

**O-162-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3317947 BY  
JUSTIN CARR  
TO REGISTER THE TRADE MARK:**

**THAT HD FEELING**

**FOR SERVICES IN CLASSES 35 AND 44**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000963  
BY HIGH DEFINITION BROWS LIMITED**

## BACKGROUND AND PLEADINGS

1) On 14 June 2018 Mr Justin Carr applied to register the following trade mark:

### THAT HD FEELING

The application was published for opposition purposes on 13 July 2018. Registration is sought for various services in Classes 35 and 44, of which the following are opposed in these proceedings:

**Class 35:** *Retail services and wholesale services connected with the sale of brushes, combs, hair styling appliances, skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes.*

**Class 44:** *Hairdressing; barber services; hair braiding and hair cornrowing services; beauty treatment; beauty salon services; spa services; consultancy, information and advisory services relating to all the aforesaid services.*

2) The application is opposed by High Definition Brows Limited (“the Opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon the following UK and European Union trade marks:

3) UK registration No. 3088867 was filed on 12 January 2015 and completed its registration procedure on 10 July 2015 for the following series of signs:



The goods and services relied on by the Opponent under UK registration No. 3088867 for the purposes of these proceedings are as follows:

**Class 3:** *Cosmetics; cosmetics in kit form; make-up and make-up remover preparations; soap; perfumery; body sprays; toiletries; false eyelashes and eyelash extension preparations; tanning and sun protection preparations; preparations for the care of facial hair; hair colourants; hair wax; hair and body lotions.*

**Class 8:** *Hand tools and hand operated implements; cutlery; side arms; razors; electric razors and hair cutters.*

**Class 11:** *Depilatory wax heaters.*

**Class 21:** *Make up brushes and hand tools for the application of cosmetics.*

**Class 35:** *Retail services including retail services via the internet connected with the sale of clothing, footwear, fragrance, hair care, skin care, sun-tanning, cosmetics, hand tools for cosmetic application, depilatory wax heaters, hair accessories, clothing accessories, and publications.*

**Class 41:** *Arranging training courses and training services in the field of cosmetic and beauty treatments.*

**Class 44:** *Hygienic and beauty care and treatments for human beings or animals; beauty salon services; beauty salons.*

4) EU trade mark No. 14275523 was filed on 19 June 2015 and completed its registration procedure on 25 November 2015 for the following sign:



「HIGH DEFINITION」

The goods and services relied on by the Opponent under EU trade mark registration No. 14275523 for the purposes of these proceedings are as follows:

**Class 3:** *Make-up remover preparations; soap; perfumery; body sprays; toiletries; false eyelashes and eyelash extension preparations; tanning and sun protection preparations; nail polish, varnish and gels; nail care preparations; nail polish removing preparations; preparations for the care or removal of facial hair; hair colourants; hair wax; skin care preparations; hair and body lotions.*

**Class 8:** *Hand tools and hand operated implements; side arms; razors; electric razors and hair cutters.*

**Class 11:** *Depilatory wax heaters.*

**Class 21:** *Make up brushes and hand tools for the application of cosmetics.*

**Class 35:** *Retail services including retail services via the internet connected with the sale of clothing, footwear, fragrance, make-up, hair care, skin care, toiletries, sun-tanning preparations, cosmetics, hand tools for cosmetic application, depilatory wax heaters, hair accessories, clothing accessories, and publications.*

**Class 41:** *Arranging training courses and training services in the field of cosmetic and beauty treatments.*

**Class 44:** *Hygienic and beauty care and treatments for human beings or animals; beauty salons; beauty salon services.*

5) EU trade mark registration No. 14275549 was filed on 19 June 2015 and completed its registration procedure on 17 November 2015 for the following sign:



The goods and services relied on by the Opponent under EU trade mark registration No. 14275549 for the purposes of these proceedings are as follows:

**Class 3:** *Cosmetics; cosmetics for sale in kit form; make-up and make-up remover preparations; soap; perfumery; body sprays; toiletries; false eyelashes and eyelash extension preparations; tanning and sun protection preparations; nail polish, varnish and gels; nail care preparations; nail polish removing preparations; preparations for the care or removal of facial hair; hair colourants; hair wax; skin care preparations; hair and body lotions.*

