

O/328/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003310477 BY
GAIL NICHOLLS
TO REGISTER THE FOLLOWING MARK:

Federation of Master Hair Extensionists

AS A TRADE MARK IN CLASSES 26, 41 AND 44

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 413568 BY
ECOTRADE EUROPE LTD

BACKGROUND AND PLEADINGS

1. On 14 May 2018, Ms Gail Nicholls (“the applicant”) applied to register the trade mark **Federation of Master Hair Extensionists** in the UK. The application was published for opposition purposes on 1 June 2018. The applicant seeks registration for the following goods and services:

Class 26 Wigs; Hair extensions; Hair weaves; False hair; False hairpieces; hairpieces; Human hair; Human hairpieces; Synthetic hair; Synthetic hairpieces; Parts and fittings for all of the foregoing.

Class 41 Education; training; education and training in methods of hair care, hair styling and hair weaving; information and advisory and consultancy services relating to all of the foregoing.

Class 44 Hair care services; hair treatment services; hair weaving; hair restoration; hair styling; hair care services being the application of hair extensions; information and advisory and consultancy services relating to all of the foregoing.

2. The application was opposed by ECOTRADE EUROPE LTD (“the opponent”). The opposition is based upon sections 3(1)(b), 3(1)(c) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). In respect of its opposition based upon sections 3(1)(b) and 3(1)(c), the opponent states:

“The mark applied for is “Federation of Master Hair Extensionists”. A “federation” describes a group of organisations that have joined together. A “master” (as an adjective) is to someone who has great skill (in a particular area of activity). “Hair extensions” references hair attached to the hair on someone’s head to give the appearance of longer hair. The mark is not distinctive because it describes the coming together (as a federation) of those who have great skill (those who are masters) in the activity of attaching hair to someone’s head to give the appearance of longer hair (those who are hair extensionists).”

3. In respect of its opposition under section 5(2)(b) of the Act, the opponent relies on UK registration no. 3184819 for the mark **MASTER EXTENSIONIST** which was filed on 9 September 2016 and registered on 9 February 2018. The opponent relies on all services for which the earlier mark is registered:

Class 41 Education; training; education and training in methods of hair care, hair styling and hair weaving; information and advisory and consultancy services relating to all of the foregoing.

Class 44 Beauty care; beauty treatment; salon services; hair care services; hair styling; hair weaving; information and advisory and consultancy services relating to the foregoing.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made. The applicant also claims that her mark has acquired distinctiveness through use.

6. The opponent is represented by Sally Cooper, Trade Mark Attorney, and the applicant is unrepresented. The opponent filed evidence in chief in the form of the witness statement of Sally Cooper dated 10 January 2019. The applicant filed evidence in the form of a witness statement by herself dated 11 January 2019. The opponent filed evidence in reply in the form of the witness statement of Martin Williams dated 13 February 2019. This was accompanied by written submissions dated 15 February 2019. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

Opponent's Evidence in Chief

7. As noted above, the opponent's evidence in chief consists of the witness statement of Sally Cooper. Ms Cooper is a Chartered Trade Mark Attorney and is representing the opponent in these proceedings.

8. Ms Cooper has provided, within her statement, an extract from Collins English dictionary which lists two definitions for the word "federation":

"A federation is a federal country."

"A federation is a group of societies or other organizations which have joined together, usually because they share a common interest."

9. Ms Cooper has also provided within her statement an extract from Collins English dictionary which lists three definitions for the word "master":

"A servant's master is the man that he or she works for."

"A dog's master is the man or boy who owns it."

"If you say that someone is a master of a particular activity, you mean that they are extremely skilled at it."

10. A further extract from Collins dictionary is provided within Ms Cooper's statement which lists the following definition for "hair extensions":

"Synthetic or human hair attached to the hair on someone's head to give the appearance of longer hair."

11. Ms Cooper states:

“3.4 (hence) the mark is not distinctive because it describes the coming together (as a federation) of those who have great skill (who are masters) in the activity of attaching hair to someone’s head to give the appearance of longer hair (those who are hair extensionists).”

