

O/189/12

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2506134**

**BY**

**DEVA CONCEPTS LLC  
TO REGISTER THE TRADE MARK**

**DEVA**

**IN CLASS 3**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 99323**

**BY**

**SALON UK LIMITED**

**Trade Marks Act 1994**  
**In the matter of application no. 2506134**  
**by Deva Concepts LLC**  
**to register the trade mark:**  
**DEVA**  
**in class 3**  
**and the opposition thereto**  
**under no. 99323**  
**by Salon UK Ltd**

**BACKGROUND**

1. On 09 January 2009, Deva Concepts LLC (the applicant) applied to register the above trade mark in class 3 of the Nice Classification system<sup>1</sup> as follows:

**Class 3**

*Hair care products; hair care preparations; hair cleaning preparations; hair styling preparations; hair dressings; hair dressing preparations; shampoo; conditioners; hair spray; hair gel; hair mousse; hair dyes; hair rinses; hair bleach; hair relaxers; hair lighteners; hair straightening preparations; hair lotions.*

2. Following publication of the application in the *Trade Marks Journal* on 17 April 2009, Salon UK Ltd (the opponent) filed notice of opposition against the application.

3. The grounds of opposition were brought under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act).

4. The opposition is directed against all of the applicant's goods and is based upon the trade mark shown below. Under section 5(2)(b) of the Act the opponent relies upon the goods shown below.

<b>MARK DETAILS AND RELEVANT DATES</b>	<b>GOODS RELIED UPON</b>
<p><b>TM:</b> 2490720</p> <p><b>Mark:</b> divA professional styling</p> <p><b>Date of application:</b> 23 June 2008</p> <p><b>Date of registration:</b> 3 December 2010</p>	<p><b>Class 03:</b> Preparations for the hair.</p> <p><b>Class 08:</b> Apparatus and instruments for cutting, trimming and removing hair; non-electric apparatus and instruments for styling hair; clippers, scissors, shears, shavers, razors, cutters, tweezers; apparatus</p>

<sup>1</sup> *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

	<p>and appliances for use in manicure; spatulas; depilatory devices; curling tongs and hair straighteners; parts and fittings and cases for all the aforesaid goods.</p> <p><b>Class 09:</b> Measuring instruments, apparatus and containers; timers; electrical appliances for perming the hair, electrically heated hair styling apparatus.</p> <p><b>Class 11:</b> Hairdryers; hood dryers; wax heaters.</p> <p><b>Class 20:</b> Salon furniture; trolleys and stands; stools, foot rests, magazine racks, holders for styling apparatus; tissue and foil dispensers; trays.</p> <p><b>Class 21:</b> Brushes and combs; apparatus for cleaning brushes and combs; bottles and dispensing containers; hand operated water sprayers; tube squeezers; bowls, storage boxes and containers; squeeze powder blowers; face shields.</p>
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5. In its statement of grounds the opponent submits, inter alia:

*4. "The two marks are highly similar phonetically, conceptually and visually differing only in non-distinctive matter. The relevant public will focus on and recall the 'DIVA' element of the earlier right rather than the entirety of the mark. Additionally, there is a clear overlap between the goods listed in the Class 3 specifications of UK Trade Mark Application Numbers 2506134 and 2490720. All of the goods of the opposed application are encompassed by the term 'preparations for the hair' in the Class 3 specification of the Opponent's earlier right. The Opponent's earlier right also extends to a wide range of goods all of which relate to the treatment or beautification of the hair. The Applicant's goods and the goods of the Opponent will be sold through the same trade channels, to the same consumers, for the same purpose. In light of the close similarity of the marks, the clear overlap of some goods and the similarity of others, there exists a high likelihood of confusion between the two marks. The relevant public will expect that products bearing the opposed mark will originate from the opponent."*

6. Under sections 5(3) and 5(4)(a) of the Act the opponent states that it has a reputation/goodwill in relation to the following goods:

*“Hair straighteners, hair dryers, electrically heated hair styling apparatus and parts, fittings and cases for all the aforesaid.”*

7. In relation to section 5(3) the opponent states:

*“The public is likely to believe that there is an economic connection between the opposed mark and the Opponent. Such use will take unfair advantage of the Opponent’s reputation in its earlier mark. The Opponent will have no control over the use of the opposed mark and such uncontrolled use will be damaging and detrimental to the distinctive character of the Opponent’s earlier mark.”*

8. In relation to section 5(4)(a) it states:

*“The Opponent has been marketing his goods in the UK under the mark ‘divA professional styling since October 2008 and has invested considerable time and money to build goodwill in the goods sold under the mark. Use of the opposed mark is a misrepresentation likely to lead the public to believe that the Applicant’s goods are those of the Opponent. The Opponent will suffer damage by reason of the public’s erroneous belief that the Applicant’s goods are those of the Opponent.”*

9. On 23 September 2009, the applicant filed a counter statement which denies the grounds upon which the opposition is based.

