

O-148-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION NO 3033379 IN THE NAME OF TATIANA
HAIR EXTENSIONS LTD IN RESPECT OF THE TRADE MARK**



IN CLASS 41

**AND AN APPLICATION FOR INVALIDATION OF THE REGISTRATION
UNDER NO 500536 BY BRITISH FASHION COUNCIL**

Background and pleadings

1) Tatiana Hair Extensions Ltd is the proprietor of UK registration 3033379 for the mark shown on the front page of this decision (“the registration”). It applied for the registration on 31 December 2013 and the registration procedure was completed on 18 April 2014. The registration covers the following services:

Class 41: *Arranging and conducting award ceremonies; Arranging and conducting competitions; Arranging for ticket reservations for shows and other entertainment events; Arranging of conferences relating to entertainment; Arranging of demonstrations for entertainment purposes; Arrangement of conventions for recreational purposes; Arranging and conducting award ceremonies; Arranging and conducting competitions; Arranging and conducting educational conferences; Arranging for ticket reservations for shows and other entertainment events; Arranging of award ceremonies; Arranging of award ceremonies to recognise achievement; Arranging of beauty contests; Arranging of competitions for entertainment purposes; Arranging of displays for entertainment purposes; Arranging of pageants.*

2) On 6 August 2014, British Fashion Council (hereafter “the applicant”) filed an application to invalidate the registration. The grounds of invalidation are:

- (i) The registration offends against both Section 5(2)(b) and Section 5(3) of the Trade Marks Act 1994 (“the Act”) because the mark, the subject of the registration, is highly similar to an earlier mark in the name of the applicant and in respect of identical services. Therefore, a likelihood of confusion exists. Further, as a result of the reputation resulting from the applicant’s long standing use of its mark, use of the proprietor’s mark will result in unfair advantage and detriment to the reputation and the distinctive character of the applicant’s marks. It claims that the proprietor has sought to benefit from this reputation to divert business and if the standards of services provided by the proprietor do “not fit to the standards required by the applicant” there will be detriment to its reputation. The relevant details of the earlier mark relied upon by the applicant are:

Mark and relevant dates	Services relied upon
<p>2203239</p> <p>LONDON FASHION WEEK</p> <p>Filing date: 15 July 1999 Date of entry in register: 18 January 2002</p>	<p>Class 35: [...]; <i>arranging, organising and conducting trade shows, fairs and exhibitions; [...].</i></p> <p>Class 41: <i>Provision of training and cultural services for designers, manufacturers, suppliers, buyers and others in the haute couture and ready to wear clothing trades; arranging and conducting courses, conferences and exhibitions, events and seminars; organising, conducting, production of shows, events and displays; provision of interactive and other training and educational information provided on line from computer</i></p>

	<p><i>databases or the Internet; provision of information relating to such services for accessing via communication and computer networks.</i></p>
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- (ii) The registration offends under Section 5(4)(a) because the applicant has an established goodwill in the UK in respect of the following list of services:

Arranging, organising and conducting trade shows, fairs and exhibitions; provision of training and cultural services for designers, manufacturers, suppliers, buyers and others in the haute couture and ready to wear clothing trades; arranging and conducting courses, conferences and exhibitions, events and seminars; organising, conducting, production of shows, events and displays; provision of interactive and other training and educational information provided on line from computer databases or the Internet; ticketing services for events; award ceremonies; hair and beauty demonstrations

It claims that the first London Fashion Week event took place in 1984 and that the current format of the logo has been in use since 2009 and as shown below (hereafter, “the logo mark”). It claims that use by the proprietor of its mark misrepresents, to the consumer, that it is a business related to, or endorsed by, the applicant.

**LONDON
FASHION
WEEK**

- (iii) The registration offends under Section 5(4)(b) of the Act because the applicant is the owner of the copyright in the sign relied upon for the purposes of Section 5(4)(a). It explains that the logo was first created in 2006 by a freelance consultant named Daren Elis, that it was further refined by Ideas By Music Limited, a creative and branding agency. It states that the work is currently owned by the applicant as the rights were transferred by way of assignment.

