; identity plates of metal.

Class 9: Identification system for spectacles; 3D spectacles; Anti-dazzle spectacles; Bars for spectacles; Chains for spectacles; Cords for spectacles; Eyeglasses; Frames for eyeglasses; Frames for spectacles; Frames for spectacles and sunglasses; Glacier eyeglasses; Lenses for eyeglasses; Lenses for spectacles; Polarizing spectacles; Protective eyeglasses; Protective spectacles; Retainers for spectacles; Safety spectacles; Spectacles; Spectacles [glasses]; Spectacles [optics]; corrective eyewear; spectacle glasses, spectacle cases, spectacle frames, spectacle lenses, spectacle hinges, their parts and accessories including chains and cords; Opera glasses; eyeglass

frames, eyeglass cases and eyeglass products, namely, headstraps and retainers, safety and tactical glasses; sunglasses, sunglass lenses; sunglasses cases, sunglasses frames, sunglasses lenses, sunglasses hinges, their parts and accessories including chains and cords; contact lenses, cases for contact lenses, parts and fittings for all the aforesaid goods; Optical equipment, apparatus and instruments, their parts and accessories including chains and cords; goggles; Goggles for action sports; optical glass; optical goods; optical lenses; sport goggles for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, sky diving and baseball, safety goggles and ski helmets; Protective and/or anti-glare eyewear, sunglasses, spectacles, goggles and their parts and accessories, namely replacement lenses, earstems, frames, nosepieces; cases specially adapted for protective and/or anti-glare eyewear, sunglasses and spectacles, and their parts and accessories; Goggles, lenses for goggles, all being in the nature of protective eyewear without any optical sight correction function; face masks; helmets; protective eyewear, headwear and bodywear; Parts and fittings included in Class 9 for ophthalmic glasses, eyeglasses, spectacles, goggles and for sunglasses; bracelets (encoded identification); encoded identification bracelets; identification labels; identification sheaths; identification strips; identification threads; shaft identification gauges; Optician's goods; Data communications apparatus; data communications hardware; Optical communications instruments; data processing; databases and recorded files; Apparatus for transmission of communication; Wireless communication apparatus; Communications equipment; Infrared optical apparatus; Laboratory optical apparatus; Optical measurement apparatus; Topographic apparatus [optical]; Optical character recognition apparatus; Target surveillance apparatus [optical]; Digital optical transmission apparatus; Optical apparatus and instruments; Target location apparatus [optical]; Pouches for optical apparatus; Testing apparatus for checking optical devices; image identifier night vision devices; sporting articles, namely, sport goggles ofr use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and baseball; all the aforesaid relating to identification and optical products and optician's services.

Class 10: Optical and medical apparatus and instruments; furniture adapted for medical use; artificial eyes; artificial lenses for implantation in the eye; eyes (artificial).

Class 16: Printed matter; printed reports; prospectuses; pamphlets; catalogues; photographs; printed publications; Paper identification tags; all the aforesaid relating to identification and optical products and opticians services.

Class 17: Identification sleeves of plastic; identification sleeves of rubber.

Class 20: Identification bracelets, not of metal; identity plates, not of metal.

Class 25: Clothing, headgear; all the aforesaid relating to identification and optical products and optician's services.

Class 28: Sporting articles, for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and baseball; sporting gloves; all the aforesaid relating to identification and optical products and optician's services.

Class 35: Management and marketing services, all for opticians; Retail services connected with the sale of spectacles and sunglasses; Business management and development; business advice and administration services; business planning; operational business services, advertising, promotional and marketing services; procurement of goods; professional management and recruitment services; accounts and auditing services, all of the aforesaid services for opticians and other healthcare professionals; arranging and conducting conferences and seminars and the provision of information and advisory services, all relating to the aforesaid services; Advisory services relating to data processing; Collection of data; Compilation of statistical data relating to optical and medical research; Compilation of statistical data for use in scientific research; Compilation and systematisation of information in databanks; data entry and data processing; Data management services.

Class 37: Repair services relating to spectacles, glasses, sunglasses, lenses, contact lenses, spectacle cases, chains, frames, holders and mountings, optical apparatus and instruments.

Class 38: Data communication services.

Class 40: Optical grinding; grinding, polishing and tinting of lenses; optical glass grinding services; custom manufacturing custom and assembly services relating to the provision of optical and hearing aid products; Custom manufacture of ophthalmic lenses for eyeglasses; Custom manufacture of optical frames; Grinding and polishing glass for eyeglasses; Engraving.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Organisation of competitions (education or entertainment), congresses, colloquiums, conferences and events, all relating to spectacles or related goods; Training in communication techniques; Training services relating to data communications; Training in the field of communication technologies; Provision of instruction relating to communication techniques; Publishing services (including electronic publishing services); Publishing of electronic publications; Publishing of printed matter; Provision of on-line electronic publications.

Class 42: Technical consultancy on design, including the services for creating lighting and optical concepts; engineering services with regard to installation of lighting and lighted related identification or communication systems; Technical research relating to automatic identification systems; Design of communication systems; Engineering services relating to the design of communications systems; Computerised analysis of data; software development; all the aforesaid relating to identification and optical products and optician's services.

Class 44: Optician services; Opticians' services; Information services relating to lenses; Sight-testing services; eyeglass fitting; eye bank services; services for the preparation of optician and medical reports; Provision of optician and medical services; Provision of optician and medical information; Optical and medical analysis services; Maintaining personal eye care and medical history records and files; Optical services; Compilation of optician and medical reports; Issuing of optician and medical reports; Preparation of

reports relating to eye care, health care and medical matters; Provision of reports relating to the optical and medical examination of individuals.

Class 45: Tagging of personal effects; Identification and security marking; identity validation services; identity validation.

5) The application was examined and accepted, and subsequently published for opposition purposes on 10 January 2014 in Trade Marks Journal No. 2014/002

6) On 9 April 2014, VL filed a notice of opposition. The grounds of opposition are in summary:

- a) VL are the proprietors of trade mark 2652006 shown in paragraph 1 above and have been using the mark since 23 February 2012 on: Printed reports; advisory services relating to data processing; collection of data; compilation of statistical data relating to medical research; compilation of statistical data for use in scientific research; data management services; publishing of printed matter; services for the preparation of medical reports; medical analysis services; maintaining personal history records and files; optical services; compilation of medical reports; issuing of medical reports; preparation of reports relating to health care matters; preparation of reports relating to medical matters; provision of reports relating to the medical examination of individuals.
- b) The marks and goods and services of the two parties are identical or similar and therefore the mark in suit offends against sections 5(2)(b), 5(3) and 5(4)(a) of the Act.
- c) VL allege that VCH were aware of their mark and its use at the time of the application and so it was filed in bad faith and offends against section 3(6) of the Act.

7) On 12 May 2014 VCH filed a counterstatement denying that the marks of the parties are similar claiming that the red and white circle device in its mark is the distinctive and dominant element. They also deny that the goods and services of the two parties are identical, similar or complementary. VCH also puts VL to strict proof of use in relation to the goods and services covered in its claim of use (see paragraph 6(a) above). It denies that its mark offends against section 5(2)(b), 5(3) and 5(4)(a). VCH also denies filing its application in bad faith, on the basis broadly, that it was the first user of the mark.

8) Both sides filed evidence. Both sides ask for an award of costs. Neither side wished to be heard but both provided written submissions which I shall refer to in my decision as required.

