

O/550/21

TRADE MARKS ACT 1994

**CONSOLIDATED PROCEEDINGS**

IN THE MATTER OF APPLICATION NO. UK00003348745

BY FIT & GLOW HEALTHCARE PRIVATE LIMITED

IN CLASSES 3 AND 5

AND IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 415858

BY FEDERICI BRANDS LLC

AND IN THE MATTER OF REGISTRATION NO. UK00003310772

IN THE NAME OF FEDERICI BRANDS LLC

IN CLASS 3

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 502989 BY FIT & GLOW HEALTHCARE PRIVATE LIMITED

AND IN THE MATTER OF REGISTRATION NO. UK00003310606

IN THE NAME OF FIT & GLOW HEALTHCARE PRIVATE LIMITED

IN CLASSES 3 AND 5

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THEREO

UNDER NO. 503076 BY FEDERICI BRANDS LLC

## BACKGROUND AND PLEADINGS

1. On 26 October 2018, Fit & Glow Healthcare Private Limited (“F&G”) applied to register the following trade mark in the UK under application no. 3348745:



(“the 745 Mark”)

2. The 745 Mark was published for opposition purposes on 21 December 2018 and registration is sought for the following goods:

Class 3      Non-medicated care preparations, namely, creams, lotion, gels, toners; face and body creams; beauty creams; non-medicated skin creams; body scrubs; facial masks.

Class 5      Acne treatment preparations.

3. On 21 March 2019, Federici Brands LLC (“Federici”) opposed the application based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Under sections 5(1) and 5(2)(a), Federici relies on the following trade mark:

WOW/wow (series of 2)

UKTM no. 3310772

Filing date 15 May 2018; registration date 31 August 2018

Relying on all goods for which the mark is registered, namely:

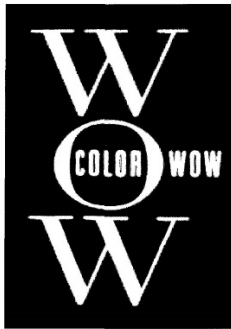
Class 3      Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and

bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair; hair serums; neutralizing hair preparations; hair colour removers.

(“the 772 Mark”)

4. The section 5(1) opposition is directed against “non-medicated care preparations, namely, creams, lotions, gels, toners” only. The section 5(2)(a) opposition is directed against the application in its entirety.

5. Under section 5(2)(b), Federici relies upon the 772 Mark and the following trade mark:<sup>1</sup>



EUTM no. 13911458<sup>2</sup>

Filing date 26 June 2015; registration date 16 October 2015

Relying on all goods for which the mark is registered, namely:

Class 3 Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a

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<sup>1</sup> Federici applied to amend its pleading to include reliance upon the 772 Mark for the purposes of the section 5(2)(b) opposition. I granted the application at a hearing on 14 February 2020.

<sup>2</sup> Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

colouring effect; hair sprays all having a colouring effect for use in styling the hair.

("the 458 Mark")

6. Federici claims that the marks are identical or similar and that the goods are identical or similar resulting in a likelihood of confusion under sections 5(2)(a) and (b). Further, Federici claims that the 772 Mark is identical to the 745 Mark, and that they are applied/registered for identical goods, with the effect that the application offends under section 5(1) of the Act.

7. F&G filed a counterstatement denying the claims made.

8. On 14 January 2020, F&G applied to invalidate the 772 Mark pursuant to section 47 of the Act. The application is based upon section 5(2)(b) of the Act. F&G relies upon the following trade mark:

BUYWOW

UKTM no. 3310606

Filing date 14 May 2018; registration date 3 August 2018

Partial priority claimed 13 November 2017 (United States of America)

Relying upon all goods for which the mark is registered, namely:

Class 3      Essential oils; hair removal lotion; creams, gels, serums; non-medicated feminine hygiene wash; non-medicated cleansers for intimate personal hygiene purposes; shampoo.

Class 5      Dietary and nutritional supplements; acne preparations.

("the 606 Mark")

9. F&G claims that the marks are similar and the goods are identical or similar, resulting in a likelihood of confusion.

10. Federici filed a counterstatement denying the claims made.

11. On 27 March 2020, Federici applied to invalidate the 606 Mark pursuant to section 47 of the Act. The application is based upon sections 5(2)(b) and 5(4)(a) of the Act. Under section 5(2)(b) of the Act, Federici relies upon the following trade mark:

COLOR WOW

UKTM no. 2612013

Filing date 28 February 2012; registration date 8 June 2012

Relying on all goods for which the mark is registered, namely:

Class 3      Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; hair care preparations; hair coloring preparations; hair colorants; hair dyes; hair lotions; hairspray, conditioner, shampoo; color cosmetics; facial cosmetics; skin care products; body and foot care products; fragrances; bath salts, cosmetic preparations for baths; body and shower products; colognes; eau de toilettes; body firming gels and lotions; face creams; nail polishes; lipsticks; makeup; sun block and deodorants.

(“the 013 Mark”)

12. Federici claims that there is a likelihood of confusion because the marks are similar, and the goods are identical or similar.

13. Under section 5(4)(a) of the Act, Federici relies upon the sign **COLOR WOW** which it claims to have used throughout the UK since 22 October 2012 in respect of:

“Soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices; hair care preparations; hair coloring preparations; hair colorants; hair dyes; hair lotions; hairspray, conditioner, shampoo; color cosmetics; facial cosmetics; skin care products; body and foot care products; fragrances; bath salts, cosmetic preparations for baths; body and shower products; colognes; eau de toilettes; body firming gels and lotions; face creams; nail polishes; lipsticks; makeup; sun block and deodorants.”

14. F&G filed a counterstatement denying the claims made and putting Federici to proof of use of the 013 Mark.

15. A hearing took place before me on 16 June 2021, by video conference. F&G were represented by Ms Georgina Messenger, of Counsel, instructed by Bird & Bird LLP. Federici were represented by Mr Edward Bragiel, of Counsel, instructed by Antinghams Solicitors. Both filed skeleton arguments in advance of the hearing.

## **EVIDENCE**

16. Only Federici filed evidence; this took the form of the witness statement of James Federici dated 8 February 2021. Mr Federici is the Vice President and General Counsel for Federici and his statement is accompanied by 12 exhibits.

17. I do not propose to summarise the evidence here, nor will I summarise the parties' submissions. However, I have taken them all into consideration and will refer to them below where necessary.