3) The proprietor filed a counterstatement denying the claims. It draws a distinction between the applicant’s event and its event. It describes the applicant’s event as a catwalk event to showcase the top names in clothing and clothing accessories, whereas it describes its own event as “an event designed to showcase hair and hairstyles in a catwalk format”. It states that no reasonable person would confuse the two. It further claims that the reputation of British Fashion Week has nothing to do

with the applicant but, rather, with the underlying events themselves. It states that the applicant has failed to provide evidence of any instances of actual confusion. It further claims that the applicant uses numerous logos and not just the one relied upon in these proceedings. Finally, it relies on the fact that its mark received no objections during the examination process at the IPO and that the Registry has not been presented with any evidence that the examiner would not have already considered in granting the mark.

4) The applicant's earlier mark relied upon for the purposes of its Section 5(2)(b) and Section 5(3) grounds is potentially subject to the proof of use provisions contained in Section 47(2A) – (2E) of the Act because it completed its registration procedure more than five years before the date of application for invalidation. However, the proprietor chose not to place the burden of providing such use upon the applicant when it ticked the "no" box at paragraph 7 of the Form TM8 counterstatement. As a consequence of this, the applicant is entitled to rely upon the full range of services listed in its earlier mark.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 10 March 2016. The applicant was represented by Ms Iram Zaidi for Lewis Silkin LLP. The proprietor did not attend and was not represented at the hearing (or in the proceedings more generally).

Applicant's evidence

5) This takes the form a witness statement by Jeremy Summers, partner and solicitor at Lewis Silkin LLP, the applicant's representatives in these proceedings. He has worked with the applicant on a variety of intellectual property matters both with Lewis Silkin and in a previous employment, since about 2010. Mr Summers has had responsibility for the applicant's trade mark portfolio since 2012.

6) Mr Summers sets out the history and structure of the applicant. It is not necessary for me to detail this other than to note that it was created in 1983 with the aim to promote British fashion talent and it has an advisory board, business and cultural ambassadors and patrons that include senior figures from the fashion industry, celebrities and patrons from some well-known businesses and organisations. Its London Fashion Week event has been held twice a year in February and September each year, since February 1993.

7) Mr Summers states that the applicant organises and hosts most of the UK's leading fashion events including London Fashion Week that takes place twice a year. He explains that London Fashion Week is the applicant's bi-annual showcase of womenswear and occurs every February and September showcasing over 250 designers to a global audience of influential media and retailers. At Exhibit JS2 is a copy of an article from *The Independent* newspaper, dated 31 August 2010, providing a brief history of London Fashion Week. The article states that it will celebrate its 25th anniversary that year and references a number of "fashion icons" that debuted at the event over the years. A further article, this time from *The Telegraph* is provided at Exhibit JS3 and also provides a history of the applicant's event.

8) Mr Summers states that the logo mark was developed from a design created in 2004. It was amended in 2006 and further refined at a later, unspecified date. He states that the logo mark is “owned” by the applicant because of a confirmatory assignment of the copyright from the various creators. This document is provided at the confidential Exhibit JS4. It was signed on 12 September 2014 (some five weeks AFTER the application for invalidation was made, namely 6 August 2014).

9) At confidential Exhibit JS5, Mr Summers provides approximate values of sponsorship agreements entered into by the applicant in relation to its London Fashion Week event. These have grown from over £[REDACTED] in 2008 to £[REDACTED] in February 2013.

10) Numerous examples of press coverage are provided at Exhibit JS8 all dated between 15 September 2008 and 2 March 2013. A small representative list of examples are:

- A London Fashion Week Special in *The Times 2* newspaper supplement dated 20 February 2013 and in *Stella*, the glossy supplement to *The Sunday Times*, dated 17 February 2013;
- An article in *Drapers* dated 2 March 2013 about the “best in show” at London Fashion Week;
- A mention in an article in the *Daily Telegraph*, dated 19 February 2013;
- A mention in an article from *The Guardian*, dated 20 February 2013;
- The front cover of *Cosmopolitan* magazine from 1 October 2012 where it is proclaimed “from backstage beauty to front row goss, we’ve got London Fashion week covered!”;
- *Drapers* magazine cover proclaiming a “five-page London Fashion Week exclusive” dated 15 September 2012.

11) Mr Summers states that the applicant produces a large number of tickets, invitations and passes to London Fashion Week events and examples of these are provided at confidential Exhibit JS9. More than half of the numerous examples are dated February 2013 and many of these show use of the logo mark and also the word only mark. Some include “BFC VIP” passes, with “BFC” being a reference to the applicant. Copies of passes from 2011 and 2012 also show the logo mark and the word only mark.

