

O-179-11

**TRADE MARKS ACT 1994**

**APPLICATION No. 2518904**

**BY UNIL ELECTRONICS CORP EUROPE LTD**

**TO REGISTER THE TRADE MARK 'C9'**

**IN CLASSES 3, 9, 11 & 21**

**AND OPPOSITION No. 99982**

**BY CORIOLISS LTD**

**BASED ON REGISTRATION AND USE OF THE MARK 'C2'**

## Background

1. On 17 June 2009, Unil Electronic Corp Europe Ltd applied to register the trade mark C9 for the following goods:

Class 03:

Hair preparation and styling products; shampoo, conditioner, hair treatments, styling lotions, waxes, sprays.

Class 09:

Hair irons; hair tongs; hair curlers; electric hair rollers; parts and fittings for the aforesaid goods.

Class 11:

Hairdryers.

Class 21:

Hair brushes.

2. On 8 January 2010, Corioliss Ltd filed notice of opposition. The grounds of opposition are, in summary, that the opposed mark is similar to earlier UK trade mark 2470106, which is registered in Class 9 for:

Electrical hair styling products and hair styling apparatus; hair curling apparatus and instruments; hair straightening apparatus and instruments; electrical hair straightening irons; hair tongs; hair waving apparatus; electrically heated combs, rollers, brushes and curling irons; heated roller apparatus for hair; electrically heated appliances for curling and styling hair; electric crimping irons for the hair; parts and fittings for the aforesaid goods.

3. The opponent claims that all the goods covered by the opposed mark are identical or similar to the goods for which the earlier mark is protected, and that there is a likelihood of confusion. Consequently, registration of the opposed mark would be contrary to s.5(2)(b) of the Act.

4. In this connection I note, in particular, that the opponent claims that:

- i) It has a very substantial reputation in the C2 mark, which has become synonymous with its hair straightening irons;
- ii) The nature of the hair styling industry is such that different hair styling tools and products are used with each other or in a complementary fashion - in particular, styling lotions, waxes and sprays are used as styling aids to complement the use of hair straightening irons;
- iii) It is common in the hair styling industry for suppliers of hair straightening irons to supply hair dryers, hair brushes, shampoos, conditioners, hair treatments, styling lotions, waxes and sprays and other hair preparations for use alongside hair straightening irons.

5. The opponent therefore claims that the use of a trade mark consisting of the letter C and a numeral for hairstyling tools and products will create an association with the opponent.

6. Further, the opponent claims that the opposed mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark. Consequently, registration of the opposed mark would be contrary to s.5(3) of the Act. In this connection, I note the following extract from the opponent's grounds:

*“The professional nature of the hair styling industry as well as numerous safety requirements for products means that quality and reliability are imperative and the Opponent has acquired a reputation in this regard. The industry is also particularly fashion conscious. There is therefore a desire for products to be aesthetically pleasing and of innovative design, and the Opponent has a particular reputation for supplying hair styling products with fashionable designs. The Opponent's reputation for supplying hair styling products combining quality and reliability with fashionable designs is associated with the Opponent's C2 trade mark in particular and there is a need for the Opponent to maintain this association in order to preserve the reputation it has acquired.”*

7. It is also a part of the opponent's case that, even if the use of the opposed mark does not cause any kind of confusion, *“such use [of the opposed mark] in relation to any hair styling tools and products may misrepresent compatibility with, or equivalence to, the opponent's products”*.

8. There is a further ground of opposition under s.5(4)(a) of the Act on the ground that use of the opposed mark would constitute passing off.

9. The applicant filed a counterstatement consisting of blanket denials and putting the opponent to proof of its claims.

## **The Evidence**

10. The opponent's evidence consists of two witness statements by Chris Burridge, who is a Director of the opponent company, and witness statements from Stacy Broughton and Johnny Paterson. Ms Broughton is the Creative Director of a website dedicated to hairdressing education and training. Mr Paterson has worked in hairdressing PR for around 12 years.

