

O-446-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2634960  
BY FARTHER AND SUN LIMITED TO REGISTER THE TRADE MARK:**



**IN CLASSES 9 & 35**

**AND:**

**OPPOSITION THERETO UNDER NO. 104386  
BY BREITFELD & SCHLIEKERT GMBH**

## BACKGROUND

1. On 16 September 2012, Farther & Sun Limited (“the applicant”) applied to register the mark shown on the cover page of this decision. The application was accepted and published for opposition purposes on 26 October 2012 for the following goods and services:

**Class 9** - Spectacles, sunglasses, cases and frames for spectacles and sunglasses; parts and fittings for the aforesaid goods.

**Class 35** – Advertising; presentation of goods on communication media for retail purposes; retail services, mail order retail services and electronic shopping retail services connected with the sale of eyewear.

2. Breitfeld & Schliekert GmbH (“the opponent”), filed a notice of opposition directed against all of the goods and services in the application. The opposition is based upon a single ground under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Although registered in a number of classes, the opponent only relies upon the goods and services shown below in:

**CTM no. 5704655** for the mark:

The logo consists of the letters 'B' and 'S' in a bold, sans-serif font, with an ampersand (&) between them. The letters are black and have a slightly stylized, blocky appearance.

applied for on 21 February 2007 and which completed its registration procedure on 24 January 2008.

**Class 9** – Optical...apparatus and instruments; spectacles, sunglasses, goggles, swimming goggles, diving masks; spectacle frames and parts therefor, namely sides, side ends, hinges, closing blocks, screws, rivets, olives, nuts, discs, spectacle fittings, bridges, bridge supports; optical glasses, sunglasses; spectacle cases.

**Class 41** - Providing of training, education, instruction, in particular tuition with regard to possible applications for optical products; organization and execution of seminars and exhibitions for cultural and teaching purposes.

3. The applicant filed a counterstatement in which the ground of opposition is denied. In its counterstatement, the applicant stated:

“In this case both marks are short marks with clear differences between them visually.

The first letter of each mark is entirely different, in this instance an “f” for the applicant’s mark and a “B” for the opponent’s mark.

If we look at the emphasis of the letters of each mark there is a clear contrast. The applicant’s mark places a big emphasis on the ampersand with variable font sizes for the “f” and “s”. The opponent’s font is printed in the same font size throughout, there is no emphasis on individual letters.

There are also clear conceptual differences. The applicant’s mark is stylised with a particularly flowing and swirly font. The opponent’s mark is clear and without particular stylisation.

There are clear differences phonetically – “Bee and SSS” is significantly different to “Eff and SSS.”

The applicant does not comment on the similarity or otherwise in the competing goods and services.

4. Whilst neither party filed evidence or asked to be heard, the opponent filed written submissions both during the evidence rounds and in lieu of attendance at a hearing; I will bear these submissions in mind when reaching a conclusion and refer to them as necessary below.

## **DECISION**

5. Section 5(2)(b) of the Act reads as follows:

“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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

6. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

7. In these proceedings the opponent is relying upon the trade mark shown in paragraph 2 above, which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which the application was published (i.e. 26 October 2012) and the date on which the earlier trade mark completed its registration procedure (i.e. 24 January 2008), the earlier trade mark is not subject to proof of use, as per section 6A of the Act.

### **Section 5(2)(b) – case law**

8. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* -BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the Court of Justice of the European Union (CJEU) cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

## The principles

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 causes the public to 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 process**

9. 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 and then to determine the manner in which these goods and services will be selected by the average consumer in the course of trade.

10. The average consumer of the goods in class 9 and “retail services, mail order retail services and electronic shopping retail services connected with the sale of eyewear” in the application in class 35 is a member of the general public. As the goods in class 9 are, in my experience, most likely to be the subject of self selection from traditional retail outlets on the high street, catalogues and websites, visual considerations are likely to dominate the selection process, but not to the extent that aural considerations can be ignored. Visual considerations will also, I think, dominate the selection of the associated retail services in class 35. Whilst my own experience tells me that the cost of, for example, spectacles and sunglasses can vary widely, the need for the average consumer to ensure they choose the correct size, material, shape and colour of even relatively inexpensive spectacles or sunglasses, will, I think, result in at least an average level of attention being paid to their selection; a similar level of attention will, I think, also be paid to the selection of a retailer specialising in such goods.

11. In relation to “Advertising; presentation of goods on communication media for retail purposes” in the application in class 35, the average consumer is, in my view, more likely to be a business user wishing, for example, enhance its sales by improving the manner in which it communicates with its customers and potential customers. As to the opponent’s services in class 41, the average consumer may be either a member of the public wishing to enhance their own personal skills or a business user wishing to improve the skills of his staff. As to how the remaining services will be selected, once again visual considerations, having inspected websites, catalogues and prospectuses, are likely to dominate the selection process. The obvious importance to a business of selecting the most appropriate advertising agency, or to a member of the public or a business of selecting the most suitable training provider, suggests an above average level of attention will be paid to the selection of the remaining services.

