

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2022165  
BY DE MENEGO SRL TO REGISTER THE  
MARK AIR FORCE IN CLASS 9**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO 44961 BY FRED**

## TRADE MARKS ACT 1994

5 **IN THE MATTER OF Application No 2022165**  
**by De Menego Srl to register the**  
**mark AIR FORCE in Class 9**

**and**

10 **IN THE MATTER OF Opposition thereto**  
**under No 44961 by Fred**

15 **DECISION**

20 On 26 May 1995 De Menego Srl applied under the Trade Marks Act 1994 to register the  
mark AIR FORCE in Class 9 under No 2022165 in respect of “Spectacles; lenses, frames and  
cases, all for spectacles; parts and fittings for spectacles”. Strictly speaking the mark was  
applied for in the following form but nothing turns on the presentational aspect of the mark:

25 **AIR FORCE**

30 The application is opposed by Fred, of Paris, France on the following grounds:

- 35 - under Section 5(2)(b) by virtue of the fact that the opponents are the  
proprietors of a similar mark (see details below) registered in respect of  
identical and similar goods;
- under Section 3(3)(b) in that the mark applied for is of such a nature as to  
deceive the public
- 40 - under Section 3(4) by virtue of the opponents’ reputation in a mark which is  
similar to the mark applied for
- under Section 5(3) in that the mark applied for will take unfair advantage of, or  
be detrimental to the distinctive character and repute of the opponents’ mark

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- under Section 5(4)(a) in that the mark applied for is liable to be prevented by virtue of a rule of law protecting an unregistered mark including an action for passing off.

5 It is also said that registration and use of the trade mark applied for under application No 2022165 would prejudice the lawful conduct of the opponents' business under the name FORCE 10 and ought to be refused in the exercise of the Registrar's discretion. I add here that as these proceedings are under the provisions of the Trade Marks Act 1994 the Registrar has no such discretion to exercise.

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The opponents also ask for their costs.

Details of their registration under No 1356284 are as follows:

15	MARK	NUMBER	CLASS	JOURNAL/ REF	SPECIFICATION OF GOODS
20	FORCE 10	1356284	9	5808/526	Optical apparatus and instruments; optical glasses; spectacles, sunglasses and frames for the aforesaid goods; spectacle cases; electrically operated lighters (non-pyrophoric) for smokers; and parts and fittings for all the aforesaid goods; all included in Class 9.
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30 The applicants did not file a counterstatement nor did they file any evidence in the proceedings. The opponents filed evidence in support of their opposition and at the hearing on 5 March they were represented by Mr Steven Waine of Castles, their trade mark agents. The applicants were not represented.

#### Opponents' evidence

35 The opponents' evidence consists of a Statutory Declaration Mr Philippe Clin who is their President, a position he has held since April 1996. Mr Clin says he is fully conversant with the English language and that the declaration is made from his own knowledge and from his company's records. I should say at this point that Mr Clin's evidence (including the Exhibits) is notarised but not dated. I drew this to Mr Waine's attention at the hearing. In the event  
40 that there is an appeal against my decision I consider that the opponents should regularise the position by having the evidence properly dated or filing a supplementary declaration confirming the date on which notarisation took place.

45 Mr Clin says that his company commenced to use its trade mark FORCE 10 in the United Kingdom in 1994 in relation to spectacles and that annual turnover since that date has

been of the order of £157,000. I add here that the applicants' application was filed on 26 May, 1995.

5 Goods bearing the opponents' mark have been promoted through advertisements placed in such magazines as HARPERS. Samples are filed under Exhibit PC1 and show that the goods are available from Harrods. However, the examples supplied are dated 1996 which is after the relevant date.

10 The goods are also featured in such specialist magazines as the OPTICIAN. Again the example provided at PC2 is dated late 1996. Promotional literature (undated) is exhibited under PC3.

15 It is said that 7% of turnover is spent on promoting the opponents' range of spectacles. There is no information about where such expenditure is incurred.

Under PC4 Mr Clin provides a list of distributors in the United Kingdom who carry his company's products. Specific reference is made to HARRODS, SPECTACLE EXPRESS, SAFARIAN & SIMON, E.B. MEYROWITZ and L.K. LEON OPTICIANS.

20 Sample invoices are provided under Exhibit PC5. Mr Clin says the invoices are in the name of LOGO PRESTIGE DE PARIS a licensee of the opponents and bear reference to the different models of the FORCE 10 range of spectacles.

