

O/1036/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3624959

BY

BANTON FRAMEWORKS LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 9

**Farh**

AND OPPOSITION THERETO UNDER NUMBER 427978

BY

PERRY ELLIS INTERNATIONAL EUROPE LIMITED

## Background and Pleadings

1. On 12 April 2021, Banton Frameworks Ltd (“the Applicant”) applied to register the trade mark numbered 3624959 (“the contested mark”), as set out on the front cover page, in the UK for goods in class 9 as set out below. The trade mark was accepted and published in the Trade Marks Journal on 6 August 2021.

Class 9: Eyewear; Eyewear cases; Corrective eyewear; Prescription eyewear; Sports eyewear; Protective eyewear; Spectacles; Polarizing spectacles; Spectacles [optics]; Spectacles [glasses]; Protective spectacles; Frames for spectacles; Chains for spectacles; Lenses for spectacles; Anti-glare spectacles; Frames for spectacles and sunglasses; Eyeglasses; Frames for eyeglasses; Chains for eyeglasses; Safety spectacles; Cords for spectacles; Retainers for spectacles; Bars for spectacles; Anti-dazzle spectacles; 3D spectacles; Optical glasses; Eye glasses; Reading glasses; Glasses cases; Sports glasses; Corrective glasses; Spectacle glasses; Glasses frames; Protective glasses; Sight glasses [optical]; Magnifying glasses [optics]; Glasses for sports; Frames for glasses; Lenses for glasses; Anti-glare glasses; Children's eye glasses; Cases adapted for glasses; Safety glasses for protecting the eyes; Sunglasses frames; Sunglasses; Clip-on sunglasses; Lenses for sunglasses; Frames for sunglasses; Cases for sunglasses; Chains for sunglasses; Straps for sunglasses; Optical lenses for use with sunglasses; Optical glasses; Optical lenses; Lenses (Optical -); Optical goods; Opticians' goods; Frames for spectacles and sunglasses; parts and fittings for all of the aforesaid; Spectacles; Spectacles [glasses]; Spectacles [optics]; Spectacles for sports; 3D spectacles; 3D spectacles for television receivers; Anti-dazzle spectacles; Anti-glare spectacles; Bars for spectacles; Cases for spectacles; Cases for spectacles and sunglasses; Chains for spectacles; Chains for spectacles and for sunglasses; Chains for spectacles and sunglasses; Cords for spectacles; Fashion spectacles; Frames for spectacles; Frames for spectacles and

sunglasses; Lenses for spectacles; Optical lenses for spectacles; Parts for spectacles; Polarizing spectacles; Prescription spectacles; Protective spectacles; Retainers for spectacles; Safety spectacles; Sunglasses frames; Boxes [cases] for sunglasses; Cases for eyeglasses and sunglasses; Cases for spectacles and sunglasses; Cases for sunglasses; Chains for spectacles and for sunglasses; Chains for spectacles and sunglasses; Chains for sunglasses; Clip-on sunglasses; Cords for sunglasses; Covers for sunglasses; Fashion sunglasses; Frames for spectacles and sunglasses; Frames for sunglasses; Glasses, sunglasses and contact lenses; Lenses for sunglasses; Optical lenses for sunglasses; Optical lenses for use with sunglasses; Prescription sunglasses; Straps for sunglasses.

2. On 5 November 2021, Perry Ellis International Europe Limited (“the Opponent”) opposed the application based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on the following trade mark:

UKTM no 3161682 (“the earlier mark”)

FARAH

Filed: 27 April 2016

Registered: 5 August 2016

Class 9: Optical products and electronic accessories, namely, cases specially adapted for electronic equipment, namely, mobile phones, smart phones, handheld mobile digital electronic devices and tablet computers, headphones, earbud headphones, computer styluses, CD cases, parts and fittings for cell phone holders, namely, clips, holders, stands and mounts for cell phones, small electronic devices, namely, MP3 players and blank USB flash drives.<sup>1</sup>

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<sup>1</sup> Whilst it stands registered in other classes, for the purposes of this opposition it relies only on those goods as outlined in class 9.

3. The Opponent claims that the respective marks are highly similar and that the goods are either identical or similar leading to a likelihood of confusion on the part of the relevant public.