12. Ms Cooper has located a website, via the Facebook page for the Federation of Master Hair Extensionists, which has a profile page for an individual named Abigail Nicholls. Ms Cooper assumes that this is the same Ms Cooper who is the applicant in the present proceedings. The extract from the profile page provided by Ms Cooper states (about Abigail Nicholls):

“She is also the proud Founder of The Federation of Master Hair Extensionists. An elite group of Hair Extensionists from across the UK containing Celebrity Extensionists to Freelance Extensionists. The group gives access to products and methods before they are reach the market. Advanced training, guidance, help, support & encouragement to achieve success in an ever evolving industry Membership is strictly by invitation only to Extensionists recognised for their talent and skill in the art of Hair Extension application.”

Applicant’s Evidence

13. As noted above, the applicant’s evidence consists of her own witness statement, which is accompanied by 11 exhibits. Ms Nicholls confirms that her full name is Abigail Nicholls; she states that she has been a hairdresser for over 20 years.

14. The applicant has provided a screenshot of the Federation of Master Hair Extensionists Facebook page, which confirms that the page was established on 2 March 2014¹. The page is marked as being a “Secret Group”. The page description states “Exclusive membership for hair extension industry professionals to support and advice each other. Our aim is to raise industry standards by giving trained professionals access to the latest products, skills and techniques from...”. The

¹ Exhibit TM1

applicant has also provided a map identifying the location of the members of the Facebook page, which are located across the country².

15. The applicant states that the Federation of Master Hair Extensionists has been using a logo, which was created in 2013³. She states that when the logo was published on 19 November 2015, this was posted on social media by members, reaching thousands of followers. The applicant has provided screenshots of various posts on Facebook which includes posts from members discussing their involvement with the applicant which are dated between 3 April 2015 and 29 June 2017 (although the date on one of the posts is illegible)⁴. The posts include the following statements:

“Members have exclusive access to the highest quality products, education programmes and newest techniques before they are launched within the industry.”

“Thankfully, I am part of A very exclusive group that is dedicated to raising industry standards... The Federation of Master Hair Extensionists is an elite network of Hair Extension Specialists from across the UK.”

16. The last of these posts, which does not appear to have been issued by the applicant, states:

“We would like to point out that we are not in any way connected to, affiliated to or endorse the use of Beauty Works Luxury Hair Extensions.

Whilst it is nice that this company has acknowledge our name as being seen as a mark of distinction and recognised our elite members being seen as the highest in the industry, they are not a Member and people should not be misled by seeing the same term “Master Extensionist” being used on their social media accounts.”

² Exhibit TM2

³ Exhibit TM3

⁴ Exhibits TM4 to TM11

17. The applicant states that she does not generate any profit from use of the mark and her advertising is carried out by members free of charge. She states:

“The Federation of Master Hair Extensionists is predominantly a Facebook based group that at its peak had over 85 members based all across the United Kingdom, each promoting that they were a member of the group in advertising, networking and pushing their membership to current and prospective clients resulting in the Federation of Master Hair Extensionists being well recognised across the United Kingdom.”

Opponent’s Evidence in Reply

18. As noted above, the opponent’s evidence in reply consists of the witness statement of Martin Williams. Mr Williams is the Operations Manager of the opponent; a position he has held since January 2010.

19. Mr Williams notes that the applicant’s evidence creates a picture of a group which consists of elite hair extensionists; with membership being strictly by invitation only. Mr Williams notes that in her statement the applicant claims that the mark has been used in relation to various goods but also states that it is not used to generate profit. Mr Williams takes issue with this, stating that if the mark has been used in relation to goods then you would expect there to be financial records available. Mr Williams notes that the applicant has provided neither examples of the mark in use in relation to products or copies of license agreements permitting others to use the mark.

20. Mr Williams argues that the post in the applicant’s evidence which confirms that the applicant does not endorse the opponent, is an admission that there is a likelihood of confusion.

PRELIMINARY ISSUES

21. Firstly, I note that the opponent has focused its evidence on the fact that the applicant has not shown use of its mark. Further, in its written submissions, the opponent states:

“The submission is that the Registry has a discretion to take account of the above and to refuse registration on the grounds that, at the time of filing of the Application, the Application stated “that the trade mark is being used, by the Applicant or with his consent, in relation to the goods or services, or that he has a bona fide intention that it should be so used” (Trade Marks Act 1994 section 32(3)) but this was not the case.

Put another way, the Registry has a discretion to take account of all of the above and refuse to register on the grounds that the name “Federation of Master Hair Extensionists” might be a name but is not (and will not be) a trade mark.”

