

O-317-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2270311
BY FASHION WEAR SERVICES LIMITED TO REGISTER
THE TRADE MARK FOUR EYEZ IN CLASSES 5 AND 9**

AND

**IN THE MATTER OF OPPOSITION No. 90757
BY FOR EYES OPTICAL COMPANY**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2270311
by Fashion Wear Services Limited to register
the Trade Mark FOUR EYEZ in Classes 5 and 9**

and

**IN THE MATTER OF OPPOSITION No. 90757
by For Eyes Optical Company**

Background

1. On 17 May 2001 Fashion Wear Services Limited applied to register the mark FOUR EYEZ for:

Class 05:

Ophthalmic preparations and solutions; preparations, fluids and solutions for contact lenses; preparations, fluids and solutions for storing and/or cleaning contact lenses.

Class 09:

Optical apparatus and instruments; lenses and contact lenses; coloured contact lenses; patterned contact lenses; containers for the cleaning and storage of contact lenses; parts and fittings for all the aforesaid goods.

2. The application is numbered 2270311.

3. On 26 June 2002 For Eyes Optical Company filed notice of opposition to this application. They are the proprietors of CTM No. 2182467 for the mark:



and registered in respect of:

Class 09:

Optical apparatus and instruments; spectacles; spectacle frames and lenses; sunglasses; cases, chains and cords for spectacles and sunglasses; contact lenses; parts and fittings for all the aforesaid goods.

Class 35:

Retail optical store services; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail optical store.

Class 42:

Opticians services; advisory, consultancy and information services relating to the aforesaid services.

4. The opponents raise objection under Section 5(2)(b) on the basis of the similarity of the respective marks and the identity and/or similarity of the respective goods and services.
5. The applicants filed a counterstatement denying the above ground.
6. Both sides ask for an award of costs in their favour.
7. Both sides filed evidence. Both sides elected to file written submissions in lieu of a hearing. Acting on behalf of the Registrar and with the above mentioned material in mind I give this decision.

The Law and principal authorities

8. Section 5(2) reads as follows:

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

Sub-paragraph (b) applies here.

9. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117 and *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77.

10. The opponents' CTM registration has a filing date of 18 April 2001. It is, therefore, an earlier trade mark within the meaning of the Act.

Evidence

11. The evidence in this case comes from Steven John Wake of Forrester Ketley & Co and Anton Hutter of Appleyard Lees who are respectively the opponents' and applicants' professional representatives in this matter. Much of the evidence is by way of submissions and is further supported by formal written submissions filed at the conclusion of the evidence rounds. I do not propose to summarise this material at this point, but will draw on it at appropriate points in my decision.

Similarity of goods and services

12. 'Optical apparatus and instruments', 'contact lenses' and 'parts and fittings' feature in both parties' Class 9 goods. The other items in the applied for specification are either sub-sets of the broad terms 'lenses and contact lenses' or closely associated items such as the containers for such items. Hence, the whole of the applicants' Class 9 specification contains either identical or closely similar goods.

13. The applicants' Class 5 goods are the preparations, fluids and solutions in which lenses are stored and cleaned. Given that they are likely to share common users, channels of trade and are closely complementary in nature to the contact lenses themselves these goods too must be considered similar to the opponents' Class 9 goods. It is unnecessary to make further comparison with the opponents' services in Classes 35 and 42 as it would be unlikely to put them in a stronger position.

Distinctive character of the respective marks

14. The distinctive character of the marks is a factor that must be taken into account (*Sabel v Puma*, paragraphs 23 and 24). In the absence of any evidence of use I have only the inherent characteristics of the marks to consider (examples of promotional leaflets exhibited to Mr Hutter's evidence do little to establish consumer recognition and reputation).

15. The applicants submit that FOR EYES is wholly descriptive of goods and services which are for eyes. Accordingly, they say that the distinctive character of the opponents' mark rests in a combination of features viz: the conjoining of the words; the contrasting black on white and white on black backgrounds; and the black border or surround. They refer also to state of the register evidence showing other marks which have contained the elements FOR and EYES (or similar). On the basis of the authorities referred to in the opponents' written submissions (notably *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 281 and *Torremar Trade Mark* [2003] RPC 4) I do not find this material to be of assistance. The opponents, for their part,

point to the fact that the validity of their registration has not been challenged. In their view the distinctive and dominant element of their mark is the words FOR EYES.

16. It does not require detailed analysis to demonstrate that the words FOR EYES contain a not particularly oblique reference to the nature and purpose of goods such as spectacles and contact lenses. It might be said that using the words introduces an element of tautology given that such goods can only be for eyes. But that in itself does not advance the words far up the scale of distinctiveness. If I understand the opponents' submission correctly they put their trust in the words themselves and take little credit for the other presentational aspects of the mark. That may be going a little too far. The contrasting (black on white, white on black) lettering makes a modest contribution to the overall presentation of the mark. Nevertheless, even on a generous view of the mark the totality of its features leave it with a low level of distinctive character.

