

O/403/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION UK3356590

BY

VIXEN & BLUSH LIMITED

TO REGISTER THE FOLLOWING SERIES OF TRADE MARKS IN CLASSES 3, 26,
35 AND 44

The London Hair Lab
London Hair Lab

AND OPPOSITION THERETO (NO. 600001098)

BY

HAIR LAB PRODUCTS LTD

Backgrounds and Pleadings

1. VIXEN & BLUSH LIMITED (The Applicant) applied to register its series of two trade marks “The London Hair Lab” and “London Hair Lab” on the 27 November 2018 which were published on the 8 February 2019 for the following goods and services:

Class 3: Shampoos for human hair.

Class 26: Hair extensions.

Class 35: Wholesale services in relation to beauty implements for humans.

Class 44: Salon Services (Hairdressing-); Salons(Hairdressing-).

2. HAIR LAB PRODUCTS LTD (The Opponent) opposes the application by way of the Fast Track opposition procedure commenced on the 8 April 2019, under section 5(2)(b) of the Trade Marks Act (the Act). It relies on its earlier UK registered trade mark “HAIR LAB” numbered UK3127093 filed on the 15 September 2015 and registered on 11 December 2015 for goods in class 3 namely:

Class 3: Hair thickening products; hair thickening preparations, fibres, creams, gels, serums, lotions, powders, sprays and mousses; toiletries and hair care products; shampoos and conditioners; hair colouring products; hair colouring preparations, fibres, creams, gels, serums, lotions, powders, sprays and mousses.

3. The Opponent relies on all the goods in class 3 for which its mark is registered. The Opponent claims that there is a likelihood of confusion because, under section 5(2)(b) of the Act, the trade marks are similar and are to be registered for goods and services identical with or similar to those for which the earlier marks are protected.

4. The Applicant filed a defence and counterstatement denying the claims made.

5. The Opponent is represented by jtTM Consultancy Limited whilst the Applicant is unrepresented. Neither party filed any submissions other than those contained within the original TM7F and TM8 pleadings. Neither party has applied for leave to file evidence and the matter has therefore proceeded in accordance with the Fast Track procedure. This decision is taken upon the perusal of the papers as filed.

Preliminary Issue

6. The Applicant within its counterstatement submits that it has been trading under the name The London Hair Lab since November 2013. In support of this it produces a document showing that the domain name was purchased in November 2013. Prior ownership of a domain name however does not provide a defence to a trade mark opposition. I would refer the parties to Tribunal Practice Note 4/2009 and in particular Ms Anna Carboni's decision (sitting as the appointed person) in the case of *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. In this case Ms Carboni rejected any defence, based on prior entitlement, raised in this way, as wrong in law. Furthermore, she determined that the proper course for any Applicant wishing to invoke an earlier right was to oppose the application or submit an application to invalidate. Since the Applicant has not submitted applications in this way, the submissions regarding any prior right will not be taken into account in my assessment and the Opponent's mark will be regarded as the earlier mark for the purposes of this decision as it was applied for first in time.

Decision

7. The opposition is based on section 5(2)(b) of the Act which states:

“5(2) A trade mark shall not be registered if because-

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

8. An earlier trade mark is defined in sections 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

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

....

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

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

9. In these proceedings, the Opponent is relying upon its UK trade mark registration, shown above, which qualifies as an earlier mark under section 6 of the Act. As the

earlier mark had been registered for no more than five years at the date the application was filed it is not subject to the proof of use provisions contained in section 6A of the Act. Consequently, the Opponent is entitled to rely upon all its Class 3 goods of its registration, as specified, without having to establish genuine use.

10. 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.

The principles:

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other

components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods and services

11. When conducting a goods and services comparison, all relevant factors should be considered as per the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc.* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

- (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.

13. In addition, in *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J stated that:

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

14. Also in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (GC) stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".

15. The competing goods and services are set out as follows:

Applicant's later Marks	Opponent's Earlier Mark
Class 3: Shampoos for human hair.	Class 3: Hair thickening products; hair thickening preparations, fibres,

	creams, gels, serums, lotions, powders, sprays and mousses; toiletries and hair care products; shampoos and conditioners; hair colouring products; hair colouring preparations, fibres, creams, gels, serums, lotions, powders, sprays and mousses.
Class 26: Hair extensions.	
Class 35: Wholesale services in relation to beauty implements for humans.	
Class 44: Salon Services (Hairdressing-); Salons (Hairdressing-).	

