

O/0130/23

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO. 3618645
IN THE NAME OF M GROUP S.À.R.L. FOR THE MARK**

ECO EARTH CONSCIOUS OPTICS

IN CLASS 9

AND

**THE OPPOSITION THERETO
UNDER NO 426591 BY EYSPACE EYEWEAR LIMITED**

Background and pleadings

1. On 30 March 2021, M Group S.à.r.l. (“the applicant”) applied for the trade mark ECO EARTH CONSCIOUS OPTICS (application 3618645) for the following goods in class 9:

Spectacles; sunglasses; optical spectacles; lenses; contact lenses; frames for sunglasses and optical spectacles; sunglasses and optical spectacles cases; containers for contact lenses; sunglasses and optical spectacles accessories; spectacles chains.

2. The trade mark application was published on 4 June 2021. On 3 September 2021, Eyespace Eyewear Limited (“the opponent”) filed an application for a declaration that the registration is invalid, claiming that it offends sections 3(1)(b), (c) and (d) of the Trade Marks Act 1994 (“the Act”). The opponent claims that ECO is commonly used across all sectors to refer to products which are environmentally friendly; Earth means the planet on which we live; Conscious means something noticed or which is important; and Optics is the brand of science which is concerned with vision, sight and light. The grounds of opposition are, in summary, as follows:

- Section 3(1)(b): The mark comprises non-distinctive elements such that the relevant consumer would recognise the mark as meaning spectacles, sunglasses or lenses which are not harmful to the earth/planet/environment or which are sensitive to the needs of the earth/planet/environment. The mark is not more than the mere sum of its parts.
- Section 3(1)(c): All the elements of the mark, both individually and combined, are purely descriptive of the goods or a characteristic or quality of the goods; namely, optics which are made from materials which are environmentally friendly/earth conscious or manufactured in a way which is not harmful to the earth or the environment.
- Section 3(1)(d): The terms ECO, ECO CONSCIOUS, EARTH FRIENDLY, EARTH CONSCIOUS, CONSCIOUS and/or ECO FRIENDLY are commonly

used within many industries including the optical/optics industry to demonstrate to consumers that the products sold are environmentally friendly. The terms are used interchangeably.

3. The applicant filed a defence and counterstatement, denying that the mark offends sections 3(1)(b), (c) or (d) of the Act. Further, or in the alternative, it claims that the mark has acquired distinctive character as a result of the use made of it. In relation to the definitions of the component words of the trade mark, the applicant admits that the words, separately, can have the meanings set out by the opponent, but the applicant does not admit that these are the only meanings. It claims that ECO is a slang term which can also act as an acronym for a variety of expressions. It states:

“In this case it is used by the applicant as an acronym for ‘Earth Conscious Optics’.”

4. The applicant claims that the other words in the mark have multiple meanings; e.g. EARTH is a term commonly used in electronics, and OPTICS is also a name for an alcoholic drink dispenser.

5. The opponent has been represented throughout the proceedings by Barker Brettell LLP and the applicant by Charles Russell Speechlys LLP. Both parties filed evidence. The matter came to be heard before me on 15 December 2022, by video conference. Only the applicant took part in the hearing, represented by Ms Ashton Chantrielle, of Counsel (instructed by Barker Brettell LLP).

Evidence

6. The opponent’s evidence comes from Catherine Wiseman, its trade mark attorney.¹ The purpose of her evidence is to show that the words in the mark, and that the mark as a whole, are non-distinctive/descriptive/used in trade. The applicant’s evidence comes from Giovanni Lo Faro, the International CEO of the

¹ Witness statements and exhibits dated 18 March 2022 and 4 July 2022.

eyewear business which trades as MODO.² Mr Giovanni explains that the applicant is the holding company for the MODO business. His evidence is aimed at refuting the opponent's claims and evidence and also to show the use which has been made of the mark.