17. The applied for mark, FOUR EYEZ, plays on the well known slang term for someone who wears glasses. I note that Collins English Dictionary suggests that the usage is a slightly disparaging one. It, too, is suggestive of a link with glasses, eyesight etc. though the allusion is less direct in the context of contact lenses. On the whole it has, in my view, a slightly higher claim to distinctive character than the opponents' mark and is aided slightly in that respect by the unusual use of a Z for an S at the end of the second word.

Similarity of marks

18. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks (*Sabel v Puma*, paragraph 23).

19. The opponents submit that, visually, the marks differ only in relation to the black/white background, the inclusion of the U in the word FOUR and the substitution of the Z for an S in EYEZ; that phonetically they are identical; and that conceptually they both allude to glasses, spectacles etc. The applicants' position is that their mark does not share the features of stylisation present in the opponents' mark (see paragraph 15 above); that FOUR is recognisably a number; that there is a misspelling of EYEZ; and that the whole of their mark is a humorous play on words and hence conceptually different.

20. I take as my starting point that the average consumer for the goods/services at issue is likely to be the public at large. The market for optical apparatus and instruments is also likely to extend to companies and trade customers. Such goods are chosen with some care. Spectacles and contact lenses are both important for correcting eyesight and to an extent as fashion accessories.

21. Although the *Sabel v Puma* test necessitates consideration of visual, aural and conceptual issues, it seems to me that where dictionary words are concerned it is somewhat difficult to separate visual from conceptual considerations. The eye recognises words and understands them for what they are. FOR and FOUR are both well known dictionary words which can be easily distinguished. Although both marks also contain the word EYES/EYEZ, that word is given context by the word that precedes it. Furthermore, whilst the opponents rightly suggest that the letter S is sometimes replaced by a Z (usually in -ise/ize endings to words) I am not aware that

this is an accepted or recognised practice in plural forms of words. That is not to say that replacing the S with a Z disguises the underlying word. It clearly does not. But it does make for a somewhat unusual misspelling. The result is that I find a low degree of visual similarity between the respective marks.

22. Phonetic comparison of the marks must, I think, be the high point of the opponents' case. It is suggested that the marks are identical in speech and to the ear. I believe that is the case if the words are taken individually. I would suggest that the phrase FOUR EYEZ has the stress on the first word whereas in FOR EYES it is more likely to be on the second word. Even so that is a thin point of differentiation. The safer view is that they might prove to be almost indistinguishable in speech.

23. Conceptually, I consider that the argument swings back in favour of the applicants. The phrases each have their own obvious but different meanings. It is true that 'four eyes' is a term normally associated with wearers of glasses rather than contact lenses (the goods of interest to the applicants) but the allusion is still clear. I can find no conceptual similarity save that at a general level both have some reference to spectacles, contact lenses or the wearers thereof.

Likelihood of confusion

24. This is to be appreciated globally taking all relevant factors into account (*Sabel v Puma*, paragraph 22). The nature of the trade in the goods concerned is one such consideration. There is no evidence from the opponents as to how they conduct, or anticipate conducting, their business. The applicants claim to have used their mark prior to the application date but have not quantified that claim. They have, on the other hand, introduced a selection of promotional leaflets and flyers which confirm my own impression that the trade in contact lenses will almost always be conducted on the basis of visual contact with, and appreciation of, the marks and goods. Prescription and selection of glasses and contact lenses must, I think, normally involve a visit to an optician where goods are on display and specific requirements can be discussed. In these circumstances the visual impression created by the marks is likely to be paramount. Oral reference (by way of reordering for instance) and recommendations cannot be ruled out, but there is no suggestion that these considerations should weigh heavily. The position can be contrasted, for instance, with *David West and Fuller Smith & Turner Plc*, O/136/00, where the Hearing Officer's view was influenced by the relative importance of oral/aural considerations given that the trade in beers through public houses etc. still relies heavily on word of mouth orders.

25. According to *Canon v MGM* a lesser degree of similarity between marks may be offset by a greater degree of similarity between the goods and vice versa. *Canon*, therefore, acknowledges the principle of interdependency. In the opponents' favour is the identity/close similarity between the goods and very close phonetic similarity between the marks. In the applicants' favour is the low level of distinctive character attaching to the opponents' mark, the visual and conceptual difference between the marks and the fact that, absent evidence to the contrary, I take the view that visual considerations are likely to be the overriding ones in relation to the goods at issue. Weighing these factors in the balance I am not persuaded that it can be said there is a likelihood of confusion or that consumers would make any relevant association between the

marks within the meaning of *Canon v MGM* (paragraph 29). Nor is this a case where allowance for imperfect recollection might produce a different result. The marks are made up of common dictionary words which each have their own distinct meanings in relation to the goods. Imperfect recollection is unlikely to blur or offset that distinction. The opposition fails on the only ground on which it was brought.

Costs

26. The applicants are entitled to an award of costs. I order the opponents to pay them the sum of £1200. 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 21st day of October 2003

**M REYNOLDS
For the Registrar
the Comptroller-General**