### **Comparison of goods and services**

12. The goods and services to be compared are as follows:

<b>The opponent’s goods and services</b>	<b>The applicant’s goods and services</b>
<b>Class 9:</b> Optical...apparatus and instruments; spectacles, sunglasses, goggles, swimming goggles, diving masks;	<b>Class 9:</b> - Spectacles, sunglasses, cases and frames for spectacles and sunglasses; parts and fittings for the aforesaid goods.

<p>spectacle frames and parts therefor, namely sides, side ends, hinges, closing blocks, screws, rivets, olives, nuts, discs, spectacle fittings, bridges, bridge supports; optical glasses, sunglasses; spectacle cases.</p> <p><b>Class 41:</b> Providing of training, education, instruction, in particular tuition with regard to possible applications for optical products; organization and execution of seminars and exhibitions for cultural and teaching purposes.</p>	<p><b>Class 35:</b> Advertising; presentation of goods on communication media for retail purposes; retail services, mail order retail services and electronic shopping retail services connected with the sale of eyewear.</p>
--	--

13. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) 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;
- (f) 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.

14. In reaching a conclusion, I will keep in mind the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedral v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

15. In relation to complementary goods and services, the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 are relevant:

“82 It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

In reaching a conclusion, I will also bear in mind the recent guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test when considering complementarity.

## **Class 9**

16. As the terms “spectacles”, “sunglasses”, “cases for spectacles” and “frames for spectacles” appears in both parties’ specifications in class 9, the goods are identical. As “frames for sunglasses” in the application would be encompassed by “sunglasses” in the earlier mark, the goods are identical on the principle outlined in *Meric*. In addition, if not identical, which in my view, they are, “frames for sunglasses” are also highly similar to “spectacle frames” in the earlier mark. “Cases for sunglasses” in the application are, identical or if not identical highly similar to “spectacle cases” in the earlier mark. As the parts for spectacles frames included in class 9 of the earlier mark would be encompassed by the “parts and fittings for the aforesaid goods” in the application, these goods are also identical on the principle outlined in *Meric*.

## **Class 35**

17. Insofar as “retail services, mail order retail services and electronic shopping retail services connected with the sale of eyewear” in the application in class 35 are concerned, I note the comments of the Court of First Instance (now the General Court) in *Oakley, Inc v Office for Harmonisation in the Internal Market (Trade Marks and*



*Designs*) (OHIM), Case T-116/06. In that case the conflict was between an earlier mark which was registered for goods in classes 18 and 25 and a later mark which had been registered for “Retail and wholesale services, including on-line retail store services; retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks and wallets”. The GC upheld OHIM’s decision that the goods in classes 18 and 25 were similar to “retail and wholesale of eyewear, sunglasses, optical goods and accessories, clothing, headwear, footwear, watches, timepieces, jewellery, decals, posters, athletic bags, backpacks and knapsacks, and wallets” as there was a complementary relationship between the retail of the goods and the goods themselves. The Court said:



“54 Clearly, in the present case, the relationship between the retail services and the goods covered by the earlier trade mark is close in the sense that the goods are indispensable to or at the very least, important for the provision of those services, which are specifically provided when those goods are sold. As the Court held in paragraph 34 of *Praktiker Bau-und Heimwerkermärkte*, paragraph 17 above, the objective of retail trade is the sale of goods to consumers, the Court having also pointed out that that trade includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction. Such services, which are provided with the aim of selling certain specific goods, would make no sense without the goods.”

18. Applying the principles outlined above, I find there is a complementary relationship between (at least) “spectacles”, “sunglasses”, “spectacle frames and parts therefor...” and “spectacle cases” in class 9 of the opponent’s mark and the applicant’s retailing of eyewear in class 35; the goods and services are, therefore, similar.

19. That leaves “advertising; presentation of goods on communication media for retail purposes” to consider; both terms are unlimited. Although the applicant has not denied that the competing goods and services are identical or similar, having applied the guidance in the case law mentioned above together with the comments of Jacob J in *Avnet Incorporated v Isoact Limited* [1998] FSR 16 (in terms of how specifications for services should be approached i.e. narrowly), I can detect little if any meaningful similarity between these remaining services and the goods and services upon which the opponent relies. However, even if I am wrong in that regard and the degree of similarity between the competing goods and services is deemed to be high, it does not, for reasons which will become apparent, have any impact on my overall conclusion.

## Comparison of marks

20. The competing marks are as follows:

The opponent's mark	The applicant's mark
	

21. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be the distinctive and dominant elements of the respective marks.

