

**O-035-18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION BY  
VISION MAINTENANCE LTD  
UNDER NO. 3187557 FOR THE TRADE MARK**



**AND  
IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408243 BY  
OPTICAL EXPRESS LIMITED**

## The background and the pleadings

1) On 25 September 2016 Vision Maintenance Ltd filed application no. 3187557 to register the following trade mark (“the opposed mark”):



The application was published for opposition purposes on 14 October 2016. Registration is sought for the following goods and services:

**Class 9:** *Opticians' goods.*

**Class 44:** *Opticians' services; Optician services.*

2) The application is opposed by Optical Express Limited (“the Opponent”) under sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), for the purposes of which it relies on trade mark registration no. 2236070 for the following series of marks:



The Opponent claims the colours green and white as an element of the first mark in the series, but since, for the purposes of this decision, nothing turns on this, for convenience I shall refer simply to “the earlier mark”. The Opponent relies on all the goods and services for which the earlier mark is registered, as shown below:

**Class 5:** *Contact lens solutions.*

**Class 9:** *Spectacles and contact lenses and parts and accessories therefor.*

**Class 44:** *Optician and ophthalmic services including sight testing and ophthalmic surgery.*

3) The earlier mark was filed on 15 June 2000 and registered on 05 January 2001. The consequences of these dates are that: i) it constitutes an earlier mark in accordance with section 6 of the Act, and ii) it is subject to the proof of use conditions laid down in section 6A of the Act, its registration process having been completed more than five years before the publication of the opposed mark.

4) The Opponent claims that because of similarity between the opposed mark and the earlier mark and identity or similarity between their respective goods and services there exists a likelihood of confusion. It further claims that use of the opposed mark would take advantage of the investment of the Opponent in the generation of goodwill associated with the earlier mark without due cause, and lessen the capacity of the earlier mark to identify and distinguish the goods and services supplied under it by the Opponent. The Applicant filed a counterstatement, denying these claims. It also put the Opponent to proof of use of the earlier mark in respect of the goods and services relied on. The period during which genuine use of the mark must be proved ("the relevant period") is 15 October 2011 to 14 October 2016. The Opponent is represented by Harper MacLeod LLP. The Applicant is not professionally represented. During the evidence rounds the Opponent filed submissions and evidence, and the Applicant filed submissions. Neither side requested a hearing. I therefore give this decision after a careful review of all the papers before me.

### **Evidence summary**

5) In a witness statement of 14 July 2017 Mr Jamie Watt states that he is a solicitor and Partner at Harper Macleod, has acted as legal advisor to the Opponent since 2007, and is aware of its business activities. He appends as **Exhibit JW1** a copy of

an advertisement placed by the Opponent in the December 2016 and January 2017 issues of the *Metro* newspaper, in relation to contact lens solutions, spectacles and contact lenses and parts and accessories therefor, and optician and ophthalmic services including sight testing and ophthalmic surgery. Appended as **Exhibit JW2** is the Audit Bureau of Circulation's most recent certificate of circulation for *Metro*, showing a circulation of over 1.4 million in the period 1-28 May 2017. Stating that he has conducted internet research and obtained the materials which are exhibited to his witness statement, he appends as **Exhibit JW3** extracts from the Opponent's website which claims that the Opponent is a global leader in refractive surgery and eyecare services, having treated over 600,000 patients for laser eye surgery in the UK alone.

**Proof of use: the law**

6) Since the registration procedure for the earlier mark was completed more than five years before publication of the opposed mark, in order to rely on the earlier mark for the purposes of its claims under section 5(2)(b) and 5(3) of the Act the Opponent needs to show genuine use of the earlier mark. The relevant provisions are as follows:

“6A. - (1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

7) In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaf” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-*

*Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the

mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

### **Proof of use: the evidence**

8) Section 100 of the Act provides that:



“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

In *Anheuser-Busch Inc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-191/07 the General Court (GC) stated:

“105 Moreover, the Court of First Instance has held that genuine use of a trade mark could not be proved by means of probabilities or suppositions, but had to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (Case T-39/01 *Kabushiki Kaisha Fernandes v OHIM – Harrison (HIWATT)* [2002] ECR II-5233, paragraph 47).”

9) The obvious and customary way of proving use is by means of a witness statement made by a person with first-hand knowledge (who would usually, therefore, be someone within the Opponent’s business) stating that the mark was used during the relevant period, and giving figures or estimates to give some idea of the amount of business done under the mark during that period; this would normally be backed with, for example, sample invoices, promotional material, etc. dating from the relevant period, and appended to the statement, showing the mark in use. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C., sitting as the Appointed Person, observed that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be

sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

10) In his witness statement Mr Watt states:

“I have acted as legal advisor to the Opponent since 2007, and am aware of their business activities. Inter alia I have acted for and advised the Opponent in connection with brand, trade mark, advertising and other matters.”