10. The opponent's mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.<sup>2</sup>

11. Both parties filed evidence in the proceedings, though the applicant’s evidence consisted of a witness statement containing only submissions; only the opponent filed written submissions in lieu of a hearing. I will refer to these as necessary below.

## **EVIDENCE**

12. The opponent’s evidence consists of a witness statement from Paul Barton, dated 8 February 2012, accompanied by 12 exhibits. Mr Barton is the Commercial Director of Salon UK Ltd, a position he has held since April 2005. The main facts emerging from Mr Barton’s statement are, in my view, as follows:

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<sup>2</sup> See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

- Salon UK Ltd has used the mark 'divA professional styling' since October 2008.
- The 'divA professional styling' mark has been used on all of Salon UK Ltd's products manufactured to date. These include *"hair straighteners, curling irons, hairdryers and curling wands."*
- In respect of marketing expenditure Mr Barton states:

*"My company has promoted the diva professional styling brand widely in the UK and Europe and our expenditure on promotion was more than £100,000 for the period between 1 October 2008 and 9 January 2009."*

- In respect of turnover figures Mr Barton states:

*"...our net sales under the divA professional styling mark for the period 1 October 2008 – 9 January 2009 exceeded £520,000."*

- The mark is used in the following form:



Copies of invoices, product packaging and evidence of attendance at trade shows have been filed in support of the opponent's claimed reputation for goods in classes 9 and 11. For reasons which will become apparent, there is no need for me to summarise these details here.

## **DECISION**

13. I shall deal first with the ground of objection under section 5(2)(b). 5(2)(b) of the Trade Marks Act 1994, states:

*"(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."*

14. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

### **The CJEU cases**

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

### **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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 great 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 the earlier mark to mind, 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 causes the public to 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

15. In his witness statement Mr Barton states:

*“16... Although we have not commenced use yet on so called 'wet goods', i.e. hair care products and preparations in class 3, we have a strong intention to use such goods in the future and our earlier registration...extends to 'preparations for the hair'.”*

16. The opponent's 'preparations for the hair' in class 3 are self evidently the closest to the applicant's goods in class 3. The opponent is in no better position in relation to goods in any of the other classes in which its earlier mark is registered. Consequently I shall confine my analysis to the goods in class 3 for the assessment under 5(2)(b) of the Act.

17. For ease of reference, the goods are shown below:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<b>Class 03:</b> Preparations for the hair.	<b>Class 03:</b> Hair care products; hair care preparations; hair cleaning preparations; hair styling preparations; hair dressings; hair dressing preparations; shampoo; conditioners; hair spray; hair gel; hair mousse; hair dyes; hair rinses; hair bleach; hair relaxers; hair lighteners; hair straightening preparations; hair lotions.

I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 where the court held that:

*“29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”*

18. All of the applicant's goods in class 3 are included in the wider category, 'preparations for the hair' in the opponent's class 3 specification. The goods are therefore identical.

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

19. In accordance with the above cited case law, I must determine who the average consumer is and consider the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant, but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

20. In its submissions the opponent states:

*“4...the relevant consumer for the goods consists of the wider UK public including trade buyers. The level of attention of the general public for the goods is likely to be low given the wide availability, broad selection and low pricing of goods in question.”*

21. I agree that the average consumer will be a member of the general public or a trade buyer. The purchase is likely to be primarily visual as it is likely to be made from a website, catalogue or directly from a shelf. However, I do not ignore aural considerations as, in my experience, it is not unusual to find more expensive hair products kept in cases or behind counters in, for example salons and department stores, while a trade buyer may purchase goods over the telephone from a wholesaler. In my experience such goods are often displayed according to the type of goods; e.g. hair dyes and bleaches separate from styling products and shampoos, whether on a web page, shelf or in a catalogue. These, in turn, are often further divided by hair colour, hair type, etc. The purchaser will pay a reasonable degree of attention, to the extent that the average consumer of hair products is likely to consider, inter alia, intended hair type, colour and particular ingredients. However, these are relatively low value, fairly frequent purchases and are unlikely to demand a high level of attention to be paid to their selection.

