

O/0472/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF APPLICATION NUMBERS UK00003798074, UK00003802166
AND UK00003845574
BY CAPELLO LTD**

**AND OPPOSITIONS THERETO UNDER NUMBERS 436882, 436883 AND 438820
BY HAIR REHAB LONDON LTD**

AND

**IN THE MATTER OF REGISTRATION NUMBER UK00916427081
IN THE NAME OF HAIR REHAB LONDON LTD**

**AND AN APPLICATION FOR REVOCATION THERETO UNDER NUMBER 505690
BY CAPELLO LTD**

AND

**IN THE MATTER OF REGISTRATION NUMBER UK00003272902
IN THE NAME OF HAIR REHAB LONDON LTD**

**AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NUMBER 505765
BY CAPELLO LTD**

BACKGROUND AND PLEADINGS

The oppositions

Application number 3798074 (“Capello’s first application”) and opposition number 436882 (“HRL’s first opposition”)

1. On 13 June 2022, CAPELLO LTD (“Capello”) filed application number 3798074 to register, in the UK, the trade mark “REHAB.”. The application was published for opposition purposes on 15 July 2022 and registration is sought for the following goods:

Class 3: *Hair oils; Hair mascara.*

Class 21: *Hair combs; Hair brushes.*

Class 26: *Hair twisters [hair accessories]; Hair curlers; Non-electric hair curlers; Curlers.*

2. On 14 October 2022, Hair Rehab London Ltd (“HRL”) filed an opposition against the entirety of Capello’s first application, based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).¹ Under both sections of the Act, HRL relies upon the following two trade marks:

i. UK00003272902 (“HRL’s first earlier mark”)

Representation: HAIR REHAB

Filing date: 24 November 2017

Registration date: 25 May 2018

Goods and services relied upon: All in Classes 3, 8, 11, 21, 26, 35 and 41.²

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² These will be listed at the relevant point/s in this decision.

ii. UK00916427081 (“HRL’s second earlier mark”)³



Representation:

Filing date: 3 March 2017

Registration date: 28 June 2017

Goods and services relied upon: All in Classes 3, 8, 11, 21, 26, 35 and 41.⁴

3. HRL’s first and second earlier marks are considered earlier marks in accordance with section 6(1)(a) of the Act given that they were filed for registration earlier than the filing date of Capello’s first application. However, HRL’s first and second earlier marks had not been registered for five years at the filing date of Capello’s first application and so, in accordance with section 6A of the Act, the marks are not subject to proof of use; HRL may rely upon all the goods/services identified for its first opposition without proving that it has genuinely used the marks.

4. Under section 5(2)(b), HRL claims that there is a likelihood of confusion between Capello’s first application and its first and second earlier marks, on the basis that the marks are similar and the goods/services are similar.

5. Under section 5(3), HRL claims to have a reputation for its first and second earlier marks in relation to all the goods/services for which they are registered. HRL claims that use of Capello’s first application would take unfair advantage of, or be detrimental to, the distinctive character or reputation of HRL’s first and second earlier marks.

Application number 3802166 (“Capello’s second application”) and opposition number 436883 (“HRL’s second opposition”)

³ On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark (“EUTM”). As a result of HRL’s EUTM number 16427081 being registered before the end of the transition period, a comparable UKTM (HRL’s second earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods/services.

⁴ These will be listed at the relevant point/s in this decision.

6. On 23 June 2022, Capello filed application number 3802166 to register, in the UK, the trade mark shown below. The application was published for opposition purposes on 15 July 2022 and registration is sought for the following goods:

Class 3: *Hair oil; Hair oils; Oils for hair conditioning; Hair balm; Hair conditioners; Hair shampoos; Hair serums; Hair fixers.*

Class 21: *Hair brushes.*

Class 26: *Hair twisters [hair accessories]; Hair curlers; Hair scrunchies; Non-electric hair curlers; Curlers.*

REHAB.
YOUR HAIR

7. On 14 October 2022, HRL filed an opposition against the entirety of the second application, based upon sections 5(2)(b) and 5(3) of the Act. Under both sections of the Act, HRL relies upon its first and second earlier marks: those relied upon under its first opposition, and listed at paragraph 2, above. Again, the marks are considered earlier marks and are not subject to proof of use. In its second opposition, under section 5(2)(b) only, HRL relies upon a third earlier mark, the details of which are below:

i. UK00003442743 (“HRL’s third earlier mark”)

Representation: Rehab Lab

Filing date: 8 November 2019

Registration date: 24 January 2020

Goods and services relied upon: All in Classes 3, 8, 11 and 35.⁵

⁵ These will be listed at the relevant point/s in this decision.

8. HRL's third earlier mark is considered an earlier mark in accordance with section 6(1)(a) of the Act; in accordance with section 6A of the Act, it is not subject to proof of use.

9. Under section 5(2)(b), HRL claims that there is a likelihood of confusion between Capello's second application and its first, second and third earlier marks, on the basis that the marks are similar and the goods/services are similar.

10. Under section 5(3), HRL claims to have a reputation for its first and second earlier marks in relation to all the goods/services for which they are registered. HRL claims that use of Capello's second application would take unfair advantage of, or be detrimental to, the distinctive character or reputation of HRL's first and second earlier marks.

Application number 3845574 ("Capello's third application") and opposition number 438820 ("HRL's third opposition")

11. On 3 November 2022, Capello filed application number 3845574 to register, in the UK, the trade mark "RYH REHAB YOUR HAIR". The application was published for opposition purposes on 23 December 2022 and registration is sought for the following goods and services:

Class 3: *Hair balm; Hair oil; Hair glaze; Hair moisturisers; Hair conditioners; Hair shampoos; Hair relaxers; Hair spray; Hair colouring; Hair colourants; Hair powder; Hair liquid; Hair serums; Hair mascara; Hair wax; Hair cream; Hair shampoo; Hair pomades; Hair sprays; Hair bleaches; Hair mousses; Hair chalks; Hair oils; Hair creams; Hair texturizers; Hair cosmetics; Hair gels; Hair dye; Hair dyes; Hair colorants; Hair frosts; Hair masks; Hair liquids; Hair balms; Hair glazes; Hair moisturizers; Hair conditioner; Hair fixers; Hair bleach; Hair decolorants; Hair rinses; Hair lotion; Hair gel; Hair mousse; Baby hair conditioner; Hair fixing oil; Hair-waving preparations; Hair styling spray; Hair dyeing preparations; Hair care masks; Hair cleaning preparations; Pet shampoos; Body shampoos; Baby shampoo.*

Class 21: *Hair combs; Combs for back-combing hair; Electric hair combs; Wide tooth combs for hair; Combs; Combs for the hair (Large-toothed -); Large-toothed combs for the hair; Eyelash combs; Hair brushes; Hair tinting brushes; Brushes; Eyebrow brushes; Shampoo brushes; Eyelash brushes; Cosmetic brushes.*

Class 26: *Hair ornaments, hair rollers, hair fastening articles, and false hair; Hair twisters [hair accessories]; Hair elastics; Hair decorations; Hair netting; Hair bands; Bands (Hair -); Hair wraps; Hair clips; Hair rollers; Hair pins; Hair scrunchies; Hair slides; Hair fasteners; Hair curl clips; Foam hair rollers.*

Class 35: *Retail services in relation to hair products.*

12. On 24 January 2023, HRL filed an opposition against the entirety of Capello's third application, based upon sections 5(2)(b) and 5(3) of the Act. Under both sections of the Act, HRL relies upon its first and second earlier marks: those listed at paragraph 2, above. Again, the marks are considered earlier marks. However, whilst HRL's first earlier mark is not subject to proof of use in its third opposition, its second earlier mark is: it had been registered for more than five years at the filing date of Capello's third application; HRL made a statement of use in relation to all the goods/services relied upon.

13. Under section 5(2)(b), HRL claims that there is a likelihood of confusion between Capello's third application and its first and second earlier marks, on the basis that the marks are similar and the goods/services are similar.

14. Under section 5(3), HRL claims to have a reputation for its first and second earlier marks in relation to all the goods/services for which they are registered. HRL claims that use of Capello's third application would take unfair advantage of, or be detrimental to, the distinctive character or reputation of HRL's first and second earlier marks.

15. Capello filed defences to HRL's three oppositions, denying the claims made therein and putting HRL to proof of its claimed reputation in its first and second earlier marks and proof of use of its second earlier mark in the third opposition.

The revocation

16. On 6 January 2023, Capello sought revocation of HRL's second earlier mark, in its entirety, for non-use under section 46(1)(a) of the Act. The period in respect of which non-use is claimed is 29 June 2017 to 28 June 2022, with an effective date of revocation of 29 June 2022.

17. HRL filed a defence and counterstatement, denying Capello's claims in full.

The invalidity

18. On 26 January 2023, Capello filed an application for a declaration of invalidity of HRL's first earlier mark, in its entirety. The application is based upon sections 3(1)(b), (c) and (d) of the Act. Capello contends that HRL's first earlier mark (HAIR REHAB) offends the aforesaid sections of the Act on the basis that 'HAIR' carries no distinctive character in connection with goods and services relating to haircare and that 'REHAB' is the action or process of rehabilitating (i.e. "restoring to a former capacity"); when viewed together, HAIR REHAB describes the intended purpose of the goods/services: to restore one's hair.⁶ I will return to Capello's submissions for each ground at the relevant points in my decision.

19. HRL filed a defence and counterstatement, denying Capello's claims in full and further, or in the alternative, contesting that its first earlier mark has acquired distinctiveness, thus precluding a section 3(1)(b), (c) or (d) objection.

⁶ See Capello's Statement of Grounds at [8]-[10].

Consolidation

20. On 6 June 2023 the parties were notified in writing that the above opposition, revocation and invalidation proceedings would be consolidated, in accordance with Rule 62(1)(g) of the Trade Marks Rules 2008.

Representation

21. Capello is represented by Tomkins & Co and HRL by Stephens Scown LLP.

Evidence and submissions

22. HRL filed evidence in the form of a witness statement from one of its Directors, Helen Pope, dated 4 August 2023, and 21 accompanying exhibits (HR1-HR21). Ms Pope's evidence goes to the use of HRL's second earlier mark, claimed acquired distinctiveness of the first earlier mark and claimed reputation of the first and second earlier marks, as well as claimed instances of actual confusion.

