

O-220-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2532892  
BY SAKS HAIR (HOLDINGS) LTD TO REGISTER THE TRADE MARK**

**THE DOGS**

**IN CLASSES 3 AND 44**

**AND IN THE MATTER OF OPPOSITION  
THERE TO UNDER NO 100293  
BY THE LITTLE WING TRADING COMPANY LTD**

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Trading Company Ltd**

### **BACKGROUND AND PLEADINGS**

1. On 27<sup>th</sup> November 2009, Saks Hair (Holdings) Ltd of 2 Peel Court, St Cuthberts Way, Darlington, Co.Durham DL1 1GB (hereafter, "Saks") applied to register the mark as above in Classes 3 and 44. The goods and services are as follows:

#### **Class 3**

Soaps, perfume, eau-de-cologne, toilet waters, essentials oils, shaving preparations, aftershave lotions, shaving foams, non-medicated preparations, (non-medicated bath salts, and bath oils), anti-perspirants; deodorants for personal use, depilatories, dentifrices, mouth washes; cosmetics, suntanning and suncreening preparations; preparations for the hair, shampoos, conditioners, hair lotions, hair sprays, non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and lotions for the skin; talcum powder; nail varnish and nail varnish removers nail preparations and artificial nails and adhesives therefor; preparations for preparing such nails; artificial eyelashes and adhesives therefor.

#### **Class 44:**

Hairdressing and beauty salon services, beauty treatment services.

2. The application was allocated number 2532892 and was published in the Trade Marks Journal on 18<sup>th</sup> December 2009. On 18<sup>th</sup> March 2010, The Little Wing Trading Company Ltd of 58 Campden Houses, Peel Street, London W8 7PQ (hereafter, "Wing") lodged an opposition against all the goods and services specified above.
3. Wing has opposed on the sole basis of section 5(2)(b), citing the following earlier marks:

Marks. Filing and registration dates	Goods relied upon under section 5(2)(b)
<p>UK 2415346</p> <p>Bulldog</p> <p>1<sup>st</sup> March 2006</p> <p>18<sup>th</sup> August 2006</p>	<p><b>Class 3:</b></p> <p>Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body mist spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations; shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.</p> <p><b>Class 05:</b></p> <p>Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>
<p>UK 2426014</p>  <p>30<sup>th</sup> June 2006</p> <p>29<sup>th</sup> December 2006</p>	<p><b>Class 03:</b></p> <p>Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body moist spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations; shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.</p> <p><b>Class 05:</b></p> <p>Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>

<p>CTM 6014179</p> <p>Bulldog</p> <p>18<sup>th</sup> June 2007</p> <p>15<sup>th</sup> May 2008</p>	<p><b>Class 03:</b></p> <p>Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body moist spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations; shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.</p> <p><b>Class 05:</b></p> <p>Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>
<p>CTM 6014195</p>  <p>18<sup>th</sup> June 2007</p> <p>20<sup>th</sup> May 2008</p>	<p><b>Class 03:</b></p> <p>Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body moist spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations; shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.</p> <p><b>Class 05:</b></p> <p>Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>

4. In its pleadings, Wing say the respective marks are similar given the clear conceptual, visual and phonetic similarities. It says the goods in Saks Class 3 specification are identical to its own Class 3 specification and similar to the

goods in its Class 5 specification. Sak's Class 44 specification is similar to its goods in Classes 3 and 5. Taking all factors into account there is a likelihood of confusion.

5. Saks filed a counterstatement denying a likelihood of confusion, saying the respective marks, considered as wholes, are not alike. As for the specification, it admits identity in some cases and similarity as regards goods in Class 3. It makes no such admission in relation to Class 5 and denies any similarity as regards its services in Class 44.
6. Evidence was filed by both parties which, insofar as it is factually relevant, I shall summarise below.
7. Written submissions were received which I shall also take into account. No hearing was requested by either party and so I give my decision based upon a careful reading of the papers.