EVIDENCE OF VCH

9) VCH filed nine witness statements. The first, dated 31 March 2014, is by Geoff McCullough, a Director of VCH. He states that following a report about the dangers of bifocal glasses published in the British Medical Journal in May 2010, his company dispensed two pairs of glasses, (distance and near single vision glasses), instead of bifocals to elderly mobile patients, unless the patient had used bifocals without issues

(such as falling) for some time. Carers for these patients began querying the practice and it was apparent that, particularly in dementia cases, patients could end up with the wrong glasses on which would adversely affect their quality of life. He states that the company had been engraving the inside of the frames stating what the glasses were for but that this was not very convenient for busy nursing staff. In December 2011 at a management meeting the colour tagging of frames was discussed with white for distance and red for reading being preferred. Mr McCullough then describes how he experimented with nail varnish and paint pens before, in March 2012, hitting upon the use of electricians' heat shrink. The new logo was determined and a decision reached to launch EYE-D and a new PCR (patient, carer, relative) report at the care conference in November 2012. Banners for the stand were ordered in October 2012. He states that the roll out would include posters detailing the Eye-D system for use in nurses stations. He comments:

“We believe that Vision [VL] call staff took their idea for their lifestyle passport from our PCR report and filed a trade mark for the name “EYE-D” after seeing us promote these innovations at the annual care conference in the Glasgow Hilton. They filed their trademark application in February 2013 and were awarded it in July. They did not make us aware of the trademark until a week before the 2013 care conference as they knew we would be promoting “Eye-D” and would have spent a lot of money on marketing materials.”

10) The second witness statement, dated 16 April 2014, is by Vishal Marwaha, a director of VCH. He states that VCH is a company of optometrists who undertake specialist design, development, manufacture and sale of spectacle lens and innovative spectacle related items and accessories (including frames), together with general retail optician services. He states that he uses, inter alia, computers, data bases, medical report and printed matter to deliver these services. He repeats the evidence of Mr McCullough regarding issuing two pairs of glasses rather than bifocals due to the incidence of falls amongst those using bifocals and also the problems for carers etc. in ensuring that the correct pair of glasses was being worn by the patient. He also repeats the evidence about the trials before heat shrink was chosen. He confirms that the idea was mooted at the care conference in November 2012. At exhibits VCH-VM 6-10 he provides printouts from Companies House regarding VL. He points out that the company, although active, is classified as a “non-trading company”. He repeats the view that staff from VL saw VCH's stand in 2012 and stole the idea. He states: “I recall we have experienced strange behaviour from Visioncall at the Scottish Care Exhibition in previous years” but does not provide any details.

11) The third witness statement, dated 17 April 2014, is by Gavin Sommerville, an employee of VCH. He confirms that the company used the name “Vision care at home” in a stylised font with a roundel logo since he joined the company in July 2010 and still uses it as at the date of his statement. He states he was present at the management meeting in December 2011 when the idea of Eye-D was mooted and the slogan “white for sight, red for reading” was conceived. He confirms that the concept was launched at the care conference in Glasgow in 2012. He recalls seeing leaflets and other stand features in the office prior to December 2012.

12) The fourth, fifth and sixth witness statements, are by Elaine McLean, Gary Maitles and Ann Bain, all dated 31 March 2014. All are/were employees of VCH and all confirm that they were at the management meeting in December 2011 and all confirm the

comments already made regarding the adoption of the red/white system and the term Eye-D.

13) The seventh witness statement, dated 17 April 2014, is by Philip Hannay, VCH's solicitor. He confirms the evidence of Mr Marwaha regarding the nature of the business of VCH. He contrasts the memorandum of associations of the two companies which shows VCH as being, broadly speaking, concentrated upon optical services and VL simply looking to trade in any field for profit. He points out that only one of the principals of VL is an optometrist, the other two being a builder and an accountant. He provides evidence which shows that both parties attended the Scottish Care Conference between 2010 and 2013 inclusive. At exhibit VCH-PH13 he provides an early version of the vision assessment form used by VCH. This has the words "VisionCare at Home" and the circle device, but without the letters "Eye-D", at the top; although it does show use of the term "Eye-D" within the circle device lower down the page.

14) The eighth witness statement, dated 18 July 2014, is by Isobel Stuart the Manager of Springboig Care Centre. She states that her care home uses the VCH PCR report and Eye-D system. However, she does not state when this use began.

15) The ninth witness statement, dated 18 April 2014 is by Mr Hannay, who has provided evidence in this case already. He points out that the counterstatement by VL referred to the goodwill and reputation that VL had in the registered mark (2652006) EYE-D. He also points out that the counterstatement refers to use of an "EYECARE PASSPORT" with trade mark 2652006 upon it, and that a registration was sought for the "eyecare passport" mark. At exhibit VCH-PH15 he provides copies of on-line searches on UK Opticians and Optometrists Directories, optical directories, a free index directory and a BT directory for the terms "EYE D" and "Eye D". None of these show results for VL, they show listings for a range of optometrists, as well as various other listings many of which are not in the UK.

EVIDENCE OF VL

16) VL filed five witness statements. The first, dated 15 July 2014, is by Brian McGuire, a director of VL. He states that his business began under the name Visioncall in 1994 providing home eye tests and eye care services to those who cannot attend their local optician. The company was incorporated on 9 December 2004. He states that they currently look after 120,000 patients and have fourteen branches throughout the UK. A list of the branches is provided at exhibit VC-BM1 and shows that the whole of the UK and Northern Ireland is covered. He states that in February 2012 his company held an event called "The Voice of the Customer" at the Holiday Inn Strathclyde. This included customers as well as staff from VL. During this event he states that the issue of care home staff and patients struggling to understand and interpret documents relating to eye care and examinations was raised. The problem centred on medical jargon and prescription numbers being used. The issue of ensuring that the patient had the correct glasses on to prevent falls was also raised. Identifying the correct glasses for various activities was also raised. He states that the meeting split into groups for an "ideas session" and the group run by Mary Macconnachie came up with the name "Eye D" and presented it to the rest of the participants. He states it is clearly a play upon the identification or "ID" of which pair of spectacles a person should be wearing for which activities and as such was very clever. He states that during the months of March- May 2012 he developed the EYE D report and then commissioned designers, Atom Create

Scotland, to create user friendly gauges and symbols within an easy to use format. They completed this work by August 2012 and a copy of the report is provided at exhibit VC-BM3. The term EYE D is at the head of the document in the left hand corner, and is the first thing a reader will take in. The name of the company is also shown at the top of the page but in the right hand corner. He states that Atom Create were paid a fee for their work.

17) Mr McGuire states that in August 2012 a presentation was made by his company to HC-One who care for over 10,000 residents in their care homes throughout the UK, and employ over 14,000 staff. The Eye D report created by Atom Create formed part of the presentation. The company's regional sales managers began providing presentations unveiling the new Eye D brand to care homes such as the Priory Group which has 275 facilities. Copies of the slides used and emails confirming various meetings are provided at exhibits VC-BM 4 & 5. This exhibit shows meetings with customers occurring on 27 September and 3 October 2012 with further meetings planned. Copies of the Eye D report were sent to various customers and potential customers. An email sent to Care UK dated June 2012 is provided at exhibit VC-BM6 which states a copy of the report was attached. Care UK is stated to have 100 nursing and care homes in the UK. The Eye D service and report were, he states, well received and new business was won because of the system, as indicated by an email from a regional sales manager to the CEO of VL in July 2012, a copy of which is provided at exhibit VC-BM7.

18) Mr McGuire denies having seen the PCR report of VCH, and points out that his company's Eye D report was drafted in February 2012 whereas the PCR report was launched in November 2012. He states that the "non-trading" SIC status of his company was a mistake which has been rectified. He also states that Community Eye Care (UK) Ltd is a wholly owned subsidiary of VL and was trading as Visioncall. It was using the Eye D mark under licence from VL and that all goodwill accruing from such use was assigned to VL. He states that when he attended the Scottish Care exhibition in 2012 he was shocked that VCH were launching their EYE D brand. His company ceased using the mark temporarily whilst considering its options and then decided to register the mark so as to formalise the rights over the brand. Following registration he decided to resume use of the Eye D brand and instructed his legal advisors to write to VCH.