Section 3(1)(b) of the Act

7. Sections 3(1)(b), (c) and (d) state:

“3.— (1) The following shall not be registered –

(a)

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

8. The trade mark application was made pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union. This provision allows those who had pending EU Trade Marks (“EUTMs”) at the end of the

² Witness statement dated 4 July 2022 and exhibits.

transition period to file a comparable UK application and claim the filing or priority date of the earlier EUTM as the priority date for the UK application for the purpose of establishing “which rights take precedence”, in accordance with section 6(A) and paragraph 25 of Schedule 2A of the Act. The applicant had a relevant pending EUTM (EU18325900) which was filed at the European Intellectual Property Office on 23 October 2020. It filed the comparable UK trade mark application within the nine month period allowed for doing so. Unlike for relative grounds objections, in relation to which the EUTM priority date is claimed to establish which rights take precedence, the relevant date for determining whether the trade mark is subject to refusal on the absolute grounds set out in section 3 of the Act is the actual filing date of the application in the UK. Therefore, the relevant date for the purposes of this opposition is 30 March 2021 (“the relevant date”).

9. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

10. The principles to be applied under article 7(1)(b) of the Community Trade Mark Regulation, now article 7(1)(b) of the EUTM Regulation, which is identical to article 3(1)(b) of the EU Trade Marks Directive and section 3(1)(b) of the Act, were conveniently summarised by the Court of Justice of the European Union (“CJEU”) in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (Case C-265/09 P) as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67)."

11. Sections 3(1)(b), (c) and (d) serve a public interest. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] E.T.M.R. 57, Case C-363/99, the CJEU described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods." The public interest underlying section 3(1)(b) of the Act is described in *BORCO*, above: the mark "must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings". That is the essential function of a trade mark.

12. Although it is well-established in law that the absolute grounds for refusing registration must be examined separately, there is a degree of overlap between sections 3(1)(b), (c) and (d) of the Act, as explained by the CJEU in *POSTKANTOOR*. At paragraph 70 of its judgment, the CJEU stated that:

“...it is thus not open to the competent authority to conclude that a mark is not devoid of any distinctive character in relation to certain goods or services purely on the ground that it is not descriptive of them.”

13. In *Flying Scotsman*, BL O/313/11, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, observed:

“19. Since there is no obligation to rule on the possible dividing line between the concept of lack of distinctiveness and that of minimum distinctiveness when assessing the registerability of a sign under Section 3(1)(b), see Case C-104/00 P Deutsche Krankenversicherung AG v OHIM (COMPANYLINE) [2002] ECR I-7561 at paragraph [20], it is not necessary to dwell on the question of how far Section 3(1)(b) may go in preventing registration beyond the scope of Section 3(1)(c). It is sufficient to observe that a sign may be:

- (1) distinctive for the purposes of Section 3(1)(b), with the result that it cannot be regarded as descriptive for the purposes of Section 3(1)(c) and must be unobjectionable on both bases; or
- (2) neither distinctive for the purposes of Section 3(1)(b), nor descriptive for the purposes of Section 3(1)(c), with the result that it must be objectionable on the former but not the latter basis; or
- (3) descriptive for the purposes of Section 3(1)(c), with the result that it cannot be regarded as distinctive for the purposes of Section 3(1)(b) and must be objectionable on both bases.

These considerations point to the overall importance of establishing that a sign is free of objection under Section 3(1)(b).”

14. Ms Wiseman, in her evidence, states that ECO is well-known and understood to be a shortened version of ‘Ecology’. She exhibits *Collins Dictionary Online* definitions for Ecology, Earth, and Conscious to support the meanings set out in the

opponent's pleadings.³ Ms Wiseman states that it is "well-known" that the term CONSCIOUS is used in conjunction with ECO and EARTH to show that a business or person is aware of or sensitive to environmental issues. Exhibit CAW4 comprises extracts from *Merriam Webster Dictionary Online* and *Lexico Dictionary Online*. The first is an American dictionary and it refers to "eco-conscious". A further exhibit shows the results of a google search for eco-conscious, presumably after the relevant date.⁴ *Lexico Dictionary Online* is connected to the *Oxford Dictionary* and refers to 'earth-conscious' as meaning "Aware of and sensitive towards environmental issues."

15. Giovanni Lo Faro, in his evidence for the applicant, agrees with the definitions of EARTH and CONSCIOUS. He doesn't disagree with the meaning for ECO, but adds that there are many different definitions of ECO. Mr Lo Faro exhibits four dictionary extracts to prove his point. The first two (from Google and *Merriam Webster*) relate to the environment.⁵ The third exhibit, from the *Cambridge Dictionary*, says that ECO is a prefix meaning connected with the environment and that it is also an abbreviation for Economic Cooperation Organization.⁶ The fourth exhibit is an extract from the online *Free Dictionary*, which gives 71 meanings for ECO, some of which relate to the environment and others which do not, such as "Early Childhood Outcomes". I note that the URL is acronyms.thefreedictionary.com/ECO, which is only likely to reveal acronyms. The search term appears to have been "What does ECO stand for", which is not the same as asking what ECO means.