4. The Applicant filed a defence and counterstatement denying the claims, particularly arguing that the Applicant's goods are primarily frames for spectacles and sunglasses or goods that are related to these terms. It is claimed that as a result of the use of the limiting term 'namely' within the Opponent's specification, this limits the Opponent's goods to cases for electronic equipment which are dissimilar. It is contended that, to the extent that there are any goods which are regarded as similar, the signs are not sufficiently close for there to be a likelihood of confusion.

5. Given its filing date, the Opponent's trade mark qualifies as an earlier mark in accordance with section 6 of the Act. Since it completed its registration process within five years of the date the application was filed, the Opponent does not need to establish proof of use of its mark pursuant to section 6A of the Act. It may therefore rely on the entirety of the goods of its registration, without needing to demonstrate what use it has made of them on the market.

6. In these proceedings, the Opponent is professionally represented by Baker & McKenzie LLP, whereas the Applicant is represented by Filemot Technology Law Ltd. Neither party filed evidence or submissions during the evidence rounds. The Applicant requested to be heard on the matter, that hearing took place before me on 19 October 2022, via video conference. Ms Frédérique Bodson of Baker & McKenzie LLP appeared on behalf of the Opponent, and Ms Barbara Cookson of Filemot Technology Law Ltd attended on behalf of the Applicant. Both parties filed skeleton arguments prior to the hearing and the Opponent filed a number of authorities which I have considered in my deliberations.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

## Decision

### Section 5(2)(b)

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

“5(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.”

9. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 be dominated by one or more of its components;

(f) however, it is also 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 greater 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 to mind the earlier mark, 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of the goods**

10. The goods comparison shall be undertaken in relation to those goods as set out in paragraphs 1 and 2 of my decision. The issue between the parties relates to the wording of the Opponent's specification and specifically the use of the word 'namely' after its terms "*optical products and electronic accessories, ...*" and whether this term acts as a limitation to the whole of the Opponent's goods such that in effect its protection only extends to "*..cases specially adapted for electronic equipment, namely, mobile phones, smart phones, handheld mobile digital electronic devices and tablet*

*computers, headphones, earbud headphones, computer styluses, CD cases, parts and fittings for cell phone holders, namely, clips, holders, stands and mounts for cell phones, small electronic devices, namely, MP3 players and blank USB flash drives.”*

If this interpretation is correct, then the Applicant argues that the goods are dissimilar. The Opponent argues that this strict interpretation cannot be correct and that the goods are either identical or similar.

11. At the hearing both parties' representatives expanded on these arguments. Ms Bodson, submitted that the optical products are not limited to the remaining list of goods that follow the word 'namely', as those terms "specifically and quite obviously refer to 'electronic accessories' only". She submitted that given that there is a comma after the term electronic accessories and not a semicolon, the limiting word 'namely' only applies to that last term. Furthermore, she submitted that "the goods "namely cases specially adapted for electronic equipment" are clearly not referring to optical products, as an optical product is not a case specially adapted for electronic equipment, but directly refer to electronic accessories."

12. Ms Cookson referred me to the UKIPO's classification guide relating to the construction of the term 'namely' in the Manual of Trade Mark Practice, which states:

"...specifications including 'namely' should be interpreted as only covering the named Goods, that is, the specification is limited to those goods. Thus, in the above 'dairy products namely cheese and butter' would only be interpreted as meaning 'cheese and butter' and not 'dairy products' at large. This is consistent with the definitions provided in Collins English Dictionary which states 'namely' to mean 'that is to say' and the Cambridge International Dictionary of English which states 'which is or are'.

13. And furthermore to Rule 8(2)(b)<sup>2</sup> which states:

"8. [..]

(2) Every application shall specify-

(a) the class in the Nice Classification to which it relates; and

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<sup>2</sup> Trade Mark Rules 2008

(b) the goods or services which are appropriate to the class and they shall be described with sufficient clarity and precision to enable the registrar and other competent authorities and economic operators, on that sole basis, to determine the extent of the protection sought and to allow them to be classified in the classes in the Nice Classification.”

14. Ms Cookson argued that the wording of the specification should be unambiguous and not open to interpretation and shall be described with sufficient clarity and precision to enable the Registrar and other operators to determine the extent of the protection sought. Ms Cookson submitted that as a matter of grammar and construction the wording should not be interpreted widely giving the Opponent a wider scope of protection than that applied for. Optical products should, therefore, be read by reference to the limitation in so far as its scope of protection is limited to the narrow term of goods referred to following the word ‘namely’.

