

O/618/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NUMBER 3431661

IN THE NAME OF P C LDN LTD FOR THE TRADE MARK



Polished  
LONDON

IN CLASSES 3 & 44

AND

THE OPPOSITION THERETO UNDER NUMBER 418186

BY NADIA AZLEN

## Background and pleadings

1. Nadia Azlen (the opponent) opposes the trade mark application no. 3431661 for

the trade mark  in the name of P C LDN LTD (the applicant). The application was filed on 26 September 2019 in respect of the following goods and services:

Class 3: *Beauty care cosmetics.*

Class 44: *Teeth whitening services.*

2. The opposition is filed on the basis of Section 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of the opponent's earlier UK Trade Mark registration no. 2559685 for the word mark 'Polished', registered for the following services:

Class 44: *Beauty Services*

3. The opponent claims to have a reputation for the mark in respect of the services as registered. The opponent submits that if the application is allowed to proceed to registration, the applicant will benefit from the opponent's investment and particularly the awards it has won in 2016, 2017 & 2019, on the basis that the consumer will believe there is an economic connection between the marks. The opponent submits this will lead to an unfair advantage for the applicant. The opponent also claims that due to the similarity of the marks, any possible negative press or court proceedings in respect of the applicant will cause detriment to the opponent's reputation.
4. The applicant filed a counterstatement denying the claims made and requesting the opponent file proof of use of the earlier mark relied upon.

5. Only the opponent filed evidence in these proceedings. Neither party requested a hearing, and neither party filed written submissions. Neither party is professionally represented in these proceedings.

### Evidence summary

6. The opponent filed evidence by way of a witness statement in the name of Nadia Azlen and Exhibit JS1 – Exhibit JS3.
7. In the witness statement, Ms Azlen describes herself as the director of Polished Nails Limited, which appears to be the party under which the use of the earlier mark is made. Ms Azlen explains that her company has been trading under the mark since May 2011, initially in respect of a single shop in London offering nails and waxing treatments, and subsequently expanding by offering a broader range of beauty treatments and opening an additional London salon in 2018.
8. An article that makes reference to the launch of the first shop in 2011 in West Dulwich is provided at **Exhibit JS1**. This appears to be a promotional article, referring to 'POLISHED NAIL AND WAX ROOMS' in the text and in the



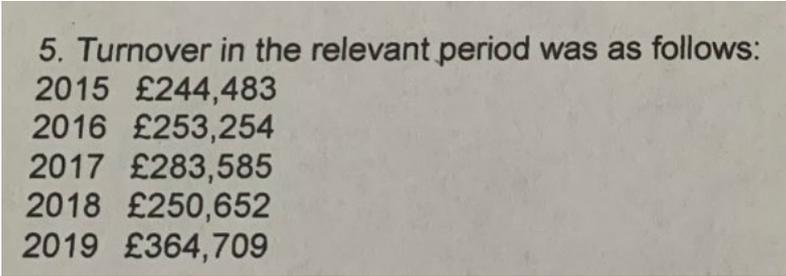
following format heading the article . The article appears to be aimed at the UK due to the London address of the salon mentioned, and the UK web address [www.louellabelle.co.uk](http://www.louellabelle.co.uk) referenced at the side of the article. The date of the article is not entirely clear but there is reference to 'Spring 12' at the side of the same.

9. Ms Azlen explains that the opponent continues to expand its offerings and provides "the price list of the business" at **Exhibit JS2**. This is an undated treatment menu, with the front page displaying . It lists a range of treatments including waxing, threading, nail treatments, massages, facials, eyelash tinting and eyelash extensions, tanning, microblading and body scrubs. The final page of the price list provides 2 addresses based in London, phone

numbers and opening times, as well as showing two signs stating “The London Hair & Beauty Awards Winner 2016” and “The London Hair & Beauty Awards Winner 2017”. Ms Azlen explains in her witness statement that the price list is also displayed clearly on the website and has been used throughout the relevant period.