16. Ms Wiseman exhibits a definition of OPTICS from *Collins Dictionary Online*:⁷

"1. UNCOUNTABLE NOUN

Optics is the branch of science concerned with vision, sight, and light.

2. See also fibre optics

³ Exhibits CAW2 and CAW3.

⁴ Exhibit CAW6

⁵ Exhibits GLF3 and GLF4.

⁶ Exhibit GLF5.

⁷ Exhibit CAW5.

3. PLURAL NOUN

The optics of an action or event are the way it looks to people.

The optics of the situation are pretty bad."

17. Whilst Mr Lo Faro accepts this definition, he states that there are other definitions. He also states that the word OPTICS would only be descriptive if the application covered scientific services, which it does not. Exhibit GLF7 is a print of a Google image search for the word 'optics'. Mr Lo Faro notes that none of the images are of glasses, although concedes that there are references to lenses and vision.

18. Exhibit CAW6 is said to show that the terms ECO, ECO CONSCIOUS, EARTH FRIENDLY, EARTH CONSCIOUS, CONSCIOUS and/or ECO FRIENDLY are commonly used within many industries, including the optical industry, to mean that products are environmentally friendly. The exhibit comprises several pages of the results, which have not been expanded, of an undated search for "eco conscious", "earth conscious meaning" and "earth friendly". The undated results of another Google search, for "eco conscious glasses" and "earth conscious glasses" are shown in Exhibit CAW7.⁸ Many of the unexpanded "shopping" results do not refer to the glasses being eco or earth conscious. Examples of those which do are an image which says "Bird Eyewear Blackcap – Eco Friendly..." and another which says "Petrel – Wooden Eco Friendly Sunglasses...". There are more references in the general search, although none of them have been expanded. I note that some are along the lines of "Recycled eco friendly sustainable glasses frames..." and "11 Eco-Friendly Sunglasses You Can Wear This Summer...".

19. Exhibit CAW8 comprises the expanded results of a search for companies who sell the goods covered by the contested mark and who use ECO. Many of the screenshots are undated.⁹ Others are dated are from 28 June 2022 (the relevant date is 30 March 2021) and 5 November 2021 (an Instagram post). Some are poorly reproduced and I can't see what the screenshot date is. However, I note that one result, for Blue-Planet Eco-Eyewear, says "As of January 1st, 2020, we will be

⁸ The searches in CAW6 and CAW7 may have been undertaken on 31 March 2021, which is the date appearing at the bottom of the screenshots.

⁹ An updated version of the exhibit was the reason for Ms Wiseman filing her second witness statement. Dates do not appear in this version.

planting one tree for every pair of Blue Planet Eco-Eyewear Sold”. This suggests that the content dates from before 1 January 2020. I note that the date format is not that which is usually used in the UK and the domain name ends in .com, so it is not possible to say how relevant this evidence is to the perception of the average UK consumer. This is also the case for some of the other screenshots which show prices in non-UK currencies.

20. Exhibit CAW9 comprises prints of online articles which refer to what Ms Wiseman describes as ““eco-friendly” optics providers.” The prints date from the actual relevant date, 30 March 2021 and are about sunglasses. Some of the prices quoted in the first article, from sustainablejungle.com, are in US dollars and refer to US content. One part of the article, at page 78 of the exhibit, reviews a company based in Cornwall selling “eco-friendly” sunglasses, made from recycled fishing nets. It is explained that Cornwall is in the UK, suggesting that the article is from the US. The same occurs with a report on another UK company, Peep, which is an “eco friendly sunglasses brand from the UK”. Its products are made from salvaged windows, doors and thrift furniture. A second article from lazyenvironmentalist.com is dated Aug 31, 2020 and the article refers to the reviewed brands being available to buy in the US (prices are in US dollars). A third article, from thegoodtrade.com, refers to product prices in dollars. I note a review about a company “Based in Brighton, UK”, but the prices are in dollars.

