

O/397/11

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATIONS NO
2 499 954A and 2 499 954B
IN THE NAME OF NICOLE FAIRALL**

**TO REGISTER IN CLASS 35 THE TRADE MARKS:
UBER BEAUTY ROOMS**



AND

AND

**CONSOLIDATED OPPOSITIONS THERETO UNDER NO No 99016 AND 99017
BY UBER BEAUTY LIMITED**

TRADE MARKS ACT 1994

In the matter of trade mark applications 2 499 954A and 2 499 954B in the name

of Nicola Fairall, to register in class 35 the trade marks:
UBER BEAUTY ROOMS



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Consolidated oppositions thereto under No 99016 and 99017 by Uber Beauty Limited

THE BACKGROUND, PLEADINGS AND ARGUMENTS

1. Nicole Fairall (the applicant) applied to register the figurative trade mark UBER BEAUTY ROOMS (as shown above) and the same denomination as a word only trade mark on 11/10/2008. The figurative trade mark application was published in the Trade Marks Journal on 13/03/2009 and the word only trade mark on 30/01/2009 in respect of the following services in class 35:

Setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice, consultancy and information services relating to such services; provision of information to customers and advice and assistance in the selection of goods; the bringing together, for the benefit of others, of articles for body and beauty-care, non-medicated toilet preparations, powders, creams and lotions (all for the face, hands and body), cosmetic sun-tanning preparations, milks, gels and oils and after-sun preparations, tissues and wipes impregnated with cosmetic lotions, nail polish, nail polish remover, cosmetics, soaps, shower and bath preparations, depilatory preparations, waxes for hair removal, depilatory kits, creams, lotions and ointments for use before and after hair removal, hair bleaching and hair lightening preparations, electric and non-electric appliances for removal of body hair, preparations for the hair, shaving and aftershave preparations, perfumes, colognes, toilet waters, eau de colognes, deodorants and anti-perspirants for personal use, essential oils, aromatherapy products, massage oils and lotions, preparations for exfoliation and body scrubs, body wraps, preparations for use in manicure and pedicure, apparatus, implements and appliances for use in manicure and pedicure, dentifrices, cosmetic tooth whitener, dental whitening and bleaching preparations, medicated creams, oils, powders and lotions, herbal remedies, homeopathic medicines, vitamin preparations, mineral food supplements, dietetic foods and beverages, and nutritional additives enabling customers to conveniently view and purchase those goods in a department store or general merchandise store or a general merchandise Internet website (including the provision of online retail sales of those goods), by mail

order, by means of telecommunications, or from a general merchandise catalogue by mail order; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail department store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a catalogue by mail order, telephone or other means of telecommunications; provision of information to customers and advice and assistance in the selection of goods brought together as above.

2. Uber Beauty Limited (the opponent) oppose the registration of the mark, citing the earlier registered trade marks “Uber” which are registered in respect of *apparatus for transmitting or reproducing sound or images; sound and video recordings* in class 09; *instructional and teaching materials* in class 16 (earlier trade mark No 2 442 677A) and *education; providing training* in class 41, *hygienic or beauty care* in class 44 (earlier trade mark No 2 442 677B).
3. The opposition is based upon several grounds. Firstly, upon Section 5(2) (a) and (b) of the Trade Marks Act 1994 (“the Act”) on the basis that the respective trade marks are identical or similar, the goods and services are similar and there is therefore a likelihood of confusion between them. Secondly, under Section 5 (3) of the Act because the earlier trade marks have a reputation and that the trade marks applied for will take unfair advantage of those marks by being able to trade off them in respect of similar goods and services and similar trade marks. Thirdly, under Section 5(4)(a) of the Act in that they have an established goodwill under the UBER and UBER BEAUTY names in respect of: *the provision of beauty, hygienic and cosmetic services and education and training relating to the same including teeth whitening, botox, dermal fillers, chemical peels, electrolysis, semi-permanent make-up, tattoo removal, hair removal, advanced cosmetic procedures including wart removal, removal of skin tags, pigmentation and thread vein removal, beauty treatment including facials, massages, tanning, manicures and pedicures* and that use of the trade mark applications will lead to a misrepresentation and damage to this goodwill. Finally, under section 3(6) of the Act in that it is claimed that the applicant acted in bad faith by applying for the trade mark. This claim is based on the fact that the applicant had previously applied for Uber Beauty Rooms in class 44 which was refused by the Intellectual Property Office on relative grounds owing to the opponent’s previous trade marks. Further, the applicant was aware of the opponent and is a competitor.
4. The applicant filed a counterstatement denying the grounds of opposition. In particular, the applicant denies the applications have been made in bad faith. Further, the applicant denies that the trade marks are similar or that they cover identical or similar services. In addition, the applicant argues that the common element Uber is widely used to denote “ideal” and is generally understood as a prefix meaning “super”. As such, it must be relatively weak in distinctive character. The applicant puts the opponent to strict proof regarding its claim of possessing a reputation in respect of Section 5(3) and having acquired a goodwill under Section 5(4)(a). Evidence was filed by both

sides as were written submissions in lieu of a Hearing. All have been full taken into account in reaching this decision.