19) The second witness statement, dated 16 July 2014, is by Gillian Hepworth, the business development manager of Community Eyecare (UK) Ltd t/a Visioncall. She states that she attended a meeting on 21 June 2012 with various regional managers from Barchester Healthcare which has over 200 care homes in the UK. She recalls that a key part of the presentation was the service being offered under the Eye D brand. She provides copies of the slides used at exhibit VG-GH1 which shows the Visioncall name and also the Eye D brand. She states that the Eye D report did not use medical jargon unlike most systems used at the time, but instead used an easy to understand format. Part of the presentation shows a fictional patient and shows that the glasses engraved Sam 2665 should be used for near vision tasks. This would make it easy for staff to ensure that the correct glasses were being used dependent upon the activity being undertaken. She states that follow up visits to homes run by Barchester, who were not previously clients, resulted in the homes using VL to provide services to its residents. She also recalls how the Eye D report won other new business in July and September 2012, because of its ease of use.

20) The third witness statement, dated 11 July 2014, is by Carol Taylor, a business development manager for Community Eyecare (UK) Ltd t/a Visioncall. She recalls being present at a number of presentations to various clients such as Caring Homes and Priory Group during the summer of 2012, and describes follow up visits where these businesses became new clients having been won over by the Eye D report system.

21) The fourth witness statement, dated 3 July 2014, is by Mary Macconnachie, the Personal Assistant to the directors of VL and an employee of Community Eyecare (UK) Ltd t/a Visioncall. She describes being present at an event called "Voice of the Customer" on 23 February 2012 at the Holiday Inn in Strathclyde. She recalls how, having discussed the difficulties faced by staff in care homes relating to eye care examinations because of the use of medical jargon and prescription numbers, the meeting split into groups for an "ideas session". She states that she came up with the name of "Eye D" for the report, as it was a play on the identification or ID of which spectacles to use for specific activities. This idea was presented to the rest of the meeting and it was decided to adopt the name for the report. She describes how she was present at a meeting to prepare for the presentation to the Barchester Group in June 2012 which included the Eye D report.

22) The fifth witness statement, dated 17 July 2014, is by Simon Rajgopaul, VL's Attorney. At exhibit VC-SR5 he provides a copy of a screen shot, dated 30 October 2013, from the website of VCH which shows an image of the PCR report. However, this report does not have the words "Eye-D". Instead it has an "eye" device above the letter "D" within a red circle with one white and one red band around the circle. Further down on the exhibit in a written section the "eye" device is again used as the name of the system. Further prints from the website of VCH, dated 17 July 2014, also show the "eye" device being used. A copy of this page is attached at Annex 1.

VCH'S EVIDENCE IN REPLY

23) VCH filed seventeen witness statements. Of these statements eight appear to be very similar in that they are by individuals who used to work for Community Eyecare (UK) Ltd (CEL) in various positions but are now employed by VCH. These include Adam Daly, employed by CEL between February 2013 and March 2014 as an optical assistant; Anthony Lord employed by CEL between January 2013 and June 2014 as an optometrist; Ben Higginson employed by CEL between September 2013 and March 2014 as an optical assistant; Jake Kearsley employed by CEL between September 2011 and September 2013 as an Optical Advisor; Lisa Tranent employed by CEL between July 2007 and December 2011 as a Marketing telesales and then web manager; Natalie Conway employed by CEL between November 2012 and April 2014 as an Optical Assistant; Pamela Sheriff employed by CEL between 2010 and April 2012 as a delivery and repair assistant and Samantha Yardy employed by CEL between September 2003 and May 2012 as an Optical Assistant, Branch Manager and Operations Manager;

24) All comment on the similarity of the trading name of CEL (VISIONCALL) to VCH. They all claim to be exposed to a wide range of company activity and industry information including the NHS and customised patient care reports. They all recall CEL using an NHS patient report until March 2013 and then a customised version entitled "lifestyle passport". They all refer to a print out of a Registry entry for VL's trade mark and comment that they do not find the mark distinctive or memorable and that it looks like the word "eyed" but state that it sounds like a technology that VCH has been developing, advertising and

marketing prior to their employment with VCH. They also all conclude with the following paragraph:

“For the avoidance of doubt, apart from the present action, I was not and am not aware of such Mark [EYE-D] being used or planned to be used by CEL/Visioncall and/or the owner/opponent (Visioncall Ltd) and/or any local business for the goods and services or otherwise; including on reports (including patient care reports) or technology, whether at present, during my current job or during my previous job.”

25) The ninth witness statement, dated 28 October 2014, is by Kevin Sefton, who carries out Business Development for VCH, a position he has held since June 2014. He too makes the same comments as set out in paragraph 24 above.

26) The tenth witness statement, dated 28 October 2014, is by Claire Gillan who is an Optical assistant for VCH, a position she has held since May 2014. In addition to making exactly the same comments as those set out in paragraph 24 above she also states that:

“I was employed by CEL/Visioncall for a number of years (“my previous job”), specifically since September 2010-September 2011.”

27) The eleventh witness statement is by Calum Martin, dated 28 October 2014, who is a Telesales Manager for VCH, a position he has held since September 2013. In addition to mirroring the comments shown above in paragraph 24, he provides at exhibit VCH-GEN2 a list of appointments that he states he arranged for others in VCH in order for them to demonstrate the “PCR report and EYE D technology” to care home managers. He states that there are 3456 appointments listed in the exhibit from September 2014 to the date of his statement. In fact the exhibit shows the earliest appointment as being on 1 November 2012 and the last on 28 October 2014. There is also a date showing when the appointment was created, the earliest of which appears to be 5 October 2012. I note that a large number of the listings show that the appointment was cancelled or is pending. Given the date that he claims to have begun his employment with VCH he cannot, as he claimed, have arranged all these visits himself. Mr Martin also provides at exhibits VCH-GEN 3-6 lists from VCH branches in Glasgow, Manchester, Yorkshire and Newcastle. He states that the lists show when “each target care home signed on as a customer with Vision Care At Home pursuant to the PCR report and EYE Technology demonstration and literature drop”. The lists for Yorkshire Manchester and Glasgow all start with transfer dates in 2010, considerably before the date that VCH claim to have come up with the idea. The list for Newcastle starts as of 25 September 2014.

28) The twelfth witness statement, dated 28 October 2014, is by Chris Cullen, who is a Marketing Manager for VCH, a position he has held since January 2013. In addition to mirroring the comments shown above in paragraph 24 he refers to exhibit VCH-Gen2 but acknowledges that the list of appointments started prior to his joining the company. However, he also refers to exhibits VCH3-6 and repeats the claims made by Mr Martin that the clients listed signed on after being shown the PCR report and EYE technology. The same comment as I made in paragraph 27 above is relevant.

29) The thirteenth witness statement, dated 28 October 2014, is by James Edgar, who is a Business Development Executive for VCH, a position he has held since January 2013. In addition to mirroring the comments shown above in paragraph 24 he refers to exhibit

VCH-Gen2 but acknowledges that the list of appointments started prior to his joining the company. However, he also refers to exhibits VCH3-6 and repeats the claims made by Mr Martin that the clients listed signed on after being shown the PCR report and EYE technology. The same comment as I made in paragraph 27 above is relevant.

30) The fourteenth witness statement, dated 28 October 2014, is by Stewart Steedman, who is a Business Development Manager for VCH, a position he has held since August 2012. In addition to mirroring the comments shown above in paragraph 24 he refers to exhibit VCH-Gen2 stating correctly that the list of appointments starts subsequent to his joining the company. However, he also refers to exhibits VCH3-6 and repeats the claims made by Mr Martin that the clients listed signed on after being shown the PCR report and EYE technology. The same comment as I made in paragraph 27 above is relevant.