16. The Opponent submits in its statement of grounds that the “goods and services covered by the opposed application are identical and otherwise confusingly similar to the goods covered by the opponent’s earlier trade mark.” The Applicant submits in its defence and counterstatement that “We operate in different field to the opponent. Our audience does not overlap at all. We produce human hair (for women) and sell this human hair to salons. We also sell training to the salons. They produce fibre products (not even remotely to do with human hair) and sell them to men on the internet.”

17. As the proceedings commenced by way of Fast Track neither party filed evidence regarding use of the respective marks and even if there had been the assessment of the likelihood of confusion considers all the circumstances in which the existing mark might be used within the scope of its classification.¹ The circumstances in which the goods were marketed therefore, are not ones to be taken into account when assessing the likelihood of confusion under 5(2)(b) of the Act.²

¹ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

² *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P

Class 3

“Shampoos for human hair”

18. The earlier specification contains the term “*shampoos and conditioners*” which is identical to the above term falling within the same category of goods.

Class 26

“Hair extensions.”

19. When comparing the Applicant’s “*hair extensions*” in class 26 I note that the Opponent has “*hair thickening fibres*” specified in Class 3 however it has not sought to explain this term. It is appropriate to bear in mind the relevance of class numbers when assessing the meaning and scope of descriptions.³ I consider that class 3 ordinarily contains lotions, preparations and products rather than wigs/fibres and artificial hair which fall in class 26. I would consider therefore that fibres in this context are particles added to the ingredients of the preparations rather than hair strands bonded to natural hair.

20. “*Hair extensions*” are similar to the Opponent’s “*Hair thickening products; hair thickening preparations, fibres, creams, gels, serums, lotions, powders, sprays and mousses*”. Hair extensions are lengths of artificial hair incorporated into a person’s own hair to extend its natural length and volume and thus give the impression of fullness; whereas “*Hair thickening products; hair thickening preparations, fibres, creams, gels, serums, lotions, powders, sprays and mousses*” are all preparations and products used to enhance the appearance of natural hair to make it appear fuller and thicker. Although the contested goods may differ in nature, they target the same end user and share purpose in that they are either added to strands of hair or are preparations applied to hair, both used to enhance or improve a person’s appearance. I do not consider the channels of trade of the goods would overlap, in that they are unlikely to be offered for sale by the same service provider or in similar areas of retail outlets. Whilst I see no complementary relationship between the contested goods

³ *Altecnic Ltd’s Trade Mark Application* [2002] RPC 34 (COA)

there may be a degree of competition between them in so far as consumers may choose a temporary treatment for example a wash in/wash out product or something more permanent to achieve the same end result. On this basis I consider the respective goods are similar to no more than a medium degree.

21. When undertaking a comparison between one party's goods specification against another party's services specification I am mindful of the decision in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, where the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. Generally speaking, when considering retail services, they relate to services that are offered in the same places where the goods are offered for sale. Wholesale services involve the selling of goods in large quantities, typically to retailers, and therefore the same principles apply since these services are also rendered in connection with activities exclusively revolving around the actual sale, supply or distribution of goods.

22. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, where Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services against goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the

opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are '*similar*' to goods are not clear cut."

23. However, on the basis of the European courts' judgements in *Sanco SA v OHIM* (Case C-411/13P), and *Assembled Investments (Proprietary) Ltd v. OHIM* (Case T-105/05 at paragraphs [30] to [35] of the judgement), upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd* (Case C-398/07P), Mr Hobbs concluded that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods 'X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to

exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

24. It is not necessary for the Applicant's goods specified in its wholesale/salon services specification to be identical to the Opponent's goods in class 3, however, in order to establish a complementary relationship between the goods and services, it is necessary for there to be sufficiently close relationship between them so that the public might reasonably believe that they are complementary goods/services likely to be offered by the one and the same undertaking.

Class 44

“Salon Services (Hairdressing-); Salons (Hairdressing-)”

25. All the Opponent's class 3 goods are products that could be used in the course of the Applicant's services in class 44. The goods and services are closely related, they are commonly sold/provided through the same trade channels and the users coincide. There is a degree of competition between the goods and the services, in that consumers may purchase the goods and choose to undertake the styling/treatment/preparation themselves or choose to engage the services of a stylist/hairdresser, such as colouring. Whilst clearly the goods and services would differ in nature they would be complementary in that the hair products would be indispensable to hairdressing services and hair salons because the provision of hairdressing services cannot occur without the hair care preparations and products. In addition, it is not unusual for hair salons to sell the products they use bearing their trade mark. The purpose of hair products is to clean, beautify and style a person's hair which is similar to the purpose of hairdressing services. Overall, I consider that the goods and services are similar to a reasonably high degree.

26. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) warned against construing specifications for services too widely, stating that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

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

whilst on the other hand:

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

28. In order to establish a likelihood of confusion between the marks it is essential for there to be at the very least some identity or similarity between the goods and services. This was highlighted in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, where Lady Justice Arden stated that (my emphasis):

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. **If there is no similarity at all, there is no likelihood of confusion to be considered.** If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.”

Class 35

“Wholesale services in relation to beauty implements for humans”

29. *“Wholesale services in relation to beauty implements for humans”* would in my view share no such relationship with the Applicant’s goods in class 3. The scope between these contested goods and services would be too far apart for the public to reasonably believe that those providing wholesale services for beauty implements would also manufacture hair care products and preparations in class 3. An implement, taking its ordinary meaning, would be considered as a tool/device or accessory and ordinarily be classified in Classes 8 or 21. Therefore, the wholesale services for beauty implements would not include hair care products, preparations and lotions. The goods in class 3 and the services in class 35 are different in nature, purpose and method of use. They would not be considered complementary to each other as one is not indispensable to the other. At a very high level of generality, the users may coincide, in that some members of the general public may have access to purchase goods via wholesale, however, on the whole, the users of wholesale services will be hairdressers rather than their customers. The goods and services target different public through different channels and it is unlikely therefore that consumers will reasonably believe that the goods and services are likely to be offered by the one and the same undertaking. *“Wholesale services in relation to beauty implements for humans”* are therefore not similar to the Opponents goods in class 3.

30. Since I have found no similarity between the Opponent's goods in class 3 and the Applicant's "*wholesale services in relation to beauty implements for humans*" in class 35, the opposition under 5(2)(b) fails in respect of these services.

Average Consumer

31. When considering the opposing marks, I must determine, first of all, who the average consumer is for the goods and services and the purchasing process. The average consumer is deemed to be reasonable well informed and reasonably observant and circumspect. When considering the opposing trade marks, I must bear in mind that the level of attention is likely to vary according to the category of goods and services in question.⁴

32. 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."

33. Neither party has made submissions regarding the average consumer or the purchasing process. I consider the average consumer of the goods and services at

⁴ *Lloyd Schuhfabrik Meyer, C-342/97*

issue, to be both the general public and those professionals within the hair styling industry. The goods at issue are likely to be chosen from a shop or supermarket through self-selection or from an online equivalent. The purchasing process is therefore primarily visual; however, the products may also be purchased from a hair salon following a recommendation from a stylist or from a sales representative with a particular affiliation to a brand of product and therefore aural considerations will also play a part.

34. The average consumer for the services is likely to be someone wishing to engage the services of a hairdresser. The purchasing process will again be primarily visual with customer selecting the services following the display of its name at the actual venue, via the internet or via advertising material. Aural considerations cannot be discounted, however, following word of mouth recommendations.

35. For both the goods and services the level of attention in the purchasing process will depend on the nature of the goods and the services on offer. The goods and services vary considerably in price from cheap shampoos and lotions to expensive courses of preparations and treatments. The frequency with which the goods and services are purchased will also vary, from relatively casual purchases such as shampoos and lotions, to hair salon treatments undertaken at less frequent intervals. In either case, since a person's appearance is key to the selection process, even for goods at the lower end of the scale, the degree of care in the selection process will still be reasonable. I regard the degree of care in the selection of the services as being slightly higher. Consumers for both the goods and services at issue will consider the cost, quality and suitability of the product or service provider before purchase.

Comparison of the marks

36. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its

various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

37. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to consider 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.

38. The respective trade marks are shown below:

Applicant's mark 1.1	Applicant's mark 1.2	Opponent's mark
The London Hair Lab	London Hair Lab	Hair Lab

39. The Applicant's series of marks consist of the word only marks "The London Hair Lab" and "London Hair Lab" presented in title case in conventional font. The overall impression of both marks rests in the combination of these words. However, given the nature of the words "The" and "London"; the former being seen as a definitive article,

the latter denoting geographical origin of the goods and services, more importance will be given to the combination of the words Hair Lab in the overall impression of the marks.

40. The Opponent's mark consists of the two words Hair and Lab presented in conventional font in title case with no additional stylisation. The overall impression of the mark resides in the two words in combination.

Visual Comparison

41. The visual similarity rests in the fact that all three marks include the identical words "Hair" and "Lab". The only difference is that the Applicant's marks have the additional words "The London" and "London" at the beginning of its marks with no counterpart in the Opponent's mark. Taking account of my conclusions regarding the overall impression of the marks visually the marks share a medium degree of visual similarity with the shared presence of the common elements.

