

o/208/06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2301413
BY MAY EXPORTS LIMITED TO REGISTER A TRADE MARK
IN CLASSES 3, 5 AND 16**

AND

**IN THE MATTER OF OPPOSITION No. 92571
BY JOHN PAUL MITCHELL SYSTEMS**

TRADE MARKS ACT 1994

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by May Exports Limited to register a Trade Mark
in Classes 3, 5 and 16**

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**IN THE MATTER OF Opposition No. 92571
by John Paul Mitchell Systems**

BACKGROUND

1. On 24 May 2002 May Exports Limited applied to register the following mark:



for a specification of goods that reads as follows:

Class 03:

Cosmetics; toiletries; shampoos, skin care preparations, essential oils, soaps, gels, lotions and creams, all for the skin, hands and/or body; bath oils and gels; talcum powder; moisturisers; cotton wool for cleansing purposes, tissues and wipes; all for babies.

Class 05:

Antiseptic disinfectants; medicated toiletries; medicated skin creams for the hands, body and face; sanitary preparations and substances; antiseptic creams; air freshening preparations; all for babies.

Class 16:

Printed matter, paper, cardboard and goods made from these materials, all for use within the baby cosmetic and baby toiletries industries; babies' bespoke disposable nappies.

2. The application is numbered 2301413.

3. On 14 July 2004, John Paul Mitchell Systems, a California corporation filed notice of opposition against this application. The opponent is the proprietor of the following registrations which are earlier trade marks within the meaning of Section 6(1) of the Act:

No.	Mark	Class	Specification
1510144(UK)	PAUL MITCHELL	03	Hair care products; all included in Class 3.
76018(CTM)	PAUL MITCHELL	03	Hair care and cosmetic products for the hands and body, namely shampoos, hair colors, hair dyes, hair tints, sprays, rinses, hair setting and styling lotions, gels, lotions, perms, solutions, waving lotions, conditioners, moisturizers, sun tanning preparations, sun screens, facial toners, creams, facial preparations and powders.
		16	Bags of paper and plastic for packaging hair care and cosmetic products, file folders and loose-leaf binders.
		25	T-shirts, sweatshirts, over-garments for use by beauticians, namely, dryer drapes and cutting capes.

4. The opponent offers a number of submissions in relation to the issues of similarity of marks and similarity/identity of goods and concludes that there exists a likelihood of confusion. Refusal is sought under Section 5(2)(b). In the alternative, refusal is sought under Section 5(3) on grounds that initially follow the wording of the statute but are subsequently refined as follows:

“It is evident that the mark applied for is likely to be linked by members of the purchasing public to the earlier marks **PAUL MITCHELL** and this would invariably take advantage of the reputation of the earlier mark by gaining credibility or by being otherwise associated with the earlier mark’s reputation, thereby omitting the need to invest in advertising or expensive marketing. Use of the later mark would also dilute the distinctive character and reputation of the earlier marks and may be seen by the public as a “*baby version*” to the PAUL MITCHELL range of products.”

5. Further grounds are raised under Section 5(4)(a) and in particular the law of passing off having regard to the opponent’s claimed use since 1985 in respect of hair care products and under Section 56(2) on the basis that the opponent’s mark is well known for such goods.

6. The applicant filed a counterstatement denying the above claims and offering its own submissions in relation to the respective marks and goods. The opponent is put to proof of its claims to have used its mark. I observe at this point that, in accordance with The Trade Marks (Proof of Use etc) Regulations 2004 which came into force on 5 May 2004 the opponent was required to make a statement of use in relation to registration No. 1510144. Accordingly, it claimed use on hair care products since 1985. No such statement of use was called for in respect of CTM No. 76018 as that mark had not been on the Community register for the requisite five year period at the time the opposition was filed.

7. Both sides ask for an award of cost in their favour.

8. Both sides filed evidence. The matter came to be heard on 20 June 2006 when the opponent was represented by Mr R Buehrlen of Beck Greener. The applicant was not represented at the hearing but filed written submissions under cover of a letter dated 16 June 2006 from Sanderson & Co, its professional advisers in this matter.

Opponent's evidence

9. The opponent's main evidence is a witness statement from Leslie George Spears, the founder and chairman of Salon Success Limited, the master distributor in 23 countries of the opponent's products and the exclusive distributor in the UK.