23. Capello filed evidence in the form of two witness statements from its Director, Vicky Marie Ellis, dated 4 August 2023 (VME WS1) and 9 October 2023 (VME WS2), and 85 accompanying exhibits (VME1-VME85). The evidence contained within VME WS1 and exhibits VME1-VME53 goes to Capello's claim that HRL's first earlier mark is descriptive, non-distinctive and has become customary in trade. The evidence contained within VME WS2 and exhibits VME54-VME85 mainly goes to the use of Capello's three applications; some of the evidence is in response to HRL's evidence of use.

24. At the conclusion of the evidence rounds, Capello requested an oral hearing in these consolidated proceedings. The hearing was held before me on 12 June 2024 at which Capello was represented by Mr Jonathan Hill, instructed by Tomkins & Co. and HRL was represented by Ms Georgina Messenger, instructed by Stephens Scown LLP.⁷

⁷ References in this decision to the submissions made at the hearing are taken from the transcript of the stenograph notes of Marten Walsh Cherer Ltd.

DECISION

Relevance of EU law

25. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

The revocation

26. I shall deal first with the application for revocation of HRL's second earlier mark.

Statutory provisions

27. The relevant provisions of section 46 of the Act are as follows:

“(1) The registration of a trade mark may be revoked on any of the following grounds –

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;

(b) [...]

[...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

28. Section 100 of the Act is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

29. As HRL’s second earlier mark is a comparable mark, paragraph 8 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“8(1) Sections 11A and 46 apply in relation to a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the period of five years referred to in sections 11A(3)(a) and 46(1)(a) or (b) (the “five-year period”) has expired before IP completion day –

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day –

(a) the references in sections 11A(3) and (insofar as they relate to use of a trade mark) 46 to a trade mark, are to be treated as references to the corresponding EUTM; and

(b) the references in sections 11A and 46 to the United Kingdom include the European Union.”

30. By virtue of the above, use in the EU will be relevant up to 31 December 2020. Thereafter, only use in the UK will be relevant.

Relevant case law

31. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

32. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

33. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘*show*’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

34. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows

me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

35. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods/services at issue during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods/services for which use has been shown;
- iv) The nature of those goods/services and the market(s) for them; and
- v) The geographical extent of the use shown.

Assessment of the evidence

36. I remind myself that for the purposes of these proceedings the relevant period in which HRL must demonstrate genuine use of its second earlier mark is 29 June 2017 to 28 June 2022. The representation of the second earlier mark, as well as the goods and services for which it is registered, are below:



Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes; Eyelashes (Adhesives for affixing false -).*

- Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*
- Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*
- Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*
- Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Wigs; False hairpieces.*
- Class 35: *Retail and Wholesale services in connection with; Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes; Eyelashes (Adhesives for affixing false -); Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators; Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances; Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes; Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Wigs; False hairpieces.*

Class 41: *Hairdressing instruction; Educational instruction; Educational consultancy; Teaching of beauty skills; Educational services relating to beauty therapy.*

37. Ms Pope's witness statement explains that HRL has been operating since 2007⁸ and has spent £178,138 on advertising, marketing and expanding the brand from 2017 to the date of the witness statement.

38. Ms Pope's narrative evidence specifically relating to the second earlier mark states:

"46. This cancellation action came as a surprise given that it is clear from the HRL website, that the [second earlier mark] (which has been in use since before its registration in 2017) is being used for the goods and services it protects.

47. Despite this, **Exhibit HR21** provides evidence of HRL's use of the mark in respect of some of the goods it protects."

39. Of the 21 exhibits filed by HRL, the only evidence depicting the second earlier mark is as follows:

- 13 invoices, of which just four are from the relevant territories (the UK or the EU) as well as being dated within the relevant part of the five-year period: Edinburgh in August 2018; Germany in April 2019; Germany in January 2020; and Greece in July 2020. The remaining invoices are either addressed to countries outside the UK/EU or are addressed in the EU but after IP completion day.⁹
- The mark appears on the landing page of HRL's website (hairrehablondon.com) and on goods shown on the website including hair serum, a comb, a hairbrush and hair scrunchies. The web pages are undated.¹⁰

⁸ See [3].

⁹ HR3.

¹⁰ HR4.

- HRL's Instagram page whereby the mark is in use as the profile picture, as well as in Instagram posts either from HRL's account or from celebrities' accounts. None of this evidence is dated, save for one post which refers to a 'deal' ending on 22 May 2023,¹¹ which falls after the end of the relevant period.
- An unknown social media platform post whereby the mark is in use as the profile picture. The post refers to HRL goods featuring on the TV programme 'This Morning'. This evidence is undated.¹²
- A page of HRL's website, featuring the mark, which is undated other than referring to HRL's training academy launching in 2016,¹³ which falls before the start of the relevant period.
- Signage outside a hair salon on which the mark appears.¹⁴ This is described in the witness statement as being part of a merchandising pack,¹⁵ but is undated.
- HRL featured in the magazine 'Marie Claire' in which the mark is visible on the packaging of goods (appearing to be hair extensions). This evidence is undated other than the title reading "Hair Rehab LDN received award at Marie Claire UK Hair Awards 2023...",¹⁶ which falls after the end of the relevant period.
- Images of HRL goods taken from (what appears to be) HRL's website which bear the mark on their packaging. The goods include hair serum, shampoo, conditioner, hair brushes, hair extension tape and heatless hair curlers. This evidence is undated.¹⁷

40. Considering the above, the only evidence which depicts HRL's second earlier mark and which is dated within the relevant period is four invoices. The goods on those invoices are: 'luxé wrap ponytails'; 'half wigs'; 'double sided tape' and 'clip-on buns', with a total sale value of £248.43.

¹¹ HR5-6.

¹² HR8.

¹³ HR10.

¹⁴ HR11.

¹⁵ See [22].

¹⁶ HR13.

¹⁷ HR21.

41. Whilst Ms Pope's witness statement refers to the invoices as a sample,¹⁸ there are no sales figures and no figures relating to the number of products sold, either at any point in the relevant period, or at all. Ms Pope has not suggested, and there is no way of me calculating, what percentage of the total sales the four invoices represent. The only figures provided are those relating to the marketing/advertising of unnamed HRL goods, though there is no dated documentary evidence for me to conclude that such marketing spend was in relation to the second earlier mark.

42. Where the remainder of the evidence depicting the second earlier mark is undated, there is no explanation in Ms Pope's witness statement as to its date. Even if I were to assume the evidence was accurate as at the date of Ms Pope's witness statement (4 August 2023), that falls more than a year after the end of the relevant period and so is not indicative of the position during that time.

43. At the hearing, Ms Messenger, for HRL, submitted that I must consider the undated evidence in parallel with Ms Pope's narrative evidence, in particular that HRL was founded in 2007 and has been operating in the UK since that date. These are sweeping statements that lack the detail required to corroborate undated documentary evidence.

44. I pause here to consider the comments of Mr Iain Purvis QC, sitting as the Appointed Person in *Amazon Technologies Inc v Rituals International Trademarks B.V.*,¹⁹ where he addressed the meaning of 'bare assertion' by way of drawing a distinction between (i) a simple statement that a mark has been used and (ii) a statement setting out when, where, in what manner and in relation to what goods/services the trade mark has been used; Mr Purvis cited Arnold J in *Pan World Brands v Tripp*,²⁰ who considered that the former would constitute bare assertion but the latter would not. This is an important distinction given the judgment of Kitchen J in *Moo Juice*²¹ that "a bare assertion would provide no evidence as to the actual use

¹⁸ See [7].

¹⁹ BL O/005/21.

²⁰ [2008] RPC 2 at [31].

²¹ [2006] RPC 18 at [16].

made by the proprietor...the evidence must provide a sufficient explanation of how the mark has been used for the tribunal to conclude that the proprietor has an arguable defence to the application [for revocation]”.

45. Whilst not all of Ms Pope’s narrative evidence constitutes bare assertion, the statements are not sufficiently detailed to compensate for the deficiencies in the documentary evidence. The website and social media evidence is undated and does not demonstrate any sales of goods/services. Neither is there any attempt in Ms Pope’s witness statement to explain the dates of the website and social media evidence or for how long the evidence appeared in the format shown, including how long the mark had been in use as the profile picture.

46. Whilst I am cognisant of the need not to look at each piece of evidence individually but consider what they collectively show, the evidence does not build a clear picture of the extent of the second earlier mark’s use. As well as the marketing spend (which is subject to the criticisms at paragraph 41), the high point of HRL’s evidence is four invoices totalling £248.43. I have in mind Ms Messenger’s reference to principle (7) at my paragraph 31, above, and there being no *de minimus* rule. However, given the nature of the relevant market for the goods/services (broadly speaking, haircare products and retail of the same) I do not consider total sales figures of around £250 to be “justified in the economic sector concerned”.²² This is supported by evidence filed by Capello which shows the market value of haircare goods in Great Britain to have exceeded £1.25 billion each year between 2009 and 2022, and the UK market size of hairdressing and beauty treatment services to have been £4.3 billion in the five years leading to 2023/24.²³ I do not consider the minimal use in this case to qualify as genuine use.

47. The evidence needs to be sufficiently solid for me to be able to build a picture of what was happening during the relevant period. Whilst the evidence indicates that HRL has a business, whether its second earlier mark has been used throughout the relevant period in relation to that business and for what goods/services, is not clear.

²² *easyGroup*, cited above.

²³ VME80 and 85.

Other than four invoices for goods sold in three countries over a three year period, there are no sales figures and no dated evidence of the mark in use in the relevant period. Considering the factors to be borne in mind (those at paragraph 35, above), the evidence does not allow me to determine the scale, frequency, nature or geographical extent of the use of the relevant mark. If the mark had been used continuously throughout the relevant period, evidence would have been available to HRL to demonstrate such use, but it has not been provided.

48. It is for the proprietor to file its best evidence up front,²⁴ however, what has been filed is sparse and does not allow me to conclude with any certainty that there has been genuine use of the second earlier mark throughout the relevant period and for what goods/services.