21. Ms Wiseman refers to observations filed against the applicant’s equivalent EUTM application and states that the EUIPO refused the application. However, the applicant has filed a copy of the successful appeal against this refusal before the EUIPO Fourth Board of Appeal.¹⁰ I will bear this decision in mind, but I am not bound by it; nor is it persuasive.

22. In its counterstatement, the applicant states:

“In this case it is used by the applicant as an acronym for ‘Earth Conscious Optics.’”

¹⁰ European Intellectual Property Office, case number R 66/2022-4.

23. This is repeated by Mr Lo Faro in his witness statement:

“11.3 In fact, in this case, the word ECO stands for EARTH CONSCIOUS OPTICS, we use it as an acronym. It actually has a dual meaning because it conveniently is also allusive of the fact that our products are environmentally friendly.”

24. This is a potentially flawed defence to the claim that the mark is devoid of any distinctive character; at least, on a *prima facie*, inherent distinctiveness, level. This is because if I were to find that EARTH CONSCIOUS OPTICS is devoid of any distinctive character and/or descriptive, then the mark would comprise an objectionable term with a letter sequence corresponding to the first letter of each of the words, something that was considered by the CJEU in *Alfred Strigl — Deutsches Patent- und Markenamt* and *Securvita Gesellschaft zur Entwicklung alternativer Versicherungskonzepte mbH v Öko-Invest Verlagsgesellschaft mbH*:¹¹

“The answer to the questions referred is therefore that Article 3(1)(b) and (c) of the directive must be interpreted as meaning that it is applicable to a word mark which consists of the juxtaposition of a descriptive word combination and a letter sequence which is non-descriptive in itself, if the relevant public perceives that sequence as being an abbreviation of that word combination by reason of the fact that it reproduces the first letter of each word of that combination, and that the mark in question, considered as a whole, can thus be understood as a combination of descriptive indications or abbreviations which is therefore devoid of distinctive character.”

25. Whether the applicant intends ECO to be an abbreviation or acronym for the three words which follow it is irrelevant if the average consumer would not see it that way. I am doubtful that they would because ECO is so well known in its own right as a word or abbreviation with the meanings given by the opponent which are accepted

¹¹ Joined cases C-90/11 and C-91/11.

by the applicant. It is not a letter combination which is unpronounceable or unknown. In my view, the mark will be seen as a sequence of four dictionary words.

25. ECO is non-distinctive for the goods. Even without the evidence, it has clear meaning in relation to the goods of the application because they can be manufactured sustainably. ECO stands by itself and the other three words will be read through as a phrase. EARTH CONSCIOUS leaves little to the imagination, particularly as it is preceded by ECO: ECO reinforces the meaning of EARTH CONSCIOUS, and vice versa. The combination of ECO and EARTH CONSCIOUS leads to an immediate perception of goods which are sustainable. OPTICS means a branch of science connected with vision. It is not the word OPTICAL or OPTICIAN. However, when used in connection with the particular goods at issue, the perception will be that it stands as a collective noun for lenses, glasses, spectacles, sunglasses and their accessories: goods to do with improving vision. OPTICS will not be construed as a fanciful word in the context of the goods. The average consumer will not pause to consider that it isn't the word optical and work backwards to conclude that OPTICS must have trade mark significance. OPTICS will also not be seen as a device for dispensing alcohol because the mark must be seen in the context of the goods for which it has been applied. In any event, even if there are other meanings, that does not avoid an objection when one of the meanings is descriptive or non-distinctive.¹²

26. In *POSTKANTOOR*, the CJEU stated:

“98. As a general rule, a mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

¹² *OHIM v WM Wrigley Jr Co*, CJEU Case C-191/01 P and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau*, CJEU Case C-363/99.

99. However, such a combination may not be descriptive within the meaning of Article 3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition must be satisfied as regards both the aural and the visual impression produced by the mark.

100. Thus, a mark consisting of a word composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics for the purposes of Article 3(1)(c) of the Directive, unless there is a perceptible difference between the word and the mere sum of its parts: that assumes either that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts, or that the word has become part of everyday language and has acquired its own meaning, with the result that it is now independent of its components. In the second case, it is necessary to ascertain whether a word which has acquired its own meaning is not itself descriptive for the purpose of the same provision.”