THE EVIDENCE

The opponent's evidence

5. This is a witness statement, dated 02/02/2011, from Mr Marco Dellapina, of Dellapina & Co Solicitors, the representatives of the opponent in these proceedings. The witness statement is a mixture of submissions and direct evidence, the sum of which is as follows:
 - According to Mr Dellapina, it shows bad faith on the part of the applicant that it chose to incorporate a company with the name Uber Beauty Rooms Limited when it was already aware of the opponent, Uber Beauty Limited, which operates in the same field of activity and at a national level.
 - Mr Dellapina explains that the opponent's business also provides beauty salon services under the name "uber" which pre-date those of the applicant. Further, the opponent's business includes the sale of third party beauty products in its outlets and also via the internet. In this regard, two internet addresses are listed, but no printouts of these websites are provided in evidence.
 - Exhibit MD1 is a copy of an advertisement for UBER BEAUTY placed in the St Helens Reporter on the 17th August 2005.
 - Exhibit MD2 shows that the opponent company was incorporated on 24th November 2005 and that the applicant company was incorporated on 2nd February 2009.
 - Exhibit MD3 shows that the opponent's registrations in classes 03, 41, 44, 09 and 16 are all in the names of Uber Beauty Ltd.
 - Exhibit MD4 is a copy of a "cease and desist" letter which was sent to Uber Beauty Rooms on 3rd April 2008.
 - Exhibit MD5 is a copy of a treatment menu offered by the opponent in its salons, which according to Mr Dellapina, clearly shows that the services being offered by the opponent and applicant are the same or substantially the same and so there is clearly a likelihood of confusion, particularly as the opponent has increased its network of coverage throughout the country.
 - Mr Dellapina accepts that many types of businesses use the word UBER but not Beauty Salons. An internet search for beauty salons with the name "uber" only reveal the opponent and the applicant as shown in Exhibit MD7.
 - The applicant argues that the applications cover retail services connected with the sale of beauty and body care products and not hygienic or beauty care services in class 44 or hair and beauty products in class 03. As already stated, the opponent is of the view that these applications are an attempt to achieve by the back door that which cannot be achieved by the front door, to achieve some trade mark

protection in connection with the word “uber” in connection with the services set out in class 35. The prior registration in class 03 related specifically and solely to the sale of products not services.

- The opponent argues it does have a valid claim for passing off. Further the opponent has had instances where it has received phone calls from potential clients asking if the applicant was part of the opponent company. I note there is no evidence to support this claim.

The applicant’s evidence

6. This is a witness statement, dated 05/04/2011, from Ms Nicola Fairall, the applicant. The following evidence and submissions emerge from this witness statement:

- The applicant, as well as operating a beauty salon and retailing beauty products, operates under two websites, the addresses of which are www.uberbeautyrooms.com and www.uberbeautyrooms.co.uk. The trade mark applications, the subject of these proceedings aim to protect the activities of the applicant in respect of these e-commerce sites, which sell third party beauty brands and related products. Exhibit NF2 displays extracts from these websites.
- According to Ms Fairall, one of the opponent’s websites is not an e-commerce site and it is not possible to purchase products on line. The other sells cosmetic skincare products which the applicant does not offer. Further, the opponent’s business is, according to Ms Fairall, very different to the applicant’s as it is a “Medi Spa” where specialist treatments, such as dermal fillers, advanced wrinkling relaxing injections, laser teeth whitening, semi-permanent make up feature far more prominently. These kinds of treatments are not offered by the applicant. The opponent’s websites are also very different from those of the applicant. First, they are both branded under the mark “Uber Medi Spa” whereas the applicant’s is “Uber Beauty Rooms”, together with a distinctive design incorporated within the overall mark. Secondly, there is no similarity at all between the wordings, the colours, images and overall layout. There is no likelihood of confusion between them.
- Further, Ms Fairall argues that the presentation of the trade mark applications also differ from the earlier trade marks in respect of stylisation; further, the uber part is presented as it is correctly used in German, with an umlaut which serves to distinguish it from the opponent’s more casual rendering of the word in the English language. This umlaut also resembles a smiley face which reinforces its distinctive character and clearly differentiates it from that of the opponent.
- A search of the UK Register confirms that the word Uber is commonplace and that over 80 marks beginning with the word Uber co-exist in a number of classes of goods and services, including class 03.
- The word origin of Uber is German and means “super”, “higher” or simply “above”. According to Ms Fairall, the word started to be used in mainstream culture, initially in the USA, in the late 1990’s. Throughout the 2000s it became known as a synonym for “super” with phrases such

as “ubercool” and “ubergeek” being widely used. It is now most often used as a superlative, prefaced with other words to indicate something exceptional or one of its kind.

