

O-669-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3292500

BY VIRGIN HAIR COMPANY.LONDON LTD

TO REGISTER THE FOLLOWING TRADE MARK:

**VIRGIN HAIR COMPANY.
LONDON**

IN CLASS 44

AND

OPPOSITION THERETO UNDER NO. 600000891

BY VIRGIN ENTERPRISES LIMITED

Background and pleadings

1. On 25 February 2018, virgin hair company.london ltd (“the applicant”) filed trade mark application number UK00003292500 for the mark above, for the following services:

Class 44: *Beauty care*

2. The application was accepted and published for opposition purposes on 23 March 2018. Virgin Enterprises Limited (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon UK Trade mark (“UKTM”) registration 3163121 and EU Trade mark (“EUTM”) registration 015255235, the pertinent details of which are as follows:

UKTM

Mark: VIRGIN

Filing date: 05 May 2016

Date of registration: 29 July 2016

Services relied upon:

Class 44: *Hygienic and beauty care for human beings or animals; hair and beauty salon services; beauty therapy treatment services*

EUTM

Mark: VIRGIN

Filing date: 03 June 2013

Date of registration: 21 March 2016

Services relied upon:

Class 44: *Hygienic and beauty care for human beings or animals; hair and beauty salon services; beauty therapy treatment services*

3. By virtue of having filing dates that predate the filing date of the contested mark, the opponent’s UKTM and EUTM qualify, under section 6 of the Act, as earlier marks for

the purposes of these proceedings. As the earlier marks completed their registration procedure less than five years before the publication date of the contested mark, they are not subject to the proof of use provisions set out in section 6A of the Act. The consequence of this is that the opponent is entitled to rely upon all of the services for which its earlier marks are registered.

4. The opponent claims that the applied for mark is highly similar to its earlier marks and the services applied for are identical or similar, leading to a likelihood of confusion.

5. The applicant filed a counterstatement in which it denies that there exists a likelihood of confusion. I will address the specific issues raised in its counterstatement in due course.

6. The opponent has used the fast track procedure for this opposition.

7. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I 2013/2235, disapplied paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.

8. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

9. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken.

10. Neither party requested a hearing and only the opponent filed written submissions. I therefore make this decision following a careful review of all the papers on file.

11. Neither party is represented.

Preliminary issues

12. The two marks relied upon by the opponent are identical and registered for identical services. Therefore, for the sake of procedural economy, I will refer to them collectively as the 'Virgin marks' throughout this decision.

13. The applicant, in its counterstatement, relies on a number of factors which it says will avoid any likelihood of confusion. Before going any further into the merits of this opposition it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

i. The applicant owns the domain name "Virgin Hair Company.London"

Firstly, owning a domain name does not mean that it is in use. Secondly, in any event, ownership of a domain name is not a defence to a trade mark opposition¹. These submissions are therefore not relevant to the matter before me.

ii. The applicant supplies human hair extensions and wigs

Differences between the services currently provided by the parties are irrelevant, except to the extent that those differences are apparent from the list of services they have tendered for the purpose of the registration of their marks. I am required to make a decision based on the services included in the parties' respective specifications. Therefore, submissions regarding the specific goods/services the applicant is providing are irrelevant to the assessment I am required.

iii. The applicant has made comparisons between its applied for mark and what it refers to as the opponent's trade mark

¹ See Tribunal Practice Notice 4/2009 "Trade mark opposition and invalidation proceedings – defences"

I am required to make a comparison of the marks in question, exactly as they are registered. What the applicant has attached to its counterstatement is a stylised form of the word virgin. This is not what the opponent relies upon for the purposes of this opposition. The opponent relies upon its plain word mark ('VIRGIN') and so that is what I must compare the application to.

- iv. The applicant is not aware of anyone confusing its mark with the opponent's mark

In *The European Limited v The Economist Newspaper Ltd*², Millett L.J. stated that:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

The fact that the applicant is not aware of any confusion to date does not mean that it has not happened, nor does it mean that it will not happen in the future. In any event, applying this case law to the matter before me, a lack of confusion to date is not an important factor for me to consider, especially as there could be a significant number of reasons for this.

Decision

Section 5(2)(b)

14. Section 5(2)(b) of the Act states that:

“5 (2) A trade mark shall not be registered is because –

² [1998] FSR 283

(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 confusion with the earlier trade mark.”

The principles

15. The following principles are gleaned from the judgment of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(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 the 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 be dominated by one or more of its components;

(f) However, it is also 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 creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of services

16. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*³, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

³ Case T-133/05

“29. In addition, the goods can be considered as identical when the goods designated by the earlier trade mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

17. I find that *hygienic and beauty care for human beings or animals* in the opponent’s specification falls within the scope of *beauty care* in the applicant’s specification. The parties’ class 44 services are identical.

The average consumer and the nature of the purchasing act

18. It is necessary for me to determine who the average consumer is for the respective parties’ services. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*⁴, Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

19. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*⁵.

⁴ [2014] EWHC 439 (Ch)

⁵ Case C-342/97

20. I am of the view that the average consumer of beauty care services is a member of the general public. The purchasing process for the services at issue is likely to be predominantly visual: beauty care services are likely to be selected following inspection of the premises' frontage on the high street, on a website, or as a result of advertisements in magazines or on posters, flyers or other advertising material. Oral recommendations may also play a role, so I do not ignore that there may be an aural element to the purchase. I bear in mind that the average consumer may need to consider factors such as the types of beauty care provided, the cost of the services offered and the nature of the establishment. I consider that, overall, the level of attention that will be paid during the purchasing process would be average.