15. Neither party referred me to any caselaw regarding how I should interpret the comma, the word ‘namely’ and to what the list of goods which follow this word refer. In assessing and interpreting the term and the construction of the specification, I note that the manual is a general policy and practice guidance document, and that the section relating to limitations is not borne from caselaw but rather based on the dictionary definition of the meaning of the word “namely”. I also take note that the examination practice and manual is for guidance only and therefore it cannot possess the same weight as a legal precedent developed and rooted from statute or caselaw.

16. I take the view that if I were to restrict the Opponent’s specification only to those goods that followed the term ‘namely’ then in effect, I would be confining the Opponent’s specification so as not to include protection for optical products at all. It is important that in determining this issue I should not act in a manner that is inconsistent or injudicious creating a precedent that does not exist or beyond the express provisions conferring jurisdiction upon the Registrar.<sup>3</sup> However, balancing the arguments put forward by both parties, to follow the approach as suggested by Ms Cookson, this in my view would result in an absurdity or a perverse result. Therefore, I consider that I should adopt a common sense approach and interpret the specification, being mindful of the intended purpose and meaning of the words and the

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<sup>3</sup> *Pharmedica GmbH’s International Trade Mark Application* [2000] RPC 536 at [541].



scope of the limitation, when read as a whole at the a time ensuring that I should not interpret the specification too liberally as to provide a wider scope of protection than that applied for or to result in terms that are less precise or clear. I take particular note that during the examination stage, the examiner wrote to the Opponent raising an objection to the broad term 'electronic accessories' only, requesting that it provide a clear and precise description of this term and for the exact goods of interest to be defined.<sup>4</sup> Whilst the Rules provides the Registry with the mechanisms and procedures to regulate its procedures, the guidance in the manual has no statutory basis in this instance, and its parameters are not binding on me in the same way. It is with this backdrop that I take the view that the obvious and intended meaning of the word 'namely' followed by a list of terms should only apply to 'electronic accessories' and not 'optical products', as to do otherwise would strain the language and impose an overly restrictive specification on the Opponent.

17. Having come to this conclusion, I shall now proceed with the comparison of the respective goods on the basis that the term "optical products" is not subject to the limitation and is so restricted.

18. Ms Bodson submitted that the Opponent's "optical products" will cover all the various eyewear, spectacles, glasses, sunglasses and optical lenses that are covered in the Applicant's sign and thus should be found to be identical. Whereas, Ms Cookson argued that the Applicant's goods were broadly speaking frames, the goods made from those frames, i.e. the eyewear and then the cases and chains etc. categorised as accessories and should be differentiated from the Opponent's goods given that the frames should be regarded separately from the eyewear. In my view, and I consider the view taken by the average consumer, an optical product would be regarded as a term which covers eyewear, spectacles and glasses and includes the frames, the lenses (prescription/tinted or otherwise) as well the finished product. On this basis the Opponent's broad term optical products would encompass the Applicant's terms, as set out below, and thus are identical in accordance with the principles in *Meric*<sup>5</sup>:

Eyewear; Corrective eyewear; Prescription eyewear; Sports eyewear;  
Protective eyewear; Spectacles; Polarizing spectacles; Spectacles [optics];

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<sup>4</sup> Examiner's letter dated 12 May 2016

<sup>5</sup> *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05

Spectacles [glasses]; Protective spectacles; Frames for spectacles; Lenses for spectacles; Anti-glare spectacles; Frames for spectacles and sunglasses; Eyeglasses; Frames for eyeglasses; Safety spectacles; Retainers for spectacles; Bars for spectacles; Anti-dazzle spectacles; 3D spectacles; Optical glasses; Eye glasses; Reading glasses; Sports glasses; Corrective glasses; Spectacle glasses; Glasses frames; Protective glasses; Sight glasses [optical]; Magnifying glasses [optics]; Glasses for sports; Frames for glasses; Lenses for glasses; Anti-glare glasses; Children's eye glasses; Safety glasses for protecting the eyes; Sunglasses frames; Sunglasses; Clip-on sunglasses; Lenses for sunglasses; Frames for sunglasses; Optical lenses for use with sunglasses; Optical glasses; Optical lenses; Lenses (Optical -); Optical goods; Opticians' goods; Frames for spectacles and sunglasses; parts and fittings for all of the aforesaid; Spectacles; Spectacles [glasses]; Spectacles [optics]; Spectacles for sports; 3D spectacles; 3D spectacles for television receivers; Anti-dazzle spectacles; Anti-glare spectacles; Bars for spectacles; Fashion spectacles; Frames for spectacles; Frames for spectacles and sunglasses; Lenses for spectacles; Optical lenses for spectacles; Parts for spectacles; Polarizing spectacles; Prescription spectacles; Protective spectacles; Retainers for spectacles; Safety spectacles; Sunglasses frames; Clip-on sunglasses; Fashion sunglasses; Frames for spectacles and sunglasses; Frames for sunglasses; Glasses, sunglasses and contact lenses; Lenses for sunglasses; Optical lenses for sunglasses; Optical lenses for use with sunglasses; Prescription sunglasses.