27. The above concerned the conjoining of descriptive words to create a ‘neologism’, but, *a fortiori*, the CJEU’s guidance must also apply to a mark consisting of descriptive words which are not conjoined. In *Feedback Matters Trade Mark*, Ms Anna Carboni, sitting as the Appointed Person, cited the above paragraphs from *POSTKANTOOR*, confirming that the same approach is applicable to section 3(1)(b) of the Act.¹³

28. Viewed as a whole, the mark is not more than the sum of its parts. *Prima facie*, it conveys the clear and immediate descriptive message that the optical goods are

¹³ O/185/12, at [48].

environmentally sustainable. There is no trade origin message. The mark does not distinguish the goods of one undertaking from those of other undertakings because it is devoid of any distinctive character. **The section 3(1)(b) ground succeeds.**

Section 3(1)(c) of the Act

29. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40 , p. 1), see, by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation*

in the Internal Market (Trade Marks and Designs) (OHIM) (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM (C-48/09 P)* , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM (C-80/09 P)*, paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that

that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

30. For the same reasons given for refusing *prima facie* registration under section 3(1)(b) of the Act, I find that the contested mark consists exclusively of a sign which may serve in trade to designate the kind, quality and other characteristics of the goods; specifically, optical goods which are environmentally sustainable. All the words in the mark convey the immediate and clear meaning that they are optical goods which are sustainably manufactured for consumers who are conscious of eco(logical) issues affecting the Earth (our planet). I realise that there are more words in that explanation of the objection than there are in the mark. The mark is a compressed expression, in the same way that people refer to 'headache tablets'. Nobody takes a headache tablet to get a headache, but everyone understands that the term denotes 'headache relieving tablets'. In case BL O/342/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, considered an application for WE

CREATE SPACE, in relation to storage services. He upheld the Registrar's refusal of the application under section 3(1)(b) of the Act:

"I think that the wording in question would clearly be regarded as a statement about creating space for the benefit of users of the service provider's storage facilities. It is in the same idiom of expression as "We create working space"; "We create living space"; "We create sleeping space"; "We create parking space". In this case, it is referring to the activity of creating storage space. The expression does not cease to be a statement about the activities of the service provider merely because the way in which space creation occurs – that is to say, the mechanism or the methodology of it - is not thereby explained in any detail. A terse explanation is none the less an explanation. There is, in the present case, no verbal manipulation or engineering of the kind which has in other cases been recognised as sufficient to turn explanatory phraseology into a sign possessed of a distinctive character. For these reasons, I determine that the appeal should be dismissed under Section 3(1)(b)."

31. Mr Hobbs went on to find that the mark was also objectionable under section 3(1)(c) of the Act:

"... I think that the expression WE CREATE SPACE is sufficiently direct and specific to be classed as a statement about the kind of services the service provider is providing, and is therefore caught by the exclusion from registration in Section 3(1)(c)."

32. The meaning of the contested mark is clear and immediate. Average consumers will not regard the compressed nature of the mark as a reason why the mark must indicate commercial origin, as opposed to an origin-neutral description. They will see the mark as a description of the kind, qualities and characteristics of the goods, which I have described above.¹⁴ **The section 3(1)(c) ground succeeds.**

¹⁴ See also the decision of Mr Simon Thorley, QC, sitting as the Appointed Person in *WHERE ALL YOUR FAVOURITES COME TOGETHER*, BL O/573/01.

Section 3(1)(d) of the Act

33. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court (“GC”) summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act, as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established

practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

34. The enquiry is not whether the mark is descriptive of a characteristic of the services, although that could also apply to a mark which falls foul of section 3(1)(d). It is whether the mark (as opposed to the individual words) was customary in the current language of the UK or was customary in the bona fide and established practice of the trade in the UK (i.e. in the trade the subject of the opposed goods) at the date of application. Proving this requires the filing of evidence of fact supporting the claim. It cannot be proved by supposition. The opponent has not provided any evidence of the mark in use by third parties in the UK (or anywhere) prior to the relevant date. There is no basis for a finding that the mark was customary in the current language or in the bona fide and established practices of the trade to designate the goods. **The section 3(1)(d) ground fails.**

Acquired distinctiveness

35. The CJEU provided guidance in *Windsurfing Chiemsee* as to the correct approach with regard to the assessment of the acquisition of distinctive character through use.¹⁵ The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

¹⁵ Joined cases C-108 & C-109/97.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.”