## **DECISION**

18. Sections 5(1), 5(2) and 5(4)(a) have application in invalidation proceedings pursuant to section 47 of the Act. Section 47 reads as follows:

“47(1) [...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground –

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) [...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered –

(i) within the period of 5 years ending with the date of application for the declaration; and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) [...]

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection 2B or 2C to the United Kingdom shall be construed as a reference to the European Union.

(2DA) [...]

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c).

[...]

(5) Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) [...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall be deemed never to have been made.

Provided that this shall not affect transactions past and closed.”

19. 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 upon 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.



## **Application to invalidate the 606 Mark**

20. The parties are in agreement that, given the consequences of this invalidation for the other consolidated cases, it is here that I should begin my assessment.

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

21. Section 5(2)(b) of the Act 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.”

22. By virtue of its earlier filing date, the 013 Mark qualifies as an earlier trade mark pursuant to section 6 of the Act. As the 013 Mark had completed its registration process more than five years before the date of the application for invalidity, the 013 Mark is subject to proof of use pursuant to the sections 47(2A)-(2E) of the Act.

### **Proof of Use**

23. The first issue I must consider is whether, or to what extent, Federici has shown genuine use of the 013 Mark.

24. I bear in mind section 100 of the Act, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

25. Pursuant to section 47(2B) of the Act, there are two relevant periods for assessing whether there has been genuine use of the 013 Mark: 1) the five-year period ending with the date of the application for invalidity i.e. 28 March 2015 to 27 March 2020 and 2) the five-year period ending with the priority date for the 606 Mark i.e. 14 November 2012 to 13 November 2017.<sup>3</sup>

26. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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<sup>3</sup> I note that the parties made submissions on the basis that the first relevant period ended on 24 March 2020, rather than 27 March 2020. This cannot be the correct date as the Form TM26(I) was dated 25 March 2020 and the covering letter under which it was filed was dated 26 March 2020. Nothing turns on this point and, as the Tribunal record shows that the application was not filed until 27 March 2020, it is upon this date that I will base my assessment.

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark,

including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

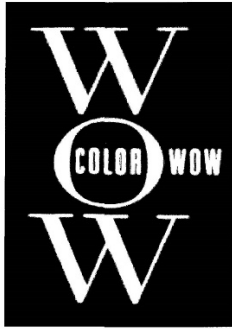
(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

27. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

#### *Form of the mark and genuine use*

28. The 013 Mark appears in the evidence as registered. Clearly, this will be use upon which Federici can rely. There are also examples of use of the following mark:



29. Ms Messenger submitted that use of this mark could not be relied upon as use of the 013 Mark; she submitted that the words COLOR WOW are simply part of the figurative element and do not retain any independent significance within the above sign. However, in my view, the words 'COLOR WOW' in the above sign appear as registered and continue to indicate origin as per *Colloseum*.<sup>4</sup> Consequently, this is use upon which Federici may rely.

30. I bear in mind that an assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>5</sup>

31. Mr Federici confirms that Federici have sold COLOR WOW products in the UK since 2012. He states that the products sold include shampoos, conditioners, hair styling products, volumizers, styling treatments, hydrating treatments, mineral removers, styling foams and mousses, anti-frizz treatments, curl enhancing treatments, hair shine sprays and treatments, hairsprays, texturizing sprays and root cover up hair colouring products.

32. Mr Federici states that Federici's website has been accessible in the UK since 2013. Mr Federici has provided print outs from Federici's website from after the relevant date.<sup>6</sup> These display conditioners, pre-shampoo mineral remover, toning and styling foam, shine spray, smoothing creams and serums, hairspray, thickening treatments, blow dry spray and root cover-ups. Mr Federici states that "most" of these

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<sup>4</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

<sup>5</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

<sup>6</sup> Exhibit JF2

products have been available for sale from the website since 2013. However, dated print outs of the website from before the relevant date do not display any identifiable products (the text on the images is too small to read).<sup>7</sup> Further, Mr Federici does not state how many of each of these products have actually been sold.

33. Mr Federici states that Federici's products are also available for sale through a number of UK stockists including Marks & Spencer (since 2017), Harvey Nichols (since 2014), Toni & Guy (since 2014) and QVC. Mr Federici has provided a copy of an invoice which he believes to be the first UK sale of COLOR WOW products.<sup>8</sup> The invoice is dated 22 October 2012 and is for the sum of £87,360. I note that this pre-dates both relevant periods. Mr Federici has also provided print outs from the websites of some of Federici's stockists which show various products.<sup>9</sup> However, none of these print outs are dated.

34. Mr Federici gives the UK sales for COLOR WOW products as:

2013	\$1,147,233
2014	\$2,971,895
2015	\$3,891,420
2016	\$2,756,151
2017	\$1,756,151
2018	\$4,398,779

35. Mr Federici has given examples of total sales per month, which are broken down by product code.<sup>10</sup> I note that some of these display the code "CW" which Mr Federici states is the code for COLOR WOW products. Whilst it is not entirely clear what products each entry relates to, I note that Mr Federici has provided some explanation to assist in identifying certain products. For example, he states that "RCU" means 'root cover up', "DC" means 'dream coat' and "OMT" means 'one-minute transformation'. The print outs from the Marks & Spencer website (albeit they are undated) show

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<sup>7</sup> Exhibit JF3

<sup>8</sup> Exhibit JF4

<sup>9</sup> Exhibit JF5

<sup>10</sup> Exhibit JF6

‘dream coat’ products in the form of hair sprays and the Harvey Nichols website appears to show some sort of treatment cream or mask. It is not, therefore, entirely clear to me to which category of products the ‘dream coat’ sales relate. Federici’s website, although not dated, indicates the ‘one-minute transformation’ is a type of conditioning treatment for hair.<sup>11</sup> The sales broken down by product relate only to 2012 and 2013. I note that some of the products appear to have been sold for no value. I recognise that the fact that goods/services are provided free of charge does not of itself mean that there has been no commercial use.<sup>12</sup> However, in this case it is clear that Federici’s goods are usually sold for a price and, in the absence of any explanation provided as to why these goods have not been attributed a price, it is difficult for me to assess whether this qualifies as commercial use of the mark. Of those that are clearly dated during the relevant period and to which a value has been attributed, I note the following sales (it is not clear whether these are in GBP):