**Class 8:** *Hand tools and hand operated implements; side arms; razors; electric razors and hair cutters.*

**Class 11:** *Depilatory wax heaters.*

**Class 21:** *Make up brushes and hand tools for the application of cosmetics.*

**Class 35:** *Retail services including retail services via the internet connected with the sale of clothing, footwear, fragrance, make-up, hair care, skin care, toiletries, sun-tanning preparations, cosmetics, hand tools for cosmetic application, depilatory wax heaters, hair accessories, clothing accessories, and publications.*

**Class 41:** *Arranging training courses and training services in the field of cosmetic and beauty treatments.*

**Class 44:** *Hygienic and beauty care and treatments for human beings or animals; beauty salons; beauty salon services.*

6) The significance of the dates given above is that (1) the marks relied on by the Opponent constitute earlier marks in accordance with section 6 of the Act, and (2) they are not subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures having been completed less than five years before the publication of the Applicant's mark.

7) The Opponent claims that the mark applied for is similar to the earlier marks, and that the services and goods of the earlier marks are identical or similar to the services of the opposed mark, so that there is a likelihood of confusion. In his counterstatement Mr Carr denies the grounds of opposition. Mr Carr is represented in these proceedings by Trademark Eagle Limited. The Opponent is represented by Mohun Intellectual Property Limited.

8) Rules 20(1)-(3) of the Trade Marks Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions such as the present proceedings, but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

The net effect of these provisions is that parties are required to seek leave in order to file evidence (other than the proof of use evidence, which is filed with the notice of opposition) in fast track oppositions. Neither side sought leave to file evidence in these proceedings.

9) Rule 62(5) (as amended) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (“the Rules”) provides that arguments in fast track proceedings shall be heard orally only if (1) the Office requests it or (2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost.

Otherwise written arguments will be taken. Neither side requested a hearing. Both sides filed written submissions in lieu of a hearing. I therefore give this decision after a careful review of all the papers before me.

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

10) Section 5(2)(b) of the Act reads as follows:

“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”.

11) The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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.

### **The Opponent's best case**

12) In a visual comparison I consider that the complex figurative treatment of the letter combination HD in the Opponent's EU trade mark Nos. 14275523 and 14275549 clearly takes them further away from Mr Carr's mark, while their very similar services specifications offer no significant advantage overall, with the result that the Opponent's



UK registration No. 3088867 represents its best case. In the interests of procedural economy, therefore, I shall confine my assessment to a comparison of Mr Carr's mark with the series of marks in this registration.

### **Comparison of the services**

13) In its statement of case the Opponent relies on all the goods and services of its specification; but I consider that its strongest case lies with its services in Classes 35 and 44, and I shall confine my comparison to these.

14) In assessing whether there is a likelihood of confusion I must make my comparison of the services on the basis of the principles laid down in the case law. In the judgment of the CJEU in *Canon*, Case C-39/97, 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”.

15) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance

whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16) In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 (“Meric”), the General Court stated that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application. This principle is equally applicable to services.

17) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market*, Case T- 325/06 the General Court explained that goods are complementary if 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. This principle is equally applicable to services.

18) When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”<sup>1</sup>. I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>, though in *Avnet Incorporated v Isoact Ltd* [1998] FSR 16 Jacob J stated: “In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

19) I will make the comparison with reference to Mr Carr’s services. I will go through them term by term, but grouping them where it is useful and reasonable to do so<sup>3</sup>.