22. It seems to me that this line of argument is one which would be more appropriately raised under section 3(6) of the Act. However, this ground of opposition has not been pleaded. Sections 3(1)(b) and 3(1)(c) of the Act are concerned only with whether the mark in issue is, prima facie, descriptive or devoid of distinctive character. The applicant’s intention to use the mark does not come into this assessment.

23. Secondly, in her Counterstatement, the applicant states as follows:

“...Our mark has been in use continually since March 2014 which was known by the opposition before they filed for their Mark in September 2016.”

24. For the avoidance of doubt, the fact that the applicant claims to have used her mark prior to the opponent’s mark being applied for/registered, is not a defence in law to the opposition under section 5(2)(b). Tribunal Practice Notice 4/2009 explains this as follows:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

25. The applicant has not sought to invalidate the opponent's mark based on reliance on an earlier unregistered right and so her alleged prior use is not relevant to the decision I must make. The applicant's evidence of use will only be relevant insofar as it relates to whether her mark has acquired distinctiveness through use in relation to the opposition under sections 3(1)(b) and 3(1)(c).

26. Finally, the claim by the opponent that the applicant has admitted to there being a likelihood of confusion between the marks is flawed. The fact that a member has posted a statement seeking to clarify the distinction between the parties' respective marks is not reflective of the applicant's position. There is no information provided about the connection between the person responsible for this post and the applicant and I see no reason to conclude that this amounts to an admission.

DECISION

27. Section 3(1)(b) and 3(1)(c) read as follows:

"3(1) The following shall not be registered –

(a) [...]

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

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

(d) [...]

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

28. The relevant date for determining whether the mark is objectionable under sections 3(1)(b) and 3(1)(c) is the date of the application in issue – 14 May 2018.

29. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b). In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

Section 3(1)(c)

30. I will begin with the opponent’s objection under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was

set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

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

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

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods

or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

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

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

And

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

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

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

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it

will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

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

31. I accept the opponent’s submissions regarding the meaning of the words “FEDERATION” and “MASTER”. It seems to me, that the meaning of these words in this context is quite clear and will be readily understood by the average consumer for the goods and services. “EXTENSIONISTS” is a made-up word. Clearly it relates in some way to the ordinary English word extension, and the average consumer is likely to attribute a related meaning to it. However, on its own, its precise meaning is ambiguous. In contrast, when it is preceded by the word “HAIR” or used in the context of hair-related goods and services, I consider that its meaning will be apparent to the average consumer. I agree with the opponent that it is likely that the average consumer will view the term “HAIR EXTENSIONISTS” as a reference to people who undertake hair extensions.

32. With regard to the use of the word MASTER, the Tribunal Works Manual states as follows:

“Master

According to Collins Dictionary, MASTER relates to “a person with exceptional skill at a certain thing”, for example MASTER BUILDER and MASTER CRAFTSMAN. MASTER is consequently much more likely to be meaningful in relation to services rather than to goods. For example ‘MASTER BRICK’ would

be acceptable in respect of bricks, but 'MASTER BRICKLAYER' would be objectionable for building services.

A further meaning given for the word 'master' is "a machine or device that operates to control a similar one" (Collins Dictionary). The word therefore can also be used in trade to describe goods with a control function, for example, a 'MASTER CONTROL'.

As a general rule, signs containing the word 'master' should be assessed as follows:

- 'master' (alone) is acceptable for goods/services which do not have a control function (e.g. beds, or cleaning services), or for goods/services not provided by 'artisans' (that is, a worker in a skilled trade, especially one that involves making things by hand). Conversely, the word is objectionable for goods/services with a control function provided by artisans
- 'master' combined with descriptive words is acceptable for goods which do not have a control function e.g. 'MASTERBUS' or 'BUSMASTER' intended for use in respect of buses, and 'SWINGMASTER' intended for use in respect of golf clubs. However, the word is objectionable when combined with goods which do have a control function for example 'MASTERSWITCH' for electric switches, or 'MASTERKEY' for keys
- 'master' combined with a word which does not directly describe goods or services provided by an artisan is acceptable for example 'OFFICE MASTER' intended for use in respect of cleaning services. Conversely, the word is objectionable when combined with a word describing products or services provided and/or rendered by artisans for example 'MASTER PRINTERS' for printing services, or 'MASTER BAKER' for bakery services."

