O/523/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003527004

BY KAZZHAIR UK LTD

TO REGISTER THE FOLLOWING MARK:

Microtape hair extensions

IN CLASS 26

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 421898

BY ADDITIONAL LENGTHS LTD

BACKGROUND AND PLEADINGS

1. On 26 August 2020, Kazzhair UK Ltd ("the applicant") applied to register the trade mark **Microtape hair extensions** in the UK. The application was published for opposition purposes on 9 October 2020. The applicant seeks registration for the following goods:

Class 26 Hair extensions.

2. The application was opposed by Additional Lengths Ltd ("the opponent") on 30 October 2020 . The opposition is based upon sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 ("the Act"). In its Notice of Opposition, the opponent states:

> "The mark applied for is inherently unregistrable, incapable of functioning to indicate trade origin and, therefore, application is not acceptable under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the goods i.e. hair extensions applied via small/imperceptible tape.
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> The mark lacks the capacity to indicate the origin of goods and will be perceived by the average consumer as no more than a description of them. "Tape Hair Extensions" is, as an internet search will readily disclose, a term used to describe hair extensions which are held in place on the head using tape. "Microtape Hair Extensions" is used to indicate that the tape element is small, unobtrusive and not readily visible once the hair extensions are in place.
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> Even if the term "Mictrotapes Hair Extensions" (as opposed to simply "tape hair extensions" is not demonstrably in widespread use (and for the avoidance of doubt, the Opponent submits that it is), there is a clear foreseeability issue and a genuine need to keep Microtapes Hair Extensions free; this is because there is a good chance it could become a recognised term in the UK with improvements in tape technology. Self-evidently, if the tape holding the hair extension is smaller/more discreet, then that is a favourable characteristic.

> Terms merely denoting a particular positive or appealing quality or function of the goods and services should be refused if applied for either alone or in combination with descriptive terms, as is the case here."

3. The applicant filed a counterstatement denying the claims made.

4. The opponent is represented by Haseltine Lake Kempner LLP and the applicant is unrepresented. Only the opponent filed evidence. Neither party requested a hearing and the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND SUBMISSIONS

6. The opponent's evidence in chief consists of the witness statement of Mr Christopher Morris, dated 22 February 2021, which is accompanied by 2 exhibits. Mr Morris is the Chartered Trade Mark Attorney acting on behalf of the opponent in these proceedings.

7. As noted above, the opponent also filed written submissions in lieu.

8. Whilst I do not propose to summarise it here, I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to it where necessary below.

PRELIMINARY ISSUE

9. The applicant's Form TM8 reads as follows:

"3(1)(C) non [sic] of this section applies there are no signs or indications geographical
other than there are 3 types of tape in extensions
1 wide tapes
2 mini tapes
3 micro-tapes – which are the ones we wish to trade mark".

10. The opponent in their submissions in lieu submit that the above is an admission from the applicant that micro-tapes are a type of extension, and therefore, it is a sign that is not registrable.

11. I consider that, on balance, this does appear to be an admission from the applicant. However, for the avoidance of doubt, I will consider the opposition on its merits.

DECISION

12. 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."

13. 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- 26 August 2020.

14. 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)."

The Average Consumer

15. The position under the above grounds must be assessed from the perspective of the average consumer, who will be deemed to be reasonably observant and circumspect.[1] In this case, the average consumer will consist of members of the general public and hair specialists such as hairdressers. I consider that a medium degree of attention will be paid for the goods at issue as the average consumer will consider factors such as ease of use, quality, and price during the purchasing process.

Section 3(1)(c)

16. 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

[1] *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

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:
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> > "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 I2779, 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]."

17. In reaching my decision, I bear in mind that the opponent relies on a previous decision of this Tribunal, MICRO MEDITATION (O/502/20), whereby the term micro in combination with meditation was found to be 'purely descriptive as a whole'.

18. The opponent argues that the words 'hair extensions' are entirely descriptive as the goods covered by the applicant's mark are hair extensions. The opponent submitted examples of tape-in hair extensions in exhibit CM1 from the opponent's own website, Beauty Works and a Byrdie article from 17 September 2020 listing the best 9 tape-in extensions that won't damage your hair. I note that the article is dated after the relevant date. However, I also note that this is less than a month afterwards and, given that the article is referring to the 'best' tape-in extensions, the goods will inevitably have been on the market for sometime prior to being written.

19. The opponent states that the relevant consumer, who is familiar with tape in hair extensions, "will immediately perceive **Microtape hair extension** as relating to a type of tape hair extension with a particularly "small or reduced in size" piece of tape, for applying the individual extension". They further submit that although it isn't necessary for it to be shown, there is already descriptive use of this mark. In exhibit CM2 the opponent does provide examples of microtape/micro tape being used in a descriptive manner, however, the majority of this evidence does fall after the relevant date.

Nonetheless, I see no reason to conclude that the position would have been any different prior to the relevant date. In any event, there is an element to futurity to the assessment section under 3(1)(c), in that it will be sufficient if the mark could be used in such a way. The lack of evidence prior the relevant date of such use is not, therefore, fatal to the opposition.

Conclusions

20. I agree with the opponent that the 'hair extensions' element of the applicant's mark is self-evidently entirely descriptive of their goods.

21. Microtape is a combination of two ordinary dictionary words: 'micro' and 'tape'. Micro is used to form nouns which refer to something that is very small.[2] Tape is known as a strip of plastic which is used to stick things together.[3] I do not consider that combining these words creates a meaning which is more than the sum of its parts.[4] Therefore, the mark as a whole will be understood as hair extensions which use smaller strips of tape which is used to be stuck and attached to the hair. I consider that this mark, therefore, consists exclusively of signs which are descriptive within the trade. I consider that due to the wholly descriptive nature of the mark, it does not fulfil the essential function of a trade mark i.e. to indicate trade origin and should be kept free for the legitimate use of other traders.

22. The opposition under section 3(1)(c), therefore, succeeds.

Section 3(1)(b)

23. I now turn to the opposition based upon section 3(1)(b). I note the Form TM7 does not appear to set out any independent basis for the opposition under this ground, other than the arguments set out above regarding the descriptive nature of the mark.

[2] https://www.collinsdictionary.com/dictionary/english/micro
[3] https://www.collinsdictionary.com/dictionary/english/tape (uncountable noun)
[4] *Campina Melkunie BV and Benelux-Merkenbureau, Case C-265/00*

24. Section 3(1)(b) prevents 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).
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> 30. Under that provision, marks which are devoid of any distinctive character are not to be registered.
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> 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).
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> 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)."

25. As previously established, I have found that when viewing the applicant's mark, the average consumer will understand that the goods are hair extensions which use smaller pieces of tape to attach them to the hair. I have already found that the applicant's mark is wholly descriptive under section 3(1)(c) and, therefore, it lacks the required distinctiveness to avoid objection under section 3(1)(b). Consequently, I consider that the applicant's mark, when used on the goods for which the mark is applied for, will not be viewed as indicative of trade origin due to its descriptive nature and will, therefore, be non-distinctive.

26. The opposition under section 3(1)(b), therefore, succeeds.

CONCLUSION

27. The opposition is successful in its entirety and the application is refused.

COSTS

28. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£800** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Preparing evidence and written submissions	£400
Official Fee	£200
Total	**£800**

29. I therefore order Kazzhair UK Ltd to pay Additional Lengths Ltd the sum of £800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 9th day of July 2021

L FAYTER

For the Registrar