Conclusion

49. Capello's application for revocation of HRL's second earlier mark on the ground of non-use succeeds under section 46(1)(a). Consequently, the trade mark is revoked in full, with an effective revocation date of 29 June 2022.

50. The effect of this revocation on the rest of these consolidated proceedings is that HRL's second earlier mark cannot be relied upon as an earlier mark in its third opposition, against Capello's third application. HRL's second earlier mark remains an earlier mark for the purpose of opposing Capello's first and second applications, as a result of their filing dates, being 12 June 2022 and 23 June 2022, respectively.

The invalidity

51. I shall deal next with the application for invalidation of HRL's first earlier mark: "HAIR REHAB".

²⁴ *Guccio Gucci SPA v Gerry Weber International AG*, BL O/424/14.

Statutory provisions

52. The relevant provisions of section 47 of the Act are as follows:

“(1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

53. The relevant provisions of section 3 of the Act are as follows:

“(1) The following shall not be registered –

[...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

54. The relevant date for determining the above grounds of invalidation is the date on which HRL’s first earlier mark was filed: 24 November 2017.

Evidence

55. Capello’s evidence contains dictionary definitions from Collins English Dictionary of the words: (i) ‘hair’, the meaning of which is obvious and not disputed; (ii) ‘rehab’ being “short for rehabilitation”; (iii) ‘rehabilitation’ meaning “the act or process of rehabilitating”; and (iv) ‘rehabilitate’ meaning “to restore to a former position or rank”.²⁵

56. Capello has evidenced decisions of the EUIPO, including its rejection of “HAIR REHAB” on grounds of non-distinctiveness and descriptiveness.²⁶ I have noted the contents of these decisions, though they are not binding on me.

57. Capello has provided evidence of use of the words HAIR REHAB as an alleged descriptor or in customary use by third parties in the hair and beauty industry. The examples dated before the relevant date are listed below.

²⁵ VME3. For the purposes of this decision, I have not included all definitions of the relevant words: a mark can fall within section 3(1)(c) even if it has more than one meaning (see *Starbucks*, cited at [63] of this decision).

²⁶ VME4-5.

- VME6 An article for 'allure' magazine dated 13 May 2008 titled "The Top Five **Hair Rehab** Products". The article contains the wording "my picks for the products that should be kept in your **hair rehab** kit". The products referred to in the article are third party products such as conditioner, oil serum and hair treatment.
- VME7 An article on the website 'Madhouse Family Reviews' dated 21 June 2012 reviewing a third party product, Osmo Berber hair oil. The article contains the wording "describe it as **hair rehab** and promise it will restore hair to pristine condition".
- VME9 An article on the website 'Memoirs & Musings' dated 16 December 2016 reviewing a third party's products, TIGI Bed Head Resurrection shampoo and conditioner. The article is titled "**HAIR REHAB** WITH TIGI – REVIEW" and contains the wording "Musings: **hair rehab**" and "[my hair] is dry, therefore it needs the moisture resurrection rehab to give it life".
- VME13 A screenshot of the website 'mankind' dated 6 May 2016, taken from the internet archive 'Way Back Machine'. The screenshot shows a description of a third party shampoo, L'Oréal Serie Expert Absolut Repair Shampoo which includes the wording "**hair-rehab** starts here".
- VME26 An article in the Glasgow Times dated 13 August 2008 and titled "STYLE: **Hair rehab**" and contains the wording "Time to check in to summer **hair rehab**".
- VME27 An article in the Chronicle Live dated 18 January 2009 (and updated on 27 February 2013), containing the wording "**HAIR REHAB** [...] give your hair the equivalent of a workout with a detox".
- VME28 An article in 'British Vogue' magazine relating to the celebrity Poppy Delevingne dated 30 January 2009. In the article, Poppy Delevingne is quoted as saying "I use Head&Shoulders Damage Rescue shampoo and conditioner – my stylist [...] calls it '**hair rehab** in a bottle'".

- VME29 An article in 'Glamour UK' magazine dated 21 October 2010 and titled "Celebrity **Hair Rehab**". The article begins "When hair is misbehaving, there's only one thing for it: **hair rehab**. These celebs have clearly sent their wayward locks to rehab to mend their bad hair day ways". The article provides several examples of celebrity hairstyles and gives examples of various hair products to use to achieve the celebrity look: it calls these products "At home rehab".
- VME30 An article on the website 'this is mothership' dated 12 October 2017 and titled "the winter hair switch up". The article describes an experience at a London hair salon and includes the wording "so we checked in for some **Hair Rehab**".
- VME31 An article in 'West London Living' magazine dated 28 September 2011 and titled "John Carne Cut/Colour and Holiday Treatment". The article describes an experience at a London hair salon and includes the wording "I was escorted down to the treatment room [...] for my Holiday **Hair Rehab** treatment".
- VME32 An article in the Evening Standard dated 31 July 2015 and titled "The best treatments for dry and damaged hair". The article contains the wording "**Hair rehab**: here's our pick of the best treatments" and lists products such as hair oil, hair serum, moisturising masque and shampoo.
- VME33 An article in 'Cosmopolitan' magazine dated 15 February 2012 and titled "Check your **hair** into **rehab**". The article refers to a third party's range of hair products: John Frieda Full Repair.
- VME34 An article in the Mail Online dated 28 August 2017 and titled "[...] How to rescue your **hair** with a **rehab** remedy". The article begins "[...] HOW TO DO IT: **HAIR REHAB**" and proceeds to list various different hair 'masques'.

VME37 An article from the online blog ‘Eltoria’ dated 18 October 2015 and titled “Why is argan oil good for your hair?”. The article relates to the user’s use of a third party argan oil ‘miracle oil’ and contains the wording “I was able to kick start my **hair rehab** mission”.

58. The above examples demonstrate 14 instances between 2008 and 2017 in which the words HAIR REHAB were used descriptively by third parties (professionals, the media and the general public) in the context of haircare, in regard to hair products and services provided in hair salons.

59. Capello has provided a further 26 articles showing the use of HAIR REHAB in the same manner as above, the majority of which are dated between 2017 and 2022.²⁷ Whilst this evidence falls after the relevant date, it does shed light backwards and provides support for Capello’s argument that HAIR REHAB was, and still is, used in a descriptive way in the hair industry.²⁸

60. Some of Capello’s exhibits also demonstrate use of the word REHAB in similar contexts, i.e. ‘scalp rehab’ and ‘lash/brow rehab’,²⁹ as well as use of HAIR REHAB in relation to publications in the field of haircare.³⁰ Further, there are eight examples, dated between 2010 and 2022 (and a further eight undated), of use of the word REHAB, solus, in relation to various hair and beauty products.³¹ Finally, there are stills of videos from YouTube, TikTok and Instagram in which the title or description of the videos contains HAIR REHAB in relation to the creator’s recommended hair products and hair styling techniques. Whilst some of these videos are dated prior to the relevant date in 2017, the majority are either undated or dated after the relevant date. I do not consider it necessary to expand upon the examples listed in this paragraph.

²⁷ VME8, 10-12, 14-25, 35, 36 and 38-44.

²⁸ Evidence dated after the relevant date may also be relevant where it indicates that the mark can become descriptive in the future, as per the comments of Simon Clark, sitting as the Appointed Person in BL O/0235/25 at [32]-[34].

²⁹ VME45-47.

³⁰ VME48-50. VME49 is undated.

³¹ VME51.

61. This concludes my summary of Capello's evidence for the purposes of the invalidity. Whilst HRL have filed evidence and pleaded an acquired distinctiveness, I will return to this point later in my decision.

Section 3(1)(c)

Relevant case law

62. At paragraph 55 of *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)*,³² the Court of Justice of the European Union ("CJEU") described section 3(1)(c) as requiring "that all signs or indications which may serve to designate characteristics of the goods or services in respect of which registration is sought remain freely available to all undertakings in order that they may use them when describing the same characteristics of their own goods."

63. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

"91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

"33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004]

³² [2004] E.T.M.R. 57, Case C-363/99.

ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. [...] due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of

no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (*Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779*, paragraph 35, and *Case C-363/99 Koninklijke KPN Nederland [2004] ECR I-1619*, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as

a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]."

64. In *Affinity Leasing Limited v Total Motion Limited*, Mr Daniel Alexander QC observed:³³

“38. Under section 3(1)(c), the case law both from the EU courts and from the Court of Appeal has emphasized that section 3(1)(c) (or its equivalents) only come into play where the average consumer would, at the relevant date, have immediately perceived without thought or explanation that the mark in question designated a characteristic of the goods or services for which the mark was registered (see *JW Spear & Sons v. Zynga Inc.* [2015] EWCA Civ 290 at [73]-[83] and cases there referred to). The cases also show that it is not necessary to demonstrate that the term exactly designates any of the goods or services specifically itself: designation of a characteristic of such services will suffice, including, importantly, ancillary characteristics that the goods or services may reasonably be expected to have (see e.g. Case C-363/99 *Koninklijke KPN Nederland NV v. Benelux Merkenbureau* [2004] ECR I-1619).

39. Second, the case law under both sub-sections [sections 3(1)(b) and (c)] and the language of 3(1)(c) itself places some emphasis on avoiding registration not only of marks or signs which are already in use by others to describe the goods or services in issue but also those which may reasonably be adopted by others in future to describe their goods or services having regard to the meaning of those terms.”

Pleadings

65. Capello claims “HAIR REHAB” offends section 3(1)(c) for the following reasons (reproduced as written):

“(8) It is well known that the term “REHAB” is the action or process of rehabilitating; as per the dictionary definitions of same. It is further known that the term “rehabilitate” is defined as “*to restore to a former capacity*”; as per standard dictionary definitions.

³³ Case BL O/522/20.

(9) The term “Hair” can also be defined as “*a slender threadlike outgrowth of the epidermis of an animal*”. It will also be noted that the term “hair” carries no distinctive character in connection with those goods and services relating to haircare to which the Contested Registration relates.

(10) The Contested Mark when viewed as a whole describes at least the intended purpose of the goods and services to which the Contested Registration is registered; namely to restore one’s hair/hair style, for example, by restoring dry/damaged hair with the class 3 goods such as shampoos, conditioners and oils, serums etc. or styling the hair with the Class 3, 8, 11, 21 and 26 goods and that the class 35 services are sale of such goods and the class 41 services the teaching in how to perform hair rehabilitation etc.