31) The fifteenth witness statement, dated 29 October 2014, is by Mr McCullough who has provided evidence previously in this case. He repeats his claim that he first thought of the idea for Eye-D in late 2011. At exhibit VCH-GM1 he provides a screenshot from his computer which shows that a file called EYE-D was created on 21 September 2011 and shows a circle with "eye-D" written within it surrounded by two bands. He also refers to exhibit VCH-GM2 which is an email dated 27 November 2012 from Ann Bain (who has provided evidence in this case) which seems to be a round robin type communication as it is not addressed to anyone specifically but is titled "Monthly courtesy call" and starts of "Hi everyone". Mr McCullough contends that the email references service audits carried out in the summer of 2012. However, the only reference I could find states:

"We have been extremely busy over the last few months, carrying out our service audits and implementing any changes from this to our new service that we launched. The services audit results will be with you shortly.

We have new benefits over the up and coming months such as:-

- Eye-D System which is optional and a simple and effective identification system for carers to tell if an individual has the correct pair of glasses on for specific tasks
- New PCR reports –Patient, Carer, Relative – comprehensive report and simple to understand."

32) He provides the following exhibits:

- VCH-GM3: Consists of copies of audit reports for Sept 2012 and 2013. Nowhere on these reports does it use or refer to the mark EYE-D. The reports refer to the PCR report and they have the circle device surrounded by two bands but with no wording within the circle. The later report also shows an image of the top of a revised PCR report which has the circle device, "Visioncare at Home" and PCR Eye Report" at the top but no mention of "Eye-D".
- VCH-GM4: Consists of a number of PCR reports. These show use of mark 3032938 at the bottom of the report. Three of these are dated November and December 2012. The report shows an image of glasses upon it with the date of September 2012, which is when Mr McCullough says the PCR report was finalised.

- VCH-GM5: Copies of two emails sent by Mr McCullough. The first is to one of his staff, dated 26 October 2012 which shows use of mark 3032938 on a banner to be used at the Scottish Care conference. The second, dated 8 November 2012, also features the mark/banner and was sent by Mr McCullough to a number of staff in VCH.
- VCH-GM6: Minutes of a sales and strategy meeting dated 30 January 2013 which refers to the PCR/eye-D system and a comparison with the report of VL. Mr McCullough feels it is relevant that the VL report is not referred to as EYE-D or even using that term.
- VCH-GM7: Orders for stationery dated between 18 January 2013 and October 2014, which refer to the PCR report.
- VCH-GM8: A copy of a letter used to enclose the PCR pack, date redacted, which mentions within the text the Eye-D system. Also a copy of an email dated 12 February 2013 which makes specific reference to Eye-D.
- VCH-GM9: A copy of a marketing pack used from January 2013 which was issued to every care home prior to the visit. It includes references to Eye-D.
- VCH-GM10: A list of client visits, identical to that at VCH-GEN2 (see paragraph 28 above). I note that a great many of these appointments were cancelled or are listed as “pending”.
- VCH-GM11: Copies of reports which Mr McCullough states shows that during 2013 and 2014 39,063 different calls were made to care homes in relation to the PCR report and Eye-D system.
- VCH-GM12: A list which shows care homes which responded to the cold calling and agreed to a visit during which they were provided with a PCR pack detailing the Eye-D system. The list begins in October 2012.
- VCH-GM13: A copy of the script used by the cold callers which mentions the Eye-D system.
- VCH-GM14: An amalgam of comments made by salesmen following their visits to potential clients. The first date shown is 28 November 2012 and the comments often refer to reaction to the Eye-D system.

33) The sixteenth witness statement, dated 29 October 2014, is by Mr Marwaha, a director of VCH, a position he has held since 2007. He provides various documents and emails which he describes as having “been passed to me from a staff member” presumably an ex-employee of VL. He contends that these documents show that VL were not using the mark EYE-D but instead using the term LIFESTYLE PASSPORT. He provides the following exhibits:

- VCH-VM12: An email, dated 24 March 2013, from Wajid Malik from VL referring to the new lifestyle passport and also referring to form GOS3 which he states “we leave them [care homes] at the moment”.
- VCH-VM13: A copy of a form, claimed by Mr Marwaha to be form GSO3, which does not have the term Eye-D anywhere upon it.
- VCH-VM14: A copy of an undated letter, which mentions a proposed visit on 8 October 2014 and informs the client of a new “Lifestyle Passport”. Attached to the letter are various forms. Neither the letter nor the forms mentions Eye-D.
- VCH-VM15: A copy of the Lifestyle Passport report which does not have any use of the term Eye-D upon it. It is dated March 2013.
- VCH-VM16: Papers which are said to be part of the presentation used at the meeting in February 2012 run by VL and copies of various notes from the discussion. In none of the papers is Eye-D mentioned.

34) The seventeenth witness statement, dated 29 October 2014, is by Mr Hannay who has previously provided evidence in this case. He contends that VL is a non-trading company, that the annual returns for VL and CEL are identical and that the records at Companies House show that VL was listed in March 2014 as being a “non trading company” but as of October 2014 it was listed as being in the business of “retail sale by opticians” and “other human health activities”.

- VCH-PH17 & 18: Companies House reports for VL confirming Mr Hannay’s comments regarding trading status.
- VCH-PH19: A copy of a Companies House form correcting the SIC codes, but only for the years 2011-2013 inclusive. Mr Hannay comments that no earlier returns were corrected.
- VCH-PH20-25: Copies of annual returns for VL and Community Eyecare (UK) Ltd (CEL) for the years 2012-2014 inclusive. These show identical returns for both companies in each of the years. The forms for CEL show that it is a 100% subsidiary of VL. Mr Hannay concludes that VL is therefore a holding company.
- VCH-PH27: Abbreviated accounts for VCH for the period 1 May 2011-30 April 2013 which show that VCH’s turnover and marketing expenditure is larger than that of CEL/VL.
- VCH-PH28: A copy of the domain register, which shows that the domain name “vision-call.co.uk” is owned by CEL. Mr Hannay comments that VL does not automatically own the work and reputation of CEL.
- VCH-PH30: A printout of the Companies House mortgage index dated 16 October 2014 together with form 410 and certificate of registration in connection with outstanding floating charge granted by VL over all property present and future of

the company. Mr Hannay notes that no evidence has been lodged to confirm the banks consent to what he refers to as “the alleged licence and/or usage” by VL.

VL’S ADDITIONAL EVIDENCE

35) VL filed two witness statements, dated 25 November 2014 and 3 December 2014, both by Mr Rajgopaul who has provided evidence earlier in this case. He states that on 30 June 2014 he drafted a trade mark licence between VL and its wholly owned subsidiary CEL, to “confirm for the avoidance of doubt terms of use (including prior and future use) of various brands between the parties”. At exhibit VC-SR9 he provides a copy of the licence.

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

DECISION

37) I shall first consider the invalidity action in respect of trade mark 2652006 which is brought under two grounds. The first of which is section 3(6), which reads:

“3.(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

38) The law in relation to section 3(6) of the Act (“bad faith”) was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, “Bad faith in European trade mark law” [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case

R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

39) Whilst VCH accept that the date of the application 12 February 2013 is the relevant date they contend that the later actions of VL should also be taken into account. In submission VCH contends that the filing of the application for the mark "LIFESTYLE PASSPORT" on 31 May 2013 is relevant as it contends that VL claims to have incorporated its mark into an eyecare passport which it began marketing in May 2012. VCH claims that the eyecare passport was a copy of its own PCR report.

40) In its evidence VCH states that the idea of marking glasses in order to ensure that the patient/resident had the correct pair was first raised in a management meeting in December 2011. The idea was then worked on and by March 2012 the idea of using heat shrink colours was finalised. The marking would form part of the PCR report system that VCH was also working on. It is not clear when the report was finalised but the evidence of VCH is clear that it launched the system at a trade exhibition in November 2012. It is stated that banners were ordered in October 2012.

41) By contrast VL contend that at an event it held in February 2012, at which clients also attended, the name "Eye-D" was thought of in an ideas session. The idea and the report were worked upon internally, and that the company then contracted an outside design company in June 2012 to work up the graphics and format. The finished product was shown to customers at a series of individual briefings during June – August 2012. These customers have been named and are evidently substantial care home providers in the UK.