### **Opponent's evidence**

8. This takes the form of a witness statement, dated 20<sup>th</sup> August 2010, by Simon Duffy, co-founder, and Managing Director of Wing. In general, Mr Duffy's evidence seeks to show that his company's marks have acquired an enhanced distinctiveness through use.
9. He says the company commenced use of the trade marks relied upon over 4 years ago, since at least as early as February 2006. It has used the marks continuously since then, both in the UK and European Union.
10. The marks are used in relation to a range of goods, but in particular male grooming products, including products and preparations for skincare, shaving and bathing. Details of some of the goods can be seen at Exhibit SD1 which comprises copies from the company's website at [www.meethebulldog.com](http://www.meethebulldog.com). These pages show the various products classified under the headings: 'skincare', 'wash', 'shave' and 'shower'. The products display the Bulldog device mark prominently on the containers and emphasise the absence of artificial or synthetic ingredients, in particular, parabens and sodium laureth sulphate. The products are made from a blend of unique essential oils and natural active ingredients.
11. Exhibit SD2 comprises copies of literature and press features dating from 2006-2010 that feature the marks. These include articles in: The Times and Sunday Times, The Telegraph, The Independent, The Guardian, The Daily Mail, The Daily Mirror, The Observer, The Daily Star, The Daily Express and others, as well as more niche magazines such as FHM, Esquire, The Grocer, GQ, Loaded, Zoo, Men's Fitness, Prima and Pure Beauty. Some of the articles focus on the business side and the issues faced by a start up

business, for example, in developing a new product and getting it successfully to market, whilst many others focus on the products themselves, and in particular the natural ingredients used in Wings products. This is all against a backdrop of something of an explosion of interest (even during recessionary times) in male grooming products, designed specifically for men (rather than male versions of female products) and appealing to a much broader range of 'mainstream' male than was previously the case.

12. Mr Duffy says he has been interviewed by various television channels such as: CNBC Europe, Sky News, and the BBC and Exhibit SD3 comprises screen stills of those interviews.
13. The company regularly takes part in, and exhibits at, trade shows, including the annual 'Natural and Organic Products Europe Show, regarded as the 'must attend' show for the trade, attracting over 8000 visitors to the London Olympia during April. Exhibit SD4 comprises screen prints from the website of this exhibition, including part of an exhibitors' list showing Wing. There is a photo of the company's stand showing the Bull Dog trade mark, photos of two bulldogs and the slogan "Man's Best Friend" in bold.
14. Mr Duffy says his company has sponsored various sporting and entertainment personalities, teams and events. These include the London Wasps Rugby team in the 2007/8 season, and the well known comedian, David Mitchell's online television series, 'David Mitchell's Soap Box'. The first season of this programme ran in 2009 and has garnered over 6,127,000 views via ChannelFlip.com, iTunes, YouTube, and meethebulldog.com. The second season is currently running. Bulldog branded 'bumpers' appear at the beginning and end of each show. Exhibit SD5 comprises details of some of the company's sponsorship activities.
15. Mr Duffy says his company's turnover in the UK for goods under the relevant marks from 2007/08 to 2009/10 has been approximately £2,000,000. Turnover in the UK of £505,526 was recorded in 2007/08, £692,577 was recorded in 2008/09 and £833,183 in 2009/10.

16. Monthly data on sales is given as below:

Time period	Sales revenue generated
September 2008	£91k
January 2009	£57k
May 2009	£34k
September 2009	£85k
January 2010	£73k
May 2010	£114k

17. Mr Duffy says his company has seen strong growth against its competitors in the period 16<sup>th</sup> May 2009 to 15<sup>th</sup> May 2010. The Bulldog brand is now the fourth largest skincare brand for men in the UK and is the UK's largest independent brand of skincare.
18. He then lists a selection of stockists including: Sainsbury's (since July 2007), Waitrose (since July 2008), Superdrug (since July 2008), Tesco (since October 2008), Boots (since February 2009) and others.
19. Products bearing the Bulldog mark can also be found in approximately 100 independent natural and health food stores around the UK. It is also stocked abroad in, eg Ireland, Sweden, Finland, Norway and Japan.
20. The goods have been awarded several notable industry awards, including Pure Beauty Magazine's Award for Best Male Grooming Launch in 2007 and The HSBC Start Up Stars Award in 2008.
21. Sampling product campaigns, such as a branded postcard with an attached sample have been produced, including at the 2010 London Marathon and Triathlon events. Exhibit SD7 shows an example of a postcard plus sample.
22. The company has a database of customers and fans who receive e-mails and a newsletter called 'The Kennel'. 17 of these e-mail newsletters have been sent out to date, the last Kennel being sent to 32,144 people.
23. Finally, Mr Duffy explains that the applicant's representatives forwarded a document to his representatives (Exhibit SD9), supposedly to alleviate his concerns as to how they were intending to use the mark the subject of the application. I do not know who authored this document but it analyses the UK market for hairdressing barbers and salons, specifically for men, and also provides background to the development of 'The Dogs' brand.
24. Exhibit SD9 shows the applicant's main business is hairdressing salons and it is looking to provide a large scale national brand to respond to a perceived gap in the market for contemporary mens' hair design. Like Mr Duffy's company, the applicants also see a burgeoning market for male grooming. The document shows the applicant's mark as intended to be used (the 'o' of dogs is in the form of a target device), alongside phrases such as "A man's best friend" and "a British brand created by men exclusively for men"; both these phrases are also used by Wing. I will consider this further in my overall assessment of likelihood of confusion. The document also shows a range of product lines alongside the main use in relation to hair salons, and these bear 'The Dogs' mark, and include hair gel, and hair glue. Mr Duffy explains that, far from alleviating their concerns, this document reinforced his company's belief that there would be likelihood of confusion, especially with the use of phrases used also by Wing.