10. Mr Spears says that the mark has been used continuously in the UK since 1987. he exhibits, LGS1, copies of screens showing the manner in which the mark is affixed to goods. Turnover is given as follows (taking the years up to and including the material date in these proceedings):

<u>YEAR</u>	<u>TURNOVER POUNDS</u>
30 June 1989	£621,029
30 June 1990	£1,372,744
30 June 1991	£2,157,904
30 June 1992	£3,332,697
30 June 1993	£4,928,587
30 June 1994	£7,004,262
30 June 1995	£6,876,552
30 June 1996	£7,630,774
30 June 1997	£8,161,232
31 December 1998 (18 month period)	£13,146,080
31 December 1999	£9,302,583
31 December 2000	£8,102,761
31 December 2001	£9,564,261
31 December 2002	£10,998,252

11. The above sales are said to represent a significant market share for salon products, PAUL MITCHELL being a brand targeted at professional hair salons and including children's, men's and ladies' haircare products and toiletries. Within this particular market Euromonitor Market Research is said to refer to PAUL MITCHELL as having 29.5% of the UK market followed by L'Oreal on 15.7%. Exhibited at LGS2 is a bundle of invoices showing sales of the products and at LGS3 a media schedule for the years 2001 to 2005 issued by Salon Success Ltd's media advisers. I note that the schedule reveals advertising in a range of national and local newspapers, fashion magazines, specialist (hair) magazines etc. A bundle of advertisements is also exhibited at LGS4 covering the years 1993 to 2004. The final exhibit, LGS5, is a list of geographical locations identifying where Salon Success' customers are based and a further list identifying the number of retail outlets by county. Finally, Mr Spears says that the PAUL MITCHELL brand has spread into providing products for children and babies. He refers again to Exhibit LGS1 which shows a number of children's products including 'Baby Don't Cry Shampoo' and 'Taming Spray'.

12. A further seven witness statements have been filed in support of the opponent's case. All are proprietors of hairdressing salons. All have lengthy experience in the hairdressing

business. All either use or stock and sell PAUL MITCHELL products and attest to the widespread recognition of the brand.

Applicant's evidence

13. Martin Andrew Cockerell, the applicant's Managing Director has filed a witness statement. He stresses the stylised presentation of his company's mark consisting of the word MITCHELL with a device element consisting of three concentric oblong shapes such as to give it a three dimensional effect. Exhibit MAC1 is an example of the mark as used and Exhibit MAC2 is a sample of May's baby soap packaging. He says that this mark has been used since 1996 with the goods being sold primarily for the export market as well as to wholesalers. The ultimate retailers being small independent chemists and general stores. The remainder of his statement consists largely of submission which address the differences between the marks; the distinctive character of the marks; the nature of the products; the different trade channels and the absence of instances of confusion. I do not propose to further summarise the points at this stage but take them into account in my decision below.

DECISION

Section 5(2)(b)

14. This reads:

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

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

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

15. I was referred to and take into account the well established guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723. The guidance from these cases is now well known. Accordingly, I do not propose to set out the relevant passages. Suffice to say that the test is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those various elements, taking into account also the degree of identity/similarity between the goods and services and how they are marketed. In comparing the marks I must have regard to the distinctive character of each and assume normal and fair use of the marks across the full range of the goods and services within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant.

The distinctive character of the earlier trade marks.

16. The distinctive character of the opponent's earlier trade mark, PAUL MITCHELL, is a factor to be taken into account. It falls to be assessed by reference to both its inherent and any acquired qualities of distinctiveness. There is now guidance from the ECJ on the assessment of distinctive character of surnames in *Nichols Trade Mark* [2005] RPC 12. The *Nichols* case and other relevant cases involving surnames and full names were reviewed in *Oska's Trade Mark Application* (and opposition by Morgan SA), O/317/04. *Nichols* was a case involving the distinctive character of a surname in the context of registrability on absolute grounds. The Appointed Person considered in *Oska's* that the same approach must be adopted when considering the inherent distinctiveness of an earlier trade mark for the purpose of a relative ground objection (paragraph 33 of that decision). Accordingly, I invited submissions at the hearing in relation to this case.