42) VCH sought to counter these claims by producing witness statements from ex-employees of VL who are now working for VCH. As such they cannot be regarded as independent. It is clear that one, if not all of them, removed confidential documents from VL and provided them to VCH as they have been filed in evidence VCH-VM 12-16. I decided not to exclude these documents from the evidence. Whilst these ex-employees state that VL did not use the mark in suit, it is not clear whether it was simply a case that these employees did not encounter them. I also have to take into account the witness statements and corroborating evidence filed by VL. In its submissions VCH makes claims regarding the behaviour of VL at trade fairs prior to the 2012 event accusing VL of taking photographs of its stand. This seems surprising to me, as when one takes an exhibition stand it is open to the world and his wife to see your wares, including your competitors. To my mind, most prudent business people would spend time at a trade fair looking at what his competitors were offering. So even if I accept that VL did engage in such activity, in and of itself not an act of bad faith, this cannot explain how it was that VL "stole" the idea from VCH prior to the public launch by VCH in November 2012, unless I

regard the whole of the evidence of VL as pure fabrication and that there was no such idea at a meeting with its clients and that the meetings with the named customers did not actually occur. I fully accept that it would have been better had VL filed statements from a customer who had been contacted during the summer of 2012. If VCH wished to undermine the credibility of the whole of the evidence of VL then it should have sought to cross examine their witnesses when such accusations could have been put directly to them rather than implied.

43) Further evidence and submissions have been made regarding the fact that the directors of VL include a builder and an accountant; that some of the records at Companies House show the wrong Standard Industrial Classification (SIC) code for the trading activity and that VL's memorandum of association showed that they were looking to trade in any field for profit. I do not regard any of these points to be relevant to the issue of whether the application was filed in bad faith. VCH also alleges that at the time of the application, 12 February 2013, VL was aware of VCH's mark as it had seen the exhibition stand of VCH at the trade fair in November 2012. Given that VL contends that it had been using its mark since June 2012, it would have a superior claim which would mean that in applying for the mark in February 2013 it was not doing so in bad faith. At the date of filing its application VL were aware that VCH were considering introducing its mark but would not be aware of any use by VCH. VL would have been aware that it coined the phrase and had used it and so this does not amount to bad faith.

44) VCH relies upon the statement by VL that it applied for the mark to "formalise and strengthen the rights". It is contended that by using the word "strengthen" it discloses an inherent weakness in VL's rights. I fully accept that it does disclose a weakness, in that VL did not have a registered right. This does not equate to bad faith. Neither does the fact that having applied for the mark in suit, VL decided to suspend use of the mark in suit and concentrate upon its LIFESTYLE PASSPORT mark until the issue surrounding the mark in suit was resolved. Having been granted the registration in July 2013 it then waited until November 2013 before issuing a warning letter to VCH just days prior to the trade exhibition of that year. The fact that this disrupted the plans of VCH does not show bad faith.

45) VCH further contend that as the mark was conceived by Ms Macconnachie, perhaps with the assistance of others, and as at the time she was an employee of Community Eyecare (UK) Ltd (CEL), then VL had no right to file the application. They state that there is no evidence of anyone at the meeting giving up their rights to the mark and assigning them to VL. Any agreement as to ownership is an issue between VL, Ms Macconnachie and perhaps other participants at the event and is not an issue for this Tribunal. It is clear from the evidence that CEL is a wholly owned subsidiary of VL. Further, due to comments regarding the accrual of goodwill VL has provided evidence of a licence, albeit backdated, between VL and CEL. In my opinion, VL had the right to file the application for a mark created by an employee of a wholly owned subsidiary company.

46) Although, for the sake of completeness, I have dealt with a great number of allegations by VCH, I note that most of them have been made in submissions and were not in the original pleadings, nor has there been any request to amend the pleadings at any stage. Taking all of the submissions into account, and considering the matter on the balance of probabilities I do not accept that the application was made in bad faith. **The invalidity action under section 3(6) therefore fails.**

47) I now turn to the second ground of invalidity under section 5(4)(a) which reads:

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

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

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

48) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the *WILD CHILD* case [1998] RPC 455. In that decision Mr Hobbs stated that:

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

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

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

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

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

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

49) I also note the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. 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 Section 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.

28. 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 at the relevant date. Once raised the applicant must rebut the prima facie case. Obviously he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of possibilities that passing off will occur."

50) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

"Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

51) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

"39. In *Last Minute*, the General Court....said:

'50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.'

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd*

O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

52) In its evidence VCH has clearly stated that the PCR report and Eye-D service was launched at a trade fair in November 2012. That these are in use is not in dispute as the evidence of a user, Ms Stuart, confirms. However, the extent of use following the launch is difficult to determine. For instance Mr Martin states that he has made appointments for employees of VCH to visit potential clients. However, the list provided and which he said related to appointments made by him preceded his employment with VCH by eleven months. Indeed the list of appointments precedes the launch of the product. Similarly a list of clients said to have been signed on as customers after receiving either literature or a presentation of the PCR/EYE-D system dates from 2010. Further, a list of potential clients which responded to cold calls regarding the new product begins in October 2012, again prior to the launch. I am willing to accept that from November 2012 VCH began accruing goodwill in the mark EYE-D.

53) However, unless I reject all of the evidence of VL, I have to accept that this company began to accrue goodwill from June 2012. Again it is not possible to quantify the extent of the goodwill in terms of sales, share of market etc. On the balance of probabilities I conclude that at the time of the application VL was the senior user. **Therefore, the ground of invalidity under Section 5(4)(a) fails.**

54) I now turn to consider the ground of opposition to the application of VCH for the mark shown on the front cover of the decision. The first ground of opposition is under section 5(2)(b) which 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.”

55) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“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.”

56) VL is relying upon its trade mark listed in paragraph 1 above which is clearly an earlier trade mark. Given the interplay between the date that VL’s mark was registered and the date that VCH’s mark was published, section 6A of the Trade Marks Act does not come into play.

57) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*,

Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

- (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 or services 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 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 great 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

58) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services; I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“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.”

59) Both sides have very extensive specifications which are couched in very general terms which do not restrict them to their core businesses for which the marks are used, broadly, optical services for care homes and their residents. I shall therefore determine the average consumer and purchase process for each set of goods and services identified in the comparison test below.

Comparison of goods

60) In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

61) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

62) I also take note of the comments in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), where Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

63) Further, in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

64) Also in *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

65) I also note that in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

66) Whilst in *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the

goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

67) In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

68) Turning to the actual goods and services contained within the specifications of the two parties. Despite VCH filing five sets of submissions and VL two sets, neither party commented upon the similarity, or otherwise, of the goods and services. I must therefore make my own determination. To my mind the following goods and services are clearly identical as they share the same wording:

VL's specification	VCH's Specification
In Class 9: Databases.	In Class 9: databases.
In Class 16: Printed reports.	In Class 16: printed reports relating to identification and optical products and opticians services.
In Class 35: Compilation of statistical data for use in scientific research. Compilation of statistical data relating to medical research. Data management services. Advisory services relating to data processing data entry and data processing. Compilation and systematisation of information in databanks. Collection of data.	In Class 35: Compilation of statistical data for use in scientific research. Compilation of statistical data relating to optical and medical research. Data management services. Advisory services relating to data processing data entry and data processing. Compilation and systematisation of information in databanks. Collection of data.
In Class 40: Engraving.	In Class 40: Engraving.
In Class 41: Publishing services (including electronic publishing services). Publishing of electronic publications.	In Class 41: Publishing services (including electronic publishing services). Publishing of electronic publications.

