

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2214352  
BY MICHAEL EVANGELUS CLARKE  
(TRADING AS MICHAEL VAN CLARKE)  
TO REGISTER THE TRADE MARK  
MICHAEL VAN CLARKE GREAT HAIR DAYS  
IN CLASSES 3 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 50917  
BY NICHOLAS ANDREW CLARKE, LESLEY ANNE GALE CLARKE  
& KASMARE LIMITED**

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**IN THE MATTER of Application No. 2214352**

**by Michael Evangelus Clarke**

**(trading as Michael Van Clarke)**

**to Register the Trade Mark**

**Michael Van Clarke Great Hair Days**

**in Classes 3 and 42**

**AND**

**IN THE MATTER OF Opposition thereto under No. 50917**

**by Nicholas Andrew Clarke, Lesley Anne Gale Clarke**

**& Kasmare Limited**

1. On 15 November 1999 Michael Evangelus Clarke, trading as Michael Van Clarke applied to register the mark MICHAEL VAN CLARKE GREAT HAIR DAYS for the following specification of goods and services:

**Class 3** - Hair and hair treatment products

**Class 42** - Hairdressing and hair care services

2. The application is numbered 2214352.

3. An issue arises in relation to the name of the applicant. The above records the applicant's name as currently recorded in the Registry's records following the filing of a Form TM21 on 28 March 2002. The application was actually filed in the name of Michael Van Clarke.

4. On 17 April 2000 opposition to this application was filed by Nicholas Andrew Clarke, Lesley Anne Gale Clarke and Kasmare Limited. The substance of the opposition can be gleaned from the following:

"The applicant's address is given as 1 Beaumont Street, London, W1N 1RA. A hairdressing salon is operated under the name NICKY CLARKE by and/or for the opponents at 130 Mount Street, London, W16 5HA which is close to Beaumont Street. Michael Van Clarke and Nicholas Andrew Clarke are brothers. Nicholas Andrew Clarke is a celebrity hairdresser on television. For these reasons it is submitted that the applicant must have been aware of the fact that CLARKE is distinctive of the goods and services of the opponents and that he could not make a valid application to register a mark incorporating CLARKE. The only marks on the Register in Class 3 and incorporating CLARKE are owned by the opponents. In Class 42 there are other "CLARKE" marks, but in respect of hairdressing and allied services the only ones are those owned by the opponents. Accordingly the application is made in bad faith and offends Section 3(6) of the Trade Marks Act 1994 and/or is contrary

to Section 5(4)(a) in that use of the mark is liable to be prevented by a rule of law protecting the unregistered mark CLARKE or other unregistered signs incorporating CLARKE and used in the course of business.

The opponent company, opponent persons and/or companies of which the opponent persons are directors have, since May 1991, operated a hairdressing salon in London under the name “NICKY CLARKE”. Since February 1993 the opponent company, opponents and/or companies of which the opponents are directors have sold shampoos, conditioners and other hair-care products under the mark “NICKY CLARKE”. It is intended to file evidence in support of the dates mentioned and also to show the fame of Nicholas Andrew Clarke known as Nicky Clarke. It is contended that the triple combination of the salon, sale of goods and television appearances of Nicky Clarke give to the name CLARKE an exclusive attachment to the opponent company and/or opponent persons such that use of another mark incorporating CLARKE in relation to hair-care products, hair treatment products, hairdressing and hair-care services would be contrary to Section 5(4)(a). Even if the mark MICHAEL VAN CLARKE GREAT HAIR DAYS or part thereof had been used in relation to hairdressing, its wider use in particular in relation to hair-care and hair treatment products would be contrary to Section 5(4)(a). Registration would give protection to which the applicant is not entitled.

Nicholas Andrews Clarke and Lesley Anne Gale Clarke are Directors of Kasmare Limited and the company are licensees of their Trade Marks and Trade Mark Registrations and distributors of NICKY CLARKE products. Nicholas Andrew Clarke and Lesley Anne Gale Clarke are the owners of the following United Kingdom registrations, .....