17. The principles to be drawn from the judgment of the ECJ in *Nichols* are summarised in paragraph 25 of *Oska's* as follows:

- “(1) There are no special, stricter rules for assessing the distinctive character of signs which consist of surnames. In particular, it cannot be assumed that surnames are *a priori* devoid of distinctive character. Nor is it legitimate to assess surnames according to general criteria such as those mentioned in paragraph 26. Nor is it legitimate to refuse registration of surnames in order to ensure that no advantage is afforded to the first applicant. Nor is it relevant that Article 6(1)(a) of the Directive entitles third parties to use their own names in certain circumstances. [Judgment paragraphs 25-26, 29-33.]
- (2) A surname must be specifically assessed for distinctive character in accordance with the criteria applicable to any sign covered by Article 2 of the Directive in relation to the goods or services for which registration is sought and the perception of the average consumer of such goods or services. [Judgment paragraphs 27, 34.]
- (3) The perception of the average consumer is not necessarily the same for all categories of signs. Thus it may be more difficult to establish that certain categories of sign are distinctive than other categories of signs. [Judgment paragraph 28.]”

(the above judgment references are to the relevant paragraph in *Nichols*)

18. The Appointed Person went on to say that it is clear from principle (3) that the Court is not saying that the tribunal must ignore the fact that a sign propounded for registration is a surname. It is proper to take into account any and all characteristics of the sign in question which bear upon its distinctiveness according to the perception of the average consumer of the goods or services in question (paragraph 26). Furthermore, he suggested that the Court acknowledged that the average consumer does not necessarily perceive surnames in the same way as other categories of signs and that this may make it more difficult to establish that they are distinctive (paragraph 27). The commonness of the surname may properly be taken into account provided it is part of a specific assessment of the distinctiveness of the surname in respect of the goods or services concerned (paragraph 28). With some hesitation he concluded that it is permissible to take into account the extent to which surnames are used to

designate commercial origin in the sector in question, again subject to it being part of a specific assessment.

19. In assessing the distinctive character of the opponent's mark in *Oska's* the Appointed Person posed the following question:

“38 The question then is whether the average consumer of clothing, being aware that (a) MORGAN is a common surname, particularly in Wales, (b) MORGAN is not in common use as a trade mark for clothing, (c) clothing is a field in which traders commonly trade under their own names, (d) many traders are engaged in the field of clothing, and (e) it may be necessary to differentiate between clothing suppliers who share a common surname by means of first names, would without education assume that MORGAN denoted clothing meaning from a single undertaking or regard it as potentially denoting clothing from more than one trade origin. I do not find this an easy question to answer, but on balance I consider that without use MORGAN would be devoid of distinctive character in relation to clothing and therefore would not be registrable.”

20. The applicant has submitted that its own mark MITCHELL and device met with an objection from the Registry on the basis that MITCHELL was a common surname. It is claimed that its own mark only proceeded to publication on the basis that the device added distinctiveness. The examination papers have not been placed before me so I cannot comment on the basis of acceptance. It is, however, clear that the mark was accepted and published for opposition purposes prior to the ECJ's judgment in *Nichols*.

21. Mr Buehrlen took me through the above criteria from the *Oska's* case. In summary he accepted that MITCHELL was a common surname (point (a)); he submitted that there is no evidence before me to suggest that MITCHELL is in common use as a trade mark for the goods at issue (particularly hair care products and cosmetics (point (b))); that haircare products and cosmetics are fields of trade where it is not so common for traders to trade under their own names as, say, clothing (point (c)); and that these areas of trade tend to have many traders but generally speaking larger scale businesses, as compared to a more fragmented market such as clothing, where many smaller traders operate (points (d) and (e)).

22. Considering the opponent's mark initially on the basis of its inherent qualities, I find that both the forename and surname are fairly common. I find it more difficult to answer the other (b) to (e) questions not least because they go to the position in the trade and that position is not directly addressed in the evidence. Based on my own experience as a consumer I have no reason to think that MITCHELL or PAUL MITCHELL are in common use as a trade mark for the goods in question. I consider that haircare products is an area of trade where traders may wish to use surnames or full names. One thinks, for example of Johnson's shampoo. It is, I think, also common knowledge that there are celebrity hairdressers who also offer goods under their names, Nicky Clarke and Vidal Sassoon come to mind. There are two qualifications to this point. Firstly, I have no knowledge of the extent of this practice. Secondly, Mr Buehrlen suggested that celebrity hairdressers are more likely to be known for their salon services rather than spin-off product offerings. There may be some force to that submission but the examples I have given suggest that it is not unknown for branded haircare products to be offered to exploit the established reputation of the salon

owner. As to the number of players engaged in the trade I consider that there are a significant number but probably fewer than, say, the clothing trade.