10. At **Exhibit JS3**, Ms Azlen provides a further promotional article which refers to ‘**POLISHED**’, explaining this is evidence of the publicity received by her company. The article appears to have been issued in the “Business Spotlight” section of SE22 magazine and provides details on the services provided under ‘POLISHED’. The article is undated but makes reference to the London addresses of the Salons as well as the 2016 & 2017 awards mentioned above. Ms Azlen states in her witness statement that this appeared in “local newspapers and magazines” in the relevant period.

11. Finally, Ms Azlen provides turnover figures for 2015 – 2019 as follows:



5. Turnover in the relevant period was as follows:

2015	£244,483
2016	£253,254
2017	£283,585
2018	£250,652
2019	£364,709

### **Preliminary issues**

12. Prior to proceeding with this decision, I will address two matters that I believe require my attention at the outset. Firstly, I note that the earlier mark no. 2559685 upon which the opposition has been based is listed on the UK Intellectual Property Register as ‘expired’ as of 25 September 2020, following its renewal date of 24 September 2020. However, as the earlier registration was alive on the date the application was filed, namely 26 September 2019, the earlier right remains a valid basis for the opposition, which will therefore be decided as normal.

13. Secondly, I note that the use of the mark appears to be made under the company Polished Nails Limited, rather than by the opponent as an individual. However, as the Ms Azlen as the opponent has confirmed in her witness statement she is a director of Polished Nails Limited, it seems apparent that the use made of the mark has been with (at least) the implied consent of the opponent, and as such, may be considered within this opposition.

### **Proof of use**

14. As the earlier mark upon which the opposition is based was over five years old on the date at which the application was filed, it is subject to proof of use under Section 6A of the Act. On this occasion, I note that the opposition has been based on Section 5(3) of the Act only, meaning if no reputation is established on the basis of the evidence filed, the opposition will fail. For procedural efficiency, I will in this instance begin by assessing the evidence for the reputation necessary for the opposition to succeed. Should the opponent fail to establish a reputation, or any one of the cumulative elements required under Section 5(3) of the Act, there will be no need to make an assessment in respect of the proof of use of this mark.

### **Legislation**

15. Section 5(3) states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.

16. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

17. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### **The principles**

18. The relevant case law can be found in the following judgments of the CJEU:

*Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L’Oreal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

a) 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.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29 and Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction,

the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

19. An opposition under Section 5(3) of the Act can only be successful via the establishment of several individual elements, the culmination of which must satisfy all elements of the claim. To be successful on this ground, firstly the opponent must establish that the marks are similar. Should this be shown, the opponent must go on to prove that they hold a reputation for the earlier mark in respect of a significant part of the public. If the opponent has convinced me both that the marks are similar, and that the earlier mark holds a reputation, it must then be shown that the result of this reputation, combined with the similarity between the earlier mark and the applied for mark will result in the public establishing a link between the marks. A link may be found on the basis that the later mark brings the earlier mark to mind. Importantly, if all three of these elements have been established, it must then be shown that the result of the link made by the public will manifest in one of the pleaded types of damage. In this instance, the opponent claims the application will both take unfair advantage of the investment made in respect of the earlier mark, as well as cause detriment to the distinctive character of the same.

### **Similarity of the marks**

20. I will begin by assessing the first of the cumulative factors required under this ground, namely the similarity of the marks.

21. 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. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

22. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

23. The respective trade marks are shown below:

Polished	
Earlier mark	Contested mark

24. The earlier mark consists of the single English word ‘Polished’, which forms the dominant and distinctive element of the mark and creates the overall impression of the same. The dominant and distinctive element of the contested mark is also the English word ‘Polished’, although the stylised font also contributes to the overall impression of the mark itself. The word London is less distinctive and will likely be seen as simply indicating the geographical location of the services under the contested mark. It is also my view that it holds at best a very low level

of distinctiveness in respect of the applicant's goods, on the basis that the word LONDON is commonly used in conjunction with items such as cosmetics and does little to indicate the economic origin of the goods. Whilst it may not be completely disregarded by all consumers, its size, subject and font means it plays a subordinate role in the overall impression of the mark as a whole.

