

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2103691  
BY DOLLOND & AITCHISON LIMITED  
TO REGISTER THE TRADE MARK:  
ICE-TITANIUM  
IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER No 47762  
BY GILMAR SPA**

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF Application No 2103691**  
**by Dollond & Aitchison Limited**  
**to register the trade mark: ICE-TITANIUM**  
**in class 9**  
**and**  
**IN THE MATTER OF Opposition thereto under No 47762**  
**by Gilmar SpA**

**Background**

1. On 27 June 1996 Dollond & Aitchison applied to register the trade mark **ICE-TITANIUM** in respect of *spectacles; spectacle frames* in class 9.
2. On 6 November 1997 Gilmar SpA filed notice of opposition to this application.
3. The statement of grounds of the opponent originally included several grounds of opposition. However, at the hearing his representative relied solely upon section 5(2)(b). In the statement of grounds the opponent relied upon seven earlier registrations and one (later) application. However, at the hearing the opponent relied upon one registration: registration no 1386189 of the trade mark **ICEBERG** which is registered in respect of: *eye glasses and lenses; spectacles, spectacle glasses and lenses; spectacle frames and parts and fittings therefor; spectacle cases; sunglasses; all included in Class 9.*
4. The applicants filed a counterstatement denying the grounds of opposition. Both sides sought an award of costs. The matter came to be heard on 8 October 2001 when the opponent was represented by Mr Hitchcock of Lloyd Wise Tregear & Co and the applicant was represented by Mr Blum of Gill Jennings & Every.

**Opponent's evidence**

5. At the hearing Mr Hitchcock did not seek to claim an enhanced penumbra of protection, as a result of recognition, for registration no 1386189. Consequently, the evidence which he furnished, which relates to user, does not have a bearing upon the instant proceedings and I need say no more about it.

**Applicant's evidence**

6. Owing to the limitation of the basis of the opposition at the hearing the evidence of the applicant has little bearing upon my decision. Where I need to refer to it I will do so in the decision.

## Opponent's evidence in reply

7. Owing to the limitation of the basis of the opposition the opponent's evidence in reply does not have a bearing upon my decision and I will say no more about it.

## Decision

8. In Mr Hitchcock's skeleton argument he referred to an annex to the evidence of the opponent which listed various of his registrations. These included several which were not included in his statement of grounds. I advised Mr Hitchcock that as there had been no request to amend the statement of grounds that I would only consider the registrations listed therein.

9. I asked Mr Hitchcock if he was still relying upon registration no 1393216 which had been surrendered during the proceedings. In relation to this matter I referred to *TRANSPAY* (2001) RPC 191. He stated that he was not. Having enquired of him if he considered that any of the registrations with the exception of 1386189 encompassed similar or identical goods, Mr Hitchcock indicated that he was relying solely upon this registration.

10. The grounds of opposition pursued by the opponent is that under sections 5(2)(b) of the Trade Marks Act 1994. The relevant provision read as follows:

Section 5:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

11. The term 'earlier trade mark' is defined in section 6 of the Act as follows:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks."

12. In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG* [2000] E.T.M.R. 723. It is clear from these cases that:-

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224; 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27.

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG* page 224;

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 7, paragraph 17;

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 8, paragraph 24;

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;

(h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;

(i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 9 paragraph 29.

### **Comparison of goods**

13. *Spectacles and spectacle frames* of the application in suit are included in the specification of the earlier registration. **The goods of the application in suit are, therefore, identical to those of the earlier registration.**

### **Comparison of signs**

14. The trade marks to be compared are as follows:

Earlier registration:

**ICEBERG**

Application in suit:

**ICE-TITANIUM**

I have to consider the respective trade marks in their entirety. However, I also need to take into account any dominant or distinctive element. In the applicant's exhibit AL2 at page 28 reference is made to spectacle frames made of an alloy of titanium and nickel. At page 31 of the same publication spectacles bearing the trade mark Air Titanium are shown. Titanium is used in the manufacture of strong light weight alloys. I consider that in relation to spectacle frames and spectacles that the TITANIUM element of the application in suit is likely to be seen as a descriptor of the metal in the goods. The dominant and distinctive element in the application in suit is, therefore the word ICE. In comparing the two trade marks I need to take into consideration normal and fair use of the signs. Titanium being potentially a descriptor of the goods of the earlier registration I can readily envisage the opponent's trade mark being used in a context such as ICEBERG titanium frames. In such potential usage the comparison of the respective trade marks would come down essentially to a comparison of ICEBERG and ICE.

15. ICEBERG consists of two syllables. The second of which has a very strong and harsh sound. The application in suit consists of one soft sibilant syllable. Consequently I consider that the respective trade marks are not phonetically similar.

16. Mr Hitchcock submitted that the ideas conveyed by the respective trade marks are essentially the same. ICE and ICEBERG are both common English words. It is true that ICEBERG contains ICE both physically and semantically. However, ICE is a word for frozen water whilst ICEBERG is a word that has clear connotations of large blocks of ICE moving in the sea which are a danger to shipping. I believe that the average consumer will readily discriminate between the respective meanings and each word will have very different conceptual associations. I, therefore, find that conceptually the respective trade marks are not similar.

17. Visually the earlier registration includes the alien element BERG, an element that is larger than the ICE element. In making a visual comparison I consider that the conceptual element of the respective trade marks must be taken into account. The impression on the eye and the recognition and recall of the signs will be conditioned by the associations of the respective trade marks. Taking all these elements into account I do not consider that the respective signs are visually similar.

**17. I, therefore, find that the respective trade marks are not similar.**

18. If weight was to be given to the TITANIUM element of the application in suit clearly there would be an even greater distance between the respective trade marks.

## **Conclusion**

19. The European Court of Justice in *Sabel* held:

“In that connection, it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, 'there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.'”

It is an essential prerequisite of finding that there is a likelihood of confusion that the respective signs are similar. ICEBERG is not allusive to the relevant goods. It is, therefore, a trade mark that is inherently distinctive. It is also the case that identical goods are involved. However, these matters cannot affect the outcome of my decision as I have decided that the respective signs are not similar.

**20. Consequently I find that there is no likelihood of confusion.**

**21. The applicant is entitled to a contribution towards his costs and I therefore order the opponent to pay him the sum of £635. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 17 day of October 2001**

**D.W.Landau  
For the Registrar  
the Comptroller-General**