33. In my view, the words MASTER HAIR EXTENSIONISTS will be descriptive of people who undertake the applicant's services in class 44. However, the applicant's mark must be considered as a whole and these words in the applicant's mark are preceded by the words FEDERATION OF. In the Trade Marks Manual it states as follows:

“Organisations (names of)

Words which describe the nature of an organisation are not excluded from registration under section 3(1)(c), unless the words may also serve in trade to describe characteristics of the goods/services. For example, the sign 'NATIONAL INSTITUTE FOR THE DEAF' describes an organisation but not the services provided by it. Consequently, there is no objection under section 3(1)(c).

In contrast, the sign 'NATIONAL BREAKDOWN' (for vehicle recovery and repair) may be the name of an organisation, but may also describe a characteristics of the services that organisation provides i.e. breakdown services with national coverage. Consequently, the mark would be objectionable under section 3(1)(c).

The inclusion of words such as 'Institute', 'Foundation', 'Association' and 'Society' will generally mean that the name describes the organisation rather than goods or services. However, where the name of an association is commonplace, it will nevertheless face an objection, e.g. 'RESIDENTS ASSOCIATION' or 'HOUSING ASSOCIATION'. In this instance, because one or more of these associations would exist in most towns and cities, such signs would not indicate the goods and services of any one particular association.”

34. In my view, the same points apply to the words FEDERATION OF. For an objection to succeed under section 3(1)(c) the mark must be descriptive of the goods and services for which the mark is applied for or a characteristic of them. In this case, the applicant's mark may be descriptive of a type of organisation in the field of hair

extension based goods and services, but it is not descriptive of the goods or services themselves. The objection under section 3(1)(c) fails in its entirety.

Section 3(1)(b)

35. I now turn to the opponent's objection under section 3(1)(b). Section 3(1)(b) prevents the registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

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

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

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

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

Eurohypo v OHIM, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

36. I have already found that the applicant's mark is not descriptive under section 3(1)(c). I accept that this does not, of itself, mean that the applicant's mark cannot be objectionable under section 3(1)(b). However, descriptiveness is the only claim that the opponent has made under this ground as to why the mark is devoid of distinctive character.

37. It is clear from the case law that for a mark to possess distinctive character, it must serve to identify the goods or services in issue as originating from a particular undertaking. The use of the words "FEDERATION OF" indicate a particular organisation. I can see no reason why the mark as a whole, not being descriptive of the goods and services in issue, would be incapable of identifying those goods and services as originating from a particular undertaking. The opposition under section 3(1)(b) fails in its entirety.

Section 5(2)(b)

38. I now turn to the opponent's objection under section 5(2)(b) of the Act. Section 5(2)(b) reads 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."

39. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

"6(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered."

40. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration

process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the services it has identified.

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

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

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

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

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

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

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

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

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

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

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

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

Comparison of goods and services

42. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services
<u>Class 41</u> Education; training; education and training in methods of hair care, hair styling and hair weaving; information and advisory and consultancy services relating to all of the foregoing.	<u>Class 26</u> Wigs; Hair extensions; Hair weaves; False hair; False hairpieces; hairpieces; Human hair; Human hairpieces; Synthetic hair; Synthetic hairpieces; Parts and fittings for all of the foregoing.

<p><u>Class 44</u> Beauty care; beauty treatment; salon services; hair care services; hair styling; hair weaving; information and advisory and consultancy services relating to the foregoing.</p>	<p><u>Class 41</u> Education; training; education and training in methods of hair care, hair styling and hair weaving; information and advisory and consultancy services relating to all of the foregoing.</p> <p><u>Class 44</u> Hair care services; hair treatment services; hair weaving; hair restoration; hair styling; hair care services being the application of hair extensions; information and advisory and consultancy services relating to all of the foregoing.</p>
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43. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. 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.”

44. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) 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;
- (f) 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.

45. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

46. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

47. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“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.”

48. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

49. 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 (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated 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 the responsibility for those goods lies with the same undertaking.”

50. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

51. In its Notice of Opposition, the opponent states:

“A) The services in Class 41 of Application 3310477 copy exactly the services of Registration 3184819.

B) In Class 44 the services of Registration 3184819 cover “hair care services” and “hair styling” and “hair weaving” and “information and advisory and consultancy services relating to all of the foregoing”: these are duplicated in Application 3310477. Terms added to Application 3310477 are “hair treatment services” and “hair restoration” which are similar to (if not identical with) the services of Registration 3184819 which are “beauty care” and “beauty treatment” and “salon services” and “hair care services”.

