

O-502-13

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2570486
BY BOI TRADING COMPANY LIMITED
TO REGISTER THE TRADE MARK SMITH & JONES
IN CLASS 9**

AND

**OPPOSITION THERETO UNDER NO 102096
BY SMITH SPORTS OPTICS INC**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2570486
by Boi Trading Company Limited
to register the Trade Mark Smith & Jones
In Class 9**

AND

**Opposition thereto under No 102096
by Smith Sports Optics Inc**

BACKGROUND

1. On 27 January 2011, Boi Trading Company Limited applied to register the trade mark SMITH & JONES in Class 9 for the following goods:

Optical apparatus and instruments; spectacles, sunglasses, spectacle glasses, contact lenses, spectacle cases; spectacle frames; parts and fittings for the aforesaid goods not included in other classes.

2. The application was published in the Trade Marks Journal on 25 March 2011. On 28 June 2011 Smith Sports Optics Inc filed an opposition which proceeded for the following ground:

Section 5(2)(b) because the opposed mark is similar to the earlier marks CTM 4611042, UK2495583 and CTM5189006 owned by the opponents, and is sought to be registered in respect of goods that are similar, such that there is a likelihood of confusion.

3. Details of the earlier marks relied upon by the opponents are as follows:

Number	Mark	Goods/Services
CTM 4611042	SMITH	Class 9 Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; automatic vending machines and mechanisms for coin-operated apparatus;

cash registers, calculating machines, data processing equipment and computers; fire-extinguishing apparatus; spectacles, eyeglasses, eyeglass frames, anti-glare glasses and sunglasses and replacement lenses therefor; sports goggles and sports glasses for use in skiing, snowboarding, bicycling, motorcycling, fishing, fly fishing, surfing, boating, kayaking, water skiing, rafting and other active outdoor sports and replacement lenses and straps therefor; cases, chains, cords and frames for eyeglasses and sunglasses; safety goggles; face protection masks and face protection shields; motorcycling goggles and replacement lenses; goggle film advancement systems comprising clear plastic film for use with goggles to provide clear vision; apparatus for advancing said film and film replacement rolls.

Class 28

Games and playthings; gymnastic and sporting articles not included in other classes; sports articles; face masks; face masks for motorcycling; sports grips, straps and bags adapted for skis (for snow and water skiing), fishing rods, fly fishing rods and surf boards.

UK2495583 SMITH

Class 25

Clothing, footwear, headgear; T-shirts, long sleeved T-shirts, sweatshirts, jackets, caps, hats, headbands.

CTM5189006 SMITH

Class 9

Helmets for use in active outdoor sports, namely, skiing and snowboarding.

Class 28

Sporting articles and apparatus.

4. The applicants filed a Counterstatement in which they deny the ground on which the opposition is made. They further deny the opponent's claim that its mark is a mark with a reputation and put the opponent to strict proof.

5. Neither party filed evidence or requested to be heard, although the applicants provided written submissions in support of their case in lieu of attending a hearing. After a careful study of the papers and submissions I now go on to give my decision.

DECISION

6. The opposition is founded under Section 5(2)(b) of the Act, which read as follows:

5. - (1) ...

(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.

(3)...

(4)...

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.

(5)...

7. Section 6 sets out what the term “earlier trade mark” means, the relevant parts reading as follows:

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

(a) a registered trade mark, international trade mark (UK), 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,

(b) a Community trade mark or international trade mark (EC) which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), (ba) a registered trade mark or international trade mark (UK) which-

(i) has been converted from a Community trade mark or international trade mark (EC) which itself had a valid claim to seniority within paragraph (b) from an earlier trade mark, and

(ii) accordingly has the same claim to seniority, or

(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 or the WTO agreement as a well known trade mark.

(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.

8. For the record the earlier trade marks are not subject to proof of use as per The Trade Marks (Proof of Use, etc) Regulations 2004 as they had not been registered for five years at the time of the publication of Boi's trade mark application.

1. The opponent's have relied upon three earlier rights, all for the trade mark SMITH in plain block capitals. One, CTM No 4611042 includes the same class as that of the application and, within this, goods that I will show to be identical. I therefore propose to base my decision on this earlier mark as if the opponents do not succeed with this they will be in no better position with regard to the others.

Section 5(2)(b) – case law

9. In my decision, I will have particular regard to the following 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.”

10. For the record, I have no evidence that the opponents have made any use of their earlier marks, let alone that they have done so to the extent that I should take the existence of a reputation into account when assessing their distinctive character as part of the global consideration of the likelihood of confusion.

Comparison of trade marks

11. In making a comparison between the marks, I must consider their visual, aural and conceptual similarities with reference to the overall impression that they create. The opponent's earlier marks consist of the single word SMITH presented in plain block capitals. The mark applied for consists of the words SMITH & JONES also in plain block type. Self-evidently the opponent's mark is identical to the first element of the mark applied for so there must be visual and aural similarity. The average consumer will be well aware that SMITH and JONES are both surnames and, to this extent, there is some conceptual similarity. That said, that there are similarities does not necessarily make the respective marks similar.