### Class 35

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<sup>1</sup>*British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

<sup>2</sup>*Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

<sup>3</sup>See the comments of the Appointed Person in *Separode* BL O-399-10

20) Mr Carr's *retail services connected with the sale of cosmetics and cosmetic preparations* is manifestly identical with the Opponent's *retail services including retail services via the internet connected with the sale of cosmetics*. Mr Carr's *retail services connected with the sale of skin care preparations, make-up, moisturisers, beauty care preparations, cosmetic kits, compacts containing make-up, sunscreen creams, nail polish, eyelashes* all clearly fall within the ambit of the Opponent's *retail services including retail services via the internet connected with the sale of cosmetics*, and are identical under the guidance in *Meric*. In like manner, Mr Carr's *retail services connected with the sale of brushes, combs, hair styling appliances, hair treatment preparations* are all covered by the Opponent's *retail services including retail services via the internet connected with the sale of hair care, hair accessories*, and are identical. Similarly, Mr Carr's *retail services connected with the sale of perfumery and fragrances* fall within the ambit of the Opponent's *retail services including retail services via the internet connected with the sale of fragrance*, and are identical.

21) Mr Carr's *retail services connected with the sale of body cleaning preparations, soaps and gels, deodorants and antiperspirants, dentifrices and mouthwashes* may perhaps strictly be described as services relating to the retailing of toiletries rather than cosmetics as such, but there is a considerable overlap in purpose, use, users, and a considerable degree of complementarity, between toiletries and cosmetics. Crucially, they have the same consumers, and these consumers will expect to see these products supplied by the same retail outlets (and, indeed, offered for sale in close proximity to each other). While Mr Carr's *retail services connected with the sale of body cleaning preparations, soaps and gels, deodorants and antiperspirants, dentifrices and mouthwashes* may not strictly fall within the ambit of the Opponent's *retail services including retail services via the internet connected with the sale of cosmetics*, there is at any rate a high degree of similarity.

22) Retail of cosmetics, toiletries, fragrances and haircare products involves the offering for sale of those goods in relatively small quantities for use or consumption by the end user rather than for resale, whereas wholesale involves the offering for sale of those goods to businesses, usually for resale. Both retail and wholesale of those products will involve selecting a range of them to offer for sale and providing a variety of services aimed at inducing the consumer to purchase from the trader in question

rather than from a competitor. Those services may differ somewhat, depending on whether the retail or wholesale market is being served. The precise nature of those services in concrete terms, however, will also depend largely upon the goods offered for sale<sup>4</sup> – which in this case I have found to be identical or highly similar cosmetics, toiletries, fragrances and haircare products. Thus, there is identity or high similarity of subject matter and, to a large extent, shared nature and purpose between the Opponent's retail services and Mr Carr's wholesale services as they apply to the products in question<sup>5</sup>.

23) Users of retail and wholesale services will differ, consisting of private consumers (the general public) and businesses respectively. However, business consumers of wholesale services for such everyday mass consumer products as cosmetics, toiletries, fragrances and haircare products will also be consumers of retail services for those products in their capacity as private consumers. Moreover, business consumers for these goods will range from, for example, large retail and hotel chains, etc, to small businesses such as individually owned corner shops, hairdressing salons and bed and breakfast hotels, etc. In the modern market environment for such consumer goods, including online, there is scope for considerable overlap of users and channels of trade. Consumers will not be surprised to find both wholesaling and retailing of these goods provided by the same or associated undertakings.

24) Accordingly, where in paragraphs 20 to 21 above I have found the earlier marks' retail services to be identical or highly similar to the applied for retail services, I also make respective parallel findings that there is at least a medium degree of similarity between the earlier marks' *retail services including retail services via the internet connected with the sale of cosmetics, hair care, hair accessories, fragrance* and the applied for *wholesale services connected with the sale of brushes, combs, hair styling appliances, skin care preparations, make-up, moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts*

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<sup>4</sup> In *Praktiker Bau und Heimwerkermärkte AG*, C-418/01 P one of the reasons given by the CJEU for its decision that the applicant for retail services must be required to specify the goods or types of goods to which those services relate is that this will make it easier to apply provisions relating to, for example, likelihood of confusion, without appreciably limiting the protection afforded to the trade mark (see paragraphs 50-51 of that decision). This principle, which is an important aspect of defining the extent of a mark's protection, is equally applicable to wholesale services.

<sup>5</sup> See by analogy the General Court's decision in *Gerd Brunner v EUIPO*, T-367/16 at paragraph 47.

*containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes.*

25) In so far as they relate to the opposed services of Mr Carr's specification in Class 35, which I have found above to be identical or highly similar to those of the Opponent, the information, consultancy and advisory services of Mr Carr's specification in Class 35 are often provided as part of retail or wholesale services. Moreover, even where provided independently of sales of the goods in question, they are highly similar to the respective services of the Opponent by virtue of their high degree of complementarity and shared users. The application of *information and advisory services relating to all the aforesaid services* to the unopposed services of the contested mark is, of course, unaffected.

#### Class 44

26) Mr Carr's *beauty salon services* is manifestly identical with the Opponent's *beauty salon services*. Mr Carr's *beauty treatment* falls within the ambit of the Opponent's *beauty salon services* and is identical under the guidance in *Meric*. Hairdressing services will frequently be provided as part of *beauty salon services*, and I consider that Mr Carr's *hairdressing; barber services; hair braiding and hair cornrowing services* are all also covered by the wide ambit of the Opponent's *hygienic and beauty care and treatments for human beings*; they are thus identical. Even if they were not so covered they share to a very large extent nature, purpose, use, users and channels of trade. The specific services associated with barbers, i.e. the cutting and styling of men's hair, shaving, beard trimming, etc. have, it is true, traditionally been provided in barber's shops; but nowadays they are increasingly provided in establishments catering for both sexes. Mr Carr's *hairdressing; barber services; hair braiding and hair cornrowing services* are thus in any event highly similar to the Opponent's *hygienic and beauty care and treatments for human beings*.

27) *Spa services* have traditionally involved the drinking of, and immersion in, the waters of natural mineral springs. Today spa services may include, for example, various body cleansing treatments, facials, manicures, pedicures, etc., all of which

would be covered by the Opponent's *hygienic and beauty care and treatments for human beings*. They will also commonly include treatments such as massage. I consider that services such as massage can also be regarded as covered by the term *hygienic and beauty care and treatments for human beings*, in which case Mr Carr's *spa services* is identical with the Opponent's *hygienic and beauty care and treatments for human beings*. Even if they are not so covered, however, there is clearly a very extensive overlap between these services and their channels of trade, and they are highly similar by virtue of users, use, nature, purpose and complementarity.

28) Consultancy, information and advice will normally be provided as part and parcel of both Mr Carr's services and the Opponent's services in Class 44. Even where they are provided separately, however, by virtue of their nature, purpose, users, use, complementarity and channels of trade Mr Carr's *consultancy, information and advisory services relating to all the aforesaid services* will be highly similar to the Opponent's *hygienic and beauty care and treatments for human beings* and *beauty salon services* in Class 44.

### **The average consumer and the purchasing process**

29) 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 or services 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.”

30) The average consumer of Mr Carr's and the Opponent's retail services in Class 35 will be the consumers of the cosmetic, toiletry, fragrance and haircare products being retailed, i.e. a member of the general public. The relevant retail services will be found and selected through advertisements, directories, street signage, internet searches, etc. The process will be primarily visual, but word of mouth directions or recommendations may also have some role to play and some articles may be selected with the assistance of a sales assistant, so aural considerations will not be overlooked in my assessment. The degree of attention paid to the selection of a retailer will tend to reflect that paid to the selection of the goods retailed. In this case cosmetics, toiletries, fragrances and haircare products are likely to be available in a range of prices – though, as a general rule, they are relatively low value, fairly frequent purchases, and are unlikely to demand a higher level of attention to be paid in their selection than that necessary to establish suitable skin type, perfume, active ingredients, and so on. The purchasing process for the respective retail services will be a normal, reasonably considered one.

31) Owing to the nature of the products, the purchasing process for wholesale services for cosmetics, toiletries, fragrances and haircare products will share many facets with the purchasing process for retail services for those goods; the level of attention, though, can be expected to be somewhat higher after taking into account commercial considerations such as profit margins and sales potential.



32) The average consumer of beauty care and treatment services, including hairdressing and barber services, and of consultancy, information and advisory services relating to such services, will be a member of the general public. The price and frequency of use of such services may all vary with the precise type of service. A somewhat higher level of attention may be paid to the selection of a full complement of spa services provided in a hotel than to a haircut and styling or manicure provided in a local salon. Generally, however, the purchasing process for the respective retail services will be a normal, reasonably considered one. The relevant retail services will be found and selected through advertisements, directories, street signage, internet searches, etc. The process will be primarily visual, but word of mouth directions or recommendations may also have some role to play, and aural considerations will not be overlooked in my assessment.