Blow-dry spray	990.72
One-minute transformation	21,356.60
Shampoo/conditioner	6,796.11
Root cover ups	34,648.51

36. I note that Federici has won a number of awards in the UK.<sup>13</sup> Not all of them are dated. However, of those that are dated, I note the following:

<i>Hair Magazine</i>	“Best Professional Shampoo”	2015
<i>Glamour</i>	“Beauty Power List” for ‘root cover up’	2015
<i>Woman</i>	“Best Root Coverage” for ‘root cover up’	2015
<i>Hair Magazine</i>	“Best Shampoo and Conditioner”	2016
<i>Hair 2017</i>	“Best Smoothing/Straightening” for ‘One-minute transformation’	2017
<i>Woman and Home</i>	“Best in Hair Care” for ‘root cover up’	2018
<i>Glamour</i>	“Best Colour Touch Up” for ‘root cover up’	2018

<sup>11</sup> Exhibit JF2

<sup>12</sup> *Antartica Srl v OHIM, The Nasdaq Stock Market, Inc.* Case C-320/07 P

<sup>13</sup> Exhibit JF8

37. Mr Federici notes that Federici's products have been advertised through newspapers, magazines and TV commercials (including Channel 4 in 2016). Federici's marketing spend in the UK is as follows:

2013	£134,246.81
2014	£247,396.06
2015	£405,072.96
2016	£424,404.76
2017	£328,071.18
2018	£482,777.23

38. Mr Federici notes that Federici also promotes its COLOR WOW products through social media. This includes Facebook (81,571 followers as of August 2012), Instagram (216,000 followers as of March 2013) and Twitter (4,693 followers as of August 2012).<sup>14</sup> However, I note that it is not clear where all of these followers are located.

39. Clearly, there are issues with Federici's evidence. For example, the overall turnover figures provided are not broken down by product. Further, I note that the use which relates specifically to the blow dry spray is very limited. I note that the broken down sales figures provided relate to the earlier relevant period only. However, it is clear from the awards won by Federici that those sales have continued into the later relevant period. It is important to view the evidence in the round. On balance, I am satisfied that Federici has demonstrated genuine use during both relevant periods in relation to shampoos, conditioners and hair colourants.

#### *Fair Specification*

40. I must now consider whether, or the extent to which, the evidence shows use of the 013 Mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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<sup>14</sup> Exhibit JF11



“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

41. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

42. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 (Court of Appeal), a case which concerned pharmaceutical substances and preparations, Kitchen LJ held that it was well established that (1) a category of goods/services may contain numerous subcategories capable of being viewed independently and, (2) the purpose and intended use of a pharmaceutical product are of particular importance in identifying the subcategory to which it belongs.

43. Clearly, Federici will be able to rely upon “hair coloring preparations”, “hair colorants”, “hair dyes”, “conditioner” and “shampoos”. I also consider that the goods in respect of which they have shown use (i.e. shampoo, conditioner and hair colorants) will enable them to rely upon the broader categories of “hair lotions” and “hair care preparations”.

44. In his skeleton argument, Mr Bragiel accepted that there was no use in relation to “soaps”, “perfumery”, “essential oils”, “dentifrices”, “facial cosmetics”, “body and foot care products”, “fragrances”, “bath salts”, “cosmetic preparations for baths”, “colognes”, “eau de toilettes”, “body firming gels and lotions”, “face creams”, “nail polishes”, “lipsticks”, “makeup”, “sunblock” or “deodorant”.

45. I also do not consider there to be sufficient use in relation to “hairspray” for Federici to be able to rely on that term.

46. Mr Bragiel submitted that the hair care products shown in Federici's evidence are a type of cosmetic and that they should, therefore, be able to retain the terms "cosmetics" and "color cosmetics". In this regard, Mr Bragiel quoted the Shorter Oxford Dictionary which defines cosmetics as "preparation[s] for beautifying the hair, skin or complexion". Ms Messenger took issue with the inclusion of this definition on the basis that Mr Bragiel was giving evidence; however, nothing turns on this. The Collins English Dictionary, to which I referred, makes no reference to hair and defines cosmetics as "beauty preparations; make-up". Whilst the dictionary definitions for such words are relevant, as Ms Messenger noted at the hearing, what I must decide is how these categories would be perceived by the average consumer. I am not convinced that the average consumer would view hair care products as falling within the term cosmetics. In my view, the average consumer is more likely to perceive cosmetics as products for the face and complexion such as make-up or skincare. However, even if they do, these are such broad terms that they would include a range of products and I consider the hair care products outlined above to be appropriate sub-categories of these terms.

47. Similarly, Mr Bragiel submitted that 1) hair is part of the skin and, consequently, products for use on the hair can be said to also be for use on the skin and/or 2) products for use on hair are also used on the scalp (which is part of the skin). Consequently, Mr Bragiel submitted that these goods should also be considered "skin care products". Ms Messenger submitted that hair is not part of the skin (it may grow out of the skin but is entirely different) and that there is little or no evidence relating to use on the scalp. I think it unlikely that the average consumer would view the hair care products outlined above to fall within this broader category. Even if that is incorrect, I do not consider that Federici has shown use across a broad enough range of goods to justify reliance upon the broad term "skin care products". Mr Bragiel submitted that shampoo and conditioner are clearly "body and shower products". Even if that is correct, hair products would, again, be an appropriate sub-category in their own right.

48. I have borne in mind Ms Messenger's submission that Federici's use is limited to products used for coloured hair. Certainly, some of the products are clearly aimed at coloured hair. However, I cannot with certainty say that that is always the case on the evidence before me. I also note that, for example, Federici have won awards in the

general category of “Best Shampoo” as opposed to “Best Shampoo [for coloured hair]”. In any event, I do not consider that anything will turn on this.

49. Taking all of this into consideration, I consider a fair specification to be:

Class 3      Hair lotions; hair care preparations; hair coloring preparations; hair colorants; hair dyes; conditioner, shampoo.

Section 5(2)(b) – case law

50. 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

51. In light of my findings above, the competing goods are as follows:

<b>Federici's Goods (the cancellation applicant)</b>	<b>F&amp;G's goods (the proprietor)</b>
<u>Class 3</u> Hair lotions; hair care preparations; hair coloring preparations; hair colorants; hair dyes; conditioner, shampoo.	<u>Class 3</u> Essential oils; hair removal lotion; creams, gels, serums; non-medicated feminine hygiene wash; non-medicated cleansers for intimate personal hygiene purposes; shampoo.  <u>Class 5</u> Dietary and nutritional supplements; acne preparations.