Publishing of printed matter. Provision of on-line electronic publications.	Publishing of printed matter. Provision of on-line electronic publications.
In Class 42: Computerised analysis of data.	In Class 42: Computerised analysis of data relating to identification and optical products and optician's services.
Class 44: Services for the preparation of medical reports. Provision of medical services. Provision of medical information. Medical analysis services. Maintaining personal medical history records and files. Optical services. Compilation of medical reports; Issuing of medical reports. Preparation of reports relating to health care matters; Preparation of reports relating to medical matters. Provision of reports relating to the medical examination of individuals.	Class 44: services for the preparation of optician and medical reports. Provision of optician and medical services. Provision of optician and medical information. Optical and medical analysis services. Maintaining personal eye care and medical history records and files. Optical services. Compilation of optician and medical reports. Issuing of optician and medical reports. Preparation of reports relating to eye care, health care and medical matters. Provision of reports relating to the optical and medical examination of individuals.
Class 45: Identification and security marking.	Class 45: Identification and security marking.

69) I regard the following goods and services to be identical or similar, to differing degrees, for the reasons provided:

VL's specification	VCH's Specification	Degree of similarity and reasons:
Class 45: Identification and security marking.	Class 6: Identification bracelets of metal; identification plates of metal; identification tags of metal; identity plates of metal.	Given that both are involved in identification and marking there is a degree of similarity.
Class 9: Databases	In Class 9: recorded files.	To my mind these would be highly similar as databases are made up of recorded files.
Class 45: Identification and security marking.	In Class 9: bracelets (encoded identification); encoded identification bracelets; identification labels; identification sheaths; identification strips; identification threads; shaft identification gauges;	Given that both are involved in identification and marking there is a degree of similarity.
Class 44: Optical services.	Class 9: Identification system for spectacles; 3D spectacles; Anti-dazzle spectacles; Bars for spectacles; Chains for spectacles; Cords for spectacles;	To my mind the various goods in VCH's class 9 specification are similar at least to the optical services of VL

	<p> Eyeglasses; Frames for eyeglasses; Frames for spectacles; Frames for spectacles and sunglasses; Glacier eyeglasses; Lenses for eyeglasses; Lenses for spectacles; Polarizing spectacles; Protective eyeglasses; Protective spectacles; Retainers for spectacles; Safety spectacles; Spectacles; Spectacles [glasses]; Spectacles [optics]; corrective eyewear; spectacle glasses, spectacle cases, spectacle frames, spectacle lenses, spectacle hinges, their parts and accessories including chains and cords; Opera glasses; eyeglass frames, eyeglass cases and eyeglass products, namely, headstraps and retainers, safety and tactical glasses; sunglasses, sunglass lenses; sunglasses cases, sunglasses frames, sunglasses lenses, sunglasses hinges, their parts and accessories including chains and cords; contact lenses, cases for contact lenses, parts and fittings for all the aforesaid goods; Optical equipment, apparatus and instruments, their parts and accessories including chains and cords; goggles; Goggles for action sports; optical glass; optical goods; optical lenses; sport goggles for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, sky diving and baseball, safety goggles and ski helmets; Protective and/or anti-glare eyewear, sunglasses, spectacles, goggles and their parts and accessories, namely replacement lenses, earstems, frames, nosepieces; cases </p>	
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	<p> specially adapted for protective and/or anti-glare eyewear, sunglasses and spectacles, and their parts and accessories; Goggles, lenses for goggles, all being in the nature of protective eyewear without any optical sight correction function; face masks; helmets; protective eyewear, headwear and bodywear; Parts and fittings included in Class 9 for ophthalmic glasses, eyeglasses, spectacles, goggles and for sunglasses; bracelets (encoded identification); encoded identification bracelets; identification labels; identification sheaths; identification strips; identification threads; shaft identification gauges; Optician's goods; Infrared optical apparatus; Laboratory optical apparatus; Optical measurement apparatus; Topographic apparatus [optical]; Optical apparatus and instruments; Pouches for optical apparatus; Testing apparatus for checking optical devices; image identifier night vision devices; sporting articles, namely, sport goggles ofr use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and baseball; all the aforesaid relating to identification and optical products and optician's services. </p>	
Class 44: Optical services.	Class 10: Optical and medical apparatus and instruments; furniture adapted for medical use; artificial eyes; artificial lenses for implantation in the eye; eyes (artificial).	There is at least a moderate degree of similarity between the services of VL and the goods of VCH as they all involve optical matters.
Class 16: Printed reports.	Class 16: Printed matter; printed publications; prospectuses; pamphlets; catalogues;	To my mind "printed reports" would be similar to these of VCH as printed reports could be in the

		form of a prospectus, pamphlet or catalogue, they would also be printed matter and a publication.
Class 45: Identification and security marking.	Class 16: Paper identification tags;	At least similar as goods relate to identification.
Class 45: Identification and security marking.	Class 17: Identification sleeves of plastic; identification sleeves of rubber.	At least similar as goods relate to identification.
Class 45: Identification and security marking.	Class 20: Identification bracelets, not of metal; identity plates, not of metal.	At least similar as goods relate to identification.
Class 44: Optical services.	Class 28: Sporting articles, for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and baseball; sporting gloves; all the aforesaid relating to identification and optical products and optician's services.	Given the limitation on the goods of VCH these must be regarded as similar to the services of VL.
Class 35: Advisory services relating to data processing; Data management services.	Class 35: business advice; Business management; professional management services.	The provision of advice relating to data processing must be considered to be similar to the provision of business advice. Equally, data management services and business / management services are also similar. In each instance the VL services are subsets of the services of VCH.
Class 44: Optical services.	Class 35: Retail services connected with the sale of spectacles and sunglasses;	Clearly similar.
Class 44: Optical services.	Class 37: Repair services relating to spectacles, glasses, sunglasses, lenses, contact lenses, spectacle cases, chains, frames, holders and mountings, optical apparatus and instruments.	Clearly similar.
Class 44: Optical services.	Class 40: Optical grinding; grinding, polishing and tinting of lenses; optical glass grinding services; custom manufacturing custom and assembly services relating to the provision of optical and hearing aid products; Custom	Clearly similar.

	manufacture of ophthalmic lenses for eyeglasses; Custom manufacture of optical frames; Grinding and polishing glass for eyeglasses.	
Class 41: Life coaching (training).	Class 41: Education; Providing of training.	Again identical services as training or life coaching must be a subset of both education and the provision of training.
Class 44: Optical services.	Class 44: Optician services; Opticians' services; Information services relating to lenses; Sight-testing services; eyeglass fitting; eye bank services.	To my mind, VL's services encompass all of the services of VCH listed in class 44 and so they must be regarded as identical or at the very least highly similar.
Class 45: Identification and security marking.	Class 45: Tagging of personal effects; identity validation services; identity validation.	The services of VCH must fall within the services of VL or at least be similar.

70) To my mind the goods in classes 9 & some of those in class 16 and the services in classes 35, 41, 42 & 44 will for the most part be purchased by businesses, selected initially by eye from advertisements or from the internet, followed up by a face to face meeting or telephone conversation. These goods and services will be selected with a reasonable to high degree of care. Some of the goods in class 16 and the services offered under classes 40, 41 and 45 will be purchased by members of the general public including businesses. I believe the selection process will be similar although those businesses offering class 40 and 45 services may also operate from the high street in which case the shop sign may well aid the initial selection. Although I believe that such services may not been chosen with as much attention as the other goods and services under consideration there will be some thought given (at least a moderate level) to the service provider.

71) In my opinion the following goods and services of VCH are not similar to any of the goods and services of VL, nor are they complementary. Most of the goods and services listed below do not require comment as it is obvious that they are not similar or complementary to any of the goods and services of VL. Whilst some refer to optical products I have refrained from interpreting VL's "optical services" too broadly.

Class 9: Data communications apparatus; data communications hardware; Optical communications instruments; data processing; Apparatus for transmission of communication; Wireless communication apparatus; Communications equipment; Optical character recognition apparatus; Target surveillance apparatus [optical]; Digital optical transmission apparatus; Target location apparatus [optical];

Class 16: Photographs; all the aforesaid relating to identification and optical products and opticians services.