(11) Taken as a whole, the Contested Mark immediately informs consumers without further reflection that the goods to which the Contested Registration covers for are use in and/or for hair rehabilitating treatment(s), and that the services to which the Contested Registration covers are the sale of these goods and the teaching in how to perform hair rehabilitation and hair rehabilitation treatments. Therefore, it is clear that the Contested Mark conveys obvious and direct information regarding intended purpose and subject matter of the goods and services for which registration was sought i.e. that the goods and services will rehabilitate ones hair/hairstyle to a former state/capacity.

(12) The Contested Mark and the term “Rehab” is currently, and has been since prior to the filing date of the Contested Registration, in widespread use in connection with haircare products and the use of such products and in connection with haircare more generally. The specific term “Hair Rehab” has be (sic) utilised in third party publication, such as beauty and lifestyle magazines prior to and after the filing date of the Contested Registration in connection with haircare, hair health and haircare products and also used directly relating to hair rehabilitation to obtain and achieve “healthy hair”.

66. HRL denies Capello’s claims and submits (reproduced as written):

“10. The Contested Mark is registered for Hair Extensions in class 35. Hair extensions cannot be said to restore the state of one’s hair to a ‘*former capacity*’ nor that they rehabilitate the hair; they act as superficial visual improvement on existing hair. Conversely, the adhesive required for hair extensions can cause a detriment to one’s natural hair. As such, they are in no way returning hair to a previous state.

11. Other hair styling tools such as ‘Hot air hair brushes’ and ‘Electric irons’ are known for its (sic) use of high heat which can also cause a detriment to hair and does not operate in a way which is rehabilitating to hair. These items are used on the styling and beautification of hair, not rehabilitation.

12. In general, the Registered Proprietor’s goods and services as protected by the Contested Mark are to enhance to look and style of a consumer’s hair by adding products to their current hair.

[...]

15. [...] the Contested Mark is neither descriptive or devoid of distinctive character as the combination of the terms HAIR and REHAB are an unusual combination that is not in common parlance or in widespread use as claimed.”

Assessment

67. There is no dispute between the parties as to the definition of HAIR, nor to the definition of REHAB, though HRL say the “usual meaning” of REHAB is in relation to “treatment for drink or drug addiction”, a point I will return to. The parties are not, however, in agreement as to whether the combination of these words is descriptive for the goods and services in the registration, which are listed below:

Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving*

preparations; Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesive removers; Glue removers.

Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*

Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*

Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*

Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Hair extensions; Wigs; False hairpieces.*

Class 35: *Retail services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair*

rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces; Wholesale services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces.

Class 41: *Hairdressing instruction; Educational instruction; Educational consultancy; Teaching of beauty skills; Educational services relating to beauty therapy.*

68. According to Capello, HAIR REHAB tells the public that the purpose of the goods and services is to restore the user's hair or hairstyle to its former capacity. At the hearing, Ms Messenger clarified HRL's position: that HAIR REHAB does have a meaning and that consumers will perceive 'hair rehab' as referring to the rehabilitation or repair of damaged hair, which would be descriptive of a characteristic of goods which are therapeutic or medicinal to the hair. However, HRL denies that any of the goods/services in its registration are therapeutic or medicinal: they are primarily cosmetic and stylistic. For this reason, HAIR REHAB cannot be descriptive of those

goods/services. HRL went further and highlighted goods and services which it claims do the opposite of repairing hair, i.e. electric hair styling tools in Class 8, for example.

69. When deciding whether the mark is descriptive, I must consider the perspective of the average consumer which, for the relevant goods/services will either be a member of the general public or a professional in the hair and beauty industry.

70. Put simply, the meanings of HAIR and REHAB individually will, in my view, be immediately recognised by the average consumer. That REHAB is commonly used in respect of recovering from addiction (or, from my own knowledge, also injury) does not prevent it from meaning to rehabilitate something else. The dictionary definition, which I have no doubt will be understood by the average consumer, limits REHAB neither to addiction, nor to anything else. There is no reason why, in the ordinary use of the English language, the subject of rehabilitation could not be hair. In fact, the mere presence of the word HAIR preceding the word REHAB clearly qualifies that word so that even if REHAB solus was not immediately recognised as referring to hair and beauty goods/services, the inclusion of HAIR in the mark portrays the message that the intended purpose of the goods/services is to rehabilitate hair.

71. I bear in mind that combining multiple descriptive elements may not always result in a descriptive mark: where the combination is unusual and creates an impression sufficiently far removed from the individual meanings, for example.³⁴ However, I do not consider that the words HAIR REHAB create such an unusual combination that its meaning is so far removed from the meanings of the individual elements that it ceases to be descriptive. The combination of the two descriptive words is not odd or unusual; on the contrary, used on certain goods/services relating to hair, HAIR qualifies REHAB and indicates 'rehabilitation for hair'. I have no doubt that this longer term 'rehabilitation for hair' would be descriptive of a characteristic of hair products or services for rehabilitating hair. In my view, HAIR REHAB is a concise way of conveying the message 'rehabilitation for hair' and despite being a shortening of a more clearly descriptive message, remains descriptive from the perspective of the average consumer. Capello's evidence, assessed at paragraphs 55 to 61, supports my view

³⁴ *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00.

and demonstrates that HAIR REHAB is used not in a trade mark sense, but as a way to describe the effects of certain goods or services in relation to haircare.

72. In my view, HAIR REHAB designates the intended purpose (and effect) of goods/services used for restoring hair or improving the condition or appearance of hair. This includes products that are applied to the hair and appliances/tools that are used for styling hair. Whilst I note HRL's argument in terms of the accuracy of the description in relation to certain goods or services that are perceived to be damaging to hair, or those that offer only a superficial improvement to hair, whether the goods/services actually return the hair to a good condition is not relevant. The test for descriptiveness is whether the average consumer would, at the relevant date, immediately perceive without thought or explanation that the mark designates a characteristic (including an ancillary characteristic) of the goods/services.³⁵ In my view, the average consumer will not proceed to decide whether the goods/services (i) are truly beneficial to the hair, (ii) provide only a superficial improvement to the hair, or (iii) are detrimental to the hair. On the contrary, consumers will see HAIR REHAB and immediately assume it has a descriptive nature for a characteristic of goods/services relating to haircare.

73. When assessing the registrability of the mark, it is necessary to analyse carefully each of the goods/services; care must be taken to ensure that, when grouping goods/services together, all members of each group share the same characteristics.³⁶ I also have in mind the relevant questions for determining whether a mark is descriptive in relation to specific goods, as set out by the Advocate General in *DOUBLEMINT*³⁷ (and approved by the Court of Appeal in *J.W. Spear v Zynga*³⁸):

“(i) how factual and objective is the relationship between an indication and the product or one of its characteristics? (ii) how readily is the message of the indication conveyed? And (iii) how significant or central to the product is the characteristic? Asking these questions will assist a fact-finding tribunal to

³⁵ *Affinity Leasing*, cited above.

³⁶ Dr. Brian Whitehead, as the Appointed Person in BL O/0301/25 at [37].

³⁷ [2003] ECR I-12447 at [61]-[64].

³⁸ [2015] FSR 19.

determine whether it is likely that a particular indication may be used in trade to designate a characteristic of goods.”

74. Having regard to the above questions, my finding of descriptiveness extends to the following goods on the basis that (i) the relationship between ‘HAIR REHAB’ and the purpose of the goods is objective in the sense that it has, in my view, been proven by Capello’s evidence; (ii) the message conveyed by the words ‘HAIR REHAB’, given their ordinary dictionary meanings, will be easily conveyed to consumers; and (iii) whilst the purpose at issue here (to restore or improve the condition or appearance of the user’s hair) is not necessarily the core purpose of the goods, even where the goods have a different, primary purpose – i.e. shampoo washes the hair, hair dryers dry the hair and combs detangle the hair – they all have the ancillary, or additional, purpose of restoring or improving the condition or appearance of the hair. Taking all of this into account, my descriptiveness finding relates to the following goods:

Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair colouring preparations; Eyelashes (False -); Artificial eyelashes.*

Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*

Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*

Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*

75. In my view, HAIR REHAB cannot be said to directly describe the purpose of hair accessories, or hair extension products, which is usually to style the hair in a particular way, sometimes with the added function of keeping the hair out of the user’s face. Restoring or improving the condition or appearance of the hair itself, is not a

characteristic of these goods. Therefore, HAIR REHAB is not descriptive for the following goods:

Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Hair extensions; Wigs; False hairpieces.*

76. I further consider that the descriptiveness finding does not extend to glue or glue remover products: whilst these are used on or with hair products, it is not the glue or glue remover itself that improves the condition or appearance of hair. HAIR REHAB is not descriptive for the following goods:

Class 3: *Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Eyelashes (Adhesives for affixing false -); Adhesive removers; Glue removers.*

77. The descriptiveness finding also does not apply to retail and wholesale services, even where those services relate to goods that I have found to be objectionable. HAIR REHAB does not describe the purpose, or any other characteristic, of retail or wholesale services and so the basis of my descriptiveness finding cannot extend to the following:

Class 35: *Retail services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash*

separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces; Wholesale services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces.

78. The descriptiveness objection is also hard to sustain in relation to the Class 41 services, which are instructional/educational in nature. I have found HAIR REHAB to be descriptive for goods which have the purpose of improving the condition or appearance of hair. Even the Class 41 services related to hairdressing have the core purpose of teaching others in the field of hairdressing, rather than directly handling hair. As such, my finding of descriptiveness cannot extend to the following services:

Class 41: *Hairdressing instruction; Educational instruction; Educational consultancy; Teaching of beauty skills; Educational services relating to beauty therapy.*

79. The final term for me to consider is *beauty care preparations* in Class 3. Beauty care is a broad term referring to the maintenance/enhancement of one's general appearance, be it their skin, hair, body or nails, for example. On this basis, the term could include haircare goods used for the purpose of improving the condition or appearance of hair. As such, HAIR REHAB is objectionable in relation to *beauty care preparations*.