## Comparison of the marks

33) 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.”

34) It would be wrong, therefore, to dissect the trade marks artificially, 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 shown below:

<b>The opposed mark</b>	<b>Earlier mark number one in the series</b>	<b>Earlier mark number two in the series</b>
<b>THAT HD FEELING</b>		



35) The opposed Mark consists of the phrase THAT HD FEELING. No part of it is negligible or inherently descriptive or allusive of any of the relevant services. The phrase as a whole has distinctive character. That said, the letter combination “HD” is visually, aurally, and conceptually central to it, as I shall explain. The graphic elements of the earlier marks are not negligible, and do make some contribution to their distinctive character. The distinctive weight of the earlier marks, however, lies heavily on the letter combination “hd”.

36) The only difference between the two marks in the series covered by the opponent's registration is that one is shown against a white background and the other against a black. This has no impact on the comparison with Mr Carr's Mark. The earlier marks depict the letter combination “hd”. The letters are elongated and have a varying stroke width, as though written with an italic pen. The Strokes of the letters are filled in with narrow diagonal white and black lines, so that against either a white or black background they show up as grey. Although mildly stylised, the earlier marks consist conspicuously of the clearly and immediately legible letter combination “hd”. In fair and notional use Mr Carr's mark will be perceived visually as a short phrase containing two extra words in comparison with the mere two letters of the earlier marks. The letter combination HD occupies a central and conspicuous place in this short phrase, however, and will not be overlooked. It should also be noted that a mark registered in capital letters covers use in lower case or different font, so that the difference in case does not represent a material difference in the comparison<sup>6</sup>. There is a medium degree of visual similarity between the competing marks.

37) The figurative element in the earlier marks will not, of course, be articulated aurally. The familiar words and letters of the competing marks will be pronounced in

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<sup>6</sup> See paragraph 16 of the decision of Professor Ruth Annand, sitting as the Appointed Person, in BL O/158/17, *Bentley Motors Limited v Bentley 1962 Limited*.

See also the observations of Mr Iain Purvis, QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14: “It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalisation which appears in the Register of Trade Marks. See for example *Present-Service Ullrich GmbH & Co. KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-66/11 at [57]. A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or hand-writing as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”.

the normal, familiar way. The letters HD will thus be pronounced identically in the competing marks. In the course of trade the whole phrase of the opposed Mark will be pronounced, making a difference of 2 extra words and 3 extra syllables in comparison with the earlier marks. In this oral use too, however, HD will play a conspicuous central role. There is a medium degree of aural similarity between the competing marks.

38) One of the Opponent's other marks includes the phrase "high density", but that is completely irrelevant to the present comparison which I have chosen to make, which must be based strictly on the series of marks in the opponent's UK registration number 3088867. There is no evidence before the Tribunal that the Opponent – or any other undertaking – has in fact used the phrase "high density" in connection with the relevant services on the UK market. Nor is there any evidence that UK consumers have been educated to attribute any particular independent conceptual content to the letters HD when used in association with those services. In the absence of such evidence there is no reason to suppose that the letter combination HD, whether in Mr Carr's or the Opponent's marks, will have any particular concrete conceptual significance for the average consumer.

39) THAT HD FEELING will be seen as a slogan referring to an emotion (presumably positive) that will be induced by "HD" – whatever "HD" maybe. Used in trade in connection with the provision of services, since HD has no immediately obvious meaning, the most natural inference would be that it is a reference to the brand itself. I shall consider this further when I come to make my global assessment of the likelihood of confusion.

40) While I accept that Mr Carr's mark introduces the concept of "that feeling" and that, in itself, "HD" has no conceptual significance beyond that of the letter combination *per se*, the fact remains that the whole phrase THAT HD FEELING emphasizes and highlights that very letter combination as itself having some particular, albeit unspecified, significance. In view of all this, I consider that it would be artificially formulaic to find overall conceptual dissimilarity here. In the particular circumstances of this case I consider the most apt analysis is that, viewed overall, there is neither

significant conceptual similarity nor significant conceptual dissimilarity between the competing marks.