36. I begin by reminding myself that the relevant date is 30 March 2021 and that the applicant must prove that the mark had acquired distinctive character prior to that date.¹⁶ Distinctive character must be acquired in the UK because it is the perception of the average consumer in the UK that matters, not how the mark is viewed elsewhere in the world. I will therefore concentrate on evidence pertaining to the UK.

37. Mr Lo Faro states that, as far as he is aware, only the applicant uses the mark ECO EARTH CONSCIOUS OPTICS. He supports his view by exhibiting the results of a search on Google for “eco earth conscious optics” and states that the first seven results are the applicant.¹⁷ Further, Mr Lo Faro states that the Google search results section called “People who ask” reveals that the answer to “Who owns Eco eyewear” was the applicant. The Google answer to the question “what are eco glasses made of” contains an extract from the applicant’s website.¹⁸

38. These searches were done after the relevant date. I am unconvinced that, even if they had been conducted prior to the relevant date, they would carry much weight. Internet searches use algorithms which become tailored to a user based on the user’s search history. Moreover, businesses can pay search engines for their details to be listed higher in search returns. Search results will vary over time and depending on who is doing the search.

¹⁶ See *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV*, CJEU, Joined cases C-217 and 218/13 and *Dualit Ltd's Trade Mark* [1999] RPC 890.

¹⁷ Exhibit GLF1.

¹⁸ Exhibit GLF2.

39. Mr Lo Faro explains that the applicant's goods are environmentally sustainable and socially responsible. For instance, some of the eyewear is biodegradable, some is made from recycled stainless steel and some from recycled ocean plastic. A tree is planted for each "ECO-branded" frame which is sold. This appears to be in Cameroon, although Mr Lo Faro states that the applicant's website modo.com refers to the scheme, as does a book produced in 2015, which Mr Lo Faro states was distributed globally, including in the UK. Extracts from the website are shown in Exhibit GLF8 and are undated. I note that the goods are branded ECO.

40. Exhibit GLF9 comprises examples of the applicant's annual brand presentations which are given to its optician customers. Mr Lo Faro states:

"22. As can be seen from page 2 of this Exhibit, the core logo for the ECO brand between 2009-2012 was ECO EARTH CONSCIOUS OPTICS. This gradually evolved towards greater use of ECO alone, once the customer had been educated that ECO meant 'earth conscious optics'.

41. Page 2 of the exhibit shows the following:

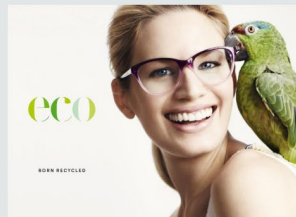


42. Page 3 shows the following:

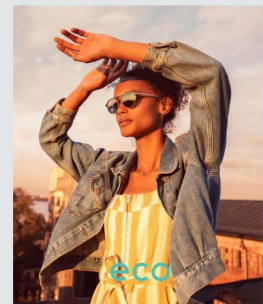
ECO: Campaign evolution



2009:
Eco Conscious Optics



2012-2018:
ECO – Look Good, Feel Good, Do Good



2019-2020
Make it last

43. This indicates that by 2012, nine years prior to the relevant date, the applicant had dropped use of the words EARTH CONSCIOUS OPTICS and was using “eco” with various straplines, such as Look Good, Feel Good, Do Good; Born Recycled and Make it last. Mr Lo Faro states that “ECO branded frames” were launched in the UK in September 2010, firstly with the optician chain Vision Express. At that time, the chain had around 350 stores in UK high streets. Mr Lo Faro states that “ECO” products were displayed in dedicated store windows. I note that a press release on opticianonline.net, dated 7 October 2010, refers to the launch of “Modo ECO (Earth-Conscious-Optics), a range of ethical eyewear sold exclusively at Vision Express”.

44. Mr Lo Faro states that ECO goods are “currently” sold in over 600 UK opticians, and these are shown in confidential exhibit GLF10. The customer list runs from 2011 to 2022. Exhibit GLF11 comprises examples of point-of-sale marketing material used between 2015 and 2020. The material all shows “eco” with or without various straplines. There are no examples of the contested mark. Exhibits GLF12 and GLF18 comprise examples of material in UK opticians in 2019 and 2020 and between 2017 and 2021, respectively:



LOOK GOOD Being environmentally friendly and looking good is the best of all worlds!
ECO is designed by the boutique eyewear firm MODDO to be on trend and easy to wear.

