

O-452-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2573975
IN THE NAME OF ROOT2TIP HAIRCARE SOLUTIONS LIMITED
OF THE FOLLOWING TRADE MARK IN CLASS 3:**



AND

**AN APPLICATION TO DECLARE THE REGISTRATION INVALID (NO. 500087)
BY JACQUELINE NORRIS-ATTERBURY**

Background and pleadings



1. This dispute concerns the validity of the trade mark **ROOT 2 TIP** which is registered in class 3 for “hair products”. The proprietor of the mark is Root2Tip Haircare Solutions Limited (“the proprietor”). The trade mark was filed on 3 March 2011, completing its registration procedure on 3 June 2011.

2. Jacqueline Norris-Atterbury is the applicant for invalidation. She pleads a ground under section 5(2(b) of the Trade Marks Act 1994 (“the Act”). Under this ground, Ms Norris-Atterbury relies on two trade mark registrations of which she is the proprietor, as follows:

- i) UK Registration 2466576A for the mark **Roots2Ends** which was filed on 12 September 2007, completing its registration procedure on 15 August 2008. The mark is registered for the following goods and services:

Class 3: Hair and Body Cosmetics.

Class 21: Hair combs and brushes.

Class 41: Education and training workshops all in relation to hair care.

Class 44: Hair and beauty care. Trichology Service

- ii) UK Registration 2466576B which was filed and registered on the same dates as the above mark, and is registered for the same goods and services. The mark the subject of this registration is shown below:



3. The main claims in Ms Norris-Atterbury’s statement of case are that:

- The marks are conceptually very similar or identical.
- The dominant and distinctive element of the proprietor’s mark are the words ROOT2TIP which is aurally and visually similar to the earlier word mark and aurally and visually similar to the words Roots2Ends that appear in its composite mark.
- The goods are identical.
- There is a likelihood of confusion.
- The applicant is aware of a number of instances of confusion.

4. The proprietor filed a counterstatement. In its counterstatement the proprietor states that it has used its mark before Ms Norris-Atterbury used hers and that the proprietor's mark "holds greater goodwill". It puts Ms Norris-Atterbury to proof in terms of establishing confusion and when she first charged for her products. The proprietor also requested "proof of use" in relation to the proof of use provisions. However, this request is misconceived because the proof of use provisions only apply to earlier marks which completed their registration processes five years or more before the date on which the application for a declaration of invalidity was filed (see section 47(2A) of the Act). The application for invalidity was lodged on 4 July 2013. The earlier marks completed their registration processes on 15 August 2008 so they had been registered for less than five years (by a period of one month and 10 days). The consequence of this is that Ms Norris-Atterbury is entitled to rely on her registered marks in these proceedings without having to establish that they have been used.

5. Both sides are self-represented. I note, though, that for part of the proceedings Ms Norris-Atterbury was represented by Branded. Only the proprietor filed evidence. Neither side requested a hearing or filed written submissions in lieu.

The evidence

6. The proprietor's evidence consists of a witness statement from Ms Salem Wynter, the originator of the proprietor's brand. It is not necessary to summarise the evidence in any detail because it mainly consists of:

- i) Evidence of the proprietor's use of its mark commencing in 2007. The proprietor has referred to its claimed prior rights and superior goodwill in its mark. This is not pertinent because the proprietor has not sought to invalidate Ms Norris-Atterbury's earlier marks. The relevance of this (or more accurately the lack of relevance) is set out in tribunal practice notice ("TPN") 4/2009. In summary, the question before the tribunal is whether there is a likelihood of confusion. The existence of a prior right has little impact upon this.
- ii) Evidence in which it is claimed that Ms Norris-Atterbury has changed her branding to look more like that of the proprietor. This is not pertinent because it is the marks that have been registered that must be compared.
- iii) Comments that Ms Wynter's clients and customers would not confuse the marks. A number have, apparently, opined on this matter. However, no supporting evidence in relation to this is provided. I note that when Ms Wynter originally submitted her evidence it did contain material purporting to be a survey. However, this was returned by the tribunal because leave for its inclusion had not been given (as is required by TPN 2/2012) and the criteria in that TPN not met. Ms Wynter was given the option of complying with the TPN but she elected not to do so.

Section 5(2)(b)

7. Section 5(2)(b) of the Act states that:

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

(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.”

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

9. The proprietor's mark is registered for hair products. The earlier mark is registered for, amongst other things, "hair....cosmetics". The latter falls within the ambit of the former. In *Gérard Meric v OHIM* (Case T-133/05) the General Court explained that goods can be considered as identical if they fall within the ambit of a general category of the competing specification, it stated:

"In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, *OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42)."

10. Given that this is the case here, identical goods are in play. I can see a potential argument that not all of the applied for "hair products" are, strictly speaking, cosmetics. However, I consider cosmetics to be a broad term that would cover anything (in class 3) for caring, beautifying or otherwise treating the hair. Thus, whatever way one looks at it, the goods are identical. Even if I am wrong on this then the goods must, nevertheless, be similar to a very high degree.

Average consumer and the purchasing act

11. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

12. The average consumer will be a member of the general public buying hair products. Such goods will be brought fairly frequently and are not, generally speaking, particularly expensive. However, some care will be used in order to ensure that the product is of the desired type, is suitable for the person’s hair etc. I consider that the average consumer will pay an average (no higher or lower than the norm) degree of care and consideration in the purchasing process.