80. That concludes my assessment under section 3(1)(c). "HAIR REHAB" is descriptive, and therefore objectionable, in relation to the following goods:

Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes.*

Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*

Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*

Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*

81. For the avoidance of doubt, goods for use on eyelashes are included in the objectionable goods under section 3(1)(c) on the basis that eyelashes are a type of hair: a fact obvious to the average consumer. In my view, it is not appropriate to artificially restrict the meaning of 'hair' to head hair, especially given there are goods in the specification for improving the appearance of eyelashes: the basis of my

descriptiveness finding. Even if HRL's argument that consumers more regularly use the word 'hair' to refer to the hair on their head is correct, that does not preclude a finding that 'hair' could reasonably include a reference to any type of hair on a person's body. In my view, consumers will see HAIR REHAB as descriptive for goods used in relation to types of hair other than head hair.

82. As a final remark, I note Ms Messenger's criticism of Capello's evidence not demonstrating examples of HAIR REHAB used on all the goods/services. I do not find this to be determinative in the present case: my view is that the words in the mark have a clear meaning in relation to those goods I have found objectionable and any additional, relevant evidence would have been only confirmatory of the position as assessed from the dictionary definition of the words.³⁹

Section 3(1)(b)

Relevant case law

83. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

"29 [...] the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

³⁹ As per Arnold J in *Starbucks*, cited above. See also the comments of Dr. Brian Whitehead, sitting as the Appointed Person in BL O/0301/25 at [18].

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

Pleadings

84. Capello claims "HAIR REHAB" offends section 3(1)(b) for the following reasons:

“(18) Signs that are commonly used in connection with the marketing of the goods and services are to be considered devoid of distinctive character for those goods and services. In this context, there is widespread use of the term “HAIR REHAB” and widespread use of the terms “HAIR” and “REHAB” separately throughout the United Kingdom such that the term “HAIR REHAB” is commonly used within the relevant market and thus is to be considered devoid of distinctive character for those goods and services for which the Contested Registration is/was registered.”

85. HRL denies Capello’s claims and submits:

“15. [...] the Contested Mark is neither descriptive or (sic) devoid of distinctive character as the combination of the terms HAIR and REHAB are an unusual combination that is not in common parlance or in widespread use as claimed.

16. In the alternative, if it is to be determined that the Contested Mark is devoid of distinctive character, acquired distinctiveness can be proven thus eradicating any potential for the Contested Mark to be cancelled in relation to the goods and services it is registered for.”

86. Paragraph 86 of *Postkantoor* confirms that if a mark is objectionable under section 3(1)(c), it is also objectionable under section 3(1)(b). The section 3(1)(b) ground of invalidation therefore succeeds in relation to the goods listed at my paragraph 80. If I am wrong that those goods are objectionable under section 3(1)(c), I find that they are nevertheless objectionable under section 3(1)(b) for the reasons set out below.

87. Even if HAIR REHAB is not perceived as directly descriptive for the goods listed at paragraph 80, consumers would nevertheless perceive it as an origin-neutral term serving only to promote hair-related goods by emphasising that such goods have the effect of restoring/improving the condition or appearance of the hair. Capello’s evidence also supports its claim that HAIR REHAB is used as a marketing slogan/promotional message. As such, consumers would not perceive the mark as

distinguishing the goods as being those of a particular undertaking.⁴⁰ The section 3(1)(b) ground succeeds in relation to the goods listed at paragraph 80.

88. I turn now to the remainder of the specification (which I found not to fall foul of section 3(1)(c)):

Class 3: *Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Eyelashes (Adhesives for affixing false -); Adhesive removers; Glue removers.*

Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Hair extensions; Wigs; False hairpieces.*

Class 35: *Retail services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair*

⁴⁰ In the same way that the Appointed Person held that WE CREATE SPACE was origin neutral in the decision published at BL O/342/10.

wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces; Wholesale services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces.

Class 41: *Hairdressing instruction; Educational instruction; Educational consultancy; Teaching of beauty skills; Educational services relating to beauty therapy.*

89. The relationship between HAIR REHAB and the majority of the goods/services listed above is sufficiently close for the same finding to apply. Even for goods/services for which I have found HAIR REHAB not to be directly descriptive, the mark will be seen simply as a marketing slogan with the intention of promoting to consumers goods/services related to goods for improving the condition or appearance of hair. Such goods/services are not so far removed from the objectionable goods that HAIR REHAB becomes a sign that is capable of indicating trade origin. The fact that there is no evidence of HAIR REHAB used on or in relation to these goods/services is not a

barrier to a finding of non-distinctiveness under section 3(1)(b). Capello has filed sufficient evidence to support its claim that HAIR REHAB is used in connection with the marketing of particular haircare goods and I find it reasonable to conclude that the relevant public's perception will be the same in relation to the other categories of goods/services in the specification. This, however, does not apply to the terms *educational instruction* and *education consultancy*: the relationship between the mark and these services is too remote. Even where these broad terms could include educational services relating to hairdressing, for example, the link is too tenuous for me to be satisfied that HAIR REHAB used in relation to such services would be incapable of indicating trade origin.

90. I therefore uphold the section 3(1)(b) ground in relation to all the goods/services in HRL's first earlier mark's registration, save for *educational instruction* and *education consultancy*.

Section 3(1)(d)

Relevant case law

91. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*, Case T-322/03, the General Court ("GC") summarised the case law of the CJEU under the equivalent of s.3(1)(d) of the Act, as follows:

"49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly

refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (BSS, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (BSS, paragraph 38). Page 33 of 45

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, Merz & Krell, paragraph 35, and BSS, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, Merz & Krell, paragraph 37, and BSS, paragraph 40)."

Pleadings

92. Capello claims "HAIR REHAB" offends section 3(1)(d) for the following reasons:⁴¹

"(22) Furthermore, or in the alternative, the Contested Mark consists exclusively of a sign or indication which at the time of filing had become customary in the current language or in the bona fide and established practices of the trade at least in connection to haircare products and treatments [...]"

⁴¹ Capello's statement of grounds.

(23) At the time of filing the Contested Registration the term “HAIR REHAB” had already been in widespread use to describe haircare and associated products and treatments by a number of various parties other than the Registered Proprietor.”

93. HRL denies Capello’s claims and submits:⁴²

“32. In accordance with the decision found in Case 383/99 BABY-DRY which discussed the registration of trade marks that consist of combinations of descriptive terms, it was found that “any perceptible difference” between descriptive terms as they are commonly used and as they appeared in the trade mark application is sufficient to satisfy the criterion of distinctiveness, even if only the composition created unusual juxtaposition (e.g. BABY-DRY instead of “dry baby”). As such, even if were common to use that the phrase “to rehab your hair” which is disputable, the Contested Mark is an unusual juxtaposition as found in the above case and therefore is a valid registered trade mark.

33. The Cancellation Applicant has not provided any evidence of the term HAIR REHAB being used in a “customary way”. The Registered Proprietor puts the Cancellation Applicant to proof of this allegation/claim.”

And, in response to Capello’s evidence:⁴³

“36. Again, Capello’s case is fundamentally flawed as a result of it failing to address the goods and services actually protected by the registration. In the evidence provided by Ms Ellis there are no examples of HAIR REHAB being used except in relation to specific restorative products that can be applied to the hair. As such, Capello has provided no evidence in support of its case on section 3(1)(d) in relation to all of the class 8, 11, 21, 26, 25 and 41 goods and services and the cancellation pursuant to section 3(1)(d) must therefore fail as against these parts of the specification.

⁴² HRL’s defence and counterstatement.

⁴³ HRL’s skeleton argument, filed ahead of the hearing.

37. In respect of the class 3 goods, no evidence has been provided of the use of HAIR REHAB in respect of the following parts of the specification [...] As such, the cancellation pursuant to section 3(1)(d) must fail as against these parts of the specification.

38. In respect of the following class 3 goods: *Hair sprays; shampoo; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair care preparations*, although Ms Ellis has been able to find some examples of products falling within these generalised categories being identifies as useable for Hair Rehab, the phrase HAIR REHAB is being used to describe the process or goal of their use not the products themselves. Insofar as the phrase has become customary, it has become customary as a short-hand way of referring to processes which treat damaged hair rather than to designate any particular goods. Furthermore, insofar as the evidence shows HAIR REHAB as designating goods at all, which we submit it does not, the evidence only refers to specific products not to categories of products more generally.” (My emphasis)

Assessment

94. Firstly, I will briefly address HRL’s reliance on the *BABYDRY* case, which I do not consider to be persuasive. In my view, HAIR REHAB is not an unusual juxtaposition. On the contrary, as explained in paragraph 70, HAIR qualifies REHAB and so the placement of these words seems to me entirely usual.

95. Secondly, I turn to the submission underlined at paragraph 93 above, taken from Ms Messenger’s skeleton argument. Whilst the submission could be read as an acceptance that HAIR REHAB has become a customary reference to processes which treat damaged hair, it was clearly made with the intention of denying the 3(1)(d) ground. Whilst it seems logical to me that a phrase which is customary for processes which treat damaged hair is also customary for the goods used in the process of treating damaged hair, I am not prepared to make such a conclusion on the basis of HRL’s submission. Further, the submission was not raised or expanded upon at the

hearing. I will say no more about this submission and proceed to decide the 3(1)(d) ground.

96. The enquiry under section 3(1)(d) is not whether the mark is descriptive of a characteristic of the goods/services, although that could also apply to mark which falls foul of section 3(1)(d). It is whether the mark was customary in the current language or was customary in the bona fide and established practice of the trade in the UK at the date of application. Proving this requires the filing of evidence of fact supporting the claim that it was customary for other traders to use HAIR REHAB at the relevant date, but not in a trade mark sense.⁴⁴ There is a relatively high evidential bar: in *Affinity Leasing* (cited above), Mr Daniel Alexander QC concluded that the overall message was that section 3(1)(d) “requires specific evidence that it is specifically customary”.⁴⁵ Mr Alexander also observed at paragraph 12 of this decision that section 3(1)(c) “does not require the same degree of proof that the term has in (sic) been used in the specific descriptive way”.

97. I need to make the assessment taking into account the expectation of relevant average consumers in deciding whether at the date of the application the mark had become customary. In *Stash Ltd v Samurai Sportswear Ltd*,⁴⁶ Professor Ruth Annand, sitting as the Appointed Person, took “customary” (in the language) to mean “usual; in accordance with custom”.