52. In the *Treat* case, [1996] R.P.C. 281, Jacob J. (as he then was) identified the following factors for assessing similarity:

- (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.

53. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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.”

#### *Essential oils*

54. In her skeleton argument, Ms Messenger accepted that these goods were similar to Federici’s “hair coloring preparations”, “hair colorants” and “hair dyes” to a medium degree. I will proceed on this basis as my assessment would not be more favourable to Federici given the differences in nature, trade channels and purpose.

#### *Hair removal lotion*

55. I have considered whether “hair removal lotion” is identical to “hair lotion”. However, I do not consider that it is. This is because the average consumer will generally consider hair lotion to be something that is added to hair (such as a serum or conditioner) intended to improve the hair’s appearance or condition; they will not think of it as something intended to remove the hair. For the same reasons, I consider the purpose of the goods to differ (one being to improve its condition and/or appearance and the other being to remove it). There will be some limited overlap in method of use, as both may be applied as a cream to hair. There may be some overlap in terms of nature, as both may take the form of creams, although I recognise that their respective ingredients and properties will differ. There may be some limited overlap in trade channels. The users will be the same. They are neither in competition, nor complementary. Taking all of this into account, I consider the goods to be similar to a medium degree.

### *Creams, gels, serums*

56. In my view, these terms are identical on the principle outlined in *Meric* to “hair lotions” and “hair care preparations” in Federici’s specification, as they can all relate to products used on the hair.

### *Non-medicated feminine hygiene wash; Non-medicated cleansers for intimate personal hygiene purposes*

57. The purpose of these goods is cleaning the body; the purpose of “shampoo” in Federici’s specification is to clean the hair. Consequently, to the extent that they are both used for cleaning there will be overlap in purpose. However, the purpose differs to the extent that they are both intended for use on different parts of the body. The method of use and nature may overlap as both are likely to take the form of creams or gels which are applied to the relevant part of the body/hair. There may be some limited overlap in trade channels, such as pharmacies. They are neither in competition nor complementary. Taking all of this into consideration, I consider the goods to be similar to a medium degree.

### *Shampoo*

58. This term appears identically in both specifications.

### *Dietary and nutritional supplements*

59. The purpose of these goods is to supplement the user’s diet, normally by adding particular vitamins or nutrients. These differ to the purpose of Federici’s goods which is the cleaning, conditioning or colouring of hair. The method of use will differ, as one will typically take the form of a consumable and the other will take the form of a cream or gel. The nature will also differ for the same reason. At the hearing, Mr Bragiel submitted that there may be overlap in trade channels as businesses that specialise in, for example, hair conditioner, may bring out a particular supplement intended to improve the quality of the user’s hair. However, in the absence of any evidence on this point, I consider it unlikely that they will be sold by the same businesses. They are



neither in competition nor complementary. I recognise that there may be overlap in user, but that is not enough on its own for a finding of similarity. Taking all of this into account, I consider the goods to be dissimilar.

#### *Acne preparations*

60. At the hearing, Mr Bragiel submitted that the purpose of these goods is to make the user look better. However, whilst that may be an effect, it is ultimately a medical preparation that is used for the treatment of a particular condition. That is different, in my view, to goods that are used for more general cleaning or conditioning. The goods may all take the form of creams, but their ingredients are likely to differ significantly given the medical nature of acne preparations. Any overlap in nature and method of use will, therefore, be limited. There may be some limited overlap in trade channels, as both may be sold through pharmacies. However, they are likely to be sold in entirely different sections. There may be overlap in user to the extent that they may be used by members of the general public. They are neither in competition nor complementary. Taking all of this into account, I consider the goods to be dissimilar.

61. As some degree of similarity is required for there to be a likelihood of confusion, the application must fail in respect of those goods that I have found to be dissimilar, namely:

Class 5      Dietary and nutritional supplements; acne preparations.

However, for the sake of completeness, I will go on to consider the position if my finding that these goods are dissimilar is incorrect and they are, in fact, similar to a low degree.

#### The average consumer and the nature of the purchasing act

62. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods 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.”

63. Federici submits that the average consumer will be a member of the general public. In my view, the goods may be purchased by members of the general public or hair stylists. The cost of the purchase is likely to be reasonably low and relatively frequent. However, given that the goods will be applied to the hair/body, the average consumer is likely to take factors such as allergies and ingredients into account when purchasing the goods. They may also take into account factors such as fragrance and suitability for skin/hair type. Consequently, I consider that a medium degree of attention will be paid during the purchasing process for the goods.

64. The goods are likely to be purchased by self-selection from the shelves of a retail outlet or their online or catalogue equivalents. The purchasing process is, therefore, likely to be predominantly visual. However, I do not discount that aural considerations will also play a part given that advice may be sought from retail assistants.

#### Comparison of trade marks

65. 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.”

66. 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.

67. The respective trade marks are shown below:

Federici's trade mark	F&G's trade mark
<p style="text-align: center;">COLOR WOW</p> <p style="text-align: center;">(the 013 Mark)</p>	<p style="text-align: center;">BUYWOW</p> <p style="text-align: center;">(the 606 Mark)</p>

68. The 013 Mark consists of the ordinary dictionary words COLOR WOW. I recognise that Federici's specification is not limited to products for use on coloured hair. However, in my view, the word COLOR when used on hair products is likely to be viewed by the average consumer as descriptive of the goods for the reasons set out below and is unlikely to be attributed any trade mark significance. In my view, the word WOW will be attributed some distinctive character (albeit low). I accept that the word COLOR appears first and is, therefore, in a more prominent position than the word WOW. Consequently, I accept that COLOR makes more than a negligible contribution to the overall impression. However, I find that the word WOW is the dominant and distinctive element of the mark. Similarly, the 606 Mark consists of the conjoined dictionary words BUYWOW. The word BUY will be perceived by average consumers

as an instruction to the purchaser i.e. that they should buy 'WOW' products. Consequently, I do not consider the word BUY will be attributed any trade mark significance. However, again, I note its positioning in the mark and do not consider that it will be negligible. For the same reasons, I consider both words will contribute to the overall impression, but the word WOW will be the dominant and distinctive element of the 606 Mark.