5. I have set out such information as I consider relevant relating to the registrations referred to above in the Annex to this decision. After a number of submissions in relation to similarity of marks and goods the opponents statement of grounds goes on to say:

“The application is made in bad faith and offends Section 3(6) of the Trade Marks Act 1994 because there is no applicant, there being no such person or legal entity as Michael Van Clarke. The application offends Section 3(6) and/or 32(3) because the mark is not used by the non-existent applicant and the non-existent applicant can have no bona fide intention of using the mark.”

6. This latter ground was in fact allowed to be added at an interlocutory hearing during the later stages of the case (the hearing date was 22 March 2002). The opponents ask that the application be refused in its entirety or alternatively in respect of the Class 3 goods.

7. The applicant filed a counterstatement confirming that he owns a hairdressing salon which has traded under the name MICHAEL VAN CLARKE at 1 Beaumont Street, London since December 1988. He says he has successfully marketed a range of hair care and hair treatment products under the mark MICHAEL VAN CLARKE since 1989. He adds that:

“The applicant trades under his own name. His name is not shortened or abbreviated

save for the abbreviation of his middle name, **EVANGELUS**, to VAN. Indeed, he has been careful to trade under the full name MICHAEL VAN CLARKE to minimise any risk of confusion with the trading activities of others including his brother, Nicky Clarke.”

8. He rejects all the claims made against him and comments in relation to the Section 3(6) ground that:

“With regard to Clause 4 of the opponents amended Statement of Grounds, it is denied that the application is made in bad faith. For all his professional life the applicant has been known as and has traded as Michael Van Clarke. The fact that he was christened Michael Evangelus Clarke had not even been considered when the application was filed. The applicant is taking steps to correct the application to reflect the name appearing on his birth certificate but this minor oversight cannot seriously amount to an act of bad faith.”

9. Both sides ask for an award of costs in their favour.

10. Both sides filed evidence. The matter came to be heard on 10 October 2002 when the applicant was represented by Mr B March of Wildbore and Gibbons and the opponents by Mr H N Matthews of Prentice and Matthews.

### **Opponents’ Evidence**

11. The opponents filed three statutory declarations as follows:

Howard Nicholas Matthews	-	21 December 2000
Jahanger Akbarali Kaba	-	21 December 2000
David Beck	-	23 March 2001

12. Mr Matthews is the Trade Mark Attorney acting for the opponents in this matter. He exhibits the results of a Marquesa database search for UK and CTM registrations for CLARKE in Classes 3 and 42 (B1); a collection of material showing the fame of Nicky Clarke and his products (B2); and a book by Nicky Clarke entitled ‘Hair Power’ (B3). The B2 material appears to be after the relevant date. The book at B3 was published in 1999.

13. Mr Kaba is the Director of Finance of Kasmare Ltd, one of the joint opponents. He says that:

“1. Nicholas Andrew Clarke, known as Nicky Clarke, and his brother Michael Evangelus Clarke worked for a well-known hairdresser called John Frieda. In May 1991 Nicky Clarke opened his own salon at 130 Mount Street. A biography of Nicky Clarke forms Exhibit A1 to this my declaration and shows his fame as a celebrity hairdresser including appearances on television and in Who’s Who in which he is the only hairdresser named. Nicky Clarke and Lesley Anne Gale Clarke are co-directors and their Mayfair salon in Mount Street keeps its records and accounts in the name of their company Southern Tropics Limited.”

14. The sales figures and amounts spend on promotion and advertising of the Nicky Clarke salon over the last five years are given as follows:

	<b>TURNOVER</b>	<b>MARKETING (ADVERTISING &amp; PROMOTION)</b>
1995	£1,396,252	£ 64,161
1996	£1,507,915	£ 95,233
1997	£1,984,387	£133,886
1998	£2,021,552	£105,133
1999	£2,292,754	£119,396

15. Mr Kaba says that in 1993 Nicky Clarke and Lesley Anne Gale Clarke his wife, commenced preparations and pre-trading promotion for the sale of Nicky Clarke hair care preparations in 1994. The preparations are sold through Kasmare Limited. The term “preparations” is used to indicate hair care products falling in Classes 3 and 5 of the International Classification of goods and services from hair care products falling in other Classes such 8, 9, 11 and 21.