### **The distinctiveness of the earlier marks**

41) The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier marks, either on the basis of 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).”

42) Mr Carr contends that “*There are a considerable number of marks incorporating the letters HD which are peacefully co-existing on the market and on the register in relation to the goods covered by the marks in question. This therefore means that*

consumers have already been able to distinguish them all with additional elements, features, words, logo, particularly because the HD acronym has approximately 92 meanings, as was shown on Annex 1 attached to the Counterstatement ..... ”. Mr Carr has filed no evidence in proper evidential format to support these contentions.

43) Even if evidence of such registrations had been admitted in these proceedings, however, it would not have assisted his case. It is well established in the case law that evidence of the state of the register in respect of other such marks is not a relevant factor to be considered. This is because such evidence would not show whether the marks were being used, or indicate the services on which there was use, or what agreements might be in place between the parties concerned. In this regard Mr Carr has filed no evidence to establish that by the time he applied for the opposed mark UK consumers in the markets for the relevant services had been exposed to marks including an “HD” element to such an extent that the distinctiveness of that element had been diluted<sup>7</sup>, or that the average consumer had been educated to distinguish between marks of different proprietors containing that element.

44) The Opponent has not claimed that the distinctiveness of its earlier marks has been enhanced through use. This leaves the question of inherent distinctive character. I have already found that the distinctive weight of the earlier marks lies heavily on the letter combination HD. Mr Carr argues that “*Following the EUIPO and UK case law and practice, the abbreviation HD has a relatively low level of inherent distinctiveness. In the Decision of the Third Board of Appeal of the EUIPO dated 31 October 2000 in Case R 294/2000-3, at paragraph 16, the Board of Appeal held that ‘Abbreviations of two letters are in principle less distinctive than word trademarks, given the limited number of letters in the alphabet of any language and the great number of meanings that acronyms and abbreviations may have in the information society’*”.

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<sup>7</sup> See Jacob J in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 and the General Court in *Zero Industry Srl v Office of Harmonisation in the Internal Market (Trade Marks and Designs)(OHIM)*, Case T-400/06 and *GfK AG v Office of Harmonisation in the Internal Market (trade Marks and Designs)(OHIM)*, Case T-135/04

45) I have borne the Board of Appeal's decision in mind, but must point out that decisions before EUIPO are not binding on the Registrar, and I am not bound to come to the same conclusions. I must reach my decision in the present proceedings on the particular facts of the present case and on the particular marks that are before me, and how they will be perceived by consumers in the UK. While I accept that the simple two-letter combination HD is unlikely to be regarded as highly distinctive, there is no reason why I should accord it only a low or weak level of inherent distinctive character when used in connection with the services of the earlier marks. The earlier marks are in no way descriptive or allusive of those services. In my judgment the distinctiveness of the letter combination HD *per se* may be slightly lower than the norm, but not by much. The contribution which the graphic treatment makes to the distinctive character of the earlier marks is modest so that, overall, their distinctiveness still lies within the normal range. In making my global assessment of the likelihood of confusion I shall bear in mind that the distinctiveness of the common element – the HD letter combination – is crucial<sup>8</sup>.

### **Likelihood of confusion**

46) 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.

47) It is appropriate to begin by noting Mr Carr's submission that "*The relevant public would therefore perceive the Applicant's mark as being a made-up slogan, particularly as the Applicant is already a registered owner of the mark THAT FEELING and therefore, consumers will only link the applied for mark with the Applicant*". There is no evidence before the Tribunal that Mr Carr's *THAT FEELING* mark has been used (or, if used, how extensively) on the UK market. In the absence of such evidence it cannot be satisfactorily established that the average consumer in the UK has been

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<sup>8</sup> See, for example, *Kurt Geiger v A-list Corporate Limited*, BL O-075-13)

educated to link the applied for mark with the Applicant. More importantly, even if this were established, it would not in any case in itself demonstrate that there was no likelihood that consumers would confuse the contested mark with the earlier marks.