Class 25: Clothing, headgear; all the aforesaid relating to identification and optical products and optician's services.

Class 35: Management and marketing services, all for opticians; Business development; business administration services; business planning; operational business services, advertising, promotional and marketing services; procurement of goods; professional recruitment services; accounts and auditing services, all of the aforesaid services for opticians and other healthcare professionals; arranging and conducting conferences and seminars and the provision of information and advisory services, all relating to the aforesaid services;

Class 38: Data communication services.

Class 41: Entertainment; Sporting and cultural activities; Organisation of competitions (education or entertainment), congresses, colloquiums, conferences and events, all relating to spectacles or related goods; Training in communication techniques; Training services relating to data communications; Training in the field of communication technologies; Provision of instruction relating to communication techniques.

Class 42: Technical consultancy on design, including the services for creating lighting and optical concepts; engineering services with regard to installation of lighting and lighted related identification or communication systems; Technical research relating to automatic identification systems; Design of communication systems; Engineering services relating to the design of communications systems; software development; all the aforesaid relating to identification and optical products and optician's services.

Distinctive character of the earlier trade mark

72) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 C-108/97 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).”

73) The mark consists of a well known word (EYE) and the letter “D”. Although there is a gap between them I believe that the average consumer will view the mark as a whole and will recognise that the mark is a play upon the term “ID” short for identification. It therefore has a moderate level of inherent distinctiveness. Although VL has provided evidence of use of its mark, as I have set out earlier in the decision the evidence is not specific enough for VL to benefit from enhanced distinctiveness through use in respect of its mark.

Comparison of trade marks

74) The trade marks to be compared are:

VL’s registered trade mark	VCH’s trade mark applied for
EYE D	

75) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’

40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

76) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM*, Case T-569/10, the General Court held that:

“96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the

overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).”

77) To my mind, both parties’ marks have as their distinctive and dominant elements identical word and letter combinations “EYE D”, albeit that the letter “D” is underneath in VCH’s mark as opposed to being on the same line in VL’s mark. In terms of both marks, the word and letter “hang together” to form a conceptual image. The term “ID” as shorthand for identification is well known and extensively used. In supermarkets, for example, one views signs warning that the cashier will ask to see a form of ID to prove that the customer is over eighteen years old when purchasing certain items such as alcohol or drugs. The only difference in the marks is that VCH’s mark is set within a roundel device. In my opinion, the average consumer will see the device but it is merely a background device and “words speak louder than devices”. Although I believe that the majority of the goods and services will be chosen visually there is also the aspect of aural selection that must be taken into account. To my mind the marks are visually highly similar and aurally and conceptually identical.

Likelihood of confusion

78) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of VL’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is for the most part businesses but must also include members of the general public, who will select the goods and services predominantly by visual means and who will pay a reasonable to high level of attention when doing so (see paragraph 70 above for details);
- there are a number of the goods and services which are identical and a few which are highly similar with a number of goods and services being dissimilar. These are set out in detail at paragraphs 68, 69 and 71 above;
- the competing trade marks are visually highly similar and aurally and conceptually identical;
- VL’s earlier trade mark is possessed of a moderate degree of inherent distinctive character, but has not been shown to benefit from an enhanced distinctiveness by the use made of it in the United Kingdom.

79) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods and services listed in paragraphs 68 and 69 provided by VCH are those of VL or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to the goods and services listed in paragraphs 68 and 69.** However, there is no likelihood of consumers being confused into believing that the goods and services listed in paragraph 71 and provided by VCH are those of VL or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore fails in relation to the goods and services listed in paragraph 71.**

80) I next turn to the ground of opposition under section 5(3) which reads:

“5(3) A trade mark which-

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

81) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

82) The onus is upon the opponent to prove that its earlier trade mark enjoys a reputation and it needs to furnish the evidence to support this claim. Earlier in this decision at paragraph 53 I accepted that VL had accrued goodwill in optical services. To my mind, the evidence of VL shows that at the relevant date, 29 November 2013, VL had achieved amongst the relatively small world of UK care home providers a reputation for its optical services, and so its opposition under section 5(3) get over the first hurdle. This is despite the length of use being very short, the market size not known and no enhanced distinctive character.

83) Once the matter of reputation is settled an opponent must then show that the relevant customers would make a link between the two trade marks and how its trade mark would be affected by the registration of the later trade mark. In Case C-408/01, *Addidas-Salomon*, the CJEU held that:

"28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).

29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23).”

84) There is some debate as to whether the judgment of the CJEU in *L’Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L’Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited*¹ [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L’Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull*.

85) In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant’s conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

86) In *Aktieselskabet af 21. November 2001 v OHIM*, Case C-197/07P, the CJEU stated that:

“22. With regard to the appellant’s argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 *Intel Corporation* [2008] ECR I-0000, paragraph 38).

23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future.”

87) From the evidence of VL it is clear that as part of the optical services it provides to care homes it provides glasses to residents and that it marks those glasses to aid identification of the correct glasses for each activity. It is not clear whether the same services are offered to the workers at the care homes but it does not seem unlikely. It examines the residents’ eyes and provides written reports on each resident for use by the care provider and the resident. Earlier in this decision I found that the marks were aurally and conceptually identical and visually highly similar. As such any goods or services that fall within the remit of the provision of optical services would be considered by the average consumer, the residential care provider, as emanating from VL or from an undertaking linked to it despite the reasonable to high degree of attention given to the choice of service provider. To my mind, the average consumer will form the requisite link between the marks when it is used on the following goods and services:

Class 9: Identification system for spectacles; 3D spectacles; Anti-dazzle spectacles; Bars for spectacles; Chains for spectacles; Cords for spectacles; Eyeglasses; Frames for eyeglasses; Frames for spectacles; Frames for spectacles and sunglasses; Glacier eyeglasses; Lenses for eyeglasses; Lenses for spectacles; Polarizing spectacles; Protective eyeglasses; Protective spectacles; Retainers for spectacles; Safety spectacles; Spectacles; Spectacles [glasses]; Spectacles [optics]; corrective eyewear; spectacle glasses, spectacle cases, spectacle frames, spectacle lenses, spectacle hinges, their parts and accessories including chains and cords; Opera glasses; eyeglass frames, eyeglass cases and eyeglass products, namely, headstraps and retainers, safety and tactical glasses; sunglasses, sunglass lenses; sunglasses cases, sunglasses frames, sunglasses lenses, sunglasses hinges, their parts and accessories including chains and cords; contact lenses, cases for contact lenses, parts and fittings for all the aforesaid goods; Optical equipment, apparatus and instruments, their parts and accessories including chains and cords; goggles; Goggles for action sports; optical glass; optical goods; optical lenses; sport goggles for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, sky diving and baseball, safety goggles and ski helmets; Protective and/or anti-glare eyewear, sunglasses, spectacles, goggles and their parts and accessories, namely replacement lenses, earstems, frames, nosepieces; cases specially adapted for protective and/or anti-glare eyewear, sunglasses and spectacles, and their parts and accessories; Goggles, lenses for goggles, all being in the nature of protective eyewear without any optical sight correction function; face masks; helmets; protective eyewear, headwear and bodywear; Parts and fittings included in Class 9 for ophthalmic glasses, eyeglasses, spectacles, goggles and for sunglasses; identification labels; identification sheaths; identification strips; identification threads; shaft identification gauges; Optician’s goods; Optical measurement apparatus; Optical apparatus and instruments; Pouches for optical apparatus; Testing apparatus for checking optical devices; sporting articles, namely, sport goggles for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and

baseball; all the aforesaid relating to identification and optical products and optician's services.

Class 10: Optical and medical apparatus and instruments; furniture adapted for medical use; artificial eyes; artificial lenses for implantation in the eye; eyes (artificial).