One would not necessarily expect a firm’s legal adviser (even one charged with advising it on matters relating to intellectual property) to have direct, first-hand knowledge of the firm’s use of its trade marks – and in fact, Mr Watt does not explicitly claim such first-hand knowledge of the actuality of use of the earlier mark. He does not explicitly state that the earlier mark itself was used during the relevant period and provides no specific evidence of the earlier mark’s use beyond that contained in the documentation appended to his witness statement. He explains:

“I have conducted internet research and obtained the materials which are exhibited to this witness statement.”

11) The extracts from the Opponent’s website contained in Exhibit JW3 to Mr Watt’s witness statement were printed out on 14 July 2017, but they contain much information relating to the Opponent’s activities during the relevant period. It is apparent from this material that the Opponent has been active since 1991 in fields covered by the specification of the earlier mark, and very successfully so during the relevant period. The crucial point, however, is that the material in Exhibit JW3 does not contain one single example of use of the earlier mark. With one exception (which I shall mention presently), the Opponent’s business, goods and services are referred to in this material exclusively by reference to the name “The Optical Express Group” and the sign “Optical Express” respectively. In the material in Exhibit JW3 I can find only one example of the use of a sign other than OPTICAL EXPRESS,

namely a reference to a personalised eye care report offered by the Opponent and referred to by the sign “iScan”. The earlier mark itself is conspicuous by its absence.

12) Turning to Exhibit JW1, which is reproduced in the Annex to this decision, I note in passing that the earlier mark does not play a prominent role in this advertisement; the words “Optical Express” appear more conspicuously in the centre of the bottom of the page. Though legible, a comparatively small reproduction of the earlier mark appears opposite the “small print” at the very bottom of the page. Nothing turns on this relevant lack of prominence, however. Even if the earlier mark had played a central and prominent role in this advertisement, it would not have supplied the deficiencies I have identified in the rest of the evidence, and enabled me to infer that the earlier mark had been used in the relevant period. The crucial point is that this advertisement appeared in the December 2016 and January 2017 issues of the *Metro* newspaper – in other words, several weeks after the end of the relevant period on 14 October 2016. There is nothing in Mr Watt’s witness statement or in the material contained in the other exhibits which would enable me to infer with any confidence that, for example, any use of the earlier mark similar or comparable to that in Exhibit JW1 took place during the relevant period.

13) I should make clear that there is no question of my disbelieving anything in Mr Watt’s evidence. The issue is simply that this evidence does not address the actuality of use of the earlier mark with the degree of specificity required to enable me to conclude with any confidence that the earlier mark itself has been used in the required manner during the relevant period. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be

assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

14) The correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate and reinforce each other. Stepping back and viewing the evidence as a whole, it falls a long way short of the standard of solidity and cogency necessary to meet the standard of proof required in the circumstances of the case – which include the fact that the Opponent should have been in a good position to put together evidence of genuine use to the necessary standard, if there had been any.

15) Accordingly, the earlier mark may not be relied upon to support the Opponent’s claims under either section 5(2)(b) or section 5(3) of the Act.

## **Outcome**

**The opposition fails in its entirety.**

## **Costs**

16) As the Applicant has been successful it would, in principle, be entitled to a contribution towards its costs. As it is unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate if it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs, including accurate estimates of the number of hours spent on a range of activities relating to the prosecution of the opposition. It was made clear that if the pro-forma was not completed “no costs will be awarded”. The Applicant did not respond to that invitation. Accordingly, I make no award of costs

**Dated this 17th day of January 2018**

**Martin Boyle**

**For the Registrar, The Comptroller-General**

## ANNEX



**20|20 vision or better  
or your money back\***

For your **FREE** laser eye surgery  
consultation call **0800 169 0191**  
or visit [opticalexpress.co.uk](http://opticalexpress.co.uk)

**We offer the following products and services:**

Spectacles, contact lenses and solutions, accessories, optician and  
ophthalmic services including sight testing and ophthalmic surgery

**Optical Express**  **25 YEARS OF  
ADVANCED  
EYECARE  
ESTABLISHED 1991**

\*Available only to those receiving EVO LASIK treatment for best distance vision for both eyes, confirmed by us prior to treatment as suitable candidates. As measured by us at least 10 months following initial treatment or 3 months following enhancement treatment. Causes of failure unconnected with our treatment excluded. All treatment and aftercare recommendations must be followed. Terms and conditions apply. Visit [www.opticalexpress.co.uk](http://www.opticalexpress.co.uk) for further information.



4