69. Visually, the marks overlap in the last word of both marks i.e. the word WOW. They differ in the presence of the first word in both marks – COLOR in the 013 Mark and BUY in the 606 Mark. I consider the marks to be visually similar to a medium degree.

70. Aurally, the words in both marks will be given their ordinary English pronunciation. The pronunciation of the word WOW will be identical in both marks. However, they will differ in the pronunciation of the first word in both marks. I consider the marks to be aurally similar to a medium degree.

71. Conceptually, the marks differ in the presence of the words BUY and COLOR which clearly have different meanings and create a difference to the meaning of the marks as a whole. They overlap in the presence of the word WOW which is an exclamation that someone is surprised, impressed or pleased.<sup>15</sup> I recognise that this word is laudatory. I consider the marks to be conceptually highly similar, with the only differences being non-distinctive.

#### Distinctive character of the earlier trade mark

72. 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

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<sup>15</sup> <https://www.collinsdictionary.com/dictionary/english/wow>

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).”

73. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

74. I will begin by assessing the inherent distinctiveness of the earlier mark. Mr Bragieli submitted that the earlier mark is distinctive to a higher than average degree. Ms Messenger submitted that the earlier mark is low in distinctiveness. I agree with the latter position. The goods for which Federici has demonstrated proof of use are all hair products. I recognise that the specification for these goods is not limited to those for use on coloured hair. However, in the context of hair products, I consider that the average consumer is likely to perceive the word COLOR as indicating goods that are compatible for use with coloured hair. It is, therefore, descriptive. The word WOW will be viewed as laudatory and, consequently, is low in inherent distinctiveness. Taking all of this into account, I consider Federici’s mark to be inherently distinctive to a low degree.

75. Federici has filed evidence of use and, consequently, I will consider whether its mark has acquired enhanced distinctive character through use. I have summarised Federici's evidence of use above. There has been use in the UK over a number of years, including sales through national retailers indicating that sales are likely to have been geographically widespread. Federici's turnover figures are not insignificant. Federici has won awards for its colouring, shampoo and conditioner products. An article from *The Sunday Times* dated 7 July 2013 refers to Federici's COLOR WOW root cover up products.<sup>16</sup> There is also mention of the associated styling cream and shampoos. Mr Federici has provided further examples of publications which refer to the COLOR WOW mark dated between February 2016 and April 2019.<sup>17</sup> These include *Glamour*, *The Salon Magazine*, *Telegraph Magazine*, *Pick Me Up*, *Woman's Weekly*, *Marie Claire*, *Woman's Own*, *Sainsbury's Magazine*, *The Telegraph*, *Country Living*, *Hello!*, *Grazia* and *Daily Mail*. These refer to the opponent's shampoo, conditioner and root touch up products.

76. Taking all of this into account, I consider that the distinctive character of Federici's mark has been enhanced through use to a medium degree in respect of shampoo, conditioner and hair colourants.

#### Likelihood of confusion

77. 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 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 vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier

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<sup>16</sup> Exhibit JF4

<sup>17</sup> Exhibit JF7

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.

78. I have found the marks to be visually and aurally similar to a medium degree. I have found the marks to be conceptually highly similar, with the only differences being non-distinctive. I have found the earlier mark to be inherently distinctive to a low degree, which has been enhanced through use to a medium degree. I have identified the average consumer to be a member of the general public or a professional who will pay a medium degree of attention when selecting the goods. I have found the purchasing process to be predominantly visual, although I do not discount an aural component. I will proceed on the basis that the goods vary from being similar to a low degree to identical.

79. I do not consider that the words COLOR and BUY will be overlooked or misremembered by the average consumer. I recognise that a finding of indirect confusion should not be made merely because two marks share a common element.<sup>18</sup> However, in my view, given that both COLOR and BUY lack distinctiveness for the goods in issue and, consequently, the word WOW is the dominant and distinctive element of both marks, it is likely that the average consumer will perceive both marks as originating from the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion for all those goods that I have found to be similar to at least a medium degree. In respect of those goods that are similar to a low degree, I consider that the distance between the goods will offset the similarity of the marks and there will be no likelihood of confusion.

80. For the avoidance of doubt, as a low degree of distinctiveness does not preclude a likelihood of confusion, my finding would have been the same even if I had found there to be no enhanced distinctiveness.<sup>19</sup>

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<sup>18</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

<sup>19</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

81. The application for invalidation based upon section 5(2)(b) of the Act against the 606 Mark succeeds in relation to the following goods:

Class 3      Essential oils; hair removal lotion; creams, gels, serums; non-medicated feminine hygiene wash; non-medicated cleansers for intimate personal hygiene purposes; shampoo.

82. The application for invalidation against the 606 Mark based upon section 5(2)(b) of the Act fails in relation to the following goods:

Class 5      Dietary and nutritional supplements; acne preparations.

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

83. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

84. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of



application for registration of the trade mark or date of the priority claimed for that application.”

85. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

86. F&G has filed no evidence of use. Consequently, I need only consider the position at the prima facie relevant date i.e. the priority date of 13 November 2017.

### Goodwill

87. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

88. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

89. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

90. Goodwill arises as a result of trading activities. I have summarised Federici's evidence of use above. Clearly, they have been trading in the UK for a number of years. The evidence shows use in relation to shampoo, conditioner and hair colourants. In my view, the evidence is sufficient to prove a reasonable, and protectable, goodwill at the relevant date in relation to these goods. The sign relied upon was distinctive of that goodwill at the relevant date.

### Misrepresentation and damage

91. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of*

*London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

92. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails ‘deception of a substantial number of members of the public’ rather than ‘confusion of the average consumer’. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here. I consider that in respect of those goods that I have found to be similar to a medium degree or higher, a substantial number of members of the relevant public would be misled into purchasing F&G’s goods in the mistaken belief that they are the goods of Federici. Damage through diversion of sales is easily foreseeable.

93. However, I do not consider that the same applies in respect of those goods that I have found to be similar to only a low degree or dissimilar. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). However, the closeness of the parties’ respective fields is a factor which must be taken into account. I recognise that Federici has established a reasonable degree of goodwill. However, where F&G’s goods are similar to Federici’s goods to only a low degree (or are dissimilar) I consider that this distance will offset the similarities between the marks. In my view, the distance between the respective fields of activity will avoid consumers purchasing F&G’s goods in the mistaken belief that they are the goods of Federici.