11. Mr Burridge has been in the hairdressing supplies and manufacture industry for over 30 years and a Director of the opponent company since 2006, which is when Mr Burridge says that the opponent started using C2 in relation to hair straighteners. The opponent sells 39k C2 straighteners per annum equating to sales of £1.86m in 2007, rising to £2.33m in 2009. Around half of these sales are in the UK. In his second witness statement dated 15 December 2010, Mr Burridge states that (in his assessment) the C2 product is the third most popular brand for hair straighteners in the UK accounting for 15-20% of the market. I assume his assessment was made as at the date of his statement. The opponent's product has been sold through

numerous wholesale outlets, including around 300 'Sally stores', which supply both hair dressing professionals and ordinary consumers. Around 60% of the opponent's C2 customers are professionals, the rest are ordinary members of the public.

12. Mr Burridge says that the opponent spends around £150k per annum promoting the C2 brand. Exhibits CB1-CB3 show that the C2 mark appeared on the packaging for the products from 2006 to date. Between 2006-2008, the mark appeared alongside the Corioliss 'house' mark, which was given at least equal prominence to C2. Between 2008-2009, two versions of the C2 mark were used on the packaging: a stylised version and another version in standard characters. The former was larger than the latter. The non-stylised version appeared alongside other word marks, such as 'Red Leopard' (the straighteners come in various finishes, one of which is a red leopard skin pattern). During this later period the word Corioliss continued to be used, but in much smaller sized letters (compared to the size of any of the other marks). The version of the packaging used from 2009 onwards featured a slightly stylised version of the C2 mark, and this was the most prominent branding on the product. Words such as 'Red Leopard' and the house mark 'Corioliss' continued to appear in supporting roles.

13. Exhibits CB5-7 provide information and examples of how and where the mark has been promoted prior to the date of the opposed application. Not surprisingly, some of the promotion was aimed at the hairdressing trade, so there are a number of examples of promotion of C2 hair straighteners in the publications Hairdressers Journal and Salon Business. Other publications, such as Black Beauty and Your Hair, are also focused on hair styling, but are aimed more at ordinary consumers. There are also some examples of promotion of C2 straighteners in more general publications, such as The Daily Mail and U Magazine.

14. In most cases the opponent's product is referred to as Corioliss C2 or similar. An advertisement in U Magazine of March 2009 referred to the product as "*C2 Red Leopard from Corioliss*". The evidence shows that the product is sold in various colours and decorative finishes, which are reflected in the name. So there is also a C2 Gold, C2 Zebra (black and white stripes), C2 Crystal and C2 Edelweiss. In fact the product is also sold with attachable 'skins' so that the user can change the exterior finish of the straighteners.

15. It is also apparent from these exhibits that the opponent markets hair dryers, for which it uses some common branding, i.e. Red Leopard, although the C2 mark itself appears to be used exclusively for hair straighteners.

16. Mr Burridge also provides the results on an informal survey conducted at Sally Salons, Wimbledon, in relation to consumer awareness of the C2 brand. Twenty five customers were asked a number of questions starting with "*Have you heard of the C2 straightening iron?*" and including "*Do you know who manufactures C2?*". Mr Burridge says that 95% of customers answered the first question positively and 80% knew that the C2 was made by Corioliss.

17. Mr Burridge does not say whether he conducted this survey himself, or say who else did. The persons questioned are not identified and no records have been provided of the respondents' actual answers. Nor is it clear where the questions

were asked and whether any C2 products were on sale and visible to the respondents at the time (particularly relevant bearing in mind Mr Burridge's evidence that C2 products are sold through Sally Salons). This evidence is plainly hearsay, and probably second hand hearsay. It is not inadmissible on that basis, but the nature of this evidence and the defects mentioned above bears on the weight that can be attached to it. In my view, the defects are so serious that no evidential weight should be given to it. I will therefore say no more about it.

18. In his witness statement dated 30 June 2010 (a year after the date of the opposed application), Mr Burridge says that the opponent also "recently began marketing hair straighteners under the C1 and C3 brands".