23. Weighing these factors in the balance and making the best I can of it in the absence of evidence bearing on the trade I find that PAUL MITCHELL is distinctive even without the benefit of use but cannot be said to enjoy a particularly high degree of distinctiveness.

24. The further question I need to address is whether that distinctiveness is evenly distributed in the mark or whether it is front or back end loaded as it were in favour of either the forename or the surname. Mr Buehrlen contended for the latter position.

25. I am unable to accept that submission. I regard both elements of the mark as common elements taken on their own, that is to say as a forename and surname respectively. It follows that I consider neither element can be said to be dominant or particularly distinctive in its own right.

26. I now turn to the position on acquired distinctiveness. I note that the applicant's written submissions concede that PAUL MITCHELL is the name of a particular individual well known in the hair care industry. That falls short of acknowledging the extent and nature of the mark's reputation in relation to the goods at issue. I have little doubt that the evidence supports the claim to an enhanced reputation in relation to hair care products. The opponent was said to have a 29.5% share of the salon products market in 1999 with its nearest rival, L'Oreal having 15.7%. The supporting exhibits satisfy me that the opponent's claim is a legitimate one. The applicant has not seriously challenged the opponent's claim to a reputation but has sought to narrow the extent of that reputation to the salon products business and the luxury end of the market.

27. I accept that the opponent's business is mainly directed at supplying hair care products to professional salons. The supporting witness statements speak with one voice in saying that the PAUL MITCHELL brand is synonymous with "luxury hair care products". I note, however, that the declarants say that they stock and sell PAUL MITCHELL products to the public. Thus, the goods are both used in salons and sold to those attending the salons. It would be too narrow an approach, therefore, to say that only salon owners would be aware of the brand.

28. Mr Buehrlen submitted that, whilst the main reputation was in haircare products, there was also a reputation albeit a lesser one in a somewhat wider range of cosmetics or toiletry products. He referred me to the product range depicted in the final few pages of Exhibit LGS1. Unfortunately, the version filed in evidence is all but illegible through the brand name itself is visible on most of the products. On one of the pages there is a picture of a bar of soap said to be from the men's Tea Tree range. No brand is visible on this product but even assuming that it carries the PAUL MITCHELL mark I am not clear when it was introduced. I have given careful consideration to the invoice evidence (in so far as it precedes the relevant date) and find that overwhelmingly, if not exclusively, it covers hair care consumables (shampoos, conditioners, detanglers etc) along with styling products such as brushes. There are a few other products, the relevance of which is doubtful (eg Rhubarb Rabbit Toy Kit and Poster) or where the branding is uncertain as the distributor's invoices do not solely cover PAUL MITCHELL products. I do not, therefore, accept that the opponent's reputation goes beyond haircare products.

Comparison of marks

29. The basis of the opposition is the visual and phonetic similarity that arises between the marks as a result of the presence of the word MITCHELL in both. I have commented above on the distinctive character of the opponent's mark.

30. So far as to the applicant's mark is concerned it consists of the word MITCHELL in what the applicant's written submissions describe as "a stylised italicised font, on a background consisting of three concentric oblongs, giving a three-dimensional effect to the device".

31. I accept that the mark is more than the plain word MITCHELL. The device does make some visual impact and is a feature of the mark but without in my view becoming the dominant feature of the mark. It will probably be taken as more than simply a non-distinctive background device (square, rectangle or such like) but it does not displace the primary importance of the word MITCHELL. I anticipate that consumers will place more reliance on the word than the device in their perception and recollection of the mark.

32. The applicant's written submissions suggest that the marks are conceptually distinct in that PAUL MITCHELL is the name of a particular individual whereas MITCHELL does not identify any particular individual. That takes the matter back to the fundamental question that needs to be addressed, that is to say how the average consumer who was familiar with PAUL MITCHELL would react to the mark MITCHELL (and device) when used in relation to identical or similar goods. Before addressing that issue I need to comment on the goods themselves.

Comparison of Goods

33. The ECJ has given the following guidance in the *Canon* case when it comes to comparing goods (and services):-

"23 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, intended purpose and their method of use and whether they are in competition with each other or are complementary."

34. The applicant has made a number of submissions that are intended to place distance between the parties' goods. Firstly, it notes that its own goods are restricted to "all for babies" or such like whereas none of the goods of the earlier trade marks are directed at babies and many would be unsuitable for babies. It is true that the opponent's specifications do not specify that the goods are targeted at babies. Equally they do not say that they are not. I must consider notional use and that would include goods for babies. Furthermore, as Exhibits LGS1 and 2 illustrate the opponent does actually offer goods directed at babies or younger children (the Kids Condition 'Taming Spray' and Kids Shampoo 'Baby Don't Cry').

