

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2132590  
BY PETER MILLICAN ASSOCIATES LIMITED  
TO REGISTER A TRADE MARK IN CLASS 9

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 50509  
BY DREPANDEOS CONSULTADORIA E MARKETING LDA

## BACKGROUND

1) On 13 May 1997, Peter Millican Associates Ltd of 24 Northumberland Road, Newcastle upon Tyne, NE1 8JF applied under the Trade Marks Act 1994 for registration of the following trade mark:



Honest concurrent use with registration No 2126247 (6270,3160)

2) The applicant subsequently changed its name to Eye Clinic Limited.

3) Registration is sought for the following goods:

In Class 9: "Spectacle frames manufactured from plastic, metal, shell or composite carbon fibre materials for prescription, leisure and recreational purposes, all supplied with prescription or non-prescription lenses according to purpose, including lenses made of glass or plastic, comprising superthin lightweight lenses, tinted, UV/light filtering systems and scratch resistant coatings, prescription and non-prescription night driving glasses and sports/recreational sun glasses, spectacle/glasses cases and spectacle/glasses chains; all included in Class 9."

4) On the 14 December 1999 Drepandeos Consultadoria E Marketing LDA of Rua Dos Murcas 68-3, 9000 Finchal, Madeira, Portugal filed notice of opposition to the application. The grounds of opposition were subsequently amended. The amended grounds are in summary:

a) The opponent is the beneficial owner of UK Trade Mark number 1532861 GIAN MARCO VENTURI.

b) The mark applied for is confusingly similar to the opponent's marks and is for identical or similar goods. It is therefore contrary to Section 5(2) of the Trade Marks Act 1994.

5) The applicant subsequently filed a counterstatement denying the opponent's claims.

6) Only the applicant filed evidence in these proceedings. Both sides ask for an award of costs. Neither party wished to be heard in this matter. However, both filed written submissions. My decision will therefore be based on the pleadings, the evidence filed and the written submissions.

#### APPLICANT'S EVIDENCE

6) The applicant filed two declarations. The first, dated 11 September 2001, is by Keith Little the Commercial Director of Eye Clinic Limited. He states that his company has been using the mark in suit since 1994 on various forms of eyeglasses in Class nine. He claims sales of approximately £270,000 per annum under the mark for each of the last six years. The product is sold in the applicant's retail outlets throughout the UK.

7) The second declaration, dated 19 September 2001, is by Alan Michael Fiddes the applicant's Trade Mark Attorney. Mr Fiddes acknowledges that the specifications of the two parties marks are identical or similar. However, he points out that the opponent's mark is subject to a disclaimer of any rights to the exclusive use of the word "Venturi".

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

#### DECISION

9) I do not propose to summarise the written submissions of the two parties but will refer to them as required in the course of my decision.

10) The only ground of opposition is under Section 5(2)(b) of the Act which states:-

*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 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) An earlier right is defined in Section 6, the relevant parts of which state

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

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

*(b)...*

*(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark."*

12) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik 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 Schfabrik 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-Meyer 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-Meyer Inc.* page 9, paragraph 29.

13) The applicant has accepted that the specifications of the two partes are identical and/or similar. The opponent's mark is registered for the following: "Sunglasses, eyeglasses, sport glasses, glasses cases, glasses frames, pince-nez, glasses lenses, glasses chains: all included in Class 9." In my opinion the applicant's specification encompasses the whole of the opponent's specification and the goods must therefore be regarded as identical for the purposes of the global assessment.

14) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the distinctive/dominant components of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

15) For ease of reference the two parties marks are reproduced below:

Applicant's mark	Opponent's mark
	 <p data-bbox="810 840 1364 896">Registration of this mark shall give no right to the exclusive use of the word "Venturi".</p>

16) Visually the marks are similar in that they are both Italian names. The surname is identical and both have forenames that begin with the letters "GI". The opponent's mark consists of three words with the initial letter of each being considerably larger than the other letters. This would make these initials easier to read from a distance and provides a "secondary" mark of GMV. The applicant's mark also has a large letter "V" at the start of the surname, but the rest of the name is in smaller letters. The thick band under the applicant's mark would not be seen as significant by most consumers and would for the most part be ignored. Overall the marks are of similar length.

17) Phonetically the marks have identical last words or surnames and hence have common endings. Both marks start with the letters GI, but the pronunciation is quite different. The opponent's mark would be pronounced "GEE - ANNE" or JI (as in Jihad) - ANN" whereas the applicant's initial word would be recognised as the Italian version of "George" and pronounced "Georg - io". The opponent's mark also has the two syllable word "Mar - co".

18) Eyeglasses, even sunglasses are a form of fashion item, chosen by name, style, appearance etc and, I would suggest, are chosen with some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even so allowance must be made for the notion of imperfect recollection.

19) Ordinarily I would also consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, no evidence has been filed. In such circumstances the opponent's marks cannot be regarded as enjoying an above average reputation at the relevant date, but it clearly is a name and therefore inherently a strong mark.

20) I must also take into account the disclaimer attached to the opponent's mark. The word "Venturi" has been disclaimed. In PACO RABANNE (2000 RPC 451) the Hearing Officer stated:

“It therefore appears to me that entry of a disclaimer should be regarded as an admission that the disclaimed matter is not in itself distinctive of the trade origin of the proprietor’s goods or services. In those circumstances use of the disclaimed matter by another party, as a trade mark, cannot, without other similarities, be sufficient to give rise to a likelihood of confusion with the registered trade mark.”

21). The only points of similarity between the earlier mark and the later trade mark are the surname, which is the subject of a disclaimer, and the initial letters “Gi”. Even allowing for the notion of imperfect recollection, and the fact that these are foreign names, the marks are not likely to be confused.

22) . With all of this in mind I come to the conclusion that while there are similarities between the mark, they are more than counterbalanced by the differences, and when all factors are considered in the global assessment, that there was no likelihood of confusion at 13 May 1997. Consequently, the opposition under Section 5(2)(b) fails.

23) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £335. 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 14<sup>TH</sup> day of March 2002

George W Salthouse  
For the Registrar  
The Comptroller General