16. Sales and promotion figures for Nicky Clarke preparations are given as:

<b>YEAR</b>	<b>TURNOVER</b>	<b>MARKETING</b>	<b>PROMOTION</b>
1995	£ 738,341	£ 34,615	
1996	£3,434,903	£ 42,402	
1997	£4,710,768	£304,230	
1998	£6,013,089	£523,158	
1999	£7,480,749	£964,960	£707,213

17. Promotion in this context is said to mean direct displays and promotions in stores such as Boots The Chemists.

18. Nicky Clarke hair care preparations are said to be sold throughout the United Kingdom primarily through large retail outlets. A list of customers forms Exhibit A2 to the declaration. On this list AAH Pharmaceuticals and Network Management Ltd are suppliers and distributors to independent chemists and pharmacies. Pulse Home Products Ltd sell Nicky Clarke hair care products in the form of hair dryers, rollers and stylers, combs, clippers, curlers and straighteners, brushes and scissors. A summary of royalties paid by Pulse Home Products Ltd for Nicky Clarke hair care products forms Exhibit A3 to the declaration. A list of export customers is also supplied at Exhibit A4 along with sample public relations material at Exhibit A5.

19. Finally Mr Kaba exhibits (A6) a photocopy of the invoice and labelling on plastic bottles of Michael Van Clarke preparations he purchased from his (Michael Van Clarke’s) salon at 1 Beaumont Street. He suggests that the blank labels on the back of the bottles with no ingredients or barcodes show that the goods are only sold from the salon and could not be sold through other outlets.

20. Mr Beck is a Research Analyst with the Carratu International Group Ltd. He says that he was asked by the opponents' attorneys to undertake the following:

- (a) Internet research to provide an on-line survey with regard to the prominence, if any, of either Nicky Clarke or Michael Van Clarke;
- (b) Use of the trade mark "Great Hair Days" by Michael Van Clarke and if in use, where the products are being sold;
- (c) A survey of the general public equidistant between the salons of Nicky Clarke and Michael Van Clark to ascertain the level of public awareness of the two names.

21. His report dated 21 March 2001 forms Exhibit A1 to his declaration.

22. It will be sufficient for present purposes to record that Mr Beck's internet and database researches discovered references to both Nicky Clarke and Michael Van Clarke. Both appear to have a variety of domain names but only nickyclarke.com was found to be in use. Database searches revealed a significantly larger number of references to Nicky Clark than Michael Van Clarke.

23. In relation to use of GREAT HAIR DAYS no products were found bearing the mark and the enquiries were in other respects inconclusive.

24. The survey that Mr Beck refers to was conducted at a location said to be equidistant between the parties respective salons. The survey was small in size (53 people) and suffers from a number of defects commonly associated with such surveys. I will deal with the detail to the extent necessary in my decision.

### **Applicant's Evidence**

25. The following witness statements were filed on the applicant's behalf:

Michael Evangelus Clarke	-	12 June 2001
Sandra Frances Boler	-	15 August 2001
Ruth Anderson	-	11 July 2001

26. Mr Van Clarke says he is a successful hairdresser in his own right. He has owned and run a hairdressing salon under the name MICHAEL VAN CLARKE at No 1 Beaumont Street, London W1N 1RA, continuously since December 1988 and has marketed a range of hair care and hair treatment products under the MICHAEL VAN CLARKE brand name since 1989. Approximate annual turnover figures for sales of both hairdressing services and hair care/hair treatment products under the MICHAEL VAN CLARKE name, are as follows (up to the material date):

<b>YEAR</b>	<b>GROSS TURNOVER</b>	<b>PRODUCTS TURNOVER</b>	<b>ADVERTISING/ PROMOTIONAL COSTS</b>
1997	£1,000,000	£63,000	£50,000
1998	£1,120,000	£63,000	£64,000
1999	£1,165,000	£65,000	£72,000