19. Finally, Mr Burridge says that:

*"I believe the application to register the mark C9 is an attempt to capitalise on the significant equity which Corioliss has built up in its C2 brand. I understand that C9 is an abbreviation of the Applicant's actual brand for hair straighteners, "Cloud Nine". However, "C9" conveys none of the meaning or image of the original brand, as for example a shortening to "Cloud 9" might. In 2006, Corioliss created a distinctive and unusual brand for hair straighteners with the mark C2, a style and concept of mark which had not previously been used in relation to hair straighteners. There is no reason why the Applicants would seek to register a meaningless abbreviation of their "Cloud Nine" brand which happens to be conceptually identical to an existing well-known brand, unless they were attempting to capitalise on the equity in that existing brand. In my view, this amounts to bad faith."*

20. Mr Paterson gives evidence as follows:

*"I first became aware of the C2 brand in 2006, when I was asked by Corioliss to work on promoting their new hair straightener brand.*

*The C2 brand is well-known in the hairdressing industry. Publicity has been massive since the brand was launched in 2006. Many top hairdressers recommend Corioliss' C2 hair straighteners.*

*Based on my knowledge of the C2 brand from 2006, if I saw hair straighteners bearing the mark C9, I would assume that they were made by Corioliss. In fact, I would feel misled if this was not the case.*

*Because of the nature of the hairdressing industry, where there is a strong emphasis on new trends and reputation, damage could easily be caused to Corioliss and their C2 brand through confusion brought about by the existence of a product bearing a C9 mark which is not made by Corioliss. Corioliss' reputation and that of their C2 brand would in my view suffer further if that C9 product was of inferior quality or design.*

*Hair care and hair styling products (such as shampoos, conditioners, styling preparations), electrical hair styling equipment (hair straighteners, hair curlers, hair dryers), and hair brushes are all closely related products since they are*

*all in the hairdressing sector and would be advertised, sold and used at the same time. If any of these products were sold under a C9 mark, I would expect there to be a connection with Corioliss in view of their well known C2 brand. I might think that C9 was being used by Corioliss as part of a range of "C-" marks for various hair-related products".*

21. Ms Broughton gives evidence as follows:

*"I first became aware of the C2 brand in 2008, when we began using Corioliss' products in our work for the education website.*

*The C2 brand is well-known and continues to grow. The hair straighteners sold under the C2 brand have a reputation for quality and uniqueness.*

*Based on my knowledge of the C2 brand from 2008, if I saw hair straighteners bearing the mark C9, I would assume that they were made by Corioliss. It would be natural to think that Corioliss had brought out a new model of hair straightener using a similar name, along the same lines.*

*If a product bearing the C9 mark was of inferior quality, or if the design was less unique than those for which the C2 brand is known, this would in my view harm the reputation which products made by Corioliss have, including those sold under the C2 brand.*

*If I found out that the C9 hair straighteners were not made by Corioliss, I would be surprised. I would expect this to cause confusion in the hairdressing industry and amongst the general public*

*In my view, hair care and hair styling products (such as shampoos, conditioners, styling preparations, etc.), electrical hair styling equipment (hair straighteners, hair curlers, hair dryers), and hair brushes are all closely related. They are all in the same beauty category, and would be sold side-by-side in hair salons or health & beauty retailers. It is common for a manufacturer of electrical hair styling equipment to sell thermal protector spray, for example, under the same brand. Other products which may be used at the same time as the electrical hair styling equipment are often sold under the same brand, such as brushes and combs, styling preparations, etc. Shampoos and conditioners may also be sold under the same brand. One brand which sells all of the above products is GHD, currently the UK market leader in hair straighteners.*

*If I saw any of the above non-electrical products bearing a C9 mark, I would assume that there was a connection with the well-known C2 brand and with Corioliss. If I saw the C9 mark used on shampoo, for example, I would think that Corioliss are using the C9 brand as part of a range of "C" marks for various hair-related products. I would be surprised to learn that the C9 product was not made by Corioliss. If the C9 product was of poor quality, this would in my view harm the reputation which products made by Corioliss have, including those sold under the C2 brand."*

22. The applicant's representatives – Novagraaf - filed written submissions and a short witness statement from Alistair Rawlence, who is a Trade Mark Attorney. The witness statement merely provides a copy of the Registrar's own 'cross search' list. This is public information about the Registrar's practice and therefore needn't have been filed as 'evidence' in order for the applicant to rely on it. The list appears to be relied upon as support for the argument that some of the goods in the application are not similar to the goods in Class 9 for which the opponent's earlier mark is protected. However, as the introduction to the cross search list itself makes clear, it is just a guide to the classes in which the Registrar's examiners usually search when looking to see if there are similar or identical earlier marks for similar goods/services. The list is not exhaustive. As such, it is of no real help to me in determining whether the specific goods listed in the application are similar to the opponent's goods.