12) Mr Summers provides copies of pages from the applicant’s website at Exhibits JS10 to JS13. Extracts dated between 15 September 2010 and 13 September 2013 all refer to, or are about, London Fashion Week. Only the word mark is seen.

13) At Exhibit JS15, Mr Summers provides copies of screenshots from the website londonfashionweek.co.uk, a website created in 1998. The screen shots have been obtained from the Internet archive *waybackmachine* and are dated 23 September 2006 through to 9 February 2013 (most of the eleven examples show the logo mark in use). Exhibit JS16 consists of information from a company called “The Alexa”, a company providing commercial web traffic data. This shows that the website londonfashionweek.co.uk was ranked 4323rd in the UK.

14) Other exhibits are provided by Mr Summers to illustrate that the London Fashion Week has a presence on social media sites such as Facebook, Pinterest, You Tube and Instagram.

15) Mr Summers also provides submissions that I will keep in mind but not detail here.

Proprietor's evidence

16) This takes the form of a witness statement by Shawn Frazer, director of the proprietor. At Exhibit EXSF1, he provides copies of various different forms of how he alleges the applicant uses its London Fashion Week marks in support of his contention that the "concept of a single identifiable London Fashion Week logo does not [...] exist". These copies are undated and their origins are unknown.

17) The remaining statement consists of submissions that I will not detail here, but I will keep in mind.

DECISION

Legislation

18) Section 5 of the Act has application in invalidation proceedings because of the provisions set out in Section 47. The relevant legislation is set out below:

47. - (1) [...]

(2) 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.

[...]

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) [...]

(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.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.

5. - (1) [...]

(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.

(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(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.

(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.

Section 5(4)(a)

19) I find it convenient to begin by considering the applicant's grounds based upon Section 5(4)(a).

General principles of Section 5(4)(a)

20) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's 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 defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

21) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

22) A long established definition of goodwill was provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

23) There is no requirement for an undertaking's goodwill to be identified by one sign and I dismiss the applicant's arguments that because the applicant does not use a single identifiable London Fashion Week logo this is a reason for dismissing the applicant's case. I must consider the evidence presented in order to reach a view of whether the applicant's logo mark identifies its goodwill, but first, I must consider if the applicant has the necessary goodwill.

24) In this respect, I note that the applicant has organised the London Fashion Week twice a year since February 1993, that in the last few years prior to the relevant date, it has achieved sponsorship in the region of £[REDACTED] and that it has achieved significant coverage in the national press and magazines. The London Fashion Week event also has its own website that is well utilised by those interested in the

event. In light of the evidence supporting this, I am in no doubt that the applicant enjoys a significant goodwill in its London Fashion Week event. There is a criticism from the proprietor that the goodwill does not reside with the applicant but with the underlying events held during London Fashion Week. I reject this. The applicant is the organiser of the event and is associated with it in the minds of its consumers and, as an example, the proprietor exhibits passes/tickets to events held as part of London Fashion Week where its name appears.

25) The evidence illustrates that the applicant's logo mark has been used since at least 2006 (see the first page of Exhibit JS15) and there are a variety of exhibits showing use since that time, such as the passes from 2011, 2012 and 2013 (Exhibit JS9) and on the applicant's website dedicated to the event, namely londonfashionweek.co.uk.

26) The applicant claims goodwill in respect of the following list of services:

Arranging, organising and conducting trade shows, fairs and exhibitions; provision of training and cultural services for designers, manufacturers, suppliers, buyers and others in the haute couture and ready to wear clothing trades; arranging and conducting courses, conferences and exhibitions, events and seminars; organising, conducting, production of shows, events and displays; provision of interactive and other training and educational information provided on line from computer databases or the Internet; ticketing services for events; award ceremonies; hair and beauty demonstrations.