19. If, however, I am wrong in this regard and that the Applicant's frames would be categorised differently to the finished product, then I still consider that they would nevertheless be highly similar to the Opponent's optical products, sharing in purpose, nature, channels of trade, end user and being complementary.

20. In relation to the Applicant's *Chains for eyeglasses; Chains for spectacles; Cords for spectacles; Chains for sunglasses; Straps for sunglasses; Chains for spectacles; Chains for spectacles and for sunglasses; Chains for spectacles and sunglasses; Cords for spectacles; Chains for spectacles and for sunglasses; Chains for spectacles and sunglasses; Chains for sunglasses; Cords for sunglasses; Straps for sunglasses* I consider that these terms will be regarded as accessories to the Opponent's optical

products and used in conjunction with the eyewear. I consider that they target the same end user, would overlap in channels of trade, are complementary but differ in nature and purpose. On this basis I consider that these goods are similar to a medium degree to the Opponent's optical products.

21. The same reasoning would apply to the Applicant's *Eyewear cases; Glasses cases; Cases adapted for glasses; Cases for sunglasses; Cases for spectacles; Cases for spectacles and sunglasses; Boxes [cases] for sunglasses; Cases for eyeglasses and sunglasses; Cases for spectacles and sunglasses; Cases for sunglasses; Covers for sunglasses* which are closely allied to optical products in so far as they are the receptacles for carrying or transporting the eyewear in order to protect them. Ms Cookson submitted that "spectacles come with spectacle cases. They are a necessary adjunct. For high-end frames you would obviously buy them, complete with a case." I agree glasses/spectacles are often sold accompanied by a case or protective covering and therefore there is a degree of overlap with the respective parties' goods sharing in user, channels of trade, and being complementary. I consider that the Applicant's cases (as outlined) and the optical products are similar to a medium degree.

### **Average consumer and the selection process**

22. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods. I must then determine the purchasing process. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods and services in question.<sup>6</sup>

23. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch)*, Birss J (as he was then) described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively

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<sup>6</sup> *Lloyd Schuhfabrik Meyer*, case C-342/97.

by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24. Both parties agreed that the average consumer of the respective goods are members of the general public, however, both parties argued that different levels of attention would be undertaken. Ms Cookson argued that the level of attention would differ between the frames and eyewear and the accessories, submitting that to buy spectacles would entail “a significant purchasing process” and a “huge degree of attention”. On the other hand, Ms Bodson argued that “the goods would not be a daily purchase. They are not very expensive, so we do not expect the consumer to have a very high level of attention.” Whilst I accept that the purchase of eyewear, glasses and spectacles are not frequent, daily purchases, like consumables for example, neither are they particularly infrequent purchases such as houses or cars. My view is that they are somewhere in the middle, perhaps purchased annually/biannually, generally following an eye examination and usually as a result of an updated prescription. I acknowledge that some eyewear, non-prescription sunglasses, reading glasses and safety glasses for example would not need an eye examination and can be purely bought ‘off the shelf’. I consider that visual considerations would dominate the purchasing process with the goods being usually tried on before purchase and selected from a display stand at specialised stores such as opticians or general retail premises (or their online equivalents). Aural considerations cannot be discounted, however, following requests for assistance made to sales staff. Considerations such as fit, suitability, cost and aesthetic qualities will be taken into account in the purchasing process for the glasses, eyewear, spectacles to include the frames and the optical products. On this basis for these goods an above average level of attention would be undertaken in the purchasing process but not significantly so and not as high as argued by Ms Cookson. I accept that the same level of attention will not be taken with the cases and accessories, which would warrant no more than an average level of attention.