27. Specimen labels are exhibited at MVC1.

28. He further describes the background to his business as follows:

- "1. I first entered the hairdressing profession in the late 1970's joining the salon known then as Stafford & Frieda in London. After 10 years of working for John Frieda (who split from Clifford Stafford), I set up my own salon. My brother, Nicky Clarke, (one of the joint opponents) was already working at Stafford & Frieda when I joined but I started working under my own name before Nicky did and in fact, Nicky worked at my salon for a short period after I opened up in 1988.
2. Since commencing to trade under my own name and with the invaluable help of my wife and partner, Frances, we have built up the reputation and profitability of the salon during the last 10 years. We have a large and faithful clientele, including many well-known, affluent and discerning clients. 85% of our clientele is female. The salon has an air of understated elegance which suits our clients who prefer not to seek publicity, at least in relation to their hair dressing arrangements and their names are more likely to be found in the pages of eg the Financial Times rather than Hello magazine. I am now shown exhibit MVC2 and recognise this as being copies of our newsletter introduced in 1997 and widely distributed to our clients. Approximately 5,000/6,000 copies of each newsletter are printed and despatched to clients and to contacts in the printed news media.
3. We attract new clients by various means, including word of mouth recommendation, regular listing in the magazines, Vogue and GQ, which listings have appeared on a monthly basis for the last 6 years and by discreet public relations promotional efforts resulting in the placing of articles or features in a variety of appropriate publications. I am now shown exhibit MVC3 and recognise this as being extracts from the magazines Vogue and GQ containing listings for the MICHAEL VAN CLARKE salon accompanied by a variety of published articles and advertisements as indicated promoting the MICHAEL VAN CLARKE hairdressing services and products.
4. The reputation of our salon, including the type and profile of our clientele, is a matter of crucial importance to us. I believe that our success is largely due to our having built a reputation as a salon where busy and important people come and have their hairdressing needs attended to in a calm atmosphere of

understated elegance and luxury.

5. My brother Nicky Clarke worked at my salon in 1989 for 9 months. He then left to set up his own salon. Shortly after Nicky left my salon, there occurred one instance of confusion and it is the only instance of confusion that I can recall. A winner of a competition organised by The Sun newspaper had won the prize of a hair cut by my brother Nicky. That winner turned up at my salon and had to be redirected. I believe that that instance of confusion was simply a case of the competition organisers failing to keep up with the news that Nicky had left my salon and had opened his own. Thus, that occasion was based on ignorance of the up-to-date information rather than an example of anyone being confused between the names Nicky Clarke and Michael Van Clarke.”

29. He concludes by saying that he cannot recall a single instance of confusion since that time and suggests that this is because the names NICKY CLARKE and MICHAEL VAN CLARKE are easily distinguishable, Clarke being a relatively common family name. He adds that he considers he has now built up a significant reputation in his name.

30. Ms Boler is Editor of Brides magazine. She says she has known the name MICHAEL VAN CLARKE in relation to hairdressing services for 3 years and in relation to hair care products for 1 year. Ms Anderson is a partner in the accountancy firm KPMG. She says she has known the name MICHAEL VAN CLARKE in relation to hairdressing services for 20 years and in respect of hair care products for about 10 years.

### **Opponents’ Evidence in Reply**

31. Nicholas Andrew Clarke has filed a witness statement dated 16 November 2001. He responds to his brother’s claims regarding their past working relationship by saying that he had an oral agreement to use Michael Van Clarke’s salon as a temporary base for his training in return for a contribution to basic expenses.

32. He also suggests that any products sold by his brother prior to 1995 were those of other well-known manufacturers and the product turnover includes such sales as well as a small percentage of products sold under the mark applied for.