23. The opponent's representatives – Thomson Gray - also filed written submissions, which I have also taken into account. The parties were asked whether they wished to be heard, but neither party did.

### **Section 5(2)(b)**

24. The relevant part of s.5 is 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.

25. There is no dispute that the opponent's mark is an 'earlier trade mark' for the purposes of s.5. As the earlier mark had not been registered for 5 years at the date of the publication of the opposed mark the proof of use requirement in s.6A are inapplicable.

26. In my consideration of whether there is a likelihood of confusion between the earlier mark and the applicant's mark, I take into account the guidance from the settled case law of the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, and *Shaker di L. Laudato & C. Sas v OHIM C-334/05 P* (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes (and ears) of the average consumer of the services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(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; *Sabel BV v Puma AG*,

(e) 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; *Shaker di L. Laudato & C. Sas v OHIM*

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(i) further, the highly distinctive character of the earlier mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG*, paragraph 41.

## **Comparison of goods**

27. I think it is self evident that all the goods covered by Class 9 of the application are identical to one or more of the goods in Class 9 for which the earlier mark is protected.

28. The goods covered by classes 3, 11 & 21 of the application are not identical to the goods covered by the earlier mark. In assessing whether and to what extent they are similar I take account of the judgment of the ECJ in *Canon* where the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.

29. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06, the General Court restated that “complementary” means:

“.... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

30. Turning first of all to the comparison between the applicant's *'hair dryers'* in class 11 and the opponent's *'Electrical hair styling products and hair styling apparatus'* in class 9, I find that the respective goods are very similar in nature – hand held electrical products - and that the respective purposes are the same to the extent that both are used to style the hair. Admittedly, hair dryers are used by some simply to dry their hair, and no one would use a hair styling tool just to dry the hair. So the intended purposes are similar rather than identical. The respective goods are therefore not in direct competition, but Mr Paterson gives evidence that they would be used at the same time. Overall, I find that *hairdryers* are very similar goods to *Electrical hair styling products and hair styling apparatus*.

31. I turn next to the similarity between the applicant's *hair brushes* and the opponent's *electrically heated... brushes*. The goods differ somewhat in nature, one being an electrical product and the other not. The purposes of the products are very similar: both are used to style the hair. The difference is one of degree. I doubt that someone in the market for an electrically heated hair styling brush would consider an ordinary brush as an alternative. This is because the whole purpose of using an electrically heated brush is to obtain more capacity to change the style of the hair than an ordinary brush or comb can provide. Similarly, someone in the market for an ordinary hair brush probably wouldn't consider buying an electrically heated brush as an alternative because of the extra cost and complication of use. The goods are not therefore in competition to any great extent. Overall, I find that the respective goods are highly similar, but not close-to-identical as their names might otherwise suggest.

32. Finally, I turn to the similarity between the applicant's *hair preparation and styling products; shampoo, conditioner, hair treatments, styling lotions, waxes, sprays* and the opponent's *electrical hair styling products and hair styling apparatus*. The nature of the respective goods is quite different. The applicant's goods are products to be applied to the hair or body whereas the opponent's products are electrical apparatus used to straighten or curl the hair. The method of use of the respective products is therefore also different. The goods are not in competition. However, the purpose of some of the applicant's goods is similar to the purpose of the opponent's goods. In particular, *hair preparation and styling products; hair treatments, styling lotions, waxes, sprays* may be used primarily for styling the hair, which is clearly what the opponent's goods are also used for.