## **Applicant's evidence**

25. This takes the form of a witness statement, dated 27<sup>th</sup> October 2010, from Graham Farrington, a trade mark attorney and partner in the firm Ladas & Parry LLP, acting for the applicant. Exhibit GF1 comprises the results of a search of trade marks in Class 3 in respect of toiletry goods which contain the term DOG or DOGS, together with details of the registrations. In its later filed submissions, the applicant concedes this is, “merely state of the register evidence”, intended to show, as far as the register is concerned, the opponents do not enjoy a monopoly in Class 3 of marks containing DOG or DOGS.

## **DECISION**

### **Section 5(2)(b)**

26. The opposition is founded upon Section 5(2) (b) of the Act. This reads:

“(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.”

27. All the earlier trade marks in this case qualify as earlier trade marks with filing dates before the date of application. Moreover, none are subject to proof of use provisions as their dates of registration are within the relevant 5 year period prior to the date of publication of the application. In terms of which earlier trade mark may give the opponents their best possible case, it will be the word only mark but for the avoidance of any doubt my overall finding would be the same whichever earlier mark was relied upon. Both these marks feature on both the UK and OHIM registers, although the device mark on the OHIM register appears to be a different colour from the version on the UK register, with the same specifications, and accordingly it makes no difference whether I focus on the UK or OHIM versions.

28. In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the Court of Justice of the European Union (“CJEU”) in *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 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P* (LIMONCELLO). It is clear from these cases that:

- (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.

### **The average consumer and nature of the purchase**

29. The average consumer for Wing's products will be the general, toiletry buying, public. They are not specialist items and are bought from a range of retail outlets, including supermarkets, chemists and small retail shops. In general they are low cost items and may not receive the highest level of attention in the purchase. Certain of the items, notably connected with shaving, may be regarded as being gender specific but others would be bought by either sex.

30. The average consumer for Saks goods and services will also be the general public. In their case, the specification also includes the services in Class 44 but these are not specialist technical services, but services one may expect in almost every high street or indeed, offered on a mobile basis. Nonetheless, I think it fair to say that hairdressing services may often engender a degree of personal loyalty such that casual and purely opportunistic access is, if not entirely unlikely, then less likely than a more considered access.

31. These observations will be factored into my considerations below, as and when appropriate.

### **Comparison of the services**

32. In assessing the similarity of the goods, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at para 23 of the judgment:

'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 and their method of use and whether they are in competition with each other or are complementary.'

33. Other factors have been identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281, such as the nature of the users and the channels of trade.
34. It is important to recognise that even though the factual evidence on similarity is non-existent, I nevertheless have the statements of case, submissions and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11, at para 20, that such evidence will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. He also stated that the tribunal may, in an appropriate case, consider the question of similarity from the viewpoint of the notional member of the relevant purchasing public.
35. I should also mention a further case in terms of the application of legal principle, and that is the European Court of First Instance (“CFI”) in *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) (“Meric”)* Case T-133/05, where, at para 29, it is stated:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