Aural Comparison

42. Aurally the parties' marks will be given their ordinary English pronunciation with each element of the respective marks being articulated in turn. The Applicant's marks will be read as "The London Hair Lab" or "London Hair Lab" whereas the Opponent's mark will be pronounced as "Hair Lab". The differences will again be created by the presence of the additional words "The" and "London" in the Applicant's marks. I consider that the marks are aurally similar to a medium degree.

Conceptual Comparison

43. All three marks refer to the concept of a Hair Lab where the Lab element will be seen as an abbreviation for laboratory and the Hair element as a reference to the respective parties' goods and services. The two words in combination will be perceived by the average consumer as alluding to a place where hair products are tested or invented. "London" in the Applicant's series of marks will be immediately recognised as the well-known capital city, conveying to the consumer the location of the premises or the origin of the goods/services. The addition of the definitive article "The" refers to a single "hair lab", the absence of which does not alter this singular concept. Taking into account my findings, overall, I consider that the marks share a good degree of conceptual similarity.

Distinctive character of the earlier mark

44. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

45. Registered trade-marks possess varying degrees of inherent distinctive character, some being suggestive or allusive of a characteristic of the goods and services on offer to those with high inherent characteristics such as invented words which have no allusive qualities.

46. The Opponent has not filed any evidence as this is a Fast track opposition and therefore I am only able to consider the position based on inherent characteristics. The earlier mark consists of two ordinary English words. The element “Hair” strongly alludes to the nature of the Opponent’s goods and as I mentioned above, in combination with the element “Lab”, will be perceived by the average consumer as alluding to a place where hair products are tested or invented. The two words in combination will still be viewed as a reference to the Opponent’s hair products and preparations. Taking all relevant matters into consideration, I find the earlier mark, in its totality, to possess a medium degree of inherent distinctiveness.

Likelihood of confusion

47. When considering whether there is a likelihood of confusion between the two marks I must consider whether there is direct confusion, where one mark is mistaken for the other or whether there is indirect confusion where the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or related source.

48. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

49. In determining whether there is a likelihood of confusion there are a number of factors to bear 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 or services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the Opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must consider 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.

50. I have found the marks to be visually and aurally similar to a medium degree. I have found the marks share a good degree of conceptual similarity. I have found the earlier mark to have a medium degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public or professional user selecting the goods primarily through visual means but with aural considerations not being discounted. I have found that the level of attention paid by the average consumer is at least a reasonable degree dependant on the nature of the products and services selected.

51. The consumer when comparing the marks will immediately recognise the shared presence of the identical words in combination namely "Hair Lab". The "London" element in the Applicant's marks will be considered as a geographical descriptor referring to the location or origin of the goods or services whereas the "the" element may well be overlooked due to its weak contribution to the overall impression. As a result of this, I find that the consumer will directly confuse one mark for the other especially for identical or similar goods and services. There is insufficient differentiation between the marks for the average consumer to distinguish between them and as such consumers will imperfectly recall the marks and directly confuse the one for the other especially within the same field of activity.

52. If, however, I am wrong in this conclusion I will consider indirect confusion as explained in L.A. Sugar. Even if the average consumer does recognise the difference with the addition of the words "The" and "London", I consider they would discount those differences perceiving the Applicant's mark to be a sub brand of the earlier mark, namely a geographical expansion of the business. On this basis I consider that consumers will conclude that the respective goods and services come from the same or economically linked undertaking leading to a likelihood of indirect confusion.

Outcome

53. The opposition under section 5(2)(b) of the Act succeeds in part in relation to the following goods and services. Subject to any successful appeal the application is refused for:

Class 3: Shampoos for human hair.

Class 26: Hair extensions.

Class 44: Salon Services (Hairdressing-); Salons(Hairdressing-).

54. The opposition under section 5(2)(b) failed in relation to the Applicant's services in class 35; subject to any successful appeal the application may proceed to registration for the following services:

Class 35: Wholesale services in relation to beauty implements for humans.

Costs

55. As the Opponent has had the greater share of success it is entitled to an award of costs. For Fast Track opposition proceedings, costs are capped at £500 according to TPN 2/2015. Therefore, I award costs on the following basis:

Preparing a notice of opposition and considering the defence and counterstatement	£200
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Official fee	£100
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Total

£300

56. I order VIXEN & BLUSH LIMITED to pay HAIR LAB PRODUCTS LTD the sum of £300. The sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of July 2019

Leisa Davies

For the Registrar