27) I find that the evidence does not support a finding that its goodwill is in respect of the full breadth of services listed. I begin by considering the claim to goodwill in respect of *arranging, organising and conducting trade shows, fairs and exhibitions, courses, conferences, exhibitions, events, seminars, shows, and displays*. At Exhibit JS8, page 187 there is reference to an event provided as part of London Fashion Week where fashion styling advice is provided and at Exhibit JS7 (page 89) is a copy of a pass from the February 2013 event for "Catwalk/Exhibition" and others for "Exhibition only" or "exhibition" (pages 91, 99, 100, 109 and 110). The nature of these exhibitions is not recorded on the passes but at Exhibit JS15, page 324, there is a screen shot where the logo mark appears alongside information about the exhibition in September 2006. It is described as "where to find the best British accessories and ready-to-wear under one roof". Therefore, taking account of this specific evidence and the general impression of the nature of the London Fashion Week, I conclude that the applicant has goodwill in respect of *arranging, organising and conducting fashion shows, fashion exhibitions and fashion events*.

28) The evidence does not reflect any use in respect of *training* of any kind or of any *cultural services*. Insofar as it can be argued that *fashion shows* are a *cultural service*, it is already covered by *arranging, organising and conducting fashion shows*.

29) In respect of *provision of interactive and other training and educational information provided on line from computer databases or the Internet*, the applicant has provided evidence (at Exhibit JS15) regarding its website dedicated to promoting its London Fashion Week event and refers to "catwalk events" and "the exhibition".

From these exhibits, it is not obvious to me that the information provided on the website relates to either training or education. Even if I am wrong on this point, because any such information is related to its fashion events and exhibition, the goodwill will be in respect of these services rather than the training or education itself. Similarly, I have found nothing in the evidence to suggest that the applicant organises *award ceremonies*.

30) In respect of *ticketing services for events*, the evidence illustrates many passes/tickets to various events held as part of London Fashion Week. There is clear oversight by the applicant demonstrated by the common style of the passes. I accept that this illustrates that the applicant provides *ticketing services for fashion events*.

31) Finally, in respect of *hair and beauty demonstrations*, at the hearing Ms Zaidi directed me to Exhibit JF6 which consists of a list of sponsors. "Tony & Guy (Hairdressing)" are listed as a sponsor every year between 2008 and 2013. Ms Zaidi also directed me to Exhibit JF24. This consists of a press release dated 12 August 2013 that announces an "exciting partnership deal" between Tony & Guy" and the applicant where London Fashion Week lends its name to a range of Tony & Guy hair products. Whilst this evidence does show some link up between London Fashion week and the hair dressing industry, it is not in the form of *hair and beauty demonstrations*. Consequently, I find that there is no goodwill in respect of these services.

32) Taking all of this into account, I conclude that the applicant's goodwill is identified by its logo mark and in respect of the following list of services:

Arranging, organising and conducting fashion shows, fashion exhibitions and fashion events; ticketing services for fashion events

Misrepresentation and damage

33) Having established that the applicant has the requisite goodwill and that this is identified by its logo mark, I must consider if use of the proprietor's mark will result in misrepresentation of, and damage to the applicants sign.

34) 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.”

35) Also in *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“The role of the court, including this court, was emphasised by *Lord Diplock in GE Trade Mark* [1973] R.P.C. 297 at page 321 where he said:

‘where the goods are sold to the general public for consumption or domestic use, the question whether such buyers would be likely to be deceived or confused by the use of the trade mark is a “jury question”. By that I mean: that if the issue had now, as formerly, to be tried by a jury, who as members of the general public would themselves be potential buyers of the goods, they would be required not only to consider any evidence of other members of the public which had been adduced but also to use their own common sense and to consider whether they would themselves be likely to be deceived or confused.

The question does not cease to be a “jury question” when the issue is tried by a judge alone or on appeal by a plurality of judges. The judge's approach to the question should be the same as that of a jury. He, too, would be a potential buyer of the goods. He should, of course, be alert to the danger of allowing his own idiosyncratic knowledge or temperament to influence his decision, but the whole of his training in the practice of the law should have accustomed him to this, and this should provide the safety which in the case of a jury is provided by their number. That in issues of this kind judges are entitled to give effect to their own opinions as to the likelihood of deception or confusion and, in doing so, are not confined to the evidence of witnesses called at the trial is well established by decisions of this House itself.”