98. Whilst there are examples of use in the market (see the evidence summary at paragraphs 55-61), I am not satisfied that 14 instances of use prior to the relevant date is an ample number of examples to demonstrate that use of the words HAIR REHAB is “usual” either in the current language or in the bona fide and established practice of the trade. Capello’s evidence does not meet the high bar and so the section 3(1)(d) ground fails.

⁴⁴ *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch.

⁴⁵ At [22].

⁴⁶ BL O/281/04.

Acquired distinctiveness

99. HRL has filed evidence of the use it has made of HAIR REHAB. The proviso to section 3(1) of the Act provides that marks which are *prima facie* objectionable under sections 3(1)(b), (c) or (d) shall be accepted “if, before the date of application for registration, [the mark] had in fact acquired a distinctive character as a result of the use made of it”. The CJEU provided guidance in *Windsurfing Chiemsee*, Joined cases C-108 & C-109/97, about the correct approach with regard to the assessment of the acquisition of distinctive character through use. The guidance is as follows:

“51. In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account: 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 class of persons who, because of the mark, identify goods as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations.

52. If, on the basis of those factors, the competent authority finds that the relevant class of persons, or at least a significant proportion thereof, identify goods as originating from a particular undertaking because of the trade mark, it must hold that the requirement for registering the mark laid down in Article 3(3) of the Directive is satisfied. However, the circumstances in which that requirement may be regarded as satisfied cannot be shown to exist solely by reference to general, abstract data such as predetermined percentages.

53. As regards the method to be used to assess the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude the competent authority, where it has particular difficulty in that connection, from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment (see, to that effect, Case C-210/96 *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 37).”

100. It is clear from *Oberbank AG & Banco Santander SA and Another v Deutscher Sparkassen- und Giroverband eV* (Joined cases C-217 and 218/13), that the burden of establishing acquired distinctiveness in these circumstances rests on the proprietor of the mark. The relevant part of the court's judgment is as follows:

"66. As to the substance, it is true that recital 6 in the preamble to Directive 2008/95 states, *inter alia*, that Member States should remain free to fix the procedural provisions concerning the invalidity of trade marks acquired by registration and determine, for example, the form of invalidity procedures. However, it cannot be inferred that the question of the burden of proof concerning distinctive character acquired through use in the context of invalidity proceedings pursuant to Article 3(1)(b), (c) or (d) of Directive 2008/95 constitutes such a procedural provision falling within the competence of Member States.

67. If the question of the burden of proof concerning distinctive character acquired by use which has been made of a mark in the context of invalidity proceedings were a matter for the national law of the Member States, the consequence for proprietors of trade marks could be that protection would vary according to the legal system concerned, with the result that the objective of 'the same protection under the legal systems of all the Member States' set out in recital 10 in the preamble to Directive 2008/95, where it is described as 'fundamental', would not be attained (see, by analogy, Case C-405/03 *Class International* EU:C:2005:616, paragraph 73 and the case-law cited, and Case C-479/12 *H. Gautzsch Großhandel* EU:C:2014:75, paragraph 40).

68. In view of that objective and the structure and purpose of Article 3(3) of Directive 2008/95, the Court finds that, in the context of invalidity proceedings, the burden of proof concerning distinctive character acquired following the use which has been made of the mark at issue must be borne by the proprietor of that mark which invokes that distinctive character.

69. First, in the same way that distinctive character acquired following the use which is made of a mark is, in proceedings for registration, an exception to the

grounds for refusal listed in Article 3(1)(b), (c) or (d) of Directive 2008/95 (see, to that effect, Case C-108/05 *Bovemij Verzekeringen* EU:C:2006:530, paragraph 21), distinctive character acquired following the use which is made of a mark is, in the context of invalidity proceedings, an exception to the grounds for invalidity listed in Article 3(1)(b), (c) or (d). Since it is an exception, the onus is on the party seeking to rely on it to justify its application.

70. Second, the Court finds that it is the proprietor of the mark at issue which is best placed to adduce evidence in support of the assertion that its mark has acquired a distinctive character following the use which has been made of it. The same applies, in particular, to evidence capable of establishing such use, in respect of which the case-law cited in paragraphs 40 and 41 above contains a list of examples, such as evidence relating to how intensive, widespread and long-standing use of the mark has been and the amount invested in promoting it.

71. Consequently, where the proprietor of the mark at issue is requested by the competent authority to adduce proof of distinctive character acquired following the use which has been made of a mark which is intrinsically devoid of distinctive character but fails to do so, that mark must be declared invalid.”

101. I begin by reminding myself that the relevant date is 24 November 2017 and that HRL must have acquired distinctive character prior to that date. The factors to consider when assessing the evidence include those listed in paragraph 51 of the *Windsurfing Chiemsee* case referred to above.

102. Turning to the evidence, the vast majority is either undated or dated after the relevant date. There are a small number of exhibits dated prior to the relevant date: reference to HRL founder, Lauren Pope, appearing on British TV show ‘Tycoon’ in 2007;⁴⁷ an article dated February 2016 referring to HRL goods being sold in the retail store, Superdrug;⁴⁸ and two social media posts in December 2014 also referring to

⁴⁷ HR1.

⁴⁸ HR1.

the goods' availability in Superdrug.⁴⁹ However, there are no sales figures and no figures relating to the market share held by the mark. Of the 13 invoices that do demonstrate sales, none are dated prior to the relevant date. The figures relating to the amount invested in promoting the mark are from 2017 onwards; HR9 sets out the promotional spend and shows a spend of just over £60,000 for the years 2017/2018, beginning February 2017: a proportion of this would relate to the 10 months leading up to the relevant date. The remainder of HRL's evidence of use of HAIR REHAB is subject to the criticisms I have made earlier in this decision, in relation to the revocation. Overall, the evidence is wholly insufficient to demonstrate that the mark has acquired a distinctive character prior to 24 November 2017.

103. The acquired distinctiveness proviso to section 3(1) does not apply and the mark remains invalid for the goods/services set out in the relevant sections of this decision.

Invalidity conclusion

104. Capello's application for invalidation of HRL's first earlier mark succeeds under section 3(1)(b) and/or 3(1)(c) for the following goods and services:

Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesive removers; Glue removers.*

Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*

⁴⁹ HR7.

- Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*
- Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*
- Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Hair extensions; Wigs; False hairpieces.*
- Class 35: *Retail services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces; Wholesale services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty*

care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces.

Class 41: *Hairdressing instruction; Teaching of beauty skills; Educational services relating to beauty therapy.*

105. HRL's first earlier mark will remain registered for the following services:

Class 41: *Educational instruction; Educational consultancy.*

106. The effect of this invalidation on the rest of these consolidated proceedings is that HRL's first earlier mark can only be relied upon as an earlier mark in its oppositions against Capello's applications in respect of the remaining services in its registration: *educational instruction and educational consultancy.*

The oppositions

107. I will now determine HRL's oppositions against Capello's applications.

108. As a preliminary point, I will briefly address the protection of HRL's first earlier mark, relied upon in all three oppositions. For the purpose of the oppositions, the mark is only registered in respect of *educational instruction* and *educational consultancy* in Class 41. The goods and services applied for by Capello are those in Classes 3, 21, 26 and 35, as set out in the background and pleadings section of this decision. Bearing

in mind the case law relevant to the comparison of goods and services (cited later in this decision),⁵⁰ it is clear to me that there is no similarity between the services in the specification of HRL's first earlier mark and any of the goods/services applied for by Capello. Where there is no similarity between goods/services, there can be no likelihood of confusion.⁵¹ As such, the oppositions based upon HRL's first earlier mark are bound to fail. I will proceed to determine the oppositions on the basis of the remaining earlier marks relevant to those oppositions.

The first opposition

109. The pleadings relevant to this opposition are set out earlier in my decision.

110. Based on my earlier findings, HRL can rely only on its second earlier mark for this opposition. Whilst the second earlier mark was revoked, the revocation date is 29 June 2022 and Capello's first application date is 12 June 2022, meaning the second earlier mark was, at the date of Capello's filing, an earlier valid mark in accordance with section 6 of the Act, which was not subject to proof of use in accordance with section 6A.

Section 5(2)(b)

111. Sections 5(2)(b) and 5A of the Act state:

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

[...]

(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,

⁵⁰ *Canon and British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281.

⁵¹ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

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

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.”

Relevant law

112. The following principles are gleaned from the decisions of the CJEU 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 C-3/03, *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.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

113. In *Gérard Meric v OHIM*, the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):⁵²

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur 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.”

114. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:⁵³

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

115. I find all of Capello’s goods to be identical to some of HRL’s goods, either due to their identical wording or in accordance with *Meric*. The identical terms are adjacent to one another in the following table:

Capello’s goods	HRL’s goods
<u>Class 3</u> <i>Hair oils</i> <i>Hair mascara</i>	<u>Class 3</u> <i>Hair oil</i> <i>Hair care preparations</i>

⁵² Case T-133/05.

⁵³ BL O/399/10.

<u>Class 21</u> <i>Hair combs</i> <i>Hair brushes</i>	<u>Class 21</u> <i>Combs</i> <i>Hairbrushes</i>
<u>Class 26</u> <i>Hair twisters [hair accessories]</i> <i>Hair curlers; Non-electric hair curlers;</i> <i>Curlers</i>	<u>Class 26</u> <i>Hair curlers; Hair rollers</i> <i>Hair curlers</i>

The average consumer and the purchasing act

116. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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*, [2014] EWHC 439 (Ch), 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

117. The average consumer for the goods will be a member of the general public or a professional in the hair and beauty industry. The goods will be subject to self-selection from the shelves of retail establishments such as supermarkets, hair salons or chemists, or their online or catalogue equivalents. Whilst visual factors are, consequently, likely to dominate the selection process, it would not be unusual for

consumers to make word-of-mouth recommendations, or for sales advisors to provide advice orally, so aural considerations cannot be ignored.

118. The goods are generally inexpensive items purchased fairly frequently. That said, consumers will be alive to factors such as ingredients (for Class 3 goods), suitability for certain hair types and aesthetics and usability of hair styling tools. The selection of hair care preparations and hair curlers, for example, may be more considered than the selection of a hairbrush or comb. Overall, either group of consumers is likely to pay a low to medium to degree of attention during the purchasing process.