#### Visual comparison

25. Visually both marks consist primarily of the word POLISHED. The earlier mark has been filed as a word mark, meaning that the mark may be used in a range of fonts under fair and notional use, which may bring its appearance closer to the contested mark even if it is found to be the case that the exact stylisation shown is outside of the fair and notional use of the same. I note the addition of the word LONDON in the contested mark does create a small point of visual difference, but I find little attention will be paid to this element by the consumer. Visually, I find the marks to be similar to a high degree.

#### Aural comparison

26. The earlier mark and the dominant component in the contested mark are aurally identical. I find it unlikely that the word LONDON will be verbalised in the contested mark by the consumer, and so I find that often the marks will be pronounced identically. However, if I am wrong and LONDON is verbalised in the later mark, it is my view the element 'polished' featuring in both marks means they will be aurally similar to at least a medium degree.

#### Conceptual comparison

27. In my view, the word polished will conjure one of several meanings. The word may portray to the consumer a meaning of something being shiny. If a person looks 'polished' it is generally understood that they look put together or 'finished' which will likely be conceptualised by a large number of consumers within the context of beauty and cosmetics. In the context of dental services including cosmetic dental treatments, 'polished' may indicate shiny teeth to the consumer,

and in the context of nail services, it may be viewed as play on words with the meaning of 'polished' (put together), and nails that have been 'polished' (meaning generally that nail polish has been applied). In my view, these conceptual meanings may be applied in respect of both the earlier and the contested marks. I note that 'London' also creates a conceptual reference in the later mark, but as it is my view this will likely be seen as simply indicating the location of the services and will be of very low distinctiveness in respect of the goods, I find Polished will be the main point of conceptual reference in the later mark for the consumer. I find the marks conceptually similar to a high degree.

28. With consideration of the factors above, I find the marks similar to a high degree.

## **Reputation**

29. As mentioned above, success on the basis of Section 5(3) of the Act requires the opponent to establish a reputation in respect of its earlier mark.

30. The courts have provided guidance on the factors to consider when assessing if a reputation has been established for a trade mark. In *General Motors, Case C-375/97*, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration

of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

31. With consideration to the factors set out in paragraph 27 of *General Motors* (above), I consider the evidence that has been provided by the opponent. In terms of the geographical extent of the use, as Ms Azlen has explained in her witness statement, the business is limited to two London shops/salons, with the business consisting of a single shop between 2011 and up until the opening of the second London store in 2018. I note there is reference to a website in Ms Azlen's witness statement, that is presumably available to at least a UK wide audience. However, there is no evidence provided on the reach of this website, and I note the nature of the services offered means that they will likely only be available in the locations of the shops. Without further evidence on this point, I am unable to find that the existence of a website alone will mean the services offered will be reached or used by an audience outside of those local to the shops themselves. I note also that the promotional article as referenced in Exhibit JS3 has been referred to as appearing in 'local' publications, and there is no evidence as to the geographic distribution of the article available at Exhibit JS1. I therefore find the geographic extent of the use of the mark appears to be limited to the local areas in which the two London shops are located. Although I note the possibility that consumers living outside these areas may 'drop in' when passing, there is no evidence if and to what extent this type of business takes place.

32. I note that no information or figures have been provided in respect of the market share held by the opponent under the trade mark, and so I cannot find with any accuracy what share of the industry is held under the mark. Although no specific figures have been filed in evidence in respect of the size of the market, I note

that the beauty services industry in the UK is undoubtedly very large. Whilst I note the opponent has provided reasonable and steadily increasing turnover figures for the period of 2015 – 2019, it is my view that in terms of the market share of the UK beauty industry, or indeed even the London market, this will be only a very small fraction of the same.

33. The evidence provided by the opponent does little to indicate the intensity of the use of the mark, or the size of the investment made in promoting the brand. I note that two promotional articles have been provided at Exhibits JS1 and JS3, but no reference to audience or distribution figures have been made, other than Ms Azlen describing that Exhibit JS3 “appeared in local newspapers and magazines in the relevant period”. From the evidence that I have been provided, it is impossible to establish that there has been any more than a very small investment made by the opponent in respect of the promotion of its services under the mark.