### **Comparison of the trade marks**

25. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice in the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

27. Both parties put forward lengthy submissions at the hearing regarding the similarity or otherwise of the respective marks which I have taken into account in my assessment. The respective trade marks are as follows:

Applicant’s mark	Opponent’s mark
<b>Farh</b>	FARAH

### **Overall impression**

28. Neither the stylisation, font nor casing of the contested mark detracts from the word itself and therefore I consider that the overall impression of the mark resides in the totality of the word. Similarly, the overall impression of the earlier mark is contained in the word itself, as there are no additional elements to contribute to the mark.

### **Visual Comparison**

29. Ms Cookson argues that visually the marks have a number of letters in common, but that “the average consumer doesn’t count letters when comparing signs”.

Furthermore, she states that it is unlikely that there would be any likelihood of visual confusion given that “the contested mark is stylised, with the vertical of the H counterbalancing the vertical of the F at opposite ends of the marks producing a pleasing visual balance”.

30. Ms Bodson rebuts this submission arguing that both marks share “four out of five letters; the first three appear in the same order and end in the same letter, differing only in one letter in the middle-end of the marks. The stylisation in the contested mark is minimal presented in an ordinary typeface which would lead to a high degree of visual similarity.”

31. Both marks present visually as five and four letter word marks (albeit that the contested mark is slightly stylised). Each mark includes the identical letters F-A-R-H, presented in the same order, with each mark beginning and ending with the identical letters. There is a point of visual difference arising from the additional letter A present in the earlier mark. The stylisation/font used by the Applicant is in my view insufficient to distinguish between the marks, given that a word mark can be used in any font or typeface which means the earlier mark could be used in the same typeface as the Applicant’s.<sup>7</sup> Given that as a rule of thumb beginning of marks generally have more impact than their middle components and given that both marks start and end with the same letters, I consider that the marks are visually highly similar.

### **Aural comparison**

32. Ms Cookson submits that the Applicant’s mark is a single syllable, likely pronounced as FAR whereas the Opponent’s is two syllables long recognised as a surname, with the first [syllable] being pronounced as FA making them aurally dissimilar. Furthermore, she suggests that the H in the contested mark “is effectively silent as in the English words cough and catarrh”. Ms Bodson rebuts this and states that there is a greater degree of aural similarity between the marks, contrary to the Applicant’s submissions.

33. I agree that the letters R and H in the contested mark are unlikely to be pronounced as separate letters such that, following normal paradigms, the average consumer is likely to pronounce it as FAH. The earlier mark is likely to be pronounced as two

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<sup>7</sup> *LA Superquimica v EUIPO*, case T-24/17

syllables namely FAH-RAH. Given that the first syllable of the earlier mark and the entirety of the contested mark are aurally identical, the marks are aurally similar to a medium degree.

### **Conceptual comparison**

34. The Applicant submitted that the earlier mark is “both a given name and surname which is now fairly common in the United Kingdom though mainly associated with individuals of Arabic ethnic origin. A famous example is Mo Farah. As a given name it is usually associated with women.” It was argued that it is a “sufficiently common name for the average consumer in the UK to regard this as its primary conceptual significance.” Therefore, Ms Cookson argued, the marks were conceptually dissimilar. Ms Bodson submits that neither mark conveys a clear and semantic content, albeit she argues that the earlier mark will be seen as a female name and the contested mark as having no apparent meaning. In her view a conceptual comparison between the two marks is therefore not possible.<sup>8</sup>

35. No evidence was filed as to the commonality of the name FARAH in the UK, or how widespread the use of the name has become as a name usually associated with women. Notwithstanding, this however I consider that the average consumer will perceive both marks as names, but neither would be common or well-known names in the UK. It may be that each will be seen as a misspelling of the other’s name making conceptual similarity closer, however, I do not consider that this is likely.

36. I consider that both will be regarded as different names and thus no conceptual comparison is possible, rendering them conceptually neutral. Even if I were to accept that the contested mark would be seen as an invented word with no meaning, this would not assist the Applicant and I agree with Ms Bodson given that names are devoid of semantic content the marks would still be rendered conceptually neutral, as opposed to dissimilar.