36. The relevant goods to be compared are:

<b><i>Wing's goods</i></b>	<b><i>Saks' goods and services</i></b>
<p><b>Class 3:</b></p> <p>Toiletries; body deodorant, anti-perspirants, shower gel; body wash, facial cleanser, facial scrub; facial wash, hand wash, soaps; skincare preparations; body mist spray; spot sticks; moisturisers; body lotion, body moisturiser, facial moisturiser; shaving gel, shaving oil, shaving cream, shaving foam, shaving spritz, shaving soap, shaving stones; after-shave; after-shave gel, after-shave balm; hair removal preparations and creams, depilatory preparations, depilatory wax; hair care preparations;</p>	<p><b>Class 3</b></p> <p>Soaps, perfume, eau-de-cologne, toilet waters, essentials oils, shaving preparations, aftershave lotions, shaving foams, non-medicated preparations, (non-medicated bath salts, and bath oils), anti-perspirants; deodorants for personal use, depilatories, dentifrices, mouth washes; cosmetics, suntanning and suncreening preparations; preparations for the hair, shampoos, conditioners, hair lotions, hair sprays, non-medicated preparations for the care of the skin, hands, scalp and the body; skin cleansing preparations; creams and</p>

<p>shampoo, conditioner, hair gel, hair wax, hair spritz, hairspray; perfumery; eau de toilette; essential oils; cosmetics; dentifrices; lip balm; moustache wax; cosmetic kits; sunscreen preparations.</p> <p><b>Class 05:</b></p> <p>Anti-bacterial and medicated face, hand and skin washes; medicated preparations for the face, hands and skin; abrasive fluids for dental use; abrasive materials for dental use (other than floss); abrasive media for dental purposes (other than floss); abrasive pads for dental use; abrasive paste for dental use; abrasive powder for dental use; abrasive substances for dental use (other than floss); abrasives (dental-); adhesion promoters for dental use; adhesive cements for dental use; adhesive compositions and preparations for dental use; adhesives for affixing dental prosthesis; adhesives for dental use; anti-microbial, antiseptic and medical mouthwash preparations (gargles) for oral hygiene purposes; colouring reagents for revealing dental plaque; cotton for dental purposes; dental bonding material; dental health gum (medicated); dental rinses, medicated; tablets for dental use in indicating tartar on the teeth.</p>	<p>lotions for the skin; talcum powder; nail varnish and nail varnish removers nail preparations and artificial nails and adhesives therefor; preparations for preparing such nails; artificial eyelashes and adhesives therefor.</p> <p><b>Class 44:</b></p> <p>Hairdressing and beauty salon services, beauty treatment services.</p>
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### **Class 3**

37. Saks concedes that certain of its items in Class 3 are identical to those goods in Wing’s Class 3 specification. This is true. Wings has the broad terms: “toiletries”, “perfumery”, “cosmetics”, “cosmetic kits” and “sunscreening preparations”, along with a range of narrower and more closely defined items. There is nothing in Saks’ specification which to my mind falls outside these broad terms. Even “nail preparations” and “artificial eyelashes” would fall within the terms “cosmetics” or “cosmetic kits”. On that basis, I find that Saks’s Class 3 specification is identical to that of Wing.

### **Class 44**

38. As I understand Wing’s argument, it is that the services are identical or highly similar to their goods in Classes 3 and 5, on the basis that there is a recognisably complementary relationship between the two and that, for example, the goods (or certain of the goods) may be offered through the same trade channels as the services. This is not to say they will inevitably be offered through the same channels; hair products can be bought in supermarkets, chemists and a range of retail outlets. But, in my experience, and I do not believe my experience to be in any way idiosyncratic, they can also be bought in hairdressers and salons. Even the smallest hairdresser, operating on fixed premises, will offer, in addition to the primary service, a range of hair care products for sale. The same will be true of beauty salons and places offering beauty treatments. Larger hairdressers, such as, eg Vidal Sassoon and others, may even have their *own* range of products. This is a pattern in trade likely to be recognised by the average consumer. The

complementarity between hair and beauty care products and the services (including treatments) which, of necessity, deploy those goods in their operation, is apt to create a 'nexus', such that the average consumer would believe that goods under the same or a similar mark as the services may emanate from the same or a linked economic undertaking, and vice versa. On that basis I find that the services in Class 44 are similar to the hair care products, such as, eg hair gel or hairspray in Wing's specification.

### **Comparison of marks**

39. The case law makes it clear I must undertake a full comparison (taking account of visual, phonetic and conceptual similarities and dissimilarities), from the perspective of the average consumer. Both marks need to be considered in their totalities and overall impression (see authority (k) above in para 28), taking account of distinctive and dominant elements.