35. Secondly, the applicant points to different channels of trade with the opponent targeting professional hair salons and the applicant the export market along with wholesalers who sell on to independent chemists and general stores.

36. Again, what the applicant is doing is focussing on the parties' actual trade to date without making allowance for notional use or what the parties would be entitled to be within the scope of their specifications. The applicant's specification, for instance, contains no restriction to export use or otherwise and, as I have noted above, the opponent's goods are not just sold to salons for professional use. They are also sold to the public through salons.

37. Thirdly, the applicant notes that the opponent appears to regard its products as being at the top end of the market. The term 'luxury hair care' products is certainly a consistent theme of the advertising and promotion of the goods. A certain amount of allowance must be made for the sort of hyperbole that is often used in the process of promoting products. But even accepting that this is a true reflection of the opponent's positioning in the market it does not preclude the possibility that the parties (or their successors in title should the marks be assigned) may adjust their positions or use the same marks in relation to a products that are rather differently traded or positioned in the marketplace. It comes back to making allowance for notional use.

38. For ease of reference I set out below the respective site of goods. This is based, in the opponent's case on its CTM registration which is more broadly based:

Applicant's Goods	Opponent's Goods
Cosmetics; toiletries; shampoos, skin care preparations, essential oils, soaps, gels, lotions and creams, all for the skin, hands and/or body; bath oils and gels; talcum powder; moisturisers; cotton wool for cleansing purposes, tissues and wipes; all for babies. (Class 3)	Hair care and cosmetic products for the hands and body, namely shampoos, hair colors, hair dyes, hair tints, sprays, rinses, hair setting and styling lotions, gels, lotions, perms, solutions, waving lotions, conditioners, moisturizers, sun tanning preparations, sun screens, facial toners, creams, facial preparations and powders. (Class 3)
Antiseptic disinfectants; medicated toiletries; medicated skin creams for the hands, body and face; sanitary preparations and substances; antiseptic creams; air freshening preparations; all for babies. (Class 5)	Bags of paper and plastic for packaging hair care and cosmetic products, file folders and loose-leaf binders. (Class 16)
Printed matter, paper, cardboard and goods made from these materials, all for use within the baby cosmetic and baby toiletries industries; babies' bespoke disposable nappies. (Class 16)	T-shirts, sweatshirts, over-garments for use by beauticians, namely, dryer drapes and cutting capes. (Class 25)

39. It is reasonably clear that the Class 3 specifications cover or include identical goods. The opponent's specification covers 'haircare and cosmetic products for the hands and body' but these are qualified by the use of 'namely'. I take the use of that word to restrict rather than simply exemplify the goods covered by the broad term.

40. Nevertheless the list of specific products in this Class is sufficiently wide that they replicate or are examples of the goods in the applicant's specification. The only goods that are not identical or closely similar are the applicant's "cotton wool for cleansing purposes, tissues and wipes". But even these items are adjuncts to cosmetics and toiletries in that they are used in the application and removal of such products. They are similar but to a lesser extent.

41. The opponent does not have coverage in Class 5 so the applicant's goods cannot be identical. I accept the opponent's pleaded claim that "medicated toiletries; medicated skin creams for the hands, body and face; sanitary preparations and substances; antiseptic creams" are similar to the creams and other products in the opponent's Class 3 specification. They are medicated equivalents of the Class 3 goods. I am less convinced that "antiseptic disinfectants" and "air freshening preparations" can really be said to be similar to the opponent's goods. If they are at all, it is likely to be at the outer reaches of similarity.

42. The opponent's statement of grounds points out that its CTM covers some printed materials such as loose-leaf binders and packaging materials for use in respect of hair care and cosmetics which, while not limited to baby cosmetics, would nevertheless include such goods. The opponent's written submissions did not deal with any clash in Class 16. I do not know whether in reality either side intends to trade in Class 16 goods as opposed to using printed matter and packaging in the course of their respective trades in goods in other classes. Class 16 appears, therefore, to have been at the periphery of the parties' vision. Allowing for the full scope of the terms employed in the specification I consider the "goods made from these materials [paper and cardboard]" are similar to "bags of papers and plastic for packaging hair care and cosmetic products". The remaining goods are not similar.