FEEL GOOD ECO Biobased eyewear is made from 63% plant-based materials, certified by the USDA. ECO Recycled is the only eyewear brand in the world made of 95% recycled materials. Plus, we are certified by UL Environment, so when you purchase ECO, you minimize the use of new resources.

DO GOOD ECO plants a tree for each frame you buy. We have planted one million trees in Cameroon to date!

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45. Mr Lo Faro states that each pair of glasses is branded with ECO on the internal side of an arm and the logo also appears on a lens sticker on the display frames, as above. Exhibit GLF13 comprises examples of packaging used between 2016 and 2020, such as:



46. Mr Lo Faro does not provide market share figures, but the following indication of turnover for “ECO” goods is given:¹⁹



47. It appears from this graph that there were no sales of goods bearing the mark in 2011, 2012 and 2013. 2010 was the year the range was launched in the UK and 2012 was the year in which the words EARTH CONSCIOUS OPTICS were dropped from use. This graph is corroborated by the confidential information contained in Exhibit GLF10. The figures from 2014 onwards must relate to the use of ‘eco’ alone (or with the various straplines).

48. The undated screenshots contained in Exhibit GLF20, from Facebook and Instagram, show ‘eco’. Exhibit GLF17 comprises figures for the number of visits to the ECO website (eco-eyewear.com) in 2020. There were 53,692 from the UK. A small selection of invoices to opticians located in London, the South East, the South West, Wales and the Midlands is shown in Exhibit GLF15, from 2018. ECO is listed (but not the contested mark). I note that Exhibit GLF22 contains a copy of an article on fashioninsight.co.uk, dated 24 February 2014, which refers to the UK debut at Optical Express of “Eco-friendly glasses brand Earth Conscious Optics (ECO)”. The other advertisements and articles in this exhibit all refer to ‘eco’, including an advertisement in the UK edition of *Vogue* during the last three months of 2020. The applicant won a prestigious design award in 2020 for its recycled metal frames collection, branded Eco.

¹⁹ Exhibit GLF14.

49. Mr Lo Faro considers that the evidence demonstrates that the trade and public know that ECO means EARTH CONSCIOUS OPTICS because of the length of trade.

50. The applicant has not used the contested mark since 2012. This is nine years prior to the relevant date. What sales there were prior to 2012 in the UK were not enough to have established that, by 2012, the mark would have at that point acquired distinctive character. The sales, which the graph shows as having been made only in 2010 in the UK, are certainly not at a level that would mean that any distinctive character acquired by 2012 endured to the relevant date, nine years later.

51. The applicant's evidence shows that the mark which it has used since 2012 is eco, without any of the words EARTH, CONSCIOUS or OPTICS. Ms Chantrielle submitted that if I were to find that the mark was *prima facie* objectionable (which I have found), then the applicant ought to be able to rely on its use of eco/ECO under the proviso to section 3(1) of the Act because the words EARTH CONSCIOUS OPTICS are devoid of distinctive character/descriptive and therefore their absence in use has no effect on the perception of the average consumer of ECO. My attention was drawn to the judgment of the GC in *adidas AG v EUIPO*, in particular paragraphs 50 to 63.²⁰ Ms Chantrielle gave the following summary of these paragraphs of the GC's judgment in her skeleton argument:

“29.1. The concept of ‘use’ of the mark within the meaning of Article 7(3) of Regulation No 207/2009 (which is the equivalent of the proviso under section 3(1)) must be interpreted in the same way as the concept of genuine use of a mark.

29.2. The article extends to use of the mark in the form in which it was submitted for registration and, where relevant, registered, but also to the use of the trade mark in forms which differ from that form solely by insignificant variations and that are able, therefore, to be regarded as broadly equivalent to that form.”

²⁰ Case T-307/17, [2019] E.T.M.R. 44.

52. Ms Chantrielle also relied upon paragraph 16 of a decision of Professor Phillip Johnson, sitting as the Appointed Person, in *Lactalis McLelland Limited v Arla Foods AMBA*:²¹

“Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).”

53. That case concerned whether the use of two marks, which were subject to the proof of use requirements of section 6A of the Act, constituted acceptable variant use of the marks in their registered form, under section 6A(4)(a).