#### ***Visual comparison***

40. Wing's word only mark comprises the single, 7 letter, recognisable word, 'Bulldog', in upper and lower case and plain script. Saks' mark comprises two separate words 'The' and 'dogs', in upper case and plain script. Plainly the three letters comprising the word 'dog' are shared, although Saks' is in the plural – dogs, preceded by the definite article – 'the'. Taking the similarities and dissimilarities into account, I find that visually the respective marks are similar to a moderate degree.

41. Wing's device mark comprises the word 'Bull' on top of the word 'dog', both in capitals with a stencil style script. The letter 'o' of 'dog' is stylised with the device of a bulldog's head plainly visible inside the letter. The 'o' itself, has a series of spikes on the outer surface which bring to mind perhaps a dog collar, or otherwise have the visual effect (together with the dog device) of conveying something which is spiky or aggressive in some way. Saks' mark is as described above. Taking the similarities and dissimilarities into account, I find that the respective marks are similar to a moderate degree.

#### **Phonetic comparison**

42. Saks' mark will be pronounced as it is written, 'THE DOGS'. Wing's device and word marks will be pronounced 'BULL DOG'. Taking the similarities and dissimilarities into account I find the respective marks to share a moderate degree of phonetic similarity.

#### **Conceptual comparison**

43. By conceptual similarity, it is meant 'semantic' conceptual similarity and it is under this head that the parties' positions most obviously diverge. Plainly, both Wing's device and word marks invoke a particular breed of dog, the

bulldog. Wing's position is that the 'the' element in Saks' mark is entirely 'devoid of distinctive character' and thus has 'no effect on the overall conceptual character of the mark'. Saks' position is that the definite article, 'the', cannot be ignored or downplayed. It is important to also recognise that the plural of dog is used, as in "dogs". Saks' says the term, 'the dogs', may lead, in the average consumers' mind to a number of alternative allusions or connotations. In everyday vernacular language the term, 'the dogs' is used to describe greyhounds taking part in greyhound racing. Alternatively, the term 'the dogs' could be seen as a shortened version or abbreviation of the vulgar term, 'the dogs testicles' or 'bollocks'. Finally, the term 'the dogs' could also be seen as a shortened version of 'going to the dogs', as in a deterioration of something.

44. I agree with Saks' that neither the definite article nor the pluralised version can be ignored or otherwise downplayed in the totality of its mark. On that basis, I believe that it is likely the average consumer will see any one or combination of the allusions referred to by Saks, since they are, and I accept them to be, based in everyday language. None of those specific allusions are shared by Wing's mark. Wing's mark, 'Bulldog', imparts allusions of 'Britishness' ('British Bulldog'), being a specific breed of dog famed for being sturdy and thick set, perhaps fierce even.
45. Insofar then as both parties' marks have general canine origin or allusion, they can be said to be conceptually similar, but that is as far as it goes. Saks' mark has, as I have said, additional possible allusions based upon everyday language. On that basis I find that the respective marks are conceptually similar but only at a high level of generality and thus to a low degree.

#### **Overall similarity of the marks**

46. At this point I need to make a finding in respect to 'overall impression' of the respective marks, having especial regard to any distinctive, dominant elements.
47. Neither parties' marks are complex marks having a number of 'independent' elements with potentially varying dominance and distinctiveness. Even Wing's device mark will not be seen as the separate words 'bull' and 'dog', notwithstanding that those words appear one above the other. Plainly Wing's device mark evokes the breed of dog called a bulldog, the device amplifying the word.
48. Both parties' marks must be analysed in their totalities, as the relevant case law makes repeatedly clear (see, eg precedent (k) referred to in para 28 above). In particular, the definite article, 'the', is not an independent element in the term 'the dogs', but contributes to the 'whole'.

49. I further reject the opponent's submissions to the effect that, even if not 'independent', the definite article, 'the', is 'insignificant', such that its presence may go unnoticed by the average consumer. Wings bases this argument around the premise that the 'human eye has a tendency to see what it expects to see' (see, eg *Sarmad's Application* [2006] ETMR 2). This case concerned, in particular, the visual confusion that may arise as between 'KENNEDY FRIED CHICKEN' and 'KENTUCKY FRIED CHICKEN', given especially a *quick visual scan* and the similarities in *overall structure* between those terms [my emphasis]. It cannot be authority for ignoring or otherwise downplaying the definite article, 'the', in the term, 'the dogs'.
50. As regards the particular mode of selection of these goods and services and the question whether visual or aural processes may predominate and thus the overall assessment needs to be weighted in some way, it is likely that visual selection be the most common. Many of the products are the subject of self selection. This is not to say that aural selection will be totally absent, it is likely for example that hairdressing and beauty salons for example may be recommended aurally.
51. In all the circumstances, and taking the visual, aural and conceptual assessments *overall*, I find the respective marks share a low to moderate degree of similarity.