33. I find that *hair preparation and styling products; hair treatments, styling lotions, waxes, sprays* may also be important for the use of *electrical hair styling products* and *electrical hair styling apparatus* such that they may be considered as complementary products. This is because hair treatments, styling lotions etc. may be marketed specifically for use with electrical hair straighteners, e.g. sprays for protecting the hair from the damage which may be caused by the use of hair straighteners.

34. Ms Broughton and Mr Paterson appear to class even *shampoo* and *conditioner* as hair styling products. However, in my experience that function would normally be

considered peripheral to their main purposes of cleaning and improving the general condition of the hair. I therefore find that *shampoo* and *conditioner* are not complementary products to *electrical hair styling products and hair styling apparatus*, even though they are sometimes sold side by side and that at least one producer makes both.

35. I conclude that there is a reasonable degree of similarity between *electrical hair styling products and hair styling apparatus* in class 9 and *hair preparation and styling products; hair treatments, styling lotions, waxes, sprays*, in class 3, but very little or no similarity between the opponent's goods and *shampoo* and *conditioner*.

### **The Average Consumer**

36. The average consumer is likely to be someone in the market for hair styling products. This could be an ordinary member of the general public or a professional who uses hair styling products in order to provide services to the public. The ordinary member of the public is likely to pay an average degree of attention when selecting consumable hair products such as styling gels, but a higher degree of attention when selecting more expensive electrical products, such as hair straighteners. The professional user is likely to pay an above average level of attention when selecting any of these products because the success of their business is liable to be affected by the quality of the products they use.

### **Distinctive Character of Earlier Mark**

37. There is no suggestion that C2 is in any way descriptive of hair straighteners or other hair products. Although the combination of a letter and a single digit numeral creates a simple sign, and letter/number combinations are not unusual signs in the field of electrical apparatus, neither factor is sufficient to deny the specific combination 'C2' an average level of inherent distinctive character. Further, it appears on the unchallenged evidence of Mr Burrige that the opponent's C2 product had acquired an enhanced distinctive character by the date of the application (the relevant date). It is true that the opponent's product carried other marks as well as C2, but these other marks were either descriptive or semi-descriptive or else was the opponent's 'house' mark. The relative prominence given to the C2 mark also varied over the relevant period of use, but in my view an average consumer's reaction to it would have been that the C2 mark was used by Corioliss for its hair straightening product, and that marks such as Red Leopard and Edelweiss denoted versions of the C2 product with particular colours or finishes. The nature of the opponent's use would not therefore have undermined its capacity to have enhanced the distinctive character of the C2 mark as designating a hair straightener from a particular undertaking.

38. The length of the opponent's use was, however, quite short and the scale of the promotion of the C2 mark prior to the relevant date, although significant, was not massive. The distribution of customers and promotional activities indicates that the C2 mark was likely to have been better known amongst professional users than amongst ordinary members of the public, although the distinctiveness of the mark was likely to have been elevated to a certain extent amongst the wider public too. I therefore find that at the relevant date, the earlier mark had an above average level

of distinctiveness amongst ordinary members of the relevant section of the public, and a high level of distinctiveness amongst professional users of hair styling products.

### **Comparison of the Marks**

39. Neither mark has any meaning so there is no conceptual similarity (or dissimilarity). In my view, there is a moderate level of visual and aural similarity between the marks because 1) both marks begin with the letter 'C', 2) the second half of the marks are different, and 3) there is a certain 'structural' similarity between the marks because they each consist of the letter C plus a single digit number.

### **Likelihood of Confusion**

40. I find that there is a likelihood of indirect confusion where the goods are identical: the class 9 goods. In this case the relatively modest level of similarity between the marks is offset by the identity of the goods and the above average distinctiveness of the earlier mark for the goods at issue. The average consumer of electrical hair styling apparatus is likely to pay an above average degree of attention when selecting the products at issue and this is liable to reduce the likelihood of imperfect recollection of the marks, and thus the likelihood of direct confusion. However, taking into account the identity of the goods and the above average level of distinctiveness of the C2 mark for those goods, it is likely that the average consumer will assume that the applicant's C9 electrical hair styling tools originate from the same undertaking that is responsible for the C2 products, or from an economically related undertaking. I therefore find that there is a risk of indirect confusion or 'association' as it described in s.5(2) of the Act.