12. Whilst there cannot be any artificial dissection of the trade marks, it is necessary to take account of any distinctive and dominant components. The opponent's mark consists of the word SMITH which being the only element must self-evidently be the dominant element. The applicant's mark consists of the words "SMITH" and "JONES". It is a rule of thumb that the beginnings of word trade marks are usually more important or dominant than the ends but the part played by the intervening ampersand cannot be overlooked. This symbol will have a significant perceptual effect in highlighting that the mark SMITH & JONES is composed of two linked elements. So notwithstanding that the beginnings of marks are generally considered to be of most significance, the applicants mark connects together and has no significantly dominant element.

13. Connected to their "dominance" argument the opponents say that many consumers and traders familiar with their mark in relation to the goods covered by the application will assume that SMITH & JONES is a variant of their mark; the full name as opposed to the shortened name SMITH. By way of support they refer to brands that appear in two related but different forms in respect of goods sold within the same fashion sector to which the applicant's goods belong. These examples include "DKNY - DONNA KARAN", "ARMANI – EMPORIO ARMANI", "CALVIN KLEIN – CK", "CHANEL – CC" and LOUIS VUITTON - LV". Apart from the fact that none are combinations of surnames, only the ARMANI example shows a shortening by use of one element and in that case the second one. This does not support the contention that SMITH & JONES will be perceived as SMITH in its full form. Nor does it support the contention that imperfect recollection will play a part with consumers recognising the name SMITH but not able to recall whether it is alternatively used with a second element JONES. There is no evidence that the opponents have ever used their mark with any other matter so as to create the potential for such a scenario.

14. In terms of distinctiveness, the opponent's mark SMITH does not readily allow itself to be divided into separate components; any distinctiveness must be within its entirety. In respect of the applicant's mark the opponents say that JONES is a very common name; the second most common in English speaking countries, and hence is an element of very low distinctiveness. Although making no specific comment in respect of SMITH, when analysing the applicants mark they say that both SMITH and JONES are common surnames. Extrapolating the opponent's arguments, it would be reasonable to infer that if JONES has low distinctiveness because it is a common surname, the same must be true for SMITH. It is generally accepted that the lower the distinctiveness, the closer the marks need to be for there to be a finding of similarity.

15. The fact that they mark may be made up of common surnames does not, in itself, impact on their individual or collective distinctive character. In its judgment in *Case C-404/02, Nichols plc v Registrar of Trade Marks, the ECJ* (as it then was) confirmed that the assessment of the distinctive character of a surname must be carried out according to the specific circumstances of the case, and that as is the case with all other types of marks, the distinctive character depends upon the perception of relevant consumers, having regard to the essential function of a trade mark. Whilst not elaborating on what it meant by "specific circumstances", the Court did exclude an assessment of distinctiveness on the basis of a threshold above which that name may be regarded as devoid of distinctive character, the number of undertakings providing products or services, or the prevalence or otherwise of the use of surnames in the relevant trade.

It further said that registration of a surname cannot be refused for the purpose of ensuring that no advantage is given to the first to file.

16. Generally, a sign will be considered to have a distinctive character where it is able to

“...guarantee the identity of the origin of the marked product to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin, and for the trade mark to be able to fulfil its essential role in the system of undistorted competition which the Treaty seeks to establish, it must offer a guarantee that all the goods or services bearing it have originated under the control of a single undertaking which is responsible for their quality....” Philips v Remington judgment, C-299/99, paragraph 30.”

17. Setting aside the question of Section 1(1) which is not at issue here, for a trade mark to lack distinctive character it would have to consist exclusively of a sign or indications that which may serve in trade to designate a characteristic of the goods, such as by denoting the kind, quality, quantity, intended purpose, value, geographical origin, time of production or of rendering of services. This will also include any that have become customary in the current language or in the bona fide and established practices of the trade. Unless it has some secondary meaning, such as BROWN, or has been adopted as a generic description from the name of the inventor such as in Röntgen (Röntgen ray being the alternative for X-ray), it is unlikely that a surname will lack distinctive character because it serves to designate a characteristic. Here the distinctive character must be appraised 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. There is no suggestion that “SMITH” or “JONES” have any reference to a characteristic of the respective goods.

18. The extent to which a surname is used within a specific sector of the market is likely to have an impact on the perception of the consumer. There is no evidence that there is a large number of traders using the name “SMITH” or “SMITH & JONES” in relation to the goods or services of the application or the earlier marks. I must therefore proceed on the basis that SMITH and JONES both individually, and more so collectively, have a distinctive character and are capable of to distinguishing the undertakings.

19. Taking all of the above into account I come to the view that whilst the respective marks have similarities, this is at the lower end of the scale.

Comparison of the respective goods

20. In assessing the similarity of the respective goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the goods in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the judgment:

'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 and their method of use and whether they are in competition with each other or are complementary.'

21. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.