Class 16: Printed matter; printed reports; prospectuses; pamphlets; catalogues; photographs; printed publications; Paper identification tags; all the aforesaid relating to identification and optical products and opticians services.

Class 25: Clothing, headgear; all the aforesaid relating to identification and optical products and optician's services.

Class 28: Sporting articles, for use in snow skiing, water skiing, jet boating, snowboarding, bicycling, golfing, kayaking, tennis, swimming, motorcycling, boating, windsurfing, surfing, fishing, hiking, climbing, skydiving and baseball; sporting gloves; all the aforesaid relating to identification and optical products and optician's services.

Class 35: Management and marketing services, all for opticians; Retail services connected with the sale of spectacles and sunglasses; Business management and development; business advice and administration services; business planning; operational business services, advertising, promotional and marketing services; procurement of goods; professional management and recruitment services; accounts and auditing services, all of the aforesaid services for opticians and other healthcare professionals; arranging and conducting conferences and seminars and the provision of information and advisory services, all relating to the aforesaid services; Advisory services relating to data processing; Collection of data; Compilation of statistical data relating to optical and medical research; Compilation of statistical data for use in scientific research; Compilation and systematisation of information in databanks; data entry and data processing; Data management services.

Class 37: Repair services relating to spectacles, glasses, sunglasses, lenses, contact lenses, spectacle cases, chains, frames, holders and mountings, optical apparatus and instruments.

Class 40: Optical grinding; grinding, polishing and tinting of lenses; optical glass grinding services; custom manufacturing custom and assembly services relating to the provision of optical and hearing aid products; Custom manufacture of ophthalmic lenses for eyeglasses; Custom manufacture of optical frames; Grinding and polishing glass for eyeglasses; Engraving.

Class 41: Organisation of competitions (education or entertainment), congresses, colloquiums, conferences and events, all relating to spectacles or related goods;
Class 44: Optician services; Opticians' services; Information services relating to lenses; Sight-testing services; eyeglass fitting; eye bank services; services for the preparation of optician and medical reports; Provision of optician and medical services; Provision of optician and medical information; Optical and medical analysis services; Maintaining personal eye care and medical history records and files; Optical services; Compilation of optician and medical reports; Issuing of optician and medical reports; Preparation of

reports relating to eye care, health care and medical matters; Provision of reports relating to the optical and medical examination of individuals.

Class 45: Tagging of personal effects; Identification and security marking;

88) However, I do not believe that the link will be formed in respect of the following despite the near identity of the marks of the two parties:

Class 6: Identification bracelets of metal; identification plates of metal; identification tags of metal; identity plates of metal.

Class 9: bracelets (encoded identification); encoded identification bracelets; Data communications apparatus; data communications hardware; data processing; databases and recorded files; Apparatus for transmission of communication; Wireless communication apparatus; Communications equipment; Infrared optical apparatus; Laboratory optical apparatus; Optical communications instruments; Topographic apparatus [optical]; Optical character recognition apparatus; Target surveillance apparatus [optical]; Digital optical transmission apparatus; Target location apparatus [optical]; image identifier night vision devices;

Class 17: Identification sleeves of plastic; identification sleeves of rubber.

Class 20: Identification bracelets, not of metal; identity plates, not of metal.

Class 38: Data communication services.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; Training in communication techniques; Training services relating to data communications; Training in the field of communication technologies; Provision of instruction relating to communication techniques; Publishing services (including electronic publishing services); Publishing of electronic publications; Publishing of printed matter; Provision of on-line electronic publications.

Class 42: Technical consultancy on design, including the services for creating lighting and optical concepts; engineering services with regard to installation of lighting and lighted related identification or communication systems; Technical research relating to automatic identification systems; Design of communication systems; Engineering services relating to the design of communications systems; Computerised analysis of data; software development; all the aforesaid relating to identification and optical products and optician's services.

Class 45: identity validation services; identity validation.

89) Adopting the composite approach advocated, leads me to the view that there is an advantage for VCH to derive. To my mind this is precisely the impact that registration of the mark in suit would have. VCH would undoubtedly benefit from any advertising and promotion carried out by VL, and the reputation built up by VL prior to the application date would also assist VCH. As far as detriment is concerned, VL has contended that use by VCH of its mark would weaken the distinctiveness of its mark and would lead to a loss of sales. I believe that this would be the case.

90) I next turn to the issue of whether the mark was applied for without due cause. VCH has provided evidence that it thought up the mark independently of VL which I am willing to accept. However, by the time that VCH came to launch its mark almost a year after the initial concept idea, it should have been aware of the use by VL of its almost identical mark. This is especially so as it quite clearly has employed a number of staff who used to work for VL and who provided various internal documents. Considering the issue overall I believe that the ground of opposition under section 5(3) should succeed in relation to the goods and services identified at paragraph 87 above, whilst failing in respect of the goods and services identified at paragraph 88 above.

91) Given that the opposition has, for the most part, succeeded under Section 5(2)(b) and 5(3) I do not believe that VL is in a stronger position under section 5(4)(a) and so I decline to consider this ground as I do not believe it will affect the overall outcome.

CONCLUSION

92) VCH has been wholly unsuccessful in its attempt to invalidate the mark of VL. However, VL has been quite successful in its opposition to the application filed by VCH. Whilst it did not succeed against all the goods and services applied for by VCH, it has considerably reduced the goods and services in the specification which will now go forward to registration. The revised specification for VCH's trade mark which will be registered is:

Class 9: Data communications apparatus; data communications hardware; Optical communications instruments; data processing; Apparatus for transmission of communication; Wireless communication apparatus; Communications equipment; Optical character recognition apparatus; Target surveillance apparatus [optical]; Digital optical transmission apparatus; Target location apparatus [optical];

Class 16: Photographs; all the aforesaid relating to identification and optical products and opticians services.

Class 25: Clothing, headgear; all the aforesaid relating to identification and optical products and optician's services.

Class 38: Data communication services.

Class 41: Entertainment; Sporting and cultural activities; Training in communication techniques; Training services relating to data communications; Training in the field of communication technologies; Provision of instruction relating to communication techniques.

Class 42: Technical consultancy on design, including the services for creating lighting and optical concepts; engineering services with regard to installation of lighting and lighted related identification or communication systems; Technical research relating to automatic identification systems; Design of communication systems; Engineering services relating to the design of communications systems; software development; all the aforesaid relating to identification and optical products and optician's services.

COSTS

93) VCH failed in its invalidity action and VL has been mostly successful in its opposition. Therefore, VL is entitled to a contribution towards its costs.

Preparing statements and considering the other side's statements	£600
Preparing evidence	£900
Preparing submissions and considering those of the other side	£800
TOTAL	£2,300

94) I order Vision Care at Home Ltd to pay the sum of £2,300 to Visioncall Ltd. 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 4th day of June 2015

**G W Salthouse
For the Registrar
the Comptroller-General**

ANNEX 1

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QUICK IDENTIFICATION SYSTEM FOR PATIENTS AND STAFF TO ENSURE THE CORRECT GLASSES ARE USED FOR SPECIFIC VISUAL TASKS

REMEMBER **WHITE** FOR SIGHT & **RED** FOR READING

	DISTANCE	NEAR	MULTIFOCAL
GENERAL USE	✓	✓	✓
TELEVISION	✓	✓	✓
READING	✓	✓	✓
EATING	✓	✓	✓
KNITTING	✓	✓	✓
WALKING	✓	✓	✓
CRAFTS	✓	✓	✓
PHOTOS	✓	✓	✓

REDUCE THE RISK OF FALLS

www.visioncareathome.co.uk

We at Visioncare at Home think it is so important to try and reduce the risk of falls in care homes, this is why we introduced our **D** system, to make it clearer for the staff, family and residents to distinguish which glasses they should be wearing at which times. If you would like any further information regarding this or training for your staff, please contact us on 0141 332 0057 or lisa@visioncareathome.co.uk

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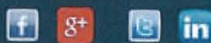
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