41. For the avoidance of doubt, I should make it clear that in reaching this finding I have given no weight to the evidence that the opponent has itself marketed C1 and C3 hair straighteners. This is because it occurred after the relevant date in these proceedings. Further, Mr Burridge's evidence on this point is so brief that I cannot exclude the possibility that the opponent's decision to extend its range of marks in this way and at that time may have been influenced by the existence of these proceedings.

42. I find that there is also a likelihood of indirect confusion as a result of the applicant's use of its mark on hair dryers. Although these goods are not identical to the electrical hair styling tools for which the earlier mark is protected in class 9, they are very similar and are therefore liable to be seen as an extension of the same range of electrical hair appliances. Consequently, the average consumer is likely to mistakenly assume that a C9 hair dryer is marketed by the undertaking responsible for C2 electrical hair styling tool.

43. By contrast, I find that there is no likelihood of confusion with regard to the use of the applicant's mark for hair brushes in class 21 or hair preparation and styling products; shampoo, conditioner, hair treatments, styling lotions, waxes, and sprays in class 3. This is because the class 3 goods are less similar to the opponent's goods than hair dryers. Further, I bear in mind that the opponent's mark has been used exclusively for hair straighteners. It has not been used for electric hair brushes,

for example, and therefore its scope of protection for these goods must rely on the marks inherent distinctiveness. I remind myself that C2 has only an average level of inherent distinctiveness for such goods. In these circumstances, the moderate level of similarity between the marks and the differences between the goods is sufficient to exclude the likelihood of direct confusion, including the likelihood of confusion through imperfect recollection. The opponent argues that consumers may imperfectly recollect the earlier mark remembering it only as 'C plus numeral'. There would be a risk of confusion through imperfect recollection if consumers were insufficiently familiar with the earlier mark so as to be able to remember more than 50% of it, but at the same time confident enough about its identity in order to make positive assumptions about whose goods it distinguishes, even when used in relation to different categories of products, such as hair sprays and non-electrical hair brushes. However, I do not believe that the average consumer is likely to make such a combination of mistake and assumption.

44. The highpoint of this part of the opponent's case is, in my view, that the application covers products for protecting the hair from the damage that may be caused by the use of electrical hair styling tools. I have accepted that these are complementary products. This presents a potential risk of indirect confusion amongst consumers who are aware that the respective marks are C2 and C9. However, whilst it is plausible that an undertaking might use a variant mark, such as C9, in order to indicate that a hair dryer is an extension of its existing C2 line of electrical hair styling products, it is unlikely, in my judgment, that an average consumer would assume that the undertaking which uses the mark C2 for hair straighteners, uses the mark C9 for complementary products, such as protective hair sprays or gels. After all, the obvious way to indicate that the goods are complementary is to use the same branding for both, or at least to include the established brand in the mark used for the complementary products.

45. Mr Paterson and Ms Broughton gave evidence that they **would** expect C9 hair styling preparations etc. to be connected to the C2 brand for electrical hair straighteners and therefore to Corioliss. However, it is ultimately for me to assess the likely reaction of an average consumer to the applicant's mark: *esure Insurance Limited v Direct Line Insurance Plc* [2008] EWCA, Civ 842. For the reasons given above, I do not think that Mr Paterson and Ms Broughton's reactions to the use of the C9 mark for these goods would be representative of the reaction of the average consumer (professional or otherwise).

46. In summary, I find that there is a likelihood of confusion as a result of the applicant's use of its mark C9 for the goods applied for in Class 9, and for hair dryers in Class 11, but not otherwise.

### Section 5(3)

47. Section 5(3) is as follows:

"5(3) A trade mark which -  
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom .... and the use of the later mark without due cause would take unfair advantage of, or be detrimental to,

the distinctive character or the repute of the earlier trade mark.”

48. The relevant case law can be found in the following judgments of the ECJ: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

(c) It is necessary, but not sufficient, for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account all relevant factors, including the degree of similarity between the respective marks and between the respective goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Although it is not a necessary factor, a link between the trade marks is necessarily established where the similarity between the marks causes the relevant public to believe that the goods/services marketed under the later mark come from the owner of the earlier mark, or from an economically connected undertaking; *Intel*, paragraph 57.