34. Ms Azlen has stated in her witness statement that the use of the mark for the services began in 2011. In addition, the article provided under Exhibit JS1 makes reference to the business beginning in 2011. The witness statement, dated 23 March 2020, states that the business offers numerous beauty treatments and continues to expand, and that the price list, clearly displaying the mark POLISHED is used on the website and has been used throughout the relevant period. It therefore seems likely that the earlier has been in use by the opponent for a duration of 9 years, and roughly eight years prior to the application being filed.

35. I note that the opponent has mentioned awards won in 2016, 2017 & 2019 in its initial TM7 filed, and I also note reference to the opponent as winner of The London Hair and Beauty Awards in 2016 & 2017, both at the end of the price list provided at Exhibit JS2, and at the end of the article provided as Exhibit JS3. No further evidence is provided in relation to these awards, and it is not clear if the opponent is the only winner. The level of acclaim that these awards grant in the industry is also unclear. Further, there is no information about the level of

promotion associated with these awards, and whether this will help to educate consumers about the opponent's services under the mark or influence its reputation. Whilst I note the receipt of awards may contribute towards a finding of a reputation, and so I will consider this in respect of the full picture the evidence creates, from the information and evidence provided in this instance, these references alone do not suffice to show the opponent has a reputation in its mark.

36. Having considered individually the factors that may contribute towards and finding of reputation, and the extent to which each of these are evidenced, I will now consider what the accumulation of the evidence provided and the factors considered mean for the establishment of a reputation by the opponent. To find that the opponent has shown a reputation for the mark, I must find that the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark, as established in *General Motors*. As also confirmed in *General Motors*, there is no particular percentage of consumers with knowledge of the mark that must be shown. It is my view that the points that weigh most heavily in the opponent's favour are that it may date its trading under the mark back to sometime in 2011 (a specific date is not mentioned), and that it has had a reasonable turnover dating at least back to 2014. I note the awards, but as mentioned above I find the lack of detail and evidence relating to these mean I can give little weight to the same. However, in my view, I cannot find that the opponent has established a reputation merely on the basis that appear to have been trading during this time, as it is my view that all other factors including the geographical extent of the use, the intensity of the use, the investment in the mark and the market share can only, from the evidence provided, be found to be very limited. It follows that it is therefore my view that the evidence provided is insufficient for me to find, as I must, that the mark is known to a significant part of the public concerned by the opponent's services.

37. As I have been unable to find that the opponent has established it has a reputation for its services, a claim on the basis of Section 5(3) of the Act must therefore fail. For this reason, I do not need to consider if the public will make a

link between the marks, or if the cumulation of these factors will result in the damage as pleaded by the opponent.

## **Final remarks**

38. The opposition based on Section 5(3) of the Act has failed. The application may therefore proceed to registration in respect of all of the goods.

## **COSTS**

39. The applicant has been successful in these proceedings. As neither party were professionally represented in these proceedings, on the 28 September 2020 the parties were sent a letter by the Tribunal attaching an optional costs pro-forma for completion. The letter included following information on costs:

### **What to do if you intend to request costs**

If you intend to make a request for an award of costs you must complete and return the attached pro-forma and send a copy to the other party. Please send these by e-mail to [tribunalhearings@ipo.gov.uk](mailto:tribunalhearings@ipo.gov.uk).

If there is to be a “decision from the papers” this should be provided by **26 October 2020**.

If a hearing is taking place you will be advised of the deadline to do so when the Hearing is appointed.

If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs. Please note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour.

40. No cost pro-forma was received from either party. As the applicant is the successful party in this instance, and as no costs pro-forma has been received from the same and the applicant incurred no official fees, no costs will be awarded in this instance.

**Dated this day of 10th December 2020**

**Rosie Le Breton  
For the Registrar,  
The Comptroller-General**