Comparison of marks

21. It is clear from *Sabel BV v Puma AG* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union ("CJEU") 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, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

23. The trade marks to be compared are as follows:

Applied for mark	Earlier marks
VIRGIN HAIR COMPANY. LONDON	VIRGIN

24. The opponent, in its statement of grounds, submits that the first word in the application is visually, aurally and conceptually identical to the earlier marks. The opponent further submits, in its written submissions, that the words HAIR COMPANY and LONDON are non-distinctive.

25. The applicant has not made any comparisons between its mark and the earlier marks as they are registered (as opposed to the form of use attached to its counterstatement) but submits that they cannot be mistaken for one another.

Overall impression

26. The opponent's Virgin marks consist solely of the word 'VIRGIN', the overall impression of which rests in the word itself. The applicant's mark consists of the words 'VIRGIN HAIR COMPANY.LONDON' in a fairly standard typeface, presented in varying shades of gold. 'HAIR COMPANY' is descriptive for the services for which the application is registered. 'LONDON' simply suggests that the applicant is a business in London. Consequently, the word 'VIRGIN' plays the greatest role in the overall impression of the applicant's mark.

Visual comparison

27. Visually, the entirety of the earlier marks is the first word in the applied for mark. The differences between the two marks are: (i) the addition of the words 'HAIR

COMPANY. LONDON' in the applied for mark, (ii) the slightly different font and (iii) the colour the marks are presented in.

28. In relation to the font, I refer Professor Ruth Annand's comments, sitting as the Appointed Person in *Bentley Motors Limited v Bentley 1962 Limited*⁶:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

29. In relation to the colour of the mark, the Court of Appeal has stated on two occasions (see paragraph 5 of the judgment of the Court of Appeal in *Specsavers* [2014]⁷ and *J.W. Spear & Sons Ltd v Zynga, Inc.* [2015]⁸ at paragraph 47) that registration of a trade mark in black and white covers use of the mark in colour. This is because colour is an implicit component of a trade mark registered in black and white (as opposed to extraneous matter). Thus a black and white version of a mark should normally be considered on the basis that it could be used in any colour.

30. Considering the above case law, the differences in font and colour between the marks do not operate as features which put visual differences between the marks. The opponent's mark covers notional use in the same font and colour as the applicant's mark. Factoring in the extra components to the applicant's mark, but that the same word ('VIRGIN') appears at the beginning, I consider there to be a medium degree of visual similarity between the marks.

Aural comparison

31. The part of the applied for mark that makes the greatest contribution to the overall impression is identical to the earlier mark in its entirety. As the average consumer is

⁶ BL O/158/17

⁷ EWCA Civ 1294

⁸ EWCA Civ 290

unlikely to articulate 'HAIR COMPANY', which describes the nature of the services, and 'LONDON' which simply denotes a business in London, the marks will be pronounced identically. It follows that I find that the marks are aurally identical. In the alternative, if the average consumer does articulate 'HAIR COMPANY' or 'HAIR COMPANY.LONDON', I would find a medium degree of aural similarity between the marks.

Conceptual comparison

32. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*⁹. The assessment must be made from the point of view of the average consumer.

33. The applicant submits that the word 'VIRGIN' in their mark refers to unprocessed hair. Virgin is a standard dictionary word which will be known to the average consumer as an adjective for something that is natural or unprocessed. I am of the view that the concept of the same word in the opponent's mark is going to be no different. Given the descriptive nature of 'HAIR COMPANY.LONDON' in the application, I find that the marks have a high degree of conceptual similarity.

Distinctive character of the earlier marks

34. The degree of distinctiveness of the earlier marks must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik* the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

⁹ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

35. As no evidence has been filed by the opponent, I have only the inherent distinctiveness of the earlier marks, ‘VIRGIN’, to consider. Virgin is an ordinary dictionary word which will be known to the average consumer, although, it does not appear to be descriptive or allusive of the services at issue. I find the earlier mark to possess an average degree of inherent character.

Likelihood of confusion

36. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]) and I must make a global assessment of the competing factors (*Sabel BV v Puma AG* at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]). Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the

same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related).

37. The marks are visually similar to a medium degree, aurally identical (or aurally similar to a medium degree where the average consumer articulates the words 'HAIR COMPANY LONDON') and conceptually highly similar. I am of the view that since the differences between the marks are caused by the descriptive words in the application, the marks will both be seen as 'VIRGIN' marks. Considering the identity of the services, I find that the average consumer will believe the marks to come from the same undertaking.

Conclusion

38. There is a likelihood of indirect confusion.

Costs

39. As the opponent has been successful, it would, ordinarily, be entitled to an award of costs in its favour. As the opponent represents itself, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs and, if so, to complete a pro-forma indicating a breakdown of its actual costs. It was made clear to the opponent that if the pro-forma was not completed "no costs, other than the official fees arising from the action and paid by the successful party...will be awarded". Since the opponent did not respond to that invitation, it is only entitled to a cost award in respect of the official fee of £100.

40. I order virgin hair company.london ltd to pay Virgin Enterprises Limited the sum of **£100**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of October 2018

**Emily Venables
For the Registrar,
The Comptroller-General**