33. A second witness statement by Howard Nicholas Matthews comments as follows:

- “1. In a witness statement dated the 12<sup>th</sup> June 2001 someone purporting to be Michael Evangelus Clarke states that he makes the Statement “in support of my Trade Mark Application No 2214352”. That application is not in the name of Michael Evangelus Clarke. A certified copy of the birth certificate of Michael Evangelus Clarke forms Exhibit HNM1 to this my declaration. As far as is known there is no person or legal entity by the name of Michael Van Clarke. In any event the application was not filed in the name of a legal entity because no country or state of incorporation was given on the application form. A faxed Certified copy of the details of Application No 2214352 forms Exhibit HNM 2 to this my Witness Statement.”



## **Applicant's further Witness Statement**

34. The witness statement is made in the name of Michael Evangelus Clarke (also known as Michael Vangelis Clarke and as Michael Van Clarke).

35. The main points to emerge are as follows:

- he acknowledges that he was christened Michael Evangelus Clarke;
- for many years he has used the middle name Evangelus. The trade mark application was made with that in mind;
- steps have been taken to correct this irregularity (I infer that this is a reference to the filing of Form TM21);
- throughout his professional career he has traded consistently and continuously under the name Michael Van Clarke;
- he has re-checked his records and finds that about 75 per cent of the product turnover figures previously given represents hair care products sold under the MICHAEL VAN CLARKE name. The remaining 25 per cent were not so branded but would have been supplied in bags and with till receipts bearing that name.

36. That completes my review of the evidence to the extent I consider it necessary.

37. I will take the objections in the order they occur. Section 3(6) reads as follows:

“ A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

38. There are three separate bases for the objection which can conveniently be summarised as follows:

- (i) the applicant must have been aware of the opponents' use and trade marks;
- (ii) there is no such legal entity as Michael Van Clarke and, therefore, no applicant;
- (iii) as a consequence of (ii) there can be no bona fide intention to use.

39. The real point at issue in the evidence and submissions has been (ii) above. Before getting to that I can deal quite briefly with point (i). This, in my view, amounts to a relative ground objection dressed up as one on absolute grounds. There is no suggestion that the applicant has sought to take unfair advantage of the opponents' marks or given other cause for a bad faith objection. To the extent that he has chosen a mark which, the opponents feel,

is in conflict with their own that is a matter which falls to be dealt with under Section 5(2)(b) and 5(4)(a).

40. Turning to (ii) the facts are not in dispute. The application was filed in the name of Michael Van Clarke, the name by which he trades and is known. Mr Clarke's full name, according to his birth certificate is Michael Evangelus Clarke. Since the filing of the opposition, steps have been taken (by means of a Form TM21) to change the name of the applicant to reflect his full Christian name whilst preserving the reference to the name he uses. Bad faith has to be judged at the time of filing the application. If it existed at that date it cannot be cured by later events or actions (*Nonogram* Trade Mark [2001] RPC 355). On that basis if the original application was bad because of the problem with the applicant's name the subsequent filing of the Form TM21 cannot put matters right.

41. Section 32 sets out the minimum requirements for a trade mark application to come into being as follows:

“(2) The application shall contain-

- (a) a request for registration of a trade mark,
- (b) the name and address of the applicant,
- (c) a statement of the goods or services in relation to which it is sought to register the trade mark, and
- (d) a representation of the trade mark.”

42. It is also relevant to bear in mind Section 2(1) of the Act which reads:

“2.-(1) A registered trade mark is a property right obtained by the registration of the trade mark under this Act and the proprietor of a registered trade mark has the rights and remedies provided by this Act.”

43. A property right cannot exist in a vacuum. There must be a proprietor. Section 32(2)(b) ensures that there is an applicant and that there is sufficient information to identify the applicant. I note by way of comparison that Article 26 of the Community Trade Mark Regulation 40/94 differs from the UK Act in requiring “information identifying the applicant” rather than using the words “name and address of the applicant”. No doubt the two things amount to much the same thing but the wording of the Community Regulation serves to emphasise the underlying purpose of the requirement.