13. The goods will, in my view, be most often self-selected from the shelves of a retail store (or the online equivalent). The goods may be pursued on websites. This suggests a process which is more visual than aural. However, I will not ignore the aural impact of the marks completely as there is still room for the goods to be requested aurally when discussing with sales advisors etc.

Comparison of marks

14. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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



v



Roots2Ends

and

Roots2Ends

16. The earlier figurative mark has greater visual and aural difference (compared to the proprietor's mark) than the earlier word mark. Consequently, I will focus on the earlier word mark because if Ms Norris-Atterbury cannot succeed with that then she will be no better off relying on the other.

17. The earlier word mark consists of the word/numeral combination **Roots2Ends**. The elements that make up the mark form a recognisable unit equivalent to the phrase "roots to ends". Consequently the overall impression will be based on the totality of the unit with no single element dominating the others.

18. The proprietor's mark is comprised of the word/numeral combination ROOT2TIP (which will be seen as unit equivalent to the phrase "root to tip"), a figurative element which is likely to be perceived as a leaf weaved into the overlapping double Os of the word ROOT, with the leaf device (and also the I of the word TIP and the heart device in the strap-line) being in a contrast colour to the rest of the mark and, finally, the strap-line itself which consists of the words "helping you to love your hair" (the o of the word love being represented by a heart). The word/numeral ROOT2TIP is clearly an important part of the mark and is likely to be the element that most strongly dominates the overall impression. However, the figurative element also plays, in my view, a reasonably strong role in the overall impression of the mark. The strap-line plays only a weak role given its lack of prominence. The contrasting colour also plays only a weak role, although, it does of course contribute to the visual impact the figurative element makes.

19. Conceptually, the hook that will be remembered by the average consumer will be of the message roots to(2) ends and root to (2) tip respectively. Both, therefore, suggest that the product in question works from the roots of the hair to its tip/ends. This creates conceptual similarity of a very high degree.

20. Visually, whilst the marks coincide in the presence of the word ROOT/ROOTS and the numeral 2, there are a number of differences, although, the most important ones are the very different third verbal element (ends/tips) and the figurative element in the proprietor's mark. There are, of course, other differences (such as the addition of the strap-line) which I bear in mind. I consider all of this to equate to only a low degree of visual similarity.

21. There is more aurally similarity than exists on a visual level. This is because the figurative element will not be articulated. I also consider it unlikely that many average consumers will articulate the strap-line given the weak role it plays in the overall impression of the proprietor's mark. Of the parts of the respective marks that will be articulated, ROOTS2 and ROOT2 are highly similar, but there is no aural similarity at all between ENDS/TIP. I consider this equates to a medium degree of aural similarity.

Distinctiveness character of the earlier mark

22. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma*

AG, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

23. Ms Norris-Atterbury has filed no evidence in relation to the use of her mark. Consequently, I have only its inherent characteristics to consider. It is not a strong mark. I have already stated that the word/numeral combination will be seen as the phrase “roots to ends” which is suggestive of a product that works on a person’s hair, from its roots to its ends. The replacement of the word TO with the numeral 2 is not the most unusual of adaptations. Whilst there are mixed national authorities on the point¹, the judgment of the CJEU in *Formula One Licensing BV v OHIM* indicates that a registered trade mark must be considered to have at least a minimum degree of distinctive character and, therefore, it is not open to me to find that the earlier mark lacks distinctive character completely. In terms of what level of distinctive character the mark has, it is clear that the mark sends a strong suggestive/allusive message as described. I consider it to be low in inherent distinctive character.

Likelihood of confusion

24. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. I note that in the notice of opposition reference is made to there being instances of confusion. However, no evidence has been provided about this, so the claim cannot be taken into account.

¹ Compare *Wella Corporation v Alberto-Culver Company* [2011] EWHC 3558 with *Samuel Smith Old Brewery v Philip Lee* [2011] EWHC 1879 at paragraph 82

25. The goods are identical. This is an important point because this may offset a lesser degree of similarity between the marks. However, notwithstanding this, I consider that the earlier mark's low distinctiveness combined with the differences that exist between the two marks (on a visual and aural basis) means that there will be no likelihood of confusion. Whilst the marks are conceptually very similar, the concept is effectively descriptive, so meaning that this aspect of similarity does not push the average consumer towards believing that the goods come from the same or an economically linked undertaking. The concept of imperfect recollection has been borne in mind, but even factoring this into the equation, I am satisfied that the average consumer will be able to distinguish between the marks. Finally, I acknowledge that there is a more aural similarity than visual similarity, but given that the purchasing process is more often a visual one, and given that even from an aural perspective there are still differences between the marks, I am not satisfied that there is a likelihood of confusion. **The invalidation case fails. It also fails in relation to the earlier figurative mark as it is even further away.**

Costs

26. The proprietor has succeeded and is entitled to a contribution towards its costs. I bear in mind that the proprietor was not legally represented so would not have incurred legal costs. Furthermore, in relation to the proprietor's evidence, I have decided not to award costs for this and it was not only unnecessary, but was largely misconceived. Ms Norris-Atterbury should not have to compensate the proprietor for filing such material. My assessment is as follows:

Preparing a statement and considering the other side's statement - £150

Filing and considering evidence - £0

27. I therefore order Ms Norris-Atterbury to pay Root2Tip Haircare Solutions Limited the sum of £150. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 29th day of September 2015

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