94. The application for invalidation based upon section 5(4)(a) of the Act against the 606 Mark succeeds in relation to the following goods:

Class 3      Essential oils; hair removal lotion; creams, gels, serums; non-medicated feminine hygiene wash; non-medicated cleansers for intimate personal hygiene purposes; shampoo.

95. The application for invalidation against the 606 Mark based upon section 5(4)(a) of the Act fails in relation to the following goods:

Class 5      Dietary and nutritional supplements; acne preparations.

**Application to invalidate the 772 Mark**

96. F&G's application to invalidate the 772 Mark is based upon section 5(2)(b) of the Act. I have set out the relevant legislation above.

97. The application is based upon the 606 Mark. Given its earlier filing date, the 606 Mark qualifies as an earlier mark pursuant to section 6 of the Act. Given its registration date, the 606 Mark is not subject to the proof of use provisions set out in section 47 (above).

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

98. I have set out the principles relevant to an assessment under section 5(2)(b) above and will apply the same here.

**Comparison of goods**

99. As the result of my decision in relation to the first invalidation to partially invalidate the 606 Mark, F&G may only rely upon the goods for which I have found its registration to be valid. Consequently, the competing goods are as follows:

<b>F&amp;G's goods (the cancellation applicant)</b>	<b>Federici's goods (the proprietor)</b>
<u>Class 5</u>	<u>Class 3</u>

Dietary and nutritional supplements; acne preparations.	Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair; hair serums; neutralizing hair preparations; hair colour removers.
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100. I have set out the case law in relation to an assessment of similarity of goods above. I will apply the same here.

101. Federici's goods are all products for use on hair. I have compared F&G's class 5 goods to various hair care products at paragraphs **59 and 60** above. For the same reasons, I consider these goods to be dissimilar. On that basis, the invalidation must fail. However, I will go on to consider the position if I am wrong in that finding and they are similar to a low degree.

The average consumer and the nature of the purchasing act

102. I have set out my findings in relation to the average consumer and the purchasing process for goods of this kind above. I consider that the same applies here.

Comparison of trade marks

103. I have set out the case law in relation to how a comparison of trade marks should be conducted above. I will apply the same here.

104. The respective trade marks are shown below:

F&G's mark	Federici's Mark
<p data-bbox="416 360 571 394">BUYWOW</p> <p data-bbox="389 524 598 562">(the 606 Mark)</p>	<p data-bbox="1015 360 1179 394">WOW/wow</p> <p data-bbox="1015 416 1182 454">(series of 2)</p> <p data-bbox="994 524 1203 562">(the 772 Mark)</p>

105. For the avoidance of doubt, whilst the 722 Mark consists of a series of 2 marks, both are the word WOW/wow presented in upper/lower case. As registration of a word only mark covers use in any standard typeface, the presentation in different cases will have no impact on my assessment. Consequently, the same comparison will apply to both. I have set out my findings in relation to the overall impression of the 606 Mark above. I will apply the same here. The 772 Mark consists of the word WOW/wow. There are no other elements to contribute to the overall impression which lies in the word itself.

106. Visually, the marks are similar due to the 772 Mark being wholly incorporated into the 606 Mark. The point of visual difference is the addition of the word BUY at the beginning of the 606 Mark, which has no counterpart in the 772 Mark. Taking all of this into account, I consider the marks to be visually similar to between a medium and high degree.

107. Aurally, the word WOW will be given its ordinary English pronunciation and will be identical in each mark. The point of aural difference is the addition of the word BUY at the beginning of the 606 Mark, which will be given its ordinary English pronunciation and has no counterpart in the 772 Mark. Taking all of this into account, I consider the marks to be aurally similar to between a medium and high degree.

108. Conceptually, I have set out the meaning of the word WOW above. It will be given its ordinary dictionary meaning which will be the same for both marks. The word BUY will be given its ordinary dictionary meaning and will act as a point of conceptual

difference. Taking all of this into account, I consider the marks to be conceptually similar to a high degree, with the only difference being non-distinctive.

#### Distinctive character of the earlier trade mark

109. I have set out the case law in relation to an assessment of distinctiveness above and will apply the same here.

110. F&G has filed no evidence of use. Consequently, I have only the inherent position to consider.

111. Ms Messenger submitted that the 606 Mark is highly distinctive; she submitted that BUY is not descriptive of a characteristic of the goods (as it might be for retail services). I disagree. As noted above, the word BUY will be non-distinctive for the goods; it will be seen as an instruction to the buyer i.e. that they should buy 'wow' products. The word WOW is laudatory and will be low in distinctiveness. Taking all of this into account, I consider the mark as a whole to be inherently distinctive to a low degree.

#### Likelihood of confusion

112. I have summarised the principles to be taken into account when assessing likelihood of confusion above. I will apply the same here.

113. I have found the marks to be visually and aurally similar to between a medium and high degree and conceptually similar to a high degree, with the only differences being non-distinctive. I have found the 606 Mark to be inherently distinctive to a low degree. I have found the average consumer to be a member of the general public or a professional user who will pay a medium degree of attention during the purchasing process. I have found the purchasing process to be predominantly visual (although I do not discount an aural component). If the goods are similar, they will be similar to only a low degree.



114. The high degree of similarity between the marks is clearly a factor in favour of F&G. However, it is important to bear in mind the interdependency principle i.e. a higher degree of similarity between the marks can be offset by a low degree of similarity between the goods and vice versa. I consider that to be the case here. Notwithstanding the high degree of similarity between the marks, I consider that when used on products that share such a low degree of similarity, the average consumer is unlikely to mistakenly recall or misremember the marks or to perceive them as indicating goods originating from the same or economically linked undertakings. This is particularly the case given the low distinctiveness of the earlier mark. I do not consider there to be a likelihood of direct or indirect confusion.

115. The application for invalidation against the 772 Mark fails.

### **The opposition against the 745 Mark**

116. The marks relied upon by Federici qualify as earlier marks pursuant to section 6 of the Act. Given their registration dates, they are not subject to the proof of use provisions set out in section 6A of the Act.

### **Section 5(1) and 5(2)(a)**

117. Under these sections, Federici relies upon the 772 Mark only. At the hearing, Mr Bragiel was content to proceed on the basis of the section 5(2)(b) objection only. However, for the avoidance of doubt, the additional words SKIN SCIENCE in the 745 Mark which are absent from the 772 Mark would not go unnoticed by the average consumer. Consequently, the marks are not identical and the section 5(1) and 5(2)(a) grounds fail.