### **Dominant and distinctive components**

22. The opponent's mark consists of the words 'divA professional styling'. In its submissions the opponent states:

*“10. The most distinctive element of the Opponent's mark, is the divA element; the remainder of the mark is of low distinctive character for the goods of UK Trade Mark Registration Number 2490720 as such goods are for styling purposes. The word 'professional', conveys that the goods will give a professional effect or finish, or that they may be used by professionals.”*

23. I agree, the words 'professional styling' are descriptive in relation to the goods and are clearly not distinctive in the context of 'hair care preparations'. They are likely to receive little or no attention from the average consumer who is, in my experience, used to seeing such terminology used in relation to such goods.

24. The applicant's mark, 'DEVA' does not split into separate distinctive and dominant components. It will be viewed as the single word 'DEVA' which is its only constituent part.

25. Taking these factors into account I find 'divA' to be the distinctive and dominant element of the opponent's mark. The applicant's mark consists of only the word 'DEVA'; consequently, the distinctiveness of the mark rests in that word.

### **Visual similarities**

26. In its submissions the applicant states:

*“6. The DEVA Mark is presented in block capitals, without any additional material, whereas the Opponent's Mark has been deliberately presented in upper and lower case, thus being visually different.”*

27. The opponent submits:

*“12...the consumer is likely to put more weight on the divA element of the Opponent's mark. The minor difference in spelling is likely to be unnoticed by the public especially when the goods are not compared side by side. The respective marks are closely similar visually.”*

28. The similarity of the marks rests in the distinctive elements 'divA' and 'DEVA'. Both consist of four letters, only the second letter is different, namely, 'i' in the opponent's mark and 'E' in the applicant's mark, though both are vowels. The first three letters of the opponents mark are presented in lower case, followed by a capital letter 'A' while the applicant's mark is presented entirely in upper case. The opponent's mark includes the additional words 'professional styling' which, as I have already discussed, given its descriptive meaning will, in my view, go largely unnoticed by the average consumer. The differences in case between the two marks are unremarkable, and are of the kind the average consumer will be used to

encountering and may not even notice. Taking all of these factors into account, I consider there to be a reasonably high degree of visual similarity between the marks.

### **Aural similarities**

29. The applicant submits:

*“6. The DEVA Mark would be pronounced differently to the Opponent's Mark, being pronounced “DEVVER”, as opposed to the Opponent's mark, which would be pronounced either “DEEVER PROFESSIONAL STYLING” or “DIVER PROFESSIONAL STYLING”.*

30. The opponent submits:

*“11...The consumer will be likely to pronounce the DEVA mark as Diva; the letters 'E' and 'I' have the capacity to be phonetically equivalent.”*

31. In my view the opponent's mark is likely to be pronounced 'DEE-VER'. It is a known dictionary word with which the average consumer is likely to be familiar. The applicant's mark has two likely pronunciations 'DEE-VER’ or “DEV-ER”. The first of these options is aurally identical to the dominant and distinctive element of the opponent's mark, the second is similar. Taking all of these factors into account, I find the marks to be (at least) aurally similar to a reasonable degree and (more likely) aurally identical.

### **Conceptual similarities**

32. For a conceptual meaning to be relevant it must be one capable of immediate grasp by the average consumer.<sup>3</sup>

33. The applicant submits:

*“7. The DEVA Mark was invented by the Applicant, and is formed from the name of the owner of the Applicant...Members of the public are likely to see this mark as an invented word, given the spelling.”*

34. The opponent submits:

*“13. In so far as the conceptual similarity of the marks is concerned, the Opponent submits that the DEVA mark will be perceived by the public as meaning “Diva” or, alternatively that DEVA will be associated with the term DIVA. Either way, a conceptual link will be very strong when goods are requested aurally in a shop or in telephone ordering.”*

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<sup>3</sup> This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

35. 'Diva' is defined as "a famous female singer of operatic or popular music."<sup>4</sup> It is a normal everyday word of which the average consumer is likely to be aware.