- The term “Ubermodel”, in particular, has been used extensively in the fashion world to describe the most successful models. The prefix Uber is therefore considered to be a generic term in the fashion and beauty sectors. Exhibit NF3 are extracts from Vogue, Elle and The Telegraph which, according to Ms Fairall, illustrate this common usage.
- On the UK Companies House website, companies beginning with the word Uber are also very prevalent. It appears that of the 100 or more companies registered, that many are linked to fashion and beauty. Exhibit NF4 contains extracts from the Companies House website showing examples of these co-existing Uber companies.
- There are also other companies in the fashion/beauty industry which share the prefix Uber, selling beauty products. Exhibit NF5 contains extracts from the webpages of a company called Uberproducts selling items under the names Uber Sassy and Uber Slick.
- Since the launch of the applicant’s websites in October 2008, Ms Fairall explains that she has spent almost £15,000 in marketing and advertising her Uber Beauty Rooms brand, the result being the high visibility and profile of the brand within the locality and through the internet in a relatively short period of time. Further, she explains that she has advertised in local publications and supported local charitable events. Exhibit NF6 are copies of dated advertisements from 2007 and 2008 which show clear use of Uber Beauty Rooms. Exhibit NF7 is data provided by the website Google, which shows that since October 2008, the applicant’s websites have received around 67,000 visits. The same exhibit contains details of the number of live pages on the applicant’s website (935) which it compares with those of the opponent’s (54). Ms Fairall argues that this demonstrates the depth of content that is available on the applicant’s website and that it provides a clearly differentiated and much wider offering.
- Ms Fairall confirms that discussions have taken place between the parties in these proceedings. However, in her view it was clear from the outset that there was no potential for conflict between the respective trade marks.
- Ms Fairall confirms that there have been previous proceedings between the parties. However, in her view, the trade mark application which are the subject of these proceedings are in respect of class 35 which are different services to the earlier class 44. In this respect, Ms Fairall points out that the trade mark examiner did not highlight the earlier trade marks as an obstacle which is proof that no conflict exists.
- The only similarity between the signs is in respect of “Uber” which, according to Ms Fairall, has become a generic term for “super”. There are other companies in the same and related sectors that also use the word “Uber” to denote their business. All are owned by different entities and compete without any problems of customer confusion.
- According to Ms Fairall, a typical customer tends to be a fairly sophisticated purchaser of beauty products and services. They are able to distinguish between different operators in the same sector and in a

sector which has become increasingly crowded. Customers purchasing products from the applicant's website are looking for specific third party products that the applicant supplies and which are different to those offered by the opponent.

- Finally, Ms Fairall argues that due to the extensive use and high visibility of the applicant's websites, its trade mark has become well known, is uniquely associated with the applicant and clearly distinguishes its services from those of the opponent. The opposition should therefore be dismissed.

DECISION

Preliminary remarks

7. I note that the applicant, through its evidence, seeks to differentiate the nature of the opponent's business and websites from its own. I therefore stress that I am required to consider a notional question as to the likelihood of confusion between the respective trade marks and services of the parties'. What this means is that my decision must consider the similarity of the respective trade marks and the respective specifications as they are applied for and are protected on the trade marks register, then bringing these together in an assessment of the overall likelihood of confusion rather than according to any actual differences in the marketplace. Support for this approach can be found in the decision of the Court of Justice in the European Union in Case C-171/06P *T.I.M.E Art v OHIM and Devinlec Development Innovation Leclerc*, at paragraph 59:

"59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks".

8. The applicant also argues that the earlier trade mark has a low distinctive character given that there are many trade marks which include the element "uber". In support of its argument the applicant refers to several earlier trade mark registrations.
9. I note that the existence of several trade mark registrations is not *per se* particularly conclusive, as it does not necessarily reflect the situation in the market. In other words, on the basis of data concerning a register only, it cannot be assumed that all such trade marks have been effectively used. It follows that the evidence filed does not demonstrate that consumers have been exposed to widespread use of, and have become accustomed to trade marks which include "uber". Under these circumstances, the applicant's/holder's claims must be set aside.

The proof of use provisions

10. The contested trade marks were published on 30/01/2009 and 13/03/2009 respectively. The earlier trade marks were registered on 12/10/2007 and 29/02/2008 respectively. As a five period has not elapsed prior to the publication of the contested trade mark, the proof of use provisions do not apply. I must therefore make a notional assessment based on the earlier specification of goods and services as they are registered.