36) Therefore, it is not necessary for the applicant to adduce evidence of misrepresentation. Rather it is an issue that I can decide based upon the facts of the case. In this respect, I first consider the level of similarity of the respective sign and mark:

Applicant's sign	Proprietors mark
	

37) As Ms Zaidi submitted at the hearing, both the mark and sign share a number of similarities in design. They both consist of words stacked into three rows and in both cases the word “London” appears in the first row, the word “fashion” in the second, and the word “Week” in the third. The style of lettering/font appears to be identical. There are also differences, namely the addition of the word “Hair” in the first row of the proprietor’s mark, the colour of the words “London Hair” and also the black letters on a white background present in the applicant’s mark is inverted in the proprietor’s mark. Aurally, the word “hair” provides the only distinguishing feature between the marks and this also provides some conceptual distinction between them. However, these differences fail to offset the high level of similarity. Such are these similarities, it appears to me that the proprietor’s mark was modelled on the applicant’s mark. I say this not because it shows the intent of the proprietor but because it highlights the impact of the similarities between the mark and sign.

38) Turning to the respective parties’ services, they are:

Applicant’s services	Proprietor’s services
<p><i>Arranging, organising and conducting fashion shows, fashion exhibitions and fashion events; ticketing services for fashion events</i></p>	<p>Class 41: <i>Arranging and conducting award ceremonies; Arranging and conducting competitions; Arranging for ticket reservations for shows and other entertainment events; Arranging of conferences relating to entertainment; Arranging of demonstrations for entertainment purposes; Arrangement of conventions for recreational purposes; Arranging and conducting award ceremonies; Arranging and conducting competitions; Arranging and conducting educational conferences; Arranging for ticket reservations for shows and other entertainment events; Arranging of award ceremonies; Arranging of award ceremonies to recognise achievement; Arranging of beauty contests; Arranging of competitions for entertainment purposes; Arranging of displays for entertainment purposes; Arranging of</i></p>

39) Whilst there is no requirement for the applicant's services to be in the same field of activity that the proprietor operates (see *Lego System Aktieselskab and Another v Lego M. Lemelstrich Ltd* [1983] FSR 155 (HC)), this is nevertheless a relevant factor.

40) As Ms Zaidi submitted at the hearing, the proprietor's services are not limited to events about hair and include services relating to any kind of award ceremonies, competitions and ticket reservations. Such services include those relating to fashion. These are all services that the applicant's customers would expect to be provided as part of, or ancillary to the services for which the proprietor has goodwill.

41) In respect of the proprietor's *Arranging of conferences relating to entertainment; Arranging of demonstrations for entertainment purposes; Arrangement of conventions for recreational purposes; Arranging of competitions for entertainment purposes; Arranging of displays for entertainment purposes*, the references to "entertainment" and "recreation" include fashion events for entertainment or recreational purposes. Consequently, these are all services that a very closely related to the proprietor's activities.

42) The similarity to the applicant's activities is less obvious when considering the proprietor's *Arranging and conducting educational conferences*. Where such educational conferences relate to fashion there will, nevertheless, be an association with fashion events of the kind and scale provided by the applicant and such events may also be organised to take place side-by-side.

43) On the other hand, I am not aware that *beauty contests* and *pageants* are events that would take place in association with the type of services provided by the applicant. There is no evidence to suggest otherwise. Consequently, I find that the proprietor's *Arranging of beauty contests* and *Arranging of pageants* are not in the same field of activity as the applicant, but as I noted earlier, this is not a requirement, but one factor that is relevant when considering all the factors before me.

44) Taking account of all of the above, I find that it is inevitable that the applicant's customers and potential customers will believe that the respective services originate from the same source or are connected. This will have the effect of diverting customers away from the applicant's business. Consequently, there will be misrepresentation and damage. Despite it being slightly more arguable in respect of the proprietor's *Arranging of beauty contests* and *Arranging of pageants*, on balance, taking account of the high similarity between the sign and mark, my findings apply to all of the proprietor's services including these.

45) In summary, the proprietor's registration is invalidated.

Other grounds

46) In light of my findings above, the applicant has been successful and the registration is invalidated. Consequently, it is not necessary for me to consider the remaining grounds.

COSTS

47) The applicant has been successful and is entitled to a contribution towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. I award costs on the following basis:

Preparing a statement and considering the counterstatement	£300
Application fee	£200
Evidence	£800
Preparing for, and attending hearing	£700
Total:	£2000

48) I order Tatiana Hair Extensions Ltd to pay British Fashion Council the sum of £2000 which, in the absence of an appeal, should be paid within 14 days of the expiry of the appeal period.

Dated this 21st day of March 2016

Mark Bryant
For the Registrar,