Likelihood of Confusion

43. The applicant has tendered a number of submissions bearing on likelihood of confusion. I have been referred to the Registry's Work Manual which by way of example suggests that 'Alexander' or 'Morgan' would not normally be seen as being in conflict with a mark comprising the full name (i.e. those elements in combination) even if the goods were the same. This is said to be because the full name derives its distinctive character from the combination with neither element being dominant. That is said to parallel the position here. Each case must be assessed on its merits so the Work Manual is only by way of general guidance. Moreover, it does not take into account the position that may be established as a result of use of an earlier trade mark.

44. The applicant also notes that no use has been shown of MITCHELL per se such that it might have led consumers to see that element as being of particular importance. I accept that that is the case. I do not accept that the absence of any instances of confusion is telling. That state of affairs may do no more than reflect the fact that the parties' actual trade to date has been well separated. But the specifications are not (and probably could not be) restricted in such a way as to fully reflect current trading patterns let alone any variations to those trading patterns in the future.

45. The opponent's position, as summarised in its skeleton argument, is that:

“There is clearly identity or very strong similarity of goods in International Class 3 and also in International Class 5, and in view of the above guidelines, taking into account the high distinctive character of the earlier mark, a likelihood of confusion must exist. Both marks have the same meaning and are phonetically near identical. The mark applied for would also be used as an abbreviated version of the earlier mark. There is no other co-existence identified within the industry to show that customers have learnt to distinguish between MITCHELL type marks and even if one were to take account of the earlier mark being a common surname, the evidence submitted would testify to the necessary distinctiveness for the section to apply.”

46. To summarise my own view of the matter, I find that

- PAUL MITCHELL is distinctive even taken as an unused mark though not to a particularly high degree.
- the distinctiveness is evenly distributed and therefore resides in the totality of the mark. Neither element is dominant in its own right.
- the similarities between the marks must be assessed in the light of these findings.
- in relation to the goods on which the opponent's mark has been used it enjoys a significant reputation and thus enhanced distinctive character.
- these goods are haircare products primarily for sale to professional hair salons though because of the trade through these establishments the reputation is likely to go beyond trade professionals to the general public.
- taking the goods at large the average consumer will include trade, professionals, wholesalers and other who are responsible for the sale and distribution of haircare products, cosmetics etc and the public at large.
- the specifications cover identical, similar and dissimilar goods as outlined above.
- the goods are, or could be, inexpensive items that do not necessarily involve special care or attention in the purchasing process though doubtless salon personnel can be expected to be more knowledgeable and discriminating than the general public.
- imperfect recollection may be a factor particularly if, as is likely to be the case, the goods are not displayed side by side. That may be partially counter-balanced by the fact that consumable items (as these goods mainly are) are likely to be the subject of rather more regular purchases than capital items. Hence, there may not be lengthy intervals between purchases.

47. It is clear from my above findings that I need to consider the matter from two perspectives – firstly the goods for which the mark PAUL MITCHELL undoubtedly enjoys a reputation and secondly the balance of the specification of the earlier CTM mark where no such reputation can be said to exist.

48. In relation to the position on reputation I have held that this is restricted to hair care products. Consumers have also been educated to expect the full name. I can find no evidence that consumers have been led to expect PAUL MITCHELL to be used in abbreviated form as Mr Buehrlen submitted or that, left to their own devices, consumers would alight on one element as capturing the distinctive character of the mark.

49. I also regard hair care products as a reasonably distinct part of the wider beauty products field. Experience suggests that within a retail environment hair care products tend to be grouped together. I am also of the view that traders in hair care products do not generally operate in the wider beauty products field or vice versa. If there is cross-over branding or if it is common practice for traders to operate in both fields then it should have been the subject of evidence.

50. Making the best I can of it I find that the opponent's reputation is of sufficient magnitude in relation to hair care products, bearing in mind the interdependency principle, that consumers would have cause to think that identical or closely similar goods sold under the mark MITCHELL emanated from the same trade source or economically linked undertakings. To that extent a likelihood of confusion exists. In reaching that view I acknowledge and allow for the fact that the opponent has not been shown to use MITCHELL on its own and also the fact that no other traders in the field have been shown to use MITCHELL either alone or as part of a full name.