Identity of marks – Section 5(2)(a)

11. The relevant parts of section 5 of the Act read as follows:

(2) A trade mark shall not be registered if because –

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

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

12. The respective trade marks are shown below:

UBER	ÜBER BEAUTY ROOMS 
Earlier trade mark	Contested trade marks

13. It is clear that the marks are not identical. As such, the ground of opposition based upon Section 5(2)(a) of the Act fails.

Likelihood of confusion – Section 5(2)(b)

14. The relevant parts of section 5 of the Act read as follows:

(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. The leading authorities which guide me in this ground are from the CJEU: *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, *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; *Sabel BV v Puma AG*,
- (b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

(e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,

(k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

16. For reasons of procedural economy, I will focus upon the earlier trade mark which, in my view, represents the opponent's best case, namely No 2 442 677B. Further, in respect of this earlier trade mark, it seems to me that the

focus of my assessment should be the earlier services in class 44, namely hygienic and beauty care. I will consider the remaining earlier services (and indeed the remaining earlier trade mark) only if and where necessary.

The average consumer

17. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods or service providers can, however, vary depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
18. The earlier services are hygienic and beauty care. These will commonly be provided through salons, shops and related establishments and will comprise a range of activities. They are directed at the public at large. Some will be services which have a very temporary effect and so are used reasonably frequently, such as hair styling, waxing etc. These are also likely to be relatively inexpensive or at least will not be prohibitively costly and so the level of attention that I expect to be displayed will be reasonable. Other services will be more specialist and semi permanent in nature, such as teeth whitening. It is expected that these will be utilised less frequently and are relatively more expensive. As such, they will be a more considered purchase. I must consider however, despite this obvious range, what the average position will be. In my view, though there is scope for more specialist services within the broad term of the earlier services, the vast majority of activities conducted will be those at the cheaper, day to day end of the scale, which will be used fairly frequently and which are not particularly expensive. The level of attention one would expect to be displayed is therefore medium.
19. In respect of the contested services, these are also directed at the public at large and can be provided through shops, including supermarkets and pharmacies, but also online. For at least some of the goods offered for retail, these can also be sold in salons or specialist beauty treatment shops. Again, many of these services are in respect of the retail of products that are likely to be purchased fairly frequently. The applicant argues that the relevant consumer is sophisticated and able to accurately discern between different types of cosmetic products. I consider that this can be true in some circumstances as within the field of retail for cosmetics and related products, a range exists between those at the high, mid and low end of the market. For those at the high end, they are likely to be a more considered purchase. However, as above I must consider the average position in respect of these services and though there may be some consumers within the public at large who would display a high degree of attention, there will also be many, for whom the level of attention will be only medium at best, particularly as many cosmetic products are those that are used on a daily basis and so are purchased frequently and without a very high degree of attention. Overall therefore, the level of attention is likely to be medium.

Comparison of the services

20. When making the comparison, all relevant factors relating to the goods and services in the respective specifications should be taken into account in determining this issue. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its 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, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

21. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

22. The earlier services are:

Class 44:

Hygienic and beauty care

The contested services are:

Class 35:

Setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice, consultancy and information services relating to such services; provision of information to customers and advice and assistance in the selection of goods; the bringing together, for the benefit of others, of articles for body and beauty-care, non-medicated toilet preparations, powders, creams and lotions (all for the face, hands and body), cosmetic sun-tanning preparations, milks, gels and oils and after-sun preparations, tissues and wipes impregnated with cosmetic lotions, nail polish, nail polish remover, cosmetics, soaps, shower and bath preparations, depilatory preparations, waxes for hair removal, depilatory kits, creams, lotions and ointments for use before and after hair removal, hair bleaching and hair lightening preparations, electric and non-electric appliances for removal of body hair, preparations for the hair, shaving and aftershave preparations, perfumes, colognes, toilet waters, eau de colognes, deodorants and anti-perspirants for personal use, essential oils, aromatherapy products, massage oils and lotions, preparations for exfoliation and body scrubs, body wraps, preparations for use in manicure and pedicure, apparatus, implements and appliances for use in manicure and pedicure, dentifrices, cosmetic tooth whitener, dental whitening and bleaching preparations, medicated creams, oils, powders and lotions, herbal remedies, homeopathic medicines, vitamin preparations, mineral food supplements, dietetic foods and beverages, and nutritional additives enabling customers to conveniently view and purchase those goods in a department store or general merchandise store or a general merchandise Internet website (including the provision of online retail sales of those goods), by mail order, by means of telecommunications, or from a general merchandise catalogue by mail order; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail department store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a catalogue by mail order, telephone or other means of telecommunications; provision of information to customers and advice and assistance in the selection of goods brought together as above.