C) The goods of Class 26 of Application 3310477 are complementary to the services of that Application in Class 41 and Class 44. The average consumer is not likely to accept an offer of the Applicant to sell goods labelled “Federation

of Master Hair Extensionists” unless that consumer has first encountered services of the Applicant labelled “Federation of Master Hair Extensionists”.”

52. In her Counterstatement, the applicant states:

“The services between the marks are similar or the same due to them both belonging to the same industry, most marks that are in this industry would use the same services as in both marks. In Class 44 we have added further marks “hair treatment services” and “hair restoration” which the opposition deem to be similar or identical to services of their registered mark, however, we strongly disagree with their statement as these are specific services that their mark is not used for and is not a service that the opposition offer in any way, shape or form.

We strongly disagree that consumers would be unlikely purchase goods labelled using our mark if they had first not encountered services labelled using our mark. We would say that Class 41 and Class 33 are complimentary to Class 26 due to the goods being purchased before any of the services in either class is carried out.”

Class 26

53. All of the applicant’s class 26 goods are products that would be used in the course of “hair care services”, “hair styling” and “hair weaving” in the opponent’s specification. They will overlap in user and uses. The goods and services will commonly be sold through the same trade channels. There may be a degree of competition in that people may choose to purchase the goods and carry out the styling themselves or they may choose to go to a salon and purchase the services. There will also be complementarity in respect of some of the goods and services. However, the goods and services will clearly be different in nature. I consider the goods and services to be similar to a medium to high degree.

Class 41

54. All of the applicant's services are reproduced identically in the opponent's specification.

Class 44

55. "Hair care services" and "hair styling" appear identically in both the applicant's and the opponent's specifications.

56. "Hair treatment services", "hair weaving", "hair restoration" and "hair care services being the application of hair extensions" in the applicant's specification all fall within the broader categories of "hair care services" and "hair styling" in the opponent's specification. These services can be considered identical on the principle outlined in *Meric*. In light of this finding, it follows that "Information and advisory and consultancy services relating to all of the foregoing" in both the applicant's specification and the opponent's specification will also be identical or, at least, highly similar.

The average consumer and the nature of the purchasing act

57. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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."

58. The average consumer for the goods will be a member of the general public or professionals in the hair styling industry. The cost of the goods and the frequency of purchase is likely to vary depending on the nature of the goods being purchased. A number of factors are likely to be taken into account when purchasing the goods such as quality, material and cost. I consider that at least an average degree of attention will be paid during the purchasing process.

59. The average consumer for the services will be a member of the general public. The cost and frequency of purchase of the services is likely to vary. Various factors will be taken into consideration such as quality and standard of service. I consider that at least an average degree of attention will be paid by the average consumer during the purchasing process.

60. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. In the case of products such as wigs, these are likely to be purchased from specialist outlets. Visual considerations are, therefore, likely to dominate the purchasing process. However, I do not discount that there will be an aural component to the purchase of the goods given that advice may be sought from a sales or retail assistant.

61. The services are likely to be purchased from specialist outlets or their online equivalent. The purchasing process for the services is likely to be dominated by visual considerations as the average consumer is likely to select the services following inspection of the premises' frontage on the high street, on websites and in advertisements (such as flyers, posters and online adverts). However, I do not discount that there will be an aural component to the selection of the services as word-of-mouth recommendations may also play a part.

Comparison of the trade marks

62. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

63. 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.

64. The respective trade marks are shown below:

Opponent's trade mark	Applicants' trade mark
MASTER EXTENSIONIST	Federation of Master Hair Extensionists

65. The applicant's mark consists of five words and the overall impression of the mark lies in the combination of these words as a unit. The opponent's mark consists of two words and the overall impression of the mark lies in the combination of these words as a unit.

66. Visually, both marks contain the words “MASTER” and “EXTENSIONIST/EXTENSIONISTS”. Clearly, there is a difference in the pluralisation of the latter word in the applicant's mark. In the applicant's mark, the word “HAIR” appears in the middle of these words and they are preceded by the words

“FEDERATION OF”. I consider the marks to be visually similar to no more than a medium degree.