44. It is not disputed that Michael Evangelus Clarke has for a considerable period of time referred to himself, and traded as, Michael Van Clarke. This is not a case where there has been any attempt to dissemble. Far from it - the applicant has filed his application in the name by which he is known. It is no different in my view from someone filing an application in a shortened form of a name or by reference to an initial only. I do not see why Dave Smith or D Smith should be any less acceptable than the full name David Smith. That is not to say that the full name is not preferable but it must be borne in mind that the applicant's name is only one of the items of information that identifies an applicant. The address is also important. Again there is no dispute about the address supplied here. The key test is whether the

information given was sufficient to properly identify the applicant. In my view it was. The point clearly did not cause the opponents any problem at the outset because the grounds of opposition identified from the information given that “Michael Van Clarke and Nicholas Andrew Clarke are brothers.” Indeed the whole opposition has progressed on this basis.

45. I drew attention at the hearing to the following passage from the Patents Manual:

“14.04.5 An applicant who is an individual should apply in his true name. Exceptionally, a pseudonym may be used if it is well established and is customarily used by the individual for banking and other business purposes.”

46. The analogy is admittedly not a direct one. The applicant here has not used a pseudonym as such merely an abbreviation of his middle name (the name by which he is also known in business). If it is right that a pseudonym can be accepted I can see no good reason for finding that an applicant cannot use an abbreviation of one of his forenames.

47. In *Gromax Plasticulture Ltd v Don & Low Nonwovens* [1999] RPC 367 Lindsay J said:

“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

48. I do not think the applicant’s behaviour comes anywhere near failing this test.

49. The final point under the bad faith head is that there can have been no bona fide intention to use. The statement of grounds puts the matter as follows:

“The application offends Section 3(6) and/or Section 32(3) because the mark is not used by the non-existent applicant and the non-existent applicant can have no bona fide intention of using the mark.”

50. It would seem, therefore, that this ground stands or falls with my decision on whether or not there can properly be said to be an applicant in the first place. In the light of my above decision it must fall. If or to the extent that there is a more general claim then it too must fail in the light of the applicant’s long standing existing trade.

51. Turning to the relative ground objections, the relevant parts of the Act read:

Section 5(2)

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (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.”

#### Section 5(4)

“(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, or
- (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

52. In relation to the first of the relative grounds, Section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore

be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

53. The opponents have a number of registrations which constitute earlier trade marks within the meaning of Section 6(1). Most consist of the words NICKY CLARKE with another descriptive or less distinctive element. Registration No. 2120261 is for the words NICKY CLARKE solus and is likely to offer the opponents their best chance of success. To put the matter another way I do not consider the opponents will be in any better position on the basis of their other earlier trade marks.

#### **Similarity of goods and services**

54. There can be little doubt that the goods and services of the application in suit are either identical to or very closely similar to the Classes 3 and 42 goods and services of the opponents' earlier trade mark, No. 2120261.

#### **Distinctive character of the opponents' earlier trade mark**

55. The distinctive character of an earlier trade mark is a factor to be borne in mind in coming to a view on the likelihood of confusion (*Sabel v Puma*, paragraph 24). That distinctive character can arise from the inherent nature of the mark or be acquired through use.

56. Mr March conceded that Nicky Clarke has a considerable reputation as a celebrity hairdresser. That was in my view a realistic and helpful concession.

57. In *DUONEBS* Trade Mark, BL O/048/01, Mr S Thorley QC, sitting as the Appointed Person, said:

“In my judgment, I believe what the ECJ had in mind was the sort of mark which by reason of extensive trade had become something of a household name so that the propensity of the public to associate other less similar marks with that mark would be enhanced. I do not believe that ECJ was seeking to introduce into every comparison required by Section 5(2), a consideration of the reputation of a particular existing trade mark.”

58. NICKY CLARKE is, in my view, a name that meets this test. In the light of Mr March’s comments I do not need to conduct a detailed analysis of the evidence. Suffice to say that he has an enviable list of celebrity clients and is included in the 2000 edition of *Who’s Who* (Exhibit A1 to Mr Kaba’s declaration). The name/mark NICKY CLARKE can be said to have a high degree of distinctive character. Initially this is likely to have been in relation to hairdressing services but it has now been extended into the goods area as well. I note from Mr Kaba’s declaration that the turnover in goods outstrips that in services.