23. The majority of the contested services are retail services in respect of cosmetic and other beauty related products. The earlier services are for actual hygienic and beauty care whereby customers can pay for particular beauty treatments, commonly carried out in a salon or shop. However, it is also very common for beauty salons and the like to provide a retail service in respect of cosmetic and closely related products. This includes, but is not limited to, for example, items that have been used to carry out a particular treatment, such as a body scrub or waxing strips and items which enable the same effect to be produced as that of a beauty treatment (or which complement it in same way) such as teeth whitening products, hair styling

products etc. Common complementary items such as those implements used for a manicure can also commonly be found on sale in such establishments. Further, retail establishments, for example department stores, can also offer particular beauty treatments (such as facials etc) and consultations (such as in relation to skin types) as well as offering for sale cosmetic and related products.

24. The majority of the contested services are therefore in respect of the retailing of cosmetic type items which would commonly be found for sale in beauty salons. The services are therefore similar in nature and purpose to this extent. The respective users would also coincide; further bearing in mind the above, the providers of beauty salon services can also provide retail services for related products and vice versa. There is therefore similarity between the services, irrespective of the manner in which the retail services of the contested trade mark are accessed (through telephone, mail order, internet etc).
25. I note that in finding similarity, I include retail services for more specialist products, such as medicated creams, oils, powders and lotions. However, to my mind, beauty salons have long catered for those with particular sensibilities, such as sensitive skin and can provide specific treatments to this end. It follows that they are also likely to offer for sale products related to such sensibilities and so to my mind, there is also similarity here. However, a line must be drawn between these types of items and other specialist products which aim to have a different overall impact from improvement to one's appearance, such as improvements to health and wellbeing. It seems somewhat unrealistic to argue that the providers of the earlier hygienic and beauty care would also offer for sale products which aim to improve health. As such, I consider that the contested services in respect of offering for sale herbal remedies, homeopathic medicines, vitamin preparations, mineral food supplements, dietetic foods and beverages, and nutritional additives to be dissimilar to the services of the earlier trade mark.
26. It is not unreasonable to propose that as well as carrying out beauty treatments and selling related items, the earlier services will also provide information, consultancy and advice to its customers regarding the suitability of a product for the individual. Indeed, I consider such a function to be implicit within the broad term "beauty care". These services are also therefore similar to in nature and purpose to the contested "provision of information to customers and advice and assistance in the selection of goods".
27. Further, some of the contested services are in respect of retail services in general, with only "goods" mentioned. I consider that similarity between these and the earlier services remains because "goods" can include cosmetics and the retailing of the type of goods I have found to be similar to the earlier services. The broadness of the wider term "goods" therefore ensures that there is similarity to the earlier services.
28. This leaves the following contested services:

“setting up, organisation, administration, operation and supervision of customer loyalty, sales, incentives and promotional activity schemes and advice, consultancy and information services relating to such services”.

The services listed above are those that will be carried out for, or on behalf of third parties in trade. Even though it is reasonable to propose that beauty salons and the like can, as part of the daily running of a business, offer incentives and conduct other promotional activities to generate sales and ensure customer loyalty, such as special prices on treatment days, buy one get one free offers etc, these services would not be covered by those displayed above as they comprise a business operating its own incentive scheme for its own customers rather than for, or on behalf of, others. They are dissimilar.

29. In summary therefore, I consider the following contested services to be similar to those of the earlier trade mark:

Provision of information to customers and advice and assistance in the selection of goods; the bringing together, for the benefit of others, of articles for body and beauty-care, non-medicated toilet preparations, powders, creams and lotions (all for the face, hands and body), cosmetic sun-tanning preparations, milks, gels and oils and after-sun preparations, tissues and wipes impregnated with cosmetic lotions, nail polish, nail polish remover, cosmetics, soaps, shower and bath preparations, depilatory preparations, waxes for hair removal, depilatory kits, creams, lotions and ointments for use before and after hair removal, hair bleaching and hair lightening preparations, electric and non-electric appliances for removal of body hair, preparations for the hair, shaving and aftershave preparations, perfumes, colognes, toilet waters, eau de colognes, deodorants and anti-perspirants for personal use, essential oils, aromatherapy products, massage oils and lotions, preparations for exfoliation and body scrubs, body wraps, preparations for use in manicure and pedicure, apparatus, implements and appliances for use in manicure and pedicure, dentifrices, cosmetic tooth whitener, dental whitening and bleaching preparations, medicated creams, oils, powders and lotions, enabling customers to conveniently view and purchase those goods in a department store or general merchandise store or a general merchandise Internet website (including the provision of online retail sales of those goods), by mail order, by means of telecommunications, or from a general merchandise catalogue by mail order; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail department store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a catalogue by mail order, telephone or other means of telecommunications; provision of information to customers and advice and assistance in the selection of goods brought together as above.

The remaining services are considered to be dissimilar.