67. Aurally, the marks coincide in the presence of the words “MASTER” and “EXTENSIONIST/EXTENSIONISTS”. They differ in the pluralisation of the latter word in the applicant’s mark and the addition of the words FEDERATION OF and HAIR, which have no counterpart in the opponent’s mark. I consider the marks to be aurally similar to no more than a medium degree.

68. Conceptually, the opponent’s mark MASTER EXTENSIONIST creates the impression of an individual who is a specialist in something. I recognise that there may be some people who are unfamiliar with the made-up word EXTENSIONIST, but in the context of hair styling products and services I consider it likely that the average consumer will recognise this as being a reference to someone who undertakes hair extensions. The applicant’s mark creates the impression of an organisation for people who are specialists in the same field. The marks overlap conceptually in that they are both related to the field of hair-related goods and services. However, the clear conceptual difference between the marks is a reference to one individual in the opponent’s mark and a reference to an organisation in the applicant’s mark. I consider the marks to be conceptually similar to no more than a medium degree.

Distinctive character of the earlier trade mark

69. 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-2779, 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).”

70. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

71. The opponent has filed no evidence to support a finding of enhanced distinctiveness and so I have only the inherent position to consider. In the context of the applicant’s mark, it is Ms Cooper’s evidence that the meaning of the words MASTER and EXTENSIONISTS will be identified by the average consumer. Ms Cooper states that the word MASTER refers to someone with skill in a particular area and the word EXTENSIONISTS will be identified as referring to someone engaged in the provision of hair extension services. It follows that the same meanings will be recognisable in the opponent’s own mark. As noted above, I do not consider that the absence of the word HAIR from the opponent’s mark, in the context of hair-related goods and services, will affect the average consumer’s understanding of the mark. The opponent’s mark will be seen as a reference to someone who is a specialist in the field of hair extensions. Section 72 of the Act provides that all registered marks must be attributed a degree of distinctive character and, consequently, I consider the opponent’s mark to be distinctive to only a very low degree.

Likelihood of confusion

72. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

73. I have found there to be no more than a medium degree of visual, aural and conceptual similarity between the marks. I have found the earlier mark to have a very low degree of inherent distinctive character. I have identified the average consumer for the goods and services to be a member of the general public or a professional user who will select the goods and services primarily through visual means (although I do not discount an aural component). I have concluded that at least an average degree of attention will be paid during the purchasing process. I have found the parties goods and services to vary from being similar to at least a medium degree to identical.

74. Notwithstanding the similarity/identity between the goods and services, I consider that the visual, aural and conceptual differences between the marks are sufficient to ensure that they will not be misremembered or mistakenly recalled as each other. This is particularly the case given that the average consumer will be paying at least an average degree of attention during the purchasing process. I do not consider there to be a likelihood of direct confusion.

75. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“16. 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.”

76. I have found the opponent’s mark to only have a very low degree of distinctive character. The common use of the words MASTER and EXTENSIONIST(S) in the parties’ respective marks is far more likely to be viewed by the average consumer as a use of two words which describe or allude to the field within which the different undertakings operate and the goods and services offered by them. A finding of confusion should not be made merely because two marks share a common element; it is not sufficient that one mark merely calls to mind the other⁵. Having recognised the differences between the marks, I can see no reason why the average consumer would consider the marks to originate from the same or economically linked undertakings. One is not a logical extension of the other. I consider that the very low degree of distinctiveness of the opponent’s mark and the conceptual differences between the two are sufficient to mitigate any potential for confusion. I do not consider that there is a likelihood of indirect confusion.

⁵ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

CONCLUSION

77. The opposition is unsuccessful and the application will proceed to registration.

COSTS

78. As the applicant has been successful, she would normally be entitled to a contribution towards her costs, based upon the scale published in Tribunal Practice Notice 2/2016. However, as the applicant is unrepresented, the tribunal wrote to her on 4 March 2019 and invited her to indicate whether she intended to make a request for an award of costs. The applicant was informed that, if so, she should complete a pro-forma, providing details of the actual costs incurred and accurate estimates of the amount of time spent on various activities in dealing with the opposition. The applicant was informed that “no costs, other than official fees arising from the action... will be awarded” if the pro-forma was not completed. No pro-forma was filed by the applicant. That being the case, and as no official fee has been paid by the applicant, I make no award of costs in respect of these proceedings.

Dated 10 June 2019

S WILSON

For the Registrar