22. Although I have cited the relevant case law, for the reason I shall give I do not see that this is a question of whether the goods are similar. Both the mark applied for and the opponent's earlier CTM No. 4611042 specifically mention the term "optical apparatus and instruments" without any further qualification so there must be identical goods.

23. There is also commonality in the use of "spectacles", "spectacle frames" and "spectacle cases", albeit the opponent's earlier mark using the alternative equivalent terms "eyeglass" or "eyeglasses" in place of "spectacle(s)". Although not mentioning "contact lenses" the opponent's specification would cover such within the scope of "optical apparatus". The earlier mark also lists "cases" which would include the "spectacle cases" mentioned in the application. Although the earlier mark does not mention "parts and fittings", there are items in its specification that fall within such a description, in particular, "replacement lenses", "straps", "chains", "cords" and "frames". As a result, there must be a finding that as they stand, all of the goods mentioned in the application are identical to the goods in Class 9 of the opponent's earlier mark No. 4611042.

The average consumer

24. In the general description "Optical apparatus and instruments" the specification applied for would cover items such as "magnifying glasses" through to precision camera lenses and microscopes. These goods have a varying degree of sophistication both in their use and the user, and also in their cost. These will be selected with varying degrees of care and attention, the more technical likely being obtained by specification rather than a visual off-the-shelf selection. Being so broad in its scope the relevant consumer will potentially be at all ends of the spectrum, from the casual high street purchaser to the specialist and technical.

25. The remaining items, namely "spectacles", "sunglasses", "spectacle glasses", "contact lenses", "spectacle cases" and "spectacle frames" are goods commonly found on any high street, primarily through specialist opticians where vision correction is important, but also in some case through general retail outlets. "Spectacles", "spectacle frames", "sunglasses", and to a lesser extent, "cases", are often looked on as a fashion accessory with aesthetic importance so visual selection will be the usual. "Contact lenses" are for vision correction and rarely (if ever) available for self-selection from a display. As with lenses they will most likely be brought to the consumer's attention by the specialist explaining about options. That said, I am aware that it is possible to purchase goods such as disposable contact

lenses through specialised retail outlets where careful visual selection will be the case.

26. The degree of care and attention will vary according to the specialism, cost and, for goods such as frames and sunglasses, by designer brand identity. Such goods will generally be goods bought by the public at large, always with a degree of care and attention, higher in the case of those for vision correction. Given that the application and the opponent's earlier mark cover identical goods, the respective consumers and trade circumstances must also be the same.

Likelihood of confusion

27. When looking at the respective goods I have found these to be identical. The specifications are quite wide ranging in their potential scope, specialism and sophistication which will influence whether they will be selected by visual or oral means, and the level of attention when doing so. Whichever is the case, that the goods are identical means that the relevant consumer and circumstances of trade are also notionally identical.

28. Earlier in this decision I concluded that whilst the respective marks have a degree of similarity, this is at the lower end. I also expressed my view that whilst SMITH must be the dominant, distinctive element of the opponent's earlier mark, in the mark applied for both SMITH and JONES are all but on par in their dominance, and their contribution to the distinctiveness of the mark.

29. When looking at the distinctiveness of the respective marks, as the opponent says, these are surnames in common usage. This being the case their individual distinctiveness must be at best "average" but I would say that a combination of two, even common surnames must have a higher degree of distinctive value.

30. The opponent invites an assessment that gives lower weight to the word JONES in the applicant's mark because it is a very common surname and notwithstanding the fact that SMITH is also a common surname. This would have the effect of disregarding the notion of the similarity of the marks when assessed as a whole in favour of one based on the unsubstantiated assertion that one element of the mark applied for has a significantly lower or negligible contribution compared to the distinctive character of the element in common. My conclusion is that whilst the common use of the word SMITH creates marks that must be somewhat similar in appearance, sound and idea, when assessed as a whole the marks are at best only moderately similar.

31. I am satisfied that at the material date in these proceedings the presence in both parties' marks of the word SMITH combined with the level of inherent distinctive character that word mark possesses, is insufficient to give rise to a likelihood of 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). Much more likely, in my view, is that the average consumer in the UK who, at the material date, would have been familiar with SMITH as a surname will simply assume that the shared use of this word is a result of unrelated undertakings using surnames of people sharing a very common surname rather than assuming the same person is involved or there is a trade connection between them.

Conclusion

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

Costs

33. The applicants having been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. With this in mind I award costs on the following basis:

34. The applicant's counterstatement is brief in its response. However, in considering the opponent's statement of case the applicants had cause to consider grounds that were subsequently not taken forward because of a failure by the opponent to file evidence or submissions. It was also necessary for the applicant to request proof of use in respect of the earlier mark 1576065 which, because of the lack of evidence, was also struck out. I therefore consider that an award of £400 in respect of the work undertaken. In addition, the applicants prepared written submissions in lieu of a hearing for which I award £200.

Total: £600

35. I order Smith Sport Optics Inc to pay Boi Trading Company Limited the sum of **£600**. 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 11th day of December 2013

**Mike Foley
For the Registrar
The Comptroller-General**