Comparison of the marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

31. The respective trade marks have already been displayed above but for convenience are also shown below:

UBER	ÜBER BEAUTY ROOMS 
Earlier trade mark	Contested trade marks

32. The earlier trade mark is a word mark, as is one of the contested trade marks. The remaining contested trade mark is figurative, comprising a stylised verbal element, which appear in purple, together with a device of a flower in the centre of the trade mark. The marks coincide to the extent that they all contain the verbal element “UBER” which comprises the entirety of the earlier trade mark and the initial part of the contested trade marks. The marks differ in respect of the additional verbal elements “beauty rooms” which have no counterpart in the earlier trade mark and the stylistic and graphical differences as regards one of the contested trade marks already described. Further, the letter “U” in the contested trade marks contains a double dot symbol above. However, I am not persuaded by the applicant’s argument that this has the impact of enabling the letter “U” in its marks to resemble a smiley face. It is still clearly a letter “U” in each of the contested

signs. Bearing in mind the foregoing and the coincidental element present, I consider that the trade marks are similar to a moderate degree.

33. Aurally, there is little to add to the visual analysis. Clearly the coincidental element UBER will be the only element articulated in the earlier trade mark and will be pronounced first in the contested trade marks. There is no evidence to suggest that the addition of the double dot in the contested trade marks will affect the annunciation of UBER and so despite the additional aural elements, they are considered to be similar to a moderate degree.
34. Conceptually, the element “beauty rooms” in the contested trade marks is likely to be understood as referring to or alluding to areas where one can concentrate on accentuating attractiveness. The element “uber” is a word of German origin, meaning ideal or super. The applicant argues that this will be understood by the average UK consumer and I will return to this point in detail further below. However for the purposes of the conceptual comparison, I must assess the situation from the perspective of those who may understand “uber” and those who will not.
35. For those who understand “uber”, I consider that the meaning of this word retains its meaningful hook in the contested trade marks, irrespective of the addition of beauty rooms. Indeed “uber” seems to serve to further qualify this element, in that it that there is something particularly good about these areas where attractiveness can be accentuated. It certainly does not diminish the impact of “uber”, nor does it create a definite and differing idea which can set it apart from “uber” alone. For those who understand “uber” therefore, the signs are conceptually similar, to a relatively high degree.
36. For those who do not understand “uber”, the position is somewhat different. In such a circumstance, the consumer is likely to view the element as meaningless. The position therefore is that there is a meaningless element versus the same meaningless element which appears alongside words that would be understood in the manner already described. It can be argued therefore that the additional elements in the contested trade mark, namely beauty rooms are the only elements that will be understood and so ensure that the trade marks therefore differ conceptually.

Distinctive and dominant components

37. The earlier trade mark and the contested word only mark have no stand out dominant components. Rather they will be appreciated instantly as complete wholes. In addition, it is noted that the remaining contested trade mark is comprised of verbal elements and a flower like device. It is also true that the graphical element appears in the centre of the trade mark. However, I am of the view that it is not clearly visually outstanding which is the position it must

hold in order for me to find that it is dominant. Rather, the trade mark in its entirety will be appreciated instantly as a whole.

38. As regards distinctive components, As already indicated, the applicant argues that the element “uber”, though a word of German origin would be understood by the relevant UK consumer. Further, that this word is essentially laudatory as it means “super”. As a result, the applicant argues that it has a weak distinctive character. To support this claim, the applicant has filed evidence from publications in the fashion industry. Here I note that the word “uber” is used as an alternative to “super” in the context of a description of models who have been very successful, the so-called super models have become uber models. Further, there is a single instance in evidence whereby a cosmetic product, namely an eye shadow, whose colour is described as “uber beige”. This is the sum of the evidence filed. I note that there are no dictionary references in evidence. Though such evidence would not be accepted as definitive out of hand and relied upon with absolute certainty, such evidence, if presented alongside that already filed, may have been more persuasive as words tend to be included within dictionaries following a period of time after which it has entered a language.
39. In this respect, I bear in mind the guidance in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in BL O/100/09 FOREX, which permits me to check a dictionary. Upon checking, for example, the Collins English Dictionary, I note that there is no listing for “uber”. The key critique of the evidence however, is that though it shows that “uber” has been used as an alternative for the word “super”, it does not adequately demonstrate that the UK public at large, who is the relevant public here, would instantly recognise the word and understand its meaning in any potential context. At best, use of the word in respect of “super models” or an eye shadow may mean that the average consumer understands its meaning in those particular contexts but does not demonstrate a wider understanding of the word, with the result being that the average consumer would instantly know that it means super or that it would be understood as a ready alternative to this word. Further, in my view, it is likely that a notable proportion of the relevant public would not understand it at all. As such, I conclude that though it may be understood by some of the relevant public, it will not be understood by all or even a majority. The word “uber”, therefore, is likely to be one that is approaching inclusion in the English language rather than having consolidated its position within and this is borne out by the lack of evidence and dictionary references on the point. If at least part of the relevant public will either a) not understand the term or b) not understand it out of context, then to my mind it must have at least an average degree of distinctiveness.
40. However, this is not the end of the matter as I note that the opponent has claimed that its earlier trade mark has a reputation and has filed evidence in support. This evidence consists of two advertisements for “uber” in respect of beauty care services which appeared in a local newspaper publication in St Helens in the North of England. This is the sum of the evidence and achieves nothing more than demonstrating that services have been offered under the