25 Mr Clin says that the mark FORCE 10 and AIR FORCE are in his view both visually and conceptually confusingly similar. The mark FORCE 10 and the "get-up" of the products are used by the opponents to conjure up a naval/sea-going image and Mr Clin believes that the mark AIR FORCE will be seen as an extension of this imagery by giving an impression of aviation which would be seen as a continuation of his company's range. If the price of AIR FORCE products were to be lower than the price of his company's products sold under the FORCE 10 mark, Mr Clin believes that the availability of such products under a similar mark would damage his company's business.

35 At the start of the hearing Mr Waine indicated that he would not be pursuing the grounds based on Section 3(3)(b) and Section 5(3). Accordingly I need say no more about them. Mr Waine also made the general point that the applicants had filed no counterstatement or evidence. It seems from the Registry's file that the applicants did in fact try to file a counterstatement but it arrived after the period prescribed by the Trade Marks Rules 1994 and could not be taken into account. Mr Waine is correct in saying that the applicants did not subsequently file any evidence.

40 I will deal firstly with the objection under Section 5(2)(b). This section reads as follows:

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

45 (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,

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

The term “earlier trade mark” is itself defined as follows in Section 6(1) of the Act:

- 10 6.- (1) In this Act an “earlier trade mark” means -
- 15 (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,
  - 20 (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
  - 25 (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.

The opponents claim an earlier trade mark in the form of their registration No 1356284. There can be no dispute that identical and similar goods are involved. The matter, therefore, resolves itself into a comparison of the respective marks, that is to say the mark applied for, AIR FORCE and the registered mark FORCE 10. For the purposes of this comparison I use the established guidance propounded by Parker J in Pianotist Co’s application (1906) 23 RPC 774 at page 777 line 26 et seq:

35 “You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all  
40 those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case.”

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At the hearing Mr Waine said that the opponents had a monopoly of “FORCE” marks in relation to goods of the kind at issue. He also developed the case put forward by Mr Clin that the opponents’ mark and the get-up of their products conjures up a naval/sea going image. He further extended the argument to embrace the proposition that both marks have military associations and, by implication, a shared theme. I also bear in mind his view that the applicants’ mark would cause members of the public to assume a connection with the opponents. In support of the latter point he referred me to *United Biscuits (UK) Ltd v Asda Stores Ltd*, 1997 RPC 513.

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It is undeniably the case that the word FORCE features in both marks. Equally it is well established that marks must be considered as wholes and not dissected into component parts for the purposes of comparison (see *ERECTIKO* case 1952 RPC 136). I have no evidence before me as to the state of the register. Certainly the opponents have not pointed to other such marks in their ownership. Asserting a monopoly of FORCE marks seems to me to be a hollow claim unless it could be demonstrated that the opponents had more than a single registration. Moreover it says nothing about whether other traders have or have not sought to apply for such marks in relation to this particular category of goods. Reference was made to the fact that another party has agreed to delete spectacles from their specification at the request of the opponents in this case (I assume that the mark consisted of or contained the word FORCE but no details were given). However, in my view, this may simply indicate that spectacles and the like goods were not of primary interest to the applicants concerned. In itself it does nothing to sustain the opponents’ case.

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In terms of the PIANOTIST test the marks are quite different in look and sound. I cannot see that there is even a remote danger of confusion arising on either of these accounts. If the opponents are to stand any chance of success it must rest on establishing a conceptual link between the marks. I do not accept Mr Waine’s submissions that such a link exists. It seems to me that each of the marks has its own, very distinct, meaning. AIR FORCE has unmistakably military connotations but FORCE 10 has in my view a wholly different association with wind speed (and in particular signifies a gale on the Beaufort scale). This is entirely consistent with the naval/sea going imagery that is said to characterise the opponents’ goods (see my comments below in relation to Section 5(4)(a)). Any attempt, therefore, to attribute a common military theme to the respective marks is, in my view, bound to fail. I do not forget the other aspects of the PIANOTIST test but I cannot see any surrounding circumstance that would lead me to a different view. Mr Waine made a particular point of emphasising the importance the opponents attach to the high quality and reputation of their goods but spectacles and frames are unlikely to be purchased without reasonable care. I do not think that actual or potential customers are likely to be confused by these marks. The opposition, therefore, fails under Section 5(2)(b).