59. Where the parties differ is in whether the opponents enjoy a reputation in the surname CLARKE solus. That point has been taken largely in the context of Section 5(4)(a) so I will say no more about it at this point.

### **Similarity of marks**

60. The guidance from *Sabel v Puma* is that marks must be assessed by reference to their distinctive and dominant components. Both marks consist of full names (setting aside the VAN/VANGELIS/EVANGELUS point for present purposes). What are the memorable features of the names and where does the distinctive character lie? Individuals are usually identified by their full names not least because any particular forename or surname is more often than not shared with others. It is the name as a whole that is likely to identify the individual. That might suggest that, as a general rule, where full names function as trade marks, the distinctive character must always be in the totality. That would also be consistent with one of the other principles from *Sabel v Puma* that consumers perceive marks as a whole and do not proceed to analyse details.

61. Attractive though that proposition might seem it is not a complete answer to how name marks should be approached. The distinctive and dominant elements of marks/names must also be considered. Unusual forenames (such as Madonna) or surnames (Solzhenitsyn, say) may attract particular attention and be the element of a full name that achieves particular recognition. How do the names NICKY CLARKE and MICHAEL VAN CLARKE stand? In posing that question I have not lost sight of the fact that the applied for mark also has the words GREAT HAIR DAYS but it is, I think, common ground that the opposition will succeed or fail primarily on the basis of the names themselves.

62. Mr Matthews acknowledged that CLARKE was a very common surname. There is nothing in the opponents' evidence to suggest that it has been highlighted or received particular recognition within the context of the name NICKY CLARKE. The exhibits to Mr Kaba's declaration consistently show use of the full name. Equally the forename NICKY is not so unusual that it is likely to attract particular attention leading to it being a dominant element within the totality of the mark. I, therefore, conclude that the distinctive character of the opponents' mark, both on the basis of the inherent qualities of the component elements and as a result of use, lies in the full name.

63. The position is somewhat different in the case of the applicant's mark. I accept that MICHAEL is a common forename and CLARKE a common surname. The second element VAN, whether or not its significance is known, does in my judgment add a somewhat unusual and memorable feature to the mark. Customers are, I assume, unlikely to be aware of its derivation in the applicant's full forename. In those circumstances it may well be seen as either an unusual forename in its own right or an unusual collocation of common English names and the element 'Van' as commonly used in conjunction with Dutch surnames (meaning 'of'). Either way it makes for a somewhat unusual totality.

64. I am required to consider the marks from the point of view of visual, aural and conceptual considerations. In all these respects the only point of similarity between the marks is the surname itself. Given that it is an extremely common one and is used here with quite different forenames I find that there is very low degree of overall similarity. The opponents suggested in their statement of grounds that "the name Michael is often shortened to Micky in the same way that Nicholas is to Nicky...." There is however nothing in the applicant's evidence of use to suggest that he has ever used anything other than the full name Michael. I do not think this point assists the opponents.

### **Likelihood of confusion**

65. The likelihood of confusion must be appreciated globally taking all relevant factors into account. In *Raleigh International Trade Mark* [2001] RPC 202 Geoffrey Hobbs QC, sitting as the Appointed Person, said:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods and services cannot eliminate differences between marks. So the purpose of the assessment under Section 5(2) must be to determine the net effect of the given similarities and differences."

66. No instances of confusion have been brought to my attention (save for the one example which the applicant cites of a competition winner being misdirected by the competition organisers). That is despite both parties having salons in the same area of London (W1). I understand from the evidence that the brothers target a somewhat different client base though as Mr March pointed out Michael Van Clarke, like his brother, has attracted a number of well known personalities. Other factors too may come into play - Mr Matthews mentioned relative cost as a possible differentiating factor (though neither party, it seems to me, is selling on price). Even so, given the physical proximity of the respective salons, it seems to me that instances of confusion might have been expected to arise if they were going to.