term “uber”. So, despite showing some use of the trade mark, the evidence provides no information on the extent of such use. The material that has been submitted does not provide any indication as regards the degree of recognition of the trade mark among the relevant public. Furthermore, there are no indications concerning the volume of sales, no indications as regards the market share of the trade mark and no indications on the extent to which it has been promoted. As a result the evidence does not show that the trade mark is known by a significant part of the relevant public. The opponent has therefore failed to demonstrate that its trade mark has a reputation or that it has acquired an enhanced distinctive character over and above that to which it is inherently entitled, namely an average degree. I will consider the impact of this further below in relation to the overall likelihood of confusion, bearing in mind that the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

41. Similarly, the element “uber” in the contested signs will be a distinctive element. The element “beauty rooms”, though not descriptive, nor devoid of distinctive character in respect of the services to which it relates, is more allusive by virtue of the inclusion of the word “beauty”. As such, it is, by definition, a less distinctive element than “uber”, a word that I have already found to be one which a notable proportion of the UK public will not understand at all. In the event I am found to be wrong on this, I am of the view that in any case, the marks coincide in respect of the most distinctive element “uber”. Their overall degree of similarity is therefore quite high.

Global Assessment – Conclusions on Section 5(2)(b)

42. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
43. I have already found that the average consumer is the public at large and that the expected level of attention displayed during the purchasing process to be on average, medium. Many of the contested services have been found to be similar to the earlier services. Further, the earlier trade mark is at least of average distinctiveness for a notable proportion of the UK public.
44. The respective trade marks have been found to be quite highly similar visually and aurally. Conceptually, when one considers those consumers who will not understand the meaning of “uber”, I have already found that there may be a conceptual difference between the signs as it is the meaning attached to “beauty rooms” which will potentially take on a greater importance as they would be the only understandable element. However, in this scenario,

it seems to me that the element “uber”, being meaningless (and therefore distinctive), will be focussed upon by the relevant consumer, not least because it comprises the entirety of the earlier trade mark and appears in the first part of the later trade marks. The respective trade marks also then coincide in respect of a distinctive element. In addition, there is no stand out dominant feature present in any of the marks. In considering all of the aforesaid, together with the notion of imperfect recollection leads me to the conclusion that there is a likelihood of confusion. To my mind, this can equally apply to both direct and indirect confusion in that the relevant public is likely to either mistake one trade mark for the other or will otherwise believe them to be economically linked.

45. The opposition based upon Section 5(2)(b) therefore succeeds as far as the contested services found to be similar are concerned. It fails in respect of those found to be dissimilar. As such, I will go on to consider the remaining grounds of opposition.

Reputation- Section 5(3) of the Act

46. Section 5(3) is as follows:

“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 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.”

47. Bearing in mind the requirement that the earlier trade mark must have a reputation, I take account of the guidance in the following cases, namely, Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, In respect of reputation, the law establishes that the reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24; that the trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26; but the reputation of the earlier mark may extend beyond the consumers for the goods and services for which it is registered; *Intel*, paragraph 51.

48. I have already described the evidence filed by the opponent in support of its claim to a reputation in respect of its earlier trade mark and have made findings in respect of this evidence as regards its impact on the overall distinctiveness of the earlier sign. I consider my previous findings to be equally valid here. The relevant public here is the public at large of the United Kingdom. To demonstrate it has a reputation, the opponent must show that its trade mark is established in relation to hygienic and beauty care services and that it is known to a significant part of the UK public. Two advertisements

in a local publication are inadequate to achieve this. The opposition in so far as it is based upon Section 5(3) of the Act therefore fails.

Passing Off – Section 5(4)(a) of the Act

49. Section 5(4)(a) reads as follows:

“5.-(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark”.

50. The requirements for this ground of opposition have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *WILD CHILD Trade Mark* [1998] R.P.C. 455. Adapted to opposition proceedings, the three elements that must be present can be summarised as follows:

(1) that the opponent's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the applicant are goods or services of the opponent; and

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

51. How then, is goodwill defined? In relation to goodwill, this was explained in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 at 223 as:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first.”

52. It is also worth noting that to qualify for protection under the law of passing-off, any goodwill must be of more than a trivial nature¹. However, being a

¹ *Hart v Relentless Records* [2002] E.W.H.C. 1984

small player does not prevent the law of passing-off from being relied upon as it can be used to protect a more limited goodwill².