22. In its submissions filed in lieu of attendance at a hearing, the opponent states:

“6...Both marks are dominated by the letters included within them but it is still a whole mark comparison that must be made. Both marks comprise two letters separated by an ampersand. Whilst the first letter of each mark is different both marks share the same second letter. Notwithstanding the different first letter we contend that there is a high degree of visual similarity due to the common element “&S”. The stylisation between the two marks is not so significant as to reduce the degree of visual similarity.

7. From an aural perspective the opponent's mark will be pronounced with reference to the two letters in the mark separated by “&” i.e. as “B and S” and likewise the applicant's mark as “F and S”. On account of the common element “and S” we submit that there is a reasonable degree of aural similarity.

8. In terms of conceptual similarity, neither mark will be conceptualised beyond the letters of which each consists. Nevertheless, there is an overlap in the letters which is likely to mean that the way in which they will be remembered has a degree of commonality. Further, the marks are conceptually similar in the sense that they will be both perceived by the relevant public as letter marks in which the two letters are separated by the ampersand symbol.”

23. The opponent's mark consists of the letters "B" and "S" presented in upper case in a slightly stylised font, separated by an incomplete ampersand device which is partially formed from the extended tail of the letter "S". All three elements are of the same size and are conjoined. In my view, the opponent's mark has no dominant elements, its distinctiveness lies in its totality.

24. The applicant's mark consists of a slightly stylised lower case letter "f" conjoined to a stylised ampersand of approximately the same size which in turn is conjoined to an upper case letter "S" which is approximately half the size of the other elements in the mark. Although the size and presentation of the device of an ampersand and the varying size of the letters is somewhat unusual, once again there are, in my view, no dominant elements, the distinctiveness of the mark lying in its totality.

25. Both marks contain an element which will be understood by the average consumer as "&S". However, the length of each mark coupled with the differing first letter and the significantly different manner in which the marks are presented, results, in my view, in only a relatively low degree of visual similarity between them. When considered from an aural perspective, the parties agree, as do I, that the competing marks will be referred to as "B and S" and "f and S". Notwithstanding the differing first letters, I agree with the opponent that the marks are aurally similar to a reasonable degree. Whilst I have considered the parties' submissions regarding the conceptual position, beyond the fact that both parties' marks consist of two letters separated by an ampersand, neither mark will, in my view, create any conceptual image in the average consumer's mind. As a consequence, the conceptual position is neutral.

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

26. I must now assess the distinctive character of the earlier mark. The distinctive character of a mark can be appraised only, first, by reference to the goods and services for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the mark to identify the goods and services for which it has been registered as coming from a particular undertaking and thus to distinguish those goods and services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

27. As no evidence has been filed by the opponent in these proceedings, I have only the inherent characteristics of its mark to consider. I have no doubt that the opponent's mark is capable of performing a trade mark function (section 1 of the Act recognises as much). However, given the propensity of those in all areas of trade to adopt letters as indicators of origin (the opponent's mark stemming, I presume, from its name i.e. **B**reitfeld & **S**chliekert GmbH), means that absent use, such marks are possessed with at best an average degree of inherent distinctive character.

## **Likelihood of confusion**

28. 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 factor in the distinctive character of the earlier 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 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.

29. Despite my earlier conclusions, I shall approach the likelihood of confusion on the basis that all of the goods and services at issue are identical or similar (the majority are) and that the average consumer is a member of the general public who will select the goods and services by predominately visual means and who will pay a lower than normal level of attention when doing so (thus making them more susceptible to the effects of imperfect recollection).

30. Earlier in this decision I concluded that there is a reasonable degree of aural similarity in the marks at issue, the conceptual position is neutral, there is a relatively low degree of visual similarity and that the earlier mark possesses at best an average degree of inherent distinctive character. It is, of course, well established that a difference of one letter in relatively short marks can have a significant impact. In addition, in my experience the average consumer is well used to seeing marks of the type at issue in these proceedings (i.e. two letters separated by an ampersand) and distinguishing between them. In those circumstances, the degree of aural similarity which results from the shared use of the symbol and letter “&S” is insufficient, in my view, given the significant visual differences between the competing marks even when a lower degree of attention on the average consumer and imperfect recollection is factored in, to result in either direct confusion (i.e. where one mark is mistaken for the other) or indirect confusion (i.e. where the average consumer assumes the undertakings are economically linked).

## **Conclusion**

**31. The opposition based upon section 5(2)(b) of the Act fails.**

## **Costs**

32. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using the TPN mentioned as a guide, but bearing in mind the applicant is unrepresented, I award costs to the applicant on the following basis:

Preparing a statement and considering  
the opponent's statement: £100

Considering the opponent's submissions: £100

**Total: £200**

33. I order Breitfeld & Schliekert GmbH to pay Farther & Sun Limited the sum of **£200**. 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 7th day of November 2013**

**C J BOWEN**  
**For the Registrar**  
**The Comptroller-General**