67. However, accepting that the absence of instances of confusion is rarely conclusive in its own right, I must come to my own view of the matter. I have little hesitation in concluding that the net effect of the above considerations is that, even allowing for the fact that the respective marks will be used on identical goods and services, the net effect is that there is no likelihood of confusion. The opposition, therefore, fails under Section 5(2)(b).

68. The requirements for a ground of opposition based on Section 5(4)(a) and in particular passing off have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD* Trade Mark [1998] RPC 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

- (1) that the opponents' goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponents, and
- (3) that the opponents have suffered or are likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

69. To the extent that the opponents rely on goodwill in the business conducted under the sign NICKY CLARKE their position is not materially different to the position considered under Section 5(2)(b). In dealing with that ground I took into account the undoubted reputation attaching to the mark NICKY CLARKE.

70. The position under Section 5(4)(a) differs in one potentially material respect. That is the opponents' claim that the sign CLARKE is eligible for protection in its own right. It is a claim that is not accepted by the applicant. I have given careful consideration to the opponents' evidence, particularly the sample promotional and product material at Exhibit A5 to Mr Kaba's declaration, and can find no evidence that there has been any promotion of the surname CLARKE alone. The products and services are invariably referred to by the name NICKY CLARKE. The Exhibits also suggest that the name is on occasion used in conjunction with what appears to be a scroll device and the letters NC. Furthermore, I can see no basis for concluding that, contrary to the manner in which the sign is used, consumers refer to or ask for the goods or services under the name CLARKE on its own. The closest the opponents get to this is the survey evidence. In fairness to Mr Matthews he acknowledged the difficulties that are usually associated with surveys and did not place undue reliance on the investigator's survey. It was in any case rather too small (53 people) to offer a basis from which any firm conclusions could be drawn. The two points that do emerge from the survey are NICKY CLARKE's reputation and the fact that he is better known than his brother. Neither of these points is disputed by the applicant.

71. The structure of the questionnaire used inevitably led to some speculation on the part of interviewees. Thus the first question was:



“If you saw a hair-care product bearing the name CLARKE, with whom or which company would you associate it?”

72. Some 36 people could give no answer. 11 said Nicky Clarke and 6 gave other individuals or organisations. The fact that 4 referred to the Clarks shoes company is indicative of the extent of the speculation interviewees are likely to indulge in when faced with such a question. It seems to me that what the responses show is that, when asked to speculate, interviewees will attempt to identify the best known person or company in the field. It is not evidence that the name CLARKE has achieved independent recognition in relation to hair care products. A number of the responses support this view. Thus the first few questionnaires record ‘Don’t Know’ in response to Q1 (above) about the name CLARKE but when asked specifically ‘Are you familiar with Nicky Clarke?’ (Q5) reply yes and go on to identify him as a hairdresser.

73. The outcome is that I am entirely unpersuaded that the opponents can claim that their goods and services are known by the distinguishing feature CLARKE as opposed to NICKY CLARKE. For the reasons elaborated on in relation to Section 5(2) I find a low level of similarity between the opponents’ sign NICKY CLARKE and the mark applied for. The opponents will be unable to establish that, within the meaning of the test, there is or will be a misrepresentation by the applicant likely to lead the public to believe that the goods or services offered by the applicant are goods or services of the opponents. The opposition fails under Section 5(4)(a).

74. The applicant has been successful and is entitled to a contribution towards his costs. I order the opponents to pay the applicant the sum of £1000. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 12<sup>th</sup> day of November 2002**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**

**Opponents' Marks**

<b>NO</b>	<b>MARK</b>	<b>CLASS</b>
2120261	NICKY CLARKE	3, 8, 9, 11, 42
2178075	NICKY CLARK SENSITIVE	1, 3
2211811	NICKY CLARKE SUPERSHINE	3, 5
2211813	www.nicky-clarke.com (series)	3, 5
2217090A	ACTIVE BY NICKY CLARKE (series)	3, 11
2116129B	NICKY CLARKE FRIZZ CONTROL	3

**Note** No 2215229 referred to in the statement of ground now stands withdrawn.