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

118. Under section 5(2)(b), Federici relies upon both the 772 Mark and the 458 Mark.

119. I have set out the legislation and relevant principles for an assessment under this ground above. I will apply the same here.

Comparison of goods

120. The competing goods are as follows:

<b>Federici's goods (the opponent)</b>	<b>F&amp;G's goods (the applicant)</b>
<p><b>The 772 Mark</b> <u>Class 3</u> Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair; hair serums; neutralizing hair preparations; hair colour removers.</p> <p><b>The 458 Mark</b> <u>Class 3</u> Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having</p>	<p><b>The 745 Mark</b> <u>Class 3</u> Non-medicated care preparations, namely, creams, lotion, gels, toners; face and body creams; beauty creams; non-medicated skin creams; body scrubs; facial masks.</p> <p><u>Class 5</u> Acne treatment preparations.</p>

a colouring effect for use in styling the hair.	
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121. I have set out the relevant case law for a comparison of goods above. I will apply the same here.

*Non-medicated care preparations, namely, creams, lotion, gels, toners;*

122. This term in the specification of the 745 Mark could, in my view, include both care preparations for the body and care preparations for the hair. In those circumstances, this term will be identical to the goods in the specifications of the 772 and 458 Marks on the principle outlined in *Meric*.

123. If I am wrong in this finding, and the term in the 745 Mark relates to skin care products only, the purpose of these goods will be to condition and clean the skin. There is, therefore, overlap in purpose with “Non-medicated preparations and products for use on and in connection with hair” in the specifications of the 772 and 458 Marks to the extent that these will also be used for cleaning and conditioning (albeit in relation to the hair). Clearly, the purpose will differ to the extent that they are both intended for use on different parts of the body. The method of use and nature may overlap as both will include creams, gels and lotions which are applied to the relevant part of the body. There may be some limited overlap in trade channels.

124. In its written submissions filed in relation to the opposition, Federici states:

“[...] The Contested Goods complement each other and overlap in a way that might suggest that one brand represented by the trade mark, ‘wow’ covers cosmetics equally for use on the face, body and hair in the same undertaking.”

125. However, the case law on complementarity is clear that the goods must be important or indispensable to each other.<sup>20</sup> In my view, they are not. They are neither in competition nor complementary. Taking all of this into account, I consider the goods to be similar to a medium degree.

*Face and body creams; Beauty creams; Non-medicated skin creams; Body scrubs; Facial masks.*

126. These are all products that are applied to the skin for cleaning or conditioning. For the same reasons, I consider these goods to be similar to the term “Non-medicated preparations and products for use on and in connection with hair” in the specifications of the 772 and 458 Marks to a medium degree.

*Acne treatment preparations.*

127. I have compared these goods to hair care products at paragraph **60** above. For the same reasons, I consider these goods to be dissimilar to the goods set out in the specifications of the 772 and 458 Marks. If I am wrong in this finding, they will be similar to only a low degree.

#### Average consumer and the nature of the purchasing act

128. I have set out my findings in relation to the average consumer and the purchasing process for goods of this kind above. I consider that the same applies here.

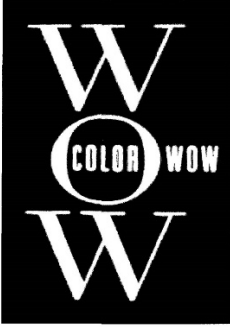

#### Comparison of trade marks

129. I have set out the case law in relation to how a comparison of trade marks should be conducted above. I will apply the same here.

130. The respective trade marks are shown below:

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<sup>20</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Federici's marks	F&G's mark
<p data-bbox="389 360 600 450">WOW/wow (the 772 Mark)</p>  <p data-bbox="389 898 600 936">(the 458 Mark)</p>	 <p data-bbox="963 651 1174 689">(the 745 Mark)</p>

131. The 745 Mark consists of the word **WOW** with an elongated line on the final 'W', above a slightly curving line and the words **SKIN SCIENCE**. The words **SKIN SCIENCE** are presented in a much smaller font. I also note (and agree with) Federici's submission that the words **SKIN SCIENCE** are non-distinctive for the goods. Consequently, I consider that the word **WOW** plays the greater role in the overall impression and is the dominant and distinctive element of the mark. The words **SKIN SCIENCE**, the slightly curving line and the stylisation play a lesser role.

132. The 772 Mark consists of the word **WOW/wow**. There are no other elements to contribute to the overall impression which lies in the word itself.

133. The 458 Mark consists of the word **WOW** presented in a vertical orientation. It appears in a white font on a black background. The word **COLOR** appears within the 'O' of the large word **WOW** and the word **WOW** is repeated in much smaller font alongside. In my view, the background will be attributed little significance as it will be viewed by the average consumer as what it is – a background. Similarly, the use of white on black is of little impact given that registration of a mark in black and white covers use in any colour. In my view, the word **WOW** plays the greater role in the

overall impression due to its size and will be the dominant element in the mark. The additional wording COLOR WOW will play a lesser (but not negligible) role, as will the particular presentation/arrangement.

### *Visual Comparison*

134. Visually, the 745 and 772 Marks will overlap to the extent that the 772 Mark is replicated exactly in the 745 Mark. The main point of visual difference is created by the additional words SKIN SCIENCE in the 745 Mark. I recognise that there is also some difference created by the stylisation, although given that the 772 Mark could be used in any typeface this may be of limited impact. The curving line will also be a point of difference. Taking all of this into account, I consider the marks to be visually similar to a medium degree.

135. Visually, the 458 Mark and the 745 Mark will overlap to the extent that both contain the word WOW. They differ in that the 745 Mark contains the additional words SKIN SCIENCE and the 458 contains the additional words COLOR WOW. There is also a difference created by the orientation, presentation and stylisation; for example, the wording in the 745 Mark is presented horizontally and the wording in the 458 Mark presented vertically. Taking all of this into account, I consider the marks to be visually similar to between a low and medium degree.

### *Aural Comparison*

136. Aurally, the word WOW in the 772 Mark and the 745 Mark will be pronounced identically. The point of aural difference is the words SKIN SCIENCE in the 745 Mark, which have no counterpart in the 772 Mark. I consider that the marks are aurally similar to a medium degree.