51. The next question is, given that the respective specifications are not co-extensive or framed in quite the same terms, what goods are open to objection on this basis. Shampoo is clearly one such item. I have not been referred to any definitions of the broad terms toiletries and cosmetics. Toiletries is in my view a term that may encompass perfumes, cosmetics, deodorants, shaving toiletries, hair care products and other personal grooming products (albeit that some of the latter may be appropriate to different classes). On the basis that hair care products are a category of goods that fall within the broad term I consider toiletries to be open to objection.

52. I have hesitated over the term cosmetics because the term is not one, in my view, that is ordinarily used to describe or cover hair care products. I am somewhat reinforced in that view by the fact that Collins English Dictionary defines cosmetic as “any preparation applied to the body, especially the face, with the intention of beautifying it”. There is no evidence as to what the term is taken to mean in trade. If the matter rested upon the dictionary definition I would be doubtful whether cosmetics should attract objection. But I am aware that there are now cosmetic products for the hair such as glitter and hair highlighters. The objection also therefore holds in relation to cosmetics as this term encompasses such goods. It does not assist that the applicant's shampoos, toiletries, and cosmetics are ‘all for babies’.

53. The balance of the Class 3 specification consists of goods that are either by their nature or by reference to the terms in which they are described of a much lower degree of similarity when compared to the hair care products for which the opponent has a reputation. On

balance I do not consider that use of the respective marks would give rise to a likelihood of confusion if used in relation to those goods.

54. The same is largely true of the Class 5 goods. I have considered whether the term ‘medicated toiletries’ would include goods that would give rise to a likelihood of confusion. However, ‘medicated shampoos’ are in Class 3 and not Class 5 and I am not aware of any other items that would give rise to conflict.

55. So far I have considered the position on the basis of the goods for which the mark PAUL MITCHELL enjoys an enhanced degree of distinctive character. The opponent has other goods in Class 3 (i.e. non hair care products), Class 16 and Class 25 in respect of which PAUL MITCHELL falls to be treated as an unused mark. The position here is that the opponent’s cosmetic products are identical or similar to the Class 3 goods specified in the application under attack. Likewise the opponent’s bags of ‘paper and plastic for packaging’ are certainly closely similar to the applicant’s ‘goods made from these materials [paper, cardboard]’.

56. What is the net effect of this state of affairs likely to be on the notional average consumer? I am less convinced that, absent the effect of an acquired reputation in the marketplace, the average consumer will have cause to think that a product, even an identical or closely similar one, sold under the common surname MITCHELL (and device) necessarily emanates from the same or related trade source as goods offered under the mark PAUL MITCHELL. The same will also be the position to the extent that certain of the respective sets of goods are lower down the scale of similarity.

57. The position under Section 5(2) is, therefore, that the opponent has succeeded in relation to ‘cosmetics, toiletries, shampoos’ but not the other goods.

Section 5(3)

58. As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004, Section 5(3) now reads:

“5.(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, 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.”

59. Mr Buehrlen referred me to the following relevant authorities: *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)*[2000] RPC 767, *Daimler Chrysler v Alavi (Merc)* [2001] RPC 42 *C A Sheimer (M) Sdn Bhd’s Trade Mark Application (Visa)* [2000] RPC 484 and *Adidas Salomon AG v Fitnessworld Trading Ltd, Case C-408/01*. He drew the following principles from these:

- (a) ‘Reputation’ for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned by the product or services covered by that trade mark (paragraph 26 of the ECJ’s judgment in *Chevy*);
- (b) The similarity between a trade mark with a reputation and a later sign or mark does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier mark and the later mark or sign, *Adidas Solomon AG v Fitnessworld Trading Ltd*;
- (c) The link must be such as to cause actual detriment, or take unfair advantage, of the earlier mark or its repute, paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- (d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J in the *Typhoon* case);
- (e) The stronger the earlier mark’s distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J in the *Typhoon* case);
- (f) Detriment can take the form of either making the earlier mark less attractive (tarnishing) or less distinctive – blurring (paragraph 88 of Pumfrey J’s judgment in the *Merc* case);
- (g) Unfair advantage can take the form of feeding on the fame of the earlier mark in order to substantially increase the marketability of the goods or services offered under the later trade mark (per G Hobbs QC in *Visa* at page 505, lines 10-17).