### **Distinctive character**

37. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

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<sup>8</sup> *Luciano Sandrone v EUIPO* T -268/18.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

38. Registered trade marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer, others being highly inherently distinctive, such as invented words. The Opponent has not filed any evidence and therefore, I am only able to consider the position based on inherent characteristics.

39. The Opponent argues that its mark is highly inherently distinctive in the UK. I disagree. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered and the CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely



to have an effect on that distinctive character.”

40. The earlier mark consists of the word FARAH which I consider will be seen as a name, either a forename or a surname. Names are commonly used as trade marks and are therefore not considered as particularly distinctive. The more common the name/surname, the less distinctive the character of the mark. Despite both parties accepting that the mark FARAH is the surname of the athlete and multi Olympic medal winner Mo Farah, without evidence, I do not consider that it is a particularly common name in the UK. Equally I do not consider that it is particularly unusual such that its level of inherent distinctive character is elevated to a high degree, as argued by Ms Bodson. In my view I consider that the earlier mark possesses a medium degree of inherent distinctive character.

### **Likelihood of confusion**

41. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion; where the consumer recognises that the marks are not the same but, nevertheless, puts the similarities between the marks and the respective goods down to the same or related source.<sup>9</sup>

42. A number of factors must also be borne in mind when undertaking the assessment of confusion. The first is the interdependency principle where a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind a global assessment of all relevant factors when undertaking the comparison. In doing so, I must consider 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 that he has retained in his mind.

43. In making my assessment, I bear in mind the purpose of a trade mark is to distinguish the goods and services of one undertaking from another and that I must assess the matter as to how the marks are perceived on first impressions and from

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<sup>9</sup> *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

the perspective of the consumer's immediate and instinctive reaction to the marks on first encounter.<sup>10</sup>

44. I remind myself that I found the marks to be visually similar to a high degree, aurally similar to a medium degree, and conceptually the position to be neutral. For the reasons outlined I found the respective goods to be either identical or similar. It was accepted by both parties at the hearing that the average consumer for the goods in question would be the general members of the public. I found that the goods would be selected predominantly via visual means but not discounting aural considerations. I considered that an average and above average level of attention would be undertaken in the purchasing process, depending on the nature of the goods. I found the earlier mark to possess a medium level of inherent distinctive character.

45. In the decision in suit, I can see no logical step that would result in the consumer being indirectly confused between the marks and therefore the issue in this case is whether there will be direct confusion. Bearing in mind the principle of imperfect recollection and that consumers do not make side by side comparisons, I note that there is only a single letter difference between the marks and it is contained in the middle of the respective words. Consequently, this single letter difference could be easily overlooked and lead to one mark being mistaken for the other. This is particularly so given that both marks coincide in the same sequence and letter pattern beginning with the identical three letters and ending with the same letter and that greater visual and aural emphasis is generally placed on the beginning of words. I accept that this cannot be said to apply in every case, especially for short marks, where minor differences may be more noticeable, but here the difference arising from a single letter positioned with the middle of a word is unlikely to have much impact, as it will be swallowed up by the remaining letters. I also consider that there is an even greater capacity for the marks to be imperfectly recalled or misremembered, when the marks are displayed on the spectacles, frames and glasses for example as ordinarily they will be positioned in small print on the arm of these goods and thus obscured.

46. The typeface/stylisation of the contested mark is not so remarkable that it will act as a determining factor to distinguish between the marks, especially since the

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<sup>10</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Opponent may use the same typeface when selling its goods on the market. Where visual considerations dominate, I am satisfied that the commonality of the shared structure and letter pattern underpinning the respective marks are sufficient for consumers to misremember them and mistake them one for the other. This leads me to conclude that there is a likelihood of direct confusion.

### **Outcome**

47. The opposition under section 5(2)(b) of the Act succeeds in full. Subject to any successful appeal, the application shall be refused registration.

### **Costs**

48. As the Opponent has been successful it is entitled to a contribution toward its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note (TPN) 2 of 2016. Applying the guidance in accordance with the TPN. I award costs to the Opponent on the following basis:

Preparing a notice of opposition and reviewing the counterstatement:	£300
Preparing for and attending a hearing (Hearing time 1hr 10mins):	£500
Official fee:	£100
<b>Total:</b>	<b>£900</b>

49. I order Banton Frameworks Ltd to pay Perry Ellis International Europe Limited the sum of £900 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 24<sup>th</sup> day of November 2022

Leisa Davies

For the Registrar