137. Similarly, the word WOW in the 458 and 745 Marks will be pronounced identically. The same differences apply as above, with the additional difference created by the pronunciation of the words COLOR WOW. I consider the marks to be aurally similar to between a low and medium degree.

### *Conceptual comparison*

138. The word WOW is laudatory and will be attributed the same meaning in both the 772 Mark and the 745 Mark. The words SKIN SCIENCE are non-distinctive, being sales puffery i.e. that the goods have some particular science behind them to make them beneficial for the skin. In my view, the marks are conceptually highly similar, with the only differences being non-distinctive.

139. The same applies to the comparison between the 745 Mark and the 458 Mark. However, the additional words in the 458 Mark create a further point of difference. The additional word WOW will not add anything due to its repetitiveness. The word COLOR is, in my view, likely to be seen as descriptive for the goods i.e. goods intended for use for colouring hair or for use with coloured hair. Taking this into account, I consider the marks to be conceptually highly similar, with the only differences being non-distinctive.

### Distinctive character of the earlier marks

140. I have set out the case law in relation to the assessment of distinctive character of the marks above.

141. As noted above, Federici has filed evidence of use as part of their invalidation case. At the hearing, Ms Messenger noted the following paragraph from Mr Federici's statement:

"5. This Witness Statement is made in support of Federici's application for cancellation of the Trade Mark BUYWOW (UK00003310606) registered in the name of Fit & Glow Healthcare Private Limited [...]

[...]

6. Specifically this Witness Statement is made:

(1) In response to Fit & Glow's request to provide proof of use of Federici's COLOR WOW mark within the period of 5 years ending with date of

publication of the application for Fit & Glow's BUYWOW mark on 25<sup>th</sup> May 2018, namely between 25<sup>th</sup> May 2013 and 25<sup>th</sup> May 2018 ("the Relevant Period")

- (2) To provide evidence in relation to the reputation and goodwill which Federici have acquired in the sign COLOR WOW by its use in the UK and the case that use of Fit & Glow's BUYWOW mark would amount to passing off."

142. Consequently, Ms Messenger submits that Federici should not now be permitted to rely upon this evidence for the purpose of proving enhanced distinctiveness in the opposition. The usual position is that evidence filed in consolidated cases is taken to apply to all consolidated cases (even if they were not all consolidated at the same time, as is the case here). However, as Mr Bragiel was content to proceed on the inherent position alone, I shall deal with my assessment on that basis.

143. I have found the word WOW to be laudatory. The 772 Mark is, therefore, inherently distinctive to a low degree. The distinctiveness of the 458 Mark is, to a degree, increased by the presentation and orientation. Ms Messenger accepted that this mark had an 'average' degree of inherent distinctiveness. Consequently, I will proceed on the basis that the mark has an 'average' (or medium) degree of inherent distinctiveness. However, I will bear in mind that it is the distinctiveness of the common element which is key for the purposes of my assessment of likelihood of confusion.

#### Likelihood of confusion

144. I have set out the factors to be considered when assessing likelihood of confusion above and will apply the same here.

145. I have found the 772 Mark and the 745 Mark to be visually and aurally similar to a medium degree. I have found them to be conceptually highly similar, with the only differences being non-distinctive. I have found the 458 Mark and the 745 Mark to be visually and aurally similar to between a low and medium degree. I have found them to be conceptually highly similar, with the only differences being non-distinctive. I have found the 772 Mark to be inherently distinctive to a low degree and the 458 Mark to be



inherently distinctive to a medium degree. I have identified the average consumer to be members of the general public or professionals who will pay a medium degree of attention when purchasing the goods. I have concluded that the purchasing process will be predominantly visual, although I do not discount an aural component. For the goods that I have found to share some similarity, I have found them to vary from being similar to a low degree to identical.

146. In my view, in relation to those goods that are similar to a medium degree or higher, the average consumer will view the common use of the word WOW to indicate goods that originate from the same or economically linked undertakings. Consequently, I consider there to be a likelihood of indirect confusion. In respect of those goods that I have found to be similar to only a low degree, I consider that the differences between the goods will be sufficient to offset the similarities between the marks, particularly given the low distinctiveness of the common word WOW. In my view, the average consumer is more likely to view the use of the common word as a coincidence when used on goods that are similar to only a low degree.

147. Consequently, the opposition against the 745 Mark succeeds in relation to the following goods:

Class 3      Non-medicated care preparations, namely, creams, lotion, gels, toners; face and body creams; beauty creams; non-medicated skin creams; body scrubs; facial masks.

148. The opposition against the 745 Mark fails in relation to the following goods:

Class 5      Acne treatment preparations.

149. For the avoidance of doubt, my findings would have been the same even if I had concluded that the distinctiveness of the earlier marks had been enhanced through use.

## **CONCLUSIONS**

150. The application for invalidation against the 606 Mark succeeds in relation to the following goods for which the application is deemed never to have been made:

Class 3      Essential oils; hair removal lotion; creams, gels, serums; non-medicated feminine hygiene wash; non-medicated cleansers for intimate personal hygiene purposes; shampoo.

151. The application for invalidation against the 606 Mark fails in relation to the following goods for which it shall remain registered:

Class 5      Dietary and nutritional supplements; acne preparations.

152. The application for invalidation against the 772 Mark fails in its entirety.

153. The opposition against the 745 Mark succeeds in relation to the following goods for which the application is refused:

Class 3      Non-medicated care preparations, namely, creams, lotion, gels, toners; face and body creams; beauty creams; non-medicated skin creams; body scrubs; facial masks.

154. The opposition against the 745 Mark fails in relation to the following goods for which it may proceed to registration:

Class 5      Acne treatment preparations.

## **COSTS**

155. Both parties have been partially successful. However, Federici has enjoyed the greater degree of success. Consequently, I will award Federici costs on the basis set out in Tribunal Practice Notice 2/2016, with an appropriate reduction for the only partial

success. Taking this into account, I award Federici the sum of **£1,850** calculated as follows:

Preparing forms and considering F&G's forms	£300
Preparing and filling evidence	£500
Preparation for and attendance at hearing	£750
Official fees for invalidation and opposition	£300
<b>Total</b>	<b>£1,850</b>

156. I therefore order Fit & Glow Healthcare Private Limited to pay Federici Brands LLC the sum of **£1,850**. This sum should 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 23<sup>rd</sup> day of July 2021**

**S WILSON**  
**For the Registrar**