### **Likelihood of confusion**

52. Before proceeding to bring all my findings together in an overall global assessment, I need to make an assessment of the distinctive character of the earlier mark. An invented word having no derivation from known words is, in its inherent characteristics, very high on the scale of distinctiveness, KODAK of course being the prime example.
53. The earlier marks comprise the recognisable, verbal element, 'bulldog'; the device mark has a stylised 'o' with the depiction of a bulldog in the middle. None of the qualities I have previously attributed to the bulldog breed of dog (see para 44 above) resonate any particular connection to hair products or toiletries. Viewed purely on an *inherent* basis, the earlier marks (whether including device, or word only) can be said to be inherently distinctive at least to an above average level. Plainly though, I need to consider carefully the impact of Wing's evidence of use insofar as it may enhance the distinctiveness of the earlier marks.
54. The evidence establishes that prior to November 2009 (being the material date of filing), the earlier marks had garnered a large measure of mainstream and niche press attention. Some of that attention being focussed upon the nature of the business, in particular its start-up nature, but also the nature and quality of the product, chiming as it apparently has with an increased interest

in male grooming and natural products. The products are stocked in several very large supermarkets and there have also been awards and trade exhibitions. Against that, the overall sales figures of £2,000,000 between 2007/08 and 2009/10 do not appear to be huge. To make the case for enhanced distinctiveness, I would have expected Wings to put their sales figures into an overall context of the total UK market. It has not done so and so the case is somewhat diminished as a result. It must also be remembered that Wings only started up in 2006 and has only had under four years exposure of its mark. Balancing all these factors, I have not been persuaded that Wing can rely on an enhanced level of distinctiveness through use at the date of the opposed application. I may just mention that even if I had been persuaded there was an enhanced level of distinctiveness, it would not have made any difference to my overall conclusion of likelihood of confusion.

55. I may just mention one further aspect of this case which is Exhibit SD9, showing the applicant's intended use of their mark alongside phrases or slogans also used by the opponent. This is not a factor in my overall assessment which must be on the basis of the intrinsic qualities of the earlier marks as registered as compared to the mark as applied for (see to that effect, eg Case C-254/09P, *Calvin Klein Trademark Trust v OHIM* (para 46)).
56. Nor, I should say, is the applicant's evidence of the state of the register a factor in my assessment. It is well established that such evidence does not necessarily reflect the conditions of the market place.
57. So, I have found that the respective goods in Class 3 are identical. The services in Class 43 are similar. I have found the earlier marks to be distinctive on an above average level and that this level of distinctiveness is not enhanced through use. I have made observations on the respective average consumers, namely that they are also identical and I have found the purchasing process not to be particularly considered. Finally, I have found the respective marks to share a moderate to low degree of similarity overall. Needless to say that in making a global assessment, it is not a 'tick box' exercise, whereby if I find more factors in Wing's favour, it wins. All factors must be weighed in the evaluation of likelihood of confusion.
58. Taking *all* the relevant factors into account, including of course the doctrine of 'imperfect recollection' whereby marks are not to be considered side by side, I find there will be no likelihood of confusion in this case. In particular, I consider the conceptual analysis to be of some significance and the only connection to be of general canine origin or allusion is something of a telling factor, but as I have said, this is not to ignore or downplay in any way, all the other factors.
59. The opposition accordingly fails in its entirety.

## **COSTS**

60. Saks Hair (Holdings) Ltd has been totally successful in defending against the opposition. Accordingly, it is entitled to a contribution towards its costs and neither party sought costs on the normal scale. In the circumstances I award Saks Hair (Holdings) Ltd the sum of £1200 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

1. Filing counterstatement and considering statement- £400
2. Filing evidence and considering other parties' evidence- £ 300
3. Filing submissions - £500

Total £1200

61. I order The Little Wing Trading Company Ltd to pay Saks Hair (Holdings) Ltd the sum of £1200. The sum should 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 22<sup>nd</sup> day of June 2011**

**Edward Smith  
For the Registrar,  
the Comptroller-General**