54. At paragraph 17 of the decision, Professor Johnson said:

“It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

55. Although I have found that the combination of all the words in the contested mark is devoid of any distinctive character, rather than weakly distinctive, the point

²¹ BL O/265/22.

still applies. What must be considered are the relative levels of distinctiveness and descriptiveness of the elements which are omitted or absent in use and those which are used. I note the same point arose in *adidas v EUIPO*, which was a cancellation action against a registered EUTM.²² The GC agreed with the Board of Appeal that it was relevant to take into account the alterations in use compared with the form in which the mark was registered because that form was “extremely simple” (three parallel lines in a rectangular configuration). The GC stated:

“72 Secondly, contrary to what the applicant claims, it must be held that, where a trade mark is extremely simple, even minor alterations to that mark may constitute significant changes, so that the amended form may not be regarded as broadly equivalent to the mark as registered. Indeed, the simpler the mark, the less likely it is to have a distinctive character and the more likely it is for an alteration to that mark to affect one of its essential characteristics and the perception of that mark by the relevant public (see, to that effect and by analogy, judgment of 13 September 2016, *Representation of a polygon*, T-146/15, EU:T:2016:469, paragraphs 33 and 52 and the case-law cited).

73 It follows that the Board of Appeal did not err in taking into account the extremely simple character of the mark at issue.”

56. The omission in use of EARTH CONSCIOUS OPTICS means that the mark as used is not broadly equivalent to the form in which the mark has been applied for and the omission affects the perception of the mark by the average consumer. What has been used is a word which is very descriptive: ECO/eco. I note that the Intellectual Property Office’s Trade Marks Examination Manual gives the following guidance in relation to ECO:

“Environmental or ecological terms

The terms ‘ECO’ and ‘ENVIRO’ are commonly used as a combining form denoting ecology, ecological or environmental and are widely used in relation to both the environment and environmentally friendly products. Whether used

²² See also *Thomas Pink Limited v Victoria’s Secret UK Limited* [2014] EWHC 2631 (Ch).

alone or as a prefix, the words 'ECO' or 'ENVIRO' will be treated as if they were the word 'ecological' or 'environmental' and an objection under section 3(1)(b) and (c) will be raised where the totality is considered descriptive.”

57. The status of the Manual is that it is only guidance, but it confirms my own view of the descriptiveness and non-distinctiveness of ECO. It is not even close to the line for acceptability. This means that the applicant has an uphill struggle on evidence, even if its application had just been for 'eco' or ECO. In *Wirex Ltd v Cryptocarbon Global Ltd & Ors* [2021] EWHC 617 (IPEC), the judge observed that the more descriptive the mark is for the goods or services in respect of which it is used, the more use as a badge of origin will be required for it to become distinctive of a single entity's goods or services. The applicant has even more of a task where the use is not even of the applied-for mark, the omission of any of the elements of which do not satisfy the proviso for the reasons given above. In *Société des Produits Nestlé SA v Mars UK Ltd*, Case C-353/03, the issue considered by the CJEU was whether a mark applied for could acquire distinctiveness as a result of its use as part of or with another mark. This is the opposite of what the applicant claims is acceptable: here, the applicant has used only part of the mark applied for.

58. I also do not agree with the applicant that the average consumer has been educated to see eco as an acronym, especially given the gap in time between the sales in 2010 (or even 2012) and the relevant date. It is a word in its own right, which is non-distinctive and descriptive for the goods, and it would take considerably more use than that for the average consumer to be educated that it is an acronym and a trade mark.

59. For all of these reasons, I reject the applicant's case that the contested mark had acquired distinctive character through use by the relevant date.

Outcome

60. The opposition is successful under sections 3(1)(b) and (c) of the Act. The application is refused.

Costs

61. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale of costs published in Tribunal Practice Notice 2/2016. I have given only £600 in relation to evidence. I have made no award for the opponent's evidence other than for the dictionary definitions because the opponent's evidence was of no assistance. As can be seen from my analysis of it, most of it was after the relevant date or undated, or outside of the UK. The remainder of the £600 is for considering the applicant's evidence.

62. The breakdown is as follows:

| | |
|---|-------|
| Official fee for filing the opposition | £200 |
| Preparing and filing the notice of opposition and considering the counterstatement | £300 |
| Filing evidence and considering the applicant's evidence | £600 |
| Total | £1100 |

63. I order M Group S.à.r.l. to pay to Eyespace Eyewear Limited the sum of **£1100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of February 2023

Judi Pike
For the Registrar,
the Comptroller-General