Comparison of trade marks

119. It is clear from *Sabel* 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 the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU states at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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.”

120. It would be wrong, therefore, to dissect the trade marks artificially, 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 marks.

121. The marks to be compared are as follows:

Capello's first application	HRL's second earlier mark
REHAB.	

122. Mr Hill and Ms Messenger made submissions regarding the marks at the hearing. I have borne these in mind and will refer to them, where necessary, either in my assessment of the mark comparison, or in the overall likelihood of confusion assessment.

Overall impression

123. Capello's mark is the word REHAB followed by a full stop. The word REHAB is the dominant and distinctive element, with the full stop playing a lesser role in the overall impression.

124. HRL's mark is figurative, comprising the words HAIR, REHAB and the letters L, D, N, each textual component being positioned one on top of the other and positioned centrally within the outline of a square. All elements of the mark are presented in black, and all textual elements are in the same standard typeface. The words HAIR and REHAB are presented in a much heavier font-weight (almost emboldened) than the LDN element, which is noticeably thinner/lighter. This renders HAIR and REHAB more visually noticeable compared to LDN, given their font-weight and position in the mark. However, as I will come to discuss further, LDN is marginally more distinctive than HAIR and REHAB, and the fact that one verbal element has more visual impact will not prevent consumers from perceiving the other element as equally or more distinctive. Overall, the textual elements all play a fairly equal role in the overall impression, with the square outline playing a lesser, decorative role.

Visual comparison

125. Visually, the marks coincide in the word REHAB, which creates the similarity. All other elements of the respective marks differ. I find the marks to be visually similar to between a low and medium degree.

Aural comparison

126. Capello's mark will be pronounced as the ordinary word REHAB; the full stop will not be articulated.

127. In my view, HRL's mark will be pronounced as HAIR REHAB LONDON, on the basis that LDN will be recognised by the average consumer as shorthand for 'London'. Ms Messenger made this submission at the hearing, which was neither admitted nor denied by Mr Hill. Whilst no evidence has been filed on this point, it is an argument raised by one party to these proceedings and one which accords with my own understanding. I further consider that LDN being a recognised abbreviation of 'London' is a fact likely to be well known, i.e. by the average consumer in the UK.⁵⁴ The square outline will not be articulated.

128. The shared element REHAB creates aural similarity between the marks. The additional words in HRL's mark create the aural difference. I find the marks to be aurally similar to between a low and medium degree.

Conceptual comparison

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

⁵⁴ See the judgment of the General Court in *Ineos Healthcare v OHIM*, Case T-222/09 at [29].

130. Conceptually, both marks convey the message of rehabilitation, rehab being shorthand for rehabilitation. HRL's mark has the additional concepts of hair - which is not a particularly strong conceptual hook given the goods are haircare goods - and London, which will be viewed as the location of the business. Both marks used for the goods at issue will give the immediate indication to the average consumer that these are goods used for rehabilitation purposes. I therefore conclude that the marks are conceptually highly similar.

Distinctive character of the earlier trade mark

131. In *Lloyd Schuhfabrik Meyer* 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 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).”

132. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

133. I will assess the inherent position first. HRL's mark comprises four elements: the textual components HAIR, REHAB and LDN and the black square outline. The textual components all have a roughly equal degree of distinctiveness, which is very low; HAIR is descriptive for hair-related goods, REHAB is descriptive or allusive of the purpose of the goods and LDN is a common abbreviation for 'London', rendering it indicative of the location of the business. As I touched upon in the mark comparison, LDN is marginally more distinctive than HAIR and REHAB, on the basis that it is not the ordinary place name 'London' but is an abbreviation. The square outline is basic stylisation and adds very little to the distinctive character. Overall, I find HRL's mark to be inherently distinctive to a very low degree.

134. Turning now to whether the mark's distinctiveness has been enhanced through use, I remind myself of the evidence of use of HRL's second earlier mark, which was assessed earlier in this decision in relation to the revocation proceedings against the same mark. I summarised the evidence and concluded that it was insufficient to demonstrate genuine use. The same criticisms of the evidence apply here: there are no sales figures, no figures relating to market share and limited evidence going to the promotion of the mark. Much of the remaining evidence is undated and insufficient to demonstrate that use of the mark has been intensive, geographically widespread or long-standing. The distinctiveness of the mark has not been enhanced through use.

Likelihood of confusion

135. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser

degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

136. I have found the marks to be visually and aurally similar to between a low and medium degree and conceptually highly similar. I have found the earlier mark to possess a very low degree of inherent distinctive character. I found the goods to be identical. I have identified the average consumer to be either a member of the general public or a professional in the hair and beauty industry, both of whom would pay a low to medium degree of attention to a mainly visual purchase, though I do not discount the aural consideration.

137. When considering whether there is a likelihood of confusion, I bear in mind *L.A. Sugar Limited v By Back Beat Inc*, in which Iain Purvis QC said:⁵⁵

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

⁵⁵ BL O/375/10.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

138. The shared element REHAB is low in distinctive character and so I remind myself of various relevant cases. The first is *Kurt Geiger v A-List Corporate Limited*,⁵⁶ in which Mr Iain Purvis QC said that “if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all”. The second is *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,⁵⁷ in which Arnold J (as he then was) said “if the only similarity between the respective marks is a common elements which has low distinctiveness, that points against there being a likelihood of confusion”.⁵⁸ The third is *L’Oreal SA v OHIM*,⁵⁹ in which the CJEU considered the likelihood of confusion where marks have a low level of distinctiveness.⁶⁰

⁵⁶ BL O/075/13.

⁵⁷ [2015] EWHC 1271 (Ch).

⁵⁸ At paragraph [44].

⁵⁹ [2006] ECR I-57.

⁶⁰ The relevant paragraph being [45].

139. I bear these cases in mind, however, the comments of Emma Himsworth KC in *Face2FaceHR Partners Limited v Peninsula Business Services Limited*⁶¹ are particularly helpful and were addressed by Mr Hill and Ms Messenger at the hearing. Miss Himsworth summarised the correct approach when assessing the likelihood of confusion where the only common element between the marks in issue has no or low distinctiveness as follows:

“(1) The distinctiveness of the mark as a whole must be assessed, taking into account that a minimum degree of distinctiveness must be acknowledged.

(2) The distinctiveness of each of the components of both marks must be assessed with priority being given to the coinciding elements.

(3) The focus of the assessment of the likelihood of confusion should be on the impact of the non-coinciding components on the overall impression of the mark.

(4) Account must be taken of the similarities/differences in the non-coinciding elements of the marks.

(5) A coincidence of an element with a low level of distinctiveness will not usually lead to a likelihood of confusion.

(6) There may be a finding of a likelihood of confusion if (a) the non-coinciding elements of the mark are of lower (or equally low) degree of distinctiveness or are of insignificant visual impact and the overall impression is similar; or (b) the overall impression of the marks is highly similar or identical.”

140. Approaching the case before me in this manner, I take the view that there is a likelihood of confusion between the marks, for the following reasons. I have assessed the distinctiveness of the components of the marks and the marks as wholes and acknowledge a minimum degree of distinctiveness in each. The non-coinciding components are the full stop in Capello’s mark as well as the square outline and the

⁶¹ BL O/0368/23.

textual components HAIR and LDN in HRL's mark. As explained above, all of these elements are of low distinctiveness and, with the exception of LDN, have either a lower or equally low degree of distinctiveness to the coinciding element. Whilst the LDN component is marginally more distinctive than the other components, it is visually less significant. The overall impression of the marks, and the concept conveyed by each, is highly similar. I therefore consider this case to fall within point (6) above, i.e. "there may be a finding of a likelihood of confusion if...the overall impression of the marks is highly similar". This conclusion is further supported by my findings that the average consumer will pay a low to medium degree of attention to the purchase of identical goods. The low distinctiveness of the non-coinciding components persuades me that the average consumer could be directly confused. In addition, or in case I am wrong and the additional components are noticed, they are not sufficient to dispel any confusion as to origin.⁶² I also find there to be a likelihood of indirect confusion.

141. I will briefly address HRL's evidence going to the claimed instances of actual confusion. Actual confusion was considered in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, wherein Kitchen L.J. stated that:

"80. [...] If the mark and the sign have both been used and there has been actual confusion between them, this may be powerful evidence that their similarity is such that there exists a likelihood of confusion. [...]"

142. HRL's evidence raises several occasions on which consumers were said to have been confused between HRL and Capello.⁶³ Whilst I agree to a point that these instances may demonstrate actual confusion, what I cannot ascertain is precisely what the consumers saw and what caused their confusion. Both HRL and Capello have filed evidence containing several different marks. I therefore cannot say with any certainty that these scenarios in HRL's evidence are directly linked to any particular trade marks in these proceedings. As a result, even if I am wrong in my finding of a likelihood of confusion, these examples of alleged actual confusion would not disturb such a finding.

⁶² Similarly to the findings of Phillip Johnson, sitting as the Appointed Person in BL O/0331/23.

⁶³ Ms Pope's witness statement at [28]-[37] and exhibits HR14 to HR18.

Conclusion

143. The opposition under section 5(2)(b) has been successful in its entirety. Subject to any successful appeal, Capello's first application, under number 3798074, is refused.

Section 5(3)

144. Section 5(3) states:

“(3) A trade mark which-

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.”

145. 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'Oréal 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'Oréal 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'Oréal v Bellure*).

146. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge/reputation amongst a significant part of the relevant public. Thirdly, it must be established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by the contested mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

147. I can deal with this ground fairly swiftly. I have set out the opponent's claim under this ground at paragraph 5, above. As a reminder, HRL can no longer rely upon its first earlier mark for this opposition, which leaves only the second earlier mark to consider. I recall that I found HRL's evidence insufficient to establish that the distinctive character of its second earlier mark has been enhanced through use. The factors that were relevant in that assessment are also the ones that I must consider when deciding whether the earlier mark has a reputation and so the criticisms of HRL's evidence apply equally here. The evidence is simply not sufficient for me to make such a finding.