(f) Where a link is established, the owner of the earlier mark must also establish that it has resulted in the existence of one or more of the types of injury set out in the section, or there a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68: whether this is the case must also be assessed globally, taking account of all the relevant factors; *Intel*, paragraph 79.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel*, paragraphs 76 and 77.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later mark identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(i) Detriment to the repute of the earlier mark is caused when the goods or services for which the later mark is used by the third party may be perceived by the public in such a way that the earlier trade mark's power of attraction is reduced; *L'Oreal, paragraph 40*.

(j) Unfair advantage covers, in particular, cases where a third party seeks to ride on the coat-tails of the senior mark in order to benefit from a transfer of the image of the earlier mark, or of the characteristics it projects to the goods/services identified by the later mark; *L'Oreal, paragraph 41*.

49. According to the opponent's evidence, its C2 product was the third most popular brand of hair straightener on the market in 2010. Although the length of the opponent's use prior to the relevant date in 2009 is quite short, I am prepared to accept that the opponent's mark enjoyed the necessary reputation at that date.

50. I am also prepared to accept that the use of C9 for electrical hair styling products, and closely similar electrical products, such as hair dryers, is likely to remind relevant consumers of the opponent's mark, even if there is no confusion as to the trade source of the goods marketed under the later mark. I therefore find that, for these goods, the necessary link is established.

51. The opponent has also established, through its evidence, that the attractive design and appearance of its C2 hair straighteners is a particular characteristic of the products.

52. It appears to me that either the applicant's hair styling products and hair dryers will be presented with an attractive design and finish, in which case I am prepared to infer that the applicant's C9 mark will take unfair advantage of the reputation of the senior mark by transferring the image of the senior mark onto its own products, or else such characteristics will be absent from the products sold under the later mark, in which case the use of the C9 is likely to be detrimental to the senior mark by diluting its reputation for attractively designed products. That would be likely to affect the economic behaviour of consumers towards the senior mark and damage its reputation.

53. The applicant has not attempted to show that it has 'due cause' for using the C9 mark, so there is no need to consider whether that exception applies.

54. I conclude that the s.5(3) ground of opposition also succeeds in relation to all the applicant's goods in Class 9 and also hair dryers in Class 11.

55. As regards the remaining goods in classes 3 and 21, I do not consider that, at the relevant date, the reputation of the C2 mark for hair straighteners was so strong that the use of the mark C9 for hair preparation and styling products etc. in class 3, or hair brushes in class 21, would have brought the senior mark to the minds of a significant proportion of the relevant classes of consumer, which I accept overlap with those for the opponent's products. Consequently, the s.5(3) ground fails for these goods.

## **Section 5(4)(a)**

56. Finally, I turn to the s.5(4)(a) ground of opposition. Given the success of the opposition under sections 5(2) and 5(3) for goods in class 9 and for hair dryers, I will limit my consideration of this ground to the goods in classes 3 and 21 which have survived the other grounds of opposition.

57. The requirements to succeed in a passing off action are well established and are summarised in *Halbury's Laws of England* 4th Ed. as being that:

- i) the claimant's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- ii) there is a misrepresentation by the defendant (whether or not intentional) which is likely to deceive the public into believing that the defendant's goods or services are those of the claimant; and
- iii) the claimant has suffered or is likely to suffer damage as a result of the erroneous belief created by the defendant's misrepresentation.

58. The evidence shows that the opponent had acquired a protectable goodwill under the sign C2 by the date of the opposed application. However, the requirement for misrepresentation is not present. For the same reasons I gave for refusing to accept that there was a likelihood of confusion under s.5(2) in respect the applicant's goods in classes 3 and 21, I find that there is no likelihood of deception amongst the section of the public who make up the opponent's goodwill. The s.5(4)(a) ground fails accordingly.

## **Costs**

59. The opposition was directed at all four classes of the application. It has succeeded in two classes and failed in two others. Consequently, I direct that each side should bear its own costs.

**Dated this 31 Day of May 2011**

**Allan James  
For the Registrar**