36. The average consumer may see the applicant's mark as being a reference to the known word Diva, either because the words are similar or because they do not notice the difference in spelling. If this is the case, then the marks are conceptually identical. It is also possible that the applicant is correct in its belief that the average consumer will view the term DEVA to be a made up word. However, given the nature of the goods at issue in these proceedings, which are purchased to beautify a person's hair and which, in my experience, are much more likely to be directed at female consumers on balance, it is, in my view, much more likely that the average consumer will either consider the applicant's mark to be the word 'Diva' or will see it as a reference to it. Consequently, I find a reasonably high degree of conceptual similarity.

### **Distinctive character**

37. I must now assess the distinctive character of the Opponent's earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

38. I have to consider whether the Opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it.

39. I have already noted at paragraph 15 above, that Mr Barton acknowledges the opponent has not used the mark 'divA professional styling' in respect of goods in class 3. Consequently, I need only consider its inherent distinctiveness.

40. The word 'diva' is a normal dictionary word which is neither descriptive of nor non-distinctive for the goods at issue. It possesses a minimal level of stylisation which is unremarkable. I find it to be a trade mark with a normal level of distinctiveness.

### **Likelihood of confusion**

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<sup>4</sup> *The Concise Oxford English Dictionary, Twelfth edition*. Ed. Catherine Soanes and Angus Stevenson. Oxford University Press, 2008.

41. In assessing the likelihood of confusion I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.<sup>5</sup> I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

42. I have found that the marks share a reasonably high degree of visual and (at least) a reasonable degree of aural similarity and have found there to be a reasonably high degree of conceptual similarity. I have also identified a normal level of distinctive character in the opponent's earlier mark. In respect of the goods I have concluded that the parties' goods are identical according to the principles in *Meric*. I have identified the average consumer, namely a member of the general public or a trader who buys hair care preparations. I have concluded that the purchasing act will, generally, be visual but may include an aural element in the case of goods displayed behind counters and orders placed by telephone. The purchase will involve a reasonable degree of care and attention, given that the average consumer will be selecting according to their own requirements and is purchasing a product to use on the person.

43. Taking all the above factors into account, and considering the marks as a whole, and the nature of the purchasing process, I conclude that the differences between the marks are not sufficient to outweigh the obvious similarities. It is clear from decisions such as joined cases T-183/02 and T-184/027<sup>6</sup> that the first parts of words catch the attention of consumers. In the context of identical goods and taking into account imperfect recollection, I find the average consumer is likely to mistake one mark for the other i.e. there would be direct confusion. Even if I am wrong in this regard, I find that the average consumer would consider the goods to come from economically linked undertakings, i.e. there would be indirect confusion.

44. The opposition having succeeded under 5(2)(b) it is not necessary for me to make an assessment under sections 5(3) and 5(4) of the Act. However, for the sake of completeness I have briefly considered both grounds below:

#### **The objections based upon section 5(3) and 5(4)(a)**

45. In its submissions the applicant said:

*"8. Although the Applicant accepts that the Opponent's evidence shows use of the Opponent's Mark in relation to goods in classes 8, 9 and 11, specifically hand-held hairdryers and hair stylers (straighteners/curlers/tongs), it does not*

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<sup>5</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

<sup>6</sup>

*II – 965, paragraph 81*

*(MUNDICOR) [2004] ECR*

*appear that the Opponent has used the Opponent's mark for any other goods covered by the Opponent's registration."*

46. The Opponent has provided evidence of use for the period October 2008 – January 2009. Three months use of the mark is highly unlikely to be enough to establish a reputation of the kind envisaged by the CJEU in *General Motors Corp v Yplon SA*<sup>7</sup> and summarised by the Principal Hearing Officer in O-179-11 at paragraph 48, particularly in view of the goods at issue. Success under this ground is, therefore, highly unlikely.

47. In respect of the objection based upon section 5(4)(a) of the Act, even if the evidence was sufficient to establish the goodwill required to get a passing-off action off the ground, the goods on which use has been shown are in classes, 9 and 11 which are further away than the goods on which the opponent has already succeeded. Put simply, the opponent is in no better position under section 5(4)(a) of the Act.

## **CONCLUSION**

**48. The opposition succeeds under section 5(2)(b) of the Act.**

### **Costs**

49. The opposition having succeeded, the Opponent, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that the opponent filed evidence as well as written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement: (including opposition fee)	£500
Preparing evidence:	£400
Written submissions:	£300
<b>Total:</b>	<b>£1200</b>

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<sup>7</sup> [2000] RPC 572

50. I order Deva Concepts LLC to pay Salon UK Ltd the sum of £1200. 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 9<sup>th</sup> day of May 2012**

**Ms AI Skilton  
For the Registrar,**