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Finally I turn to the grounds under Sections 3(4) and 5(4)(a). At the hearing Mr Waine sought to deal with both grounds at the same time in his submissions. However, Section 3 of the Act is concerned with absolute grounds for refusal of registration. Subsection (4) appears to be based on Article 3(2)(a) of the Directive (89/104/EEC) which provides that trade marks should not be registered to the extent that their use may be prohibited pursuant to provisions of law *other than trade mark law* (my emphasis). Although the italicised words have not

been carried into Section 3(4) of the Act it is, I think, clear that the section is concerned with some inherent 'feature' of a mark which may be contrary to law rather than conflict between competing marks. The latter is provided for in Section 5. I do not think the opponents have made out any case under Section 3(4) and must accordingly fail under that head. I, therefore, go on to consider the matter under Section 5(4)(a). I note that the opponents in their statement of grounds refer to "... any rule of law protecting an unregistered trade mark including an action for passing off..." (my emphasis). As no other rule of law has been mentioned I intend to consider the matter from the point of view of whether registration of the mark at issue would be liable to be prevented by the law of passing off.

The characteristics of a valid cause of action in passing off were set out in *Erven Warnink BV and another v J Townsend & Sons (Hull) Ltd* 1980 RPC 31 as follows

(A) *per Lord Diplock* (page 93)

*(1) a misrepresentation (2) made by a trader in the course of his trade (3) to prospective customers of his or ultimate consumers of goods or services supplied by him (4) which is calculated to injure the business or goodwill of another trader (in the sense that it is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a quia timet action) will probably do so.*

(B) *per Lord Fraser of Tullybelton* (page 105)

*that a plaintiff must show (1) that his business consists of, or includes, selling in England a class of goods to which the particular trade name applies; (2) that the class of goods is clearly defined, and that in the mind of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods; (3) that because of the reputation of the goods, there is goodwill attached to the name; (4) that he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value; (5) that he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill by reason of the defendant selling goods which are falsely described by the trade name to which the goodwill is attached.*

Although the principal elements of reputation, misrepresentation and damage have generally to be considered separately they are, for practical purposes, interrelated. Thus, if identical marks and identical goods are involved, misrepresentation and damage are likely to be direct consequences if a plaintiff (opponent) can establish a reputation. Where on the other hand marks and/or the goods are not the same there must be a correspondingly greater burden on the party claiming relief to establish that his reputation extends beyond the immediate scope of his mark or goods if he is to make good his claim that there is or will be misrepresentation and damage.

In this particular case I have already found that, for the purposes of Section 5(2)(b), the goods at issue are the same and/or similar but that the marks are not similar. It does not, of course,

follow that the opponents must necessarily fail under Section 5(4)(a) but it does in my view mean that they must demonstrate that their mark FORCE 10 enjoys a broader reputation such that they are entitled to prevent use of a different mark (albeit one that incorporates an element of their own).

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The opponents' mark is said to have been first used in this country in 1994 in relation to spectacles. The earliest actual date I can find is an invoice dated 22 July 1994 which is less than a year before the filing date of the application in suit. Most of the exhibits are either undated or bear dates which are after the material date in these proceedings (26 May 1995).

10 To that extent they are of little assistance to the opponents.

It appears from the evidence and was confirmed at the hearing that the opponents' goods carry or are associated with a number of trade marks. The word FRED appears to be in the nature of a house mark (this being the first name of the business's founder). FORCE 10 itself is a mark used to designate the eyewear range. In addition a number of third tier marks are used to identify individual models within the eyewear range. In use, therefore, the opponents nearly always associate the FORCE 10 mark with other distinguishing matter. I must also return at this point to the nautical imagery which is said to be a theme in the promotion of the goods. This manifests itself in a number of ways. There is, for instances, the rope/cabbling effect employed in the promotional literature and picked up in the actual construction of the frames of the spectacles themselves. Furthermore, many individual models in the range carry nautical references such as America Cup, Cap Horn, Ocean, Corvette etc. Taken as a whole it seems to me that the mark FORCE 10 is either used in association with the house mark FRED or to reinforce the nautical/sailing theme. In my view these factors are likely to circumscribe rather than extend any reputation associated with the mark. It seems to me that the opponents in any case face a problem in establishing their reputation given the limited period and scale of use at the material date. In short I am not persuaded that use of the mark at issue would be liable to be prevented by the law of passing off. The opposition thus fails under this head.

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As the applicants have been successful in these proceedings they are entitled to a contribution towards their costs. I, therefore, order the opponents to pay the applicants the sum of £200.

Dated this 23rd day of March 1998

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M REYNOLDS  
For the Registrar  
the Comptroller General