60. I accept that this is a fair statement of where the law stands.

61. I also accept that the opponent has the requisite *Chevy* reputation in relation to hair care products. As the opponent has already achieved partial success under Section 5(2) I need only consider whether it can achieve success on a broader front under Section 5(3). Although I have found no likelihood of confusion in relation to goods other than shampoos, cosmetics and toiletries it is clear from point (b) that this does not rule out a further finding in the opponent’s favour under Section 5(3) because confusion is not a necessary ingredient. The opponent must, however, show that the relevant public would establish a link between the marks and that that link is such as to take unfair advantage or cause detriment. In other words it is not enough that the later mark simply brings to mind the earlier trade mark if one or more of the adverse consequences envisaged by the Section is not present.

62. I think it is possible that if the mark MITCHELL and device was to be used in relation to similar goods in the wider beauty products field then the nature and extent of the reputation of the PAUL MITCHELL mark might result in the latter being brought to mind. I am less inclined to think that even that limited association would exist in relation to items such as

“cotton wool for cleaning purposes; tissues and wipes; all for babies” along with the Class 5 and Class 16 goods.

63. To the extent that such an association does exist, setting aside the goods where the opponent has already succeeded) the opponent considers that the applied for mark would take unfair advantage of the earlier trade mark’s reputation and/or dilute its distinctive character and reputation. The opponent’s pleaded case and submissions have not developed these claims to any appreciable extent save that attention is drawn to the image associated with its goods, that is to say that they are luxury goods sold through an exclusive network of hairdressers. This is said to be in contrast to the applicant’s goods which are sold through small independent chemists and general stores.

64. The suggestion appears to be therefore, that the nature of the parties’ trades is different and that the applicant may benefit from the link with the opponent’s luxury hair care products sold under the mark PAUL MITCHELL or that the opponent’s brand will be damaged as a result of the applicant’s use.

65. The opponent’s use in the UK dates from 1987. It has grown consistently since that time. At no point has it been shown that a reputation has been cultivated in relation to goods other than hair care products and the mark has always been used in a particular form. This is not a case where consumers have been led to expect the mark to appear on a wider range of goods. I also take hair care products to be a discrete area of trade within the general beauty products field.

66. In the circumstances it seems to me to be a matter of speculation rather than reasonable inference to conclude that either the applicant would gain advantage or the opponent would suffer damage as a result of use of MITCHELL and device. Even assuming an association was made it would in my view be fleeting and inconsequential in nature. The opposition fails under Section 5(3).

Section 5(4)(a)

67. The opponent’s use is within the scope of its CTM registration and co-extensive with the scope of the UK registration. In these circumstances it is unlikely that materially different issues or outcomes would arise in relation to Section 5(4)(a) than under Section 5(2)(b). One point calls for comment. The applicant’s written submissions note that the mark used by the opponent consists of the words themselves in a particular typeface with lines above and below as follows:

68. I assumed for Section 5(2)(b) purposes that the mark as used can be treated as an acceptable variant form of the plain block capital mark which is the form in which it is registered. If I am wrong in that then the opponent’s use would fall to be considered under Section 5(4)(a). I would then have come to the same conclusion under this Section.

Section 56

69. This was not pursued as a separate matter at the hearing and would not in any case give rise to different considerations. I need say no more about it.

70. In summary the opponent has achieved partial success but the application will be allowed to proceed for all goods except “cosmetics; toiletries; shampoos.”

COSTS

71. Both parties have achieved a measure of success. Mr Buehrlen submitted at the hearing that the opponent had been put to proof of use when the applicant should have been aware of its reputation. He suggested that this put the opponent to unnecessary effort and expense. Given that the parties, at least in terms of their current trade, are in somewhat different sectors of the market and trade through different channels I do not think it was unreasonable for the applicant to put the opponent to proof. Being aware of another trader’s mark (if that was the case here) is not the same as knowing about the extent and duration of use. It is the fact of filing evidence that has brought out the nature of the opponent’s trade.

72. The applicant’s written submissions ask me to take into account that it has sought to minimise its own costs by agreeing that a decision could be made from the papers and by declining to be represented in person at the hearing. It is submitted that it should not be held liable for the opponent’s ‘unnecessary costs’ in preparing for and attending the hearing.

73. Parties are offered the opportunity of a hearing or an opportunity to file written submissions. I see no reason why the opponent should be held to have incurred unnecessary costs in opting for a hearing. It was fully entitled to present its case at a hearing. The above factors have not, therefore, influenced my decision on costs. In terms of the issues at the heart of this dispute which have occupied the parties’ time in evidence and submissions both can claim a measure of success. I will make no award of costs.

Dated this day of 2006

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