53. I consider that the evidence filed by the opponent, namely two advertisements, is also insufficient to support any claim for relief under Section 5(4)(a). Further, I fail to see how they are in any better position under Section 5(4)(a) in respect of the services of the applications found to be dissimilar. If there is no confusion, I cannot see how there can be a misrepresentation. It must also, necessarily fail.

BAD FAITH – Section 3(6) of the Act

54. Section 3(6) of the Act states that:

“A trade mark shall not be registered if or to the extent that the application is made in bad faith”.

55. It is clear that bad faith includes dishonesty and “some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular field being examined”³. It is necessary to apply what is known as the “combined test”⁴. This requires an assessment of what the applicant knew at the time of making its application⁵ and then, in the light of that knowledge, whether their behaviour fell short of acceptable commercial behaviour. Bad faith impugns the character of an individual or the collective character of a business or firm. As such, it is a serious allegation. The more serious the allegation the more cogent the evidence must be to support it. I also take particular note of the decision of Arnold J. in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others* [2008] EWHC 3032 (Ch) 5⁶ where he held:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a

² See, for instance, *Stannard v Reay* [1967] F.S.R. 140, *Teleworks v Telework Group* [2002] R.P.C. and *Stacey v 2020 Communications* [1991] F.S.R. 49).

³ See *Gromax Plastics Ltd v. Don and Low Nonwovens Ltd* [1999] RPC 367.

⁴ See the judgment in (1) *Barlow Clowes International Ltd. (in liquidation)* (2) *Nigel James Hamilton* and (3) *Michael Anthony Jordan v (1) Eurotrust International Limited (2) Peter Stephen William Henwood* and (3) *Andrew George Sebastian* Privy Council Appeal No. 38 of 2004 and also the decision in *Ajit Weekly Trade Mark* [2006] RPC 25.

⁵ The relevant date for the assessment is the date of filing of the application – see *Hotpicks Trade Mark*, [2004] RPC 42, *Nonogram Trade Mark* [2001] RPC 21 and *Chocoladefabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH*.

⁶ Arnold J's judgment was recently upheld in the Court of Appeal - [2008] EWHC 3032 (Ch).

superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

56. This claim is based on the fact that the applicant had previously applied for Uber Beauty Rooms in class 44 which was refused by the Intellectual Property Office on relative grounds owing to the opponent’s previous trade marks. Further, the applicant was aware of the opponent and is a competitor. To my mind, the view of Arnold J in the Cipriani decision is crucial here. It is clear from this judgment that such actions on the part of the applicant in such circumstances as those in these proceedings, cannot amount to bad faith. In the absence of any other arguments and/or evidence from the opponent, this ground of opposition also fails.

57. The sum of all this is that the opponent has succeeded in its opposition in respect of the following services:

Provision of information to customers and advice and assistance in the selection of goods; the bringing together, for the benefit of others, of articles for body and beauty-care, non-medicated toilet preparations, powders, creams and lotions (all for the face, hands and body), cosmetic sun-tanning preparations, milks, gels and oils and after-sun preparations, tissues and wipes impregnated with cosmetic lotions, nail polish, nail polish remover, cosmetics, soaps, shower and bath preparations, depilatory preparations, waxes for hair removal, depilatory kits, creams, lotions and ointments for use before and after hair removal, hair bleaching and hair lightening preparations, electric and non-electric appliances for removal of body hair, preparations for the hair, shaving and aftershave preparations, perfumes, colognes, toilet waters, eau de colognes, deodorants and anti-perspirants for personal use, essential oils, aromatherapy products, massage oils and lotions, preparations for exfoliation and body scrubs, body wraps, preparations for use in manicure and pedicure, apparatus, implements and appliances for use in manicure and pedicure, dentifrices, cosmetic tooth whitener, dental whitening and bleaching preparations, medicated creams, oils, powders and lotions, enabling customers to conveniently view and purchase those goods in a department store or general merchandise store or a general merchandise Internet website (including the provision of online retail sales of those goods), by mail order,

by means of telecommunications, or from a general merchandise catalogue by mail order; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods in a retail department store; the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods from a catalogue by mail order, telephone or other means of telecommunications; provision of information to customers and advice and assistance in the selection of goods brought together as above.

58. The opposition fails in respect of the remaining services, for which the applications are allowed to proceed.

COSTS

59. Though each party has achieved a measure of success in these proceedings, it is clear that the opponent has been proportionally more successful than the applicant. As such, it is entitled to a contribution towards its costs. Neither party sought costs off the normal scale and I am of course mindful that neither sought a hearing. In the circumstances I award the opponent the sum of £900 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £200

Filing evidence and submissions and considering the applicant's evidence - £500

Total - £900

60. The above 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 16th day of November 2011

**Louise White
For the Registrar,
The Comptroller-General**