148. The section 5(3) ground of opposition is dismissed.

The second opposition

149. I will deal with this opposition briefly since many of the findings will be a repeat of the first opposition.

150. The pleadings relevant to this opposition are set out earlier in my decision.

151. Based on my earlier findings, HRL can rely only on its second and third earlier marks for this opposition. Whilst the second earlier mark was revoked, the revocation date is 29 June 2022 and Capello's second application date is 23 June 2022, meaning the second earlier mark was, at the date of Capello's filing, an earlier valid mark in accordance with section 6 of the Act, which was not subject to proof of use in accordance with section 6A.

152. I will proceed with this opposition on the basis of the second earlier mark and will return to address the third earlier mark if necessary.

Section 5(2)(b)

153. The relevant statutory provisions and case law are set out earlier in my decision.

Comparison of goods

154. I bear in mind the cases of *Meric* and *Separode*, cited above.

155. I find all of Capello's goods to be identical to some of HRL's goods, either due to their identical wording or in accordance with *Meric*. The identical terms are adjacent to one another in the following table:

Capello's goods	HRL's goods
<u>Class 3</u>	<u>Class 3</u>

<i>Hair oil; Hair oils; Oils for hair conditioning.</i> <i>Hair balm; Hair conditioners; Hair shampoos; Hair serums; Hair fixers.</i> <u>Class 21</u> <i>Hair brushes</i> <u>Class 26</u> <i>Hair twisters [hair accessories]</i> <i>Hair curlers; Non-electric hair curlers; Curlers.</i> <i>Hair scrunchies</i>	<i>Hair oil</i> <i>Hair care preparations</i> <u>Class 21</u> <i>Hairbrushes</i> <u>Class 26</u> <i>Hair curlers; Hair rollers</i> <i>Hair curlers</i> <i>Hairbands; Hair fasteners.</i>
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The average consumer and the purchasing act

156. My findings on this point in the first opposition are repeated here.

Comparison of trade marks

157. The marks to be compared are as follows:

Capello's second application	HRL's second earlier mark
	

Overall impression

158. Capello's mark comprises the word REHAB followed by a full stop and, underneath, the words YOUR HAIR. The word REHAB is the most visually dominant

component given its position and emboldened font, though the fact it has more visual impact will not prevent consumers from perceiving the other elements as equally distinctive. As such, all the textual elements play a roughly equally distinctive role, with the full stop playing a lesser role in the overall impression.

159. HRL's mark is figurative, comprising the words HAIR, REHAB and the letters L, D, N, each textual component being positioned one on top of the other and positioned centrally within the outline of a square. All elements of the mark are presented in black, and all textual elements are in the same standard typeface. The words HAIR and REHAB are presented in a much heavier font-weight (almost emboldened) than the LDN element, which is noticeably thinner/lighter. This renders HAIR and REHAB more visually noticeable compared to LDN, given their font-weight and position in the mark. However, as I will come to discuss further, LDN is marginally more distinctive than HAIR and REHAB, and the fact that one verbal element has more visual impact will not prevent consumers from perceiving the other element as equally or more distinctive. Overall, the textual elements all play a fairly equal role in the overall impression, with the square outline playing a lesser, decorative role.

Visual comparison

160. Visually, the marks coincide in the words REHAB and HAIR, which creates the similarity, though they are in different positions. All other elements of the respective marks differ. I find the marks to be visually similar to a medium degree.

Aural comparison

161. Capello's mark will be pronounced as the words REHAB YOUR HAIR, all in the ordinary way; the full stop will not be articulated.

162. In my view, HRL's mark will be pronounced as HAIR REHAB LONDON, on the basis that LDN will be recognised by the average consumer as shorthand for 'London'. My reasoning is explained in the first opposition.

163. The shared elements REHAB and HAIR create aural similarity between the marks, despite them being in different positions. The additional words in HRL's mark create the aural difference. I find the marks to be aurally similar to a medium degree.

Conceptual comparison

164. Conceptually, both marks convey the message of rehabilitation for hair, rehab being shorthand for rehabilitation. HRL's mark has the additional concept of London, which will be viewed as the location of the business. Both marks used for the goods at issue will give the immediate indication to the average consumer that these are goods used for hair rehabilitation purposes. I therefore conclude that the marks are conceptually highly similar.

Distinctive character of the earlier trade mark

165. My findings on this point in the first opposition apply equally here. HRL's second earlier mark is inherently distinctive to a very low degree, which has not been enhanced through use.

Likelihood of confusion

166. In my view, the likelihood of confusion assessment in this opposition is not too dissimilar to my assessment in the first opposition. I will, however, briefly set out my findings.

167. I have found the marks to be visually and aurally similar to a medium degree and conceptually highly similar. I have found the earlier mark to possess a very low degree of inherent distinctive character. I found the goods to be identical. I have identified the average consumer to be either a member of the general public or a professional in the hair and beauty industry, both of whom would pay a low to medium degree of attention to a mainly visual purchase, though I do not discount the aural consideration.

168. Bearing in mind the same case law as in the first opposition, it is my view that there exists a likelihood of direct and indirect confusion for the same reasons as set

out in the first opposition. There are two coinciding components: REHAB and HAIR. Whilst these have either no or very little distinctiveness, the same applies to the non-coinciding components. They have a highly similar overall impression and portray a highly similar concept to the average consumer.

169. My assessment of actual confusion, considered in the first opposition, applies equally here.

170. Returning to the third earlier mark, REHAB LAB, it is my view that HRL's position is no stronger based on this mark. The marks are less similar and the non-coinciding component, LAB, introduces a different concept and overall impression to the mark. Accordingly, if I am wrong in finding a likelihood of confusion between Capello's second application and HRL's second earlier mark, there is no likelihood of confusion with HRL's third earlier mark.

Conclusion

171. The opposition under section 5(2)(b) has been successful. Subject to any successful appeal, Capello's first application, under number 3798074, is refused in its entirety.

Section 5(3)

172. My assessment of this ground in the first opposition applies equally here. The evidence provided by HRL is insufficient to demonstrate a reputation in either the second earlier mark or the third earlier mark. The section 5(3) ground of opposition is dismissed.

The third opposition

173. The pleadings relevant to this opposition are set out earlier in my decision.

174. Based on my earlier findings, there are no valid earlier marks for HRL to rely upon for this opposition. The first earlier mark has been invalidated for all its goods and

services save for *educational instruction* and *educational consultancy* in Class 41. I explained in paragraph 108 that these services are not similar to any of the goods or services applied for in the relevant applications by Capello; accordingly, the three oppositions based on the first earlier mark are bound to fail. The second earlier mark has been revoked as of 29 June 2022. The filing date of Capello's third application is 3 November 2022 and so HRL's second earlier mark was not a valid earlier mark at the relevant date.

175. The opposition against Capello's third application, under number 3845574, fails and the application may proceed to registration in full.

FINDINGS

176. I will now summarise the entirety of my findings in this decision.

(i) Trade mark number UK00916427081, in the name of HRL, is revoked in full for non-use as of 29 June 2022.

(ii) Trade mark number UK00003272902, in the name of HRL, is invalidated for the following goods and services:

Class 3: *Hair sprays; shampoo; Hair curling preparations; Hair serums; Hair oil; Hair nourishers; Hair conditioners; Hair treatment preparations; Hair straightening preparations; Hair care preparations; Hair waving preparations; Hair piece bonding glue; False hair (Adhesives for affixing -); Adhesives for affixing false hair; Hair colouring preparations; Beauty care preparations; Eyelashes (False -); Artificial eyelashes; Eyelashes (Adhesives for affixing false -); Adhesive removers; Glue removers.*

Class 8: *Curling tongs; Hair curling (Hand implements for -); Hair styling appliances; Electric hair straightening irons; Electric hair curling irons; Electric irons for styling hair; Eyelash curlers; Eyelash separators.*

- Class 11: *Hair dryers; Apparatus for drying the hair; Driers (Hair -); Electric hair dryers; Hair drying appliances.*
- Class 21: *Brushes; combs; Hairbrushes; Eyelash combs; Hot air hair brushes.*
- Class 26: *Human hair extensions; Hairbands; Hairpieces; Hair fasteners; Hair curlers; Hair rollers; Bands (Hair -); Synthetic hair; Plaited hair; Hair tresses; Hair wraps; Human hair; Hair pieces; Hair weaves; Hair pins; False hair; Hair extensions; Synthetic hairpieces; Hair extensions; Wigs; False hairpieces.*
- Class 35: *Retail services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces; Wholesale services in connection with, Hair sprays, shampoo, Hair curling preparations, Hair serums, Hair oil, Hair nourishers, Hair conditioners, Hair treatment preparations, Hair straightening preparations, Hair care preparations, Hair waving preparations, Hair piece bonding glue, False hair (Adhesives for affixing -), Adhesives for affixing false hair, Hair colouring preparations, Beauty*

care preparations, Eyelashes (False -), Artificial eyelashes, Eyelashes (Adhesives for affixing false -), Adhesive removers, Glue removers, Curling tongs, Hair curling (Hand implements for -), Hair styling appliances, Electric hair straightening irons, Electric hair curling irons, Electric irons for styling hair, Eyelash curlers, Eyelash separators, Hair dryers, Apparatus for drying the hair, Driers (Hair -), Electric hair dryers, Hair drying appliances, Brushes, combs, Hairbrushes, Eyelash combs, Hot air hair brushes, Human hair extensions, Hairbands, Hairpieces, Hair fasteners, Hair curlers, Hair rollers, Bands (Hair -), Synthetic hair, Plaited hair, Hair tresses, Hair wraps, Human hair, Hair pieces, Hair weaves, Hair pins, False hair, Hair extensions, Synthetic hairpieces, Hair extensions, Wigs, False hairpieces.

Class 41: *Hairdressing instruction; Teaching of beauty skills; Educational services relating to beauty therapy.*

(iii) Trade mark application number UK00003798074, in the name of Capello, is refused registration.

(iv) Trade mark application number UK00003802166, in the name of Capello, is refused registration.

(v) Trade mark application number UK00003845574, in the name of Capello, may proceed to registration in full.

COSTS

177. Each party has achieved a roughly equal measure of success in these consolidated proceedings. As such, I order each party to bear its own costs.

Dated this 28th day of May 2025

Mrs E Fisher

For the Registrar