48) I have found degrees of similarity between the opposed services of Mr Carr's registration and those of the Opponent ranging from at least medium to identical. I have found a medium degree of visual and aural similarity between the competing marks and that, viewed overall, there is neither significant conceptual similarity nor significant conceptual dissimilarity between them. Given my findings on the average consumer, the purchasing process, and the level of attention with which the respective services will be selected, I find that the differences between the simple two-letter combination HD and the phrase THAT HD FEELING are too great for them to be directly confused, i.e. mistaken for one another.

49) This leaves the question of indirect confusion to be considered. In this connection it is helpful to bear in mind the observations of Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, where he noted that:

“Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

50) I have found that the distinctiveness of the earlier marks overall lies within the normal range. I have further found that the distinctiveness of the simple two-letter combination HD – the common element between the competing marks – may in itself be slightly lower than the norm, but not by much. I have also found: (1) that THAT HD

FEELING will be seen as a slogan referring to an emotion (presumably positive) that will be induced by “HD” – whatever “HD” maybe; (2) that while in itself “HD” has no conceptual significance beyond that of the letter combination *per se*, the fact remains that the whole phrase THAT HD FEELING emphasizes and highlights that very letter combination as itself having some particular, albeit unspecified, significance; and (3) that, used in trade in connection with the provision of the relevant services, since HD has no immediately obvious meaning, the most natural inference would be that it is a reference to the brand itself.

51) Given my findings on the average consumer, the purchasing process and the scope for overlap of users and channels of trade in the modern market environment for the goods at issue, there is a strong likelihood that a consumer – whether a business or private consumer – who came across Mr Carr’s mark after encountering the Opponent’s, used in connection with services which I have found to be of at least medium similarity, would immediately connect the letter combination “HD” of Mr Carr’s mark with that of the Opponent. Similarly, there is a strong likelihood that a consumer who came across the Opponent’s marks after encountering Mr Carr’s would connect the “HD” of the former with that referred to in Mr Carr’s mark. The natural inference in either case would be that the competing marks are variants or sub-brands. I have already pointed out above why difference in case or font should make no material difference to the comparison in this case. In fact, however, the consumer will in any case perceive the lower case and stylisation of the Opponent’s marks as consistent with use of a variant mark. The consumer will believe that the competing marks are marks used by the same or by economically linked undertakings – that they “come from the same stable”. There will be indirect confusion. Since I have found all the contested services to have at least a medium or greater degree of similarity with those of the Opponent’s specification, it must follow that **the opposition succeeds in its entirety.**

## **Outcome**

52) **The opposition has succeeded in respect of the following services of the application, all of which were opposed, and in respect of all of which I have found a likelihood of confusion:**

**Class 35:** *Retail services and wholesale services connected with the sale of brushes, combs, hair styling appliances, skin care preparations, make-up,*

*moisturisers, body cleaning and beauty care preparations, cosmetics and cosmetic preparations, cosmetic kits, compacts containing make-up, sunscreen creams, hair treatment preparations, soaps and gels, perfumery and fragrances, nail polish, eyelashes, deodorants and antiperspirants, dentifrices and mouthwashes.*

**Class 44:** *Hairdressing; barber services; hair braiding and hair cornrowing services; beauty treatment; beauty salon services; spa services; consultancy, information and advisory services relating to all the aforesaid services.*

**53) Mr Carr's mark may therefore proceed to registration only in respect of the following services, which were not opposed in these proceedings:**

**Class 35:** *Advertising; marketing; sales promotion; business management; business administration; business information; business assistance; commercial information; information, consultancy and advisory services related to all the aforesaid services.*

## **Costs**

54) Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. The Opponent has been successful and is entitled to a contribution towards its costs. The pleadings of both parties, and the written submissions of the Applicant, were simple and brief. I hereby order Mr Justin Carr to pay High Definition Brows Limited the sum of £450. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£150
Preparing written submissions	£200

The above sum 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 27<sup>th</sup> day of March 2019**

**Martin Boyle**

**For the Registrar,**

**The Comptroller-General**