

O-124-14

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2586716
IN THE NAME OF DVA BEAUTIQUE (LONDON) LIMITED
IN RESPECT OF THE FOLLOWING TRADE MARK IN CLASS 3:**



AND

**AN APPLICATION FOR A DECLARATION OF INVALIDITY (NO 84589)
BY SALON UK LTD**

THE BACKGROUND AND THE PLEADINGS

1) The trade mark the subject of this dispute was filed by Diva Lash and Brow Bar Limited (“DLBB”) on 4 July 2011. It was published in the Trade Marks Journal on 29 July 2011 and it completed its registration process on 7 October 2011. It currently stands registered for the following goods in class 3:

Cosmetic products; artificial eyelashes; false eyelashes. non-medicated toilet preparations; toiletries; skin care preparations; skin moisturizers; body and beauty care preparations; powders, creams and lotions, all for the face, hands and body; soaps; shower and bath preparations; beauty masks; talcum powder; nail polish; nail polish remover; enamels for manicure; false nails; adhesives for cosmetic purposes; cosmetics; eye/brow makeup remover, eye shadow, eye liner, mascara, lipstick, lip liner, lip gloss; make-up foundation; blusher; tissues impregnated with cosmetic lotions; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes; preparations for cleaning the teeth; shaving and aftershave preparations; perfumes, fragrance, toilet waters, eau de colognes; essential oils (cosmetic); but not including preparations for cleaning, moisturising, colouring and styling the hair; all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items.

2) Salon UK Ltd (the “applicant”) seeks a declaration that the above trade mark is invalid. Its grounds for doing so are based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under the first two grounds the applicant relies on UK registration 2490720 which was filed on 23 June 2008 and which completed its registration procedure on 3 December 2010; the mark and the goods for which it is registered are:

divA professional styling

Class 3: Preparations for the hair.

Class 8: Apparatus and instruments for cutting, trimming and removing hair; non-electric apparatus and instruments for styling hair; clippers, scissors, shears, shavers, razors, cutters, tweezers; apparatus and appliances for use in manicure; spatulas; depilatory devices; curling tongs and hair straighteners; parts and fittings and cases for all the aforesaid goods.

Class 9: Measuring instruments, apparatus and containers; timers; electrical appliances for perming the hair, electrically heated hair styling apparatus.

Class 11: Hairdryers; hood dryers; wax heaters.

Class 18: Bags, vanity cases, cosmetic bags, beauty tool rolls, holdalls, carry cases, cases on wheels, cases for manicure instruments.

Class 20: Salon furniture; trolleys and stands; stools, foot rests, magazine racks, holders for styling apparatus; tissue and foil dispensers; trays.

Class 21: Brushes and combs; apparatus for cleaning brushes and combs; bottles and dispensing containers; hand operated water sprayers; tube squeezers; bowls, storage boxes and containers; squeeze powder blowers; face shields.

Class 25: Clothing and headgear; overalls; cutting gowns, aprons and capes; collars; disposable gloves, caps and hats.

Class 26: Lace and embroidery, and braids; buttons, hooks and eyes, pins and needles spangles for clothing; toupees; parts and fittings for all the aforesaid goods; rosettes, parts for all the aforesaid goods

3) It is not in dispute that the applicant's mark constitutes an earlier mark as defined by section 6 of the Act. Nor is it in dispute that the earlier mark is free from the requirement to prove that genuine use has been made of it; it may, consequently, be relied upon for its specification as registered. Under section 5(2)(b) the applicant states that the competing marks are highly similar, that DLBB's mark will be read as DIVA and that the stylization is also similar. Under section 5(3) the applicant states that it has a reputation in relation to "electrically heated hair styling apparatus; hair straighteners; curling tongs; hair dryers; bags, cases, parts and fittings for the aforesaid goods".

4) The ground under section 5(4)(a) is based on the claimed use, since 2008, of the signs DIVA and DIVA PROFESSIONAL STYLING in relation to: "electrically heated hair styling apparatus; hair straighteners; curling irons; curling tongs; hair dryers; bags, cases, parts and fittings for the aforesaid goods; hair combs; hair rollers". The applicant claims that it could prevent the use of the proprietor's mark under the law of passing-off.

5) DLBB filed a counterstatement denying the grounds of invalidity. Both sides filed evidence. During the course of the proceedings DLBB assigned the registration to DVA Boutique (London) Limited (the "proprietor"). The proprietor made an undertaking that it had seen the papers and evidence filed and stood by them, and that it was prepared to take on any liability for the costs of the proceedings. The matter then came to be heard before me on 24 January 2014 at which the applicant was represented by Ms Claire Hutchinson of Harrison Goddard Foote (incorporating Grant Spencer) and the proprietor was represented by Ms Harriet Seymour of Field Fisher Waterhouse LLP.

THE PARTIAL SURRENDER

6) During the course of the proceedings the registration was voluntarily surrendered, albeit partially, in so far as it covered “preparations for cleaning, moisturizing, colouring, and styling the hair”.

7) The specification as set out in paragraph 1 is how the registrar effected the surrender, namely, by:

- i) Deleting the term “preparations for cleaning, moisturising, colouring and styling the hair” which was contained in the specification when registered, and
- ii) Adding the exclusion “but not including preparations for cleaning, moisturising, colouring and styling the hair” to the end of the list of goods.

8) The question arose during the hearing as to whether the surrender requested by the proprietor had been effected in accordance with its request. I took it from Ms Seymour’s response that it had. However, in subsequent correspondence from Ms Hutchinson, she had taken it from Ms Seymour’s response that it had not and that the registration should have been surrendered only by deleting the term and not excluding it.

9) Regardless of any ambiguity, I must bear in mind that a surrender takes effect only from the date of surrender. The consequence of this is that during the period between registration and the date of surrender, the surrendered goods would have formed part of the registration and could, potentially, still provide infringement rights vis a vis the now surrendered terms. It will therefore be necessary to consider the specification both from a pre and post surrender position. I wrote to the parties to inform them of my approach and to state my assumption that the post surrendered specification was as per paragraph 1; Ms Seymour confirmed that the partial surrender had been effected as intended, Ms Hutchinson made no further comment; as neither party have taken issue with my approach, I will proceed on this basis.

THE EVIDENCE

The applicant’s evidence

10) The evidence comes from the applicant’s commercial director, Mr Paul Barton. Much of Mr Barton’s evidence is about the use made of the applicant’s DIVA trade mark, use which began in October 2008. He states that goods sold under the mark are used in the salons of top hairdressers and backstage in film and TV. He states that the mark has been used on all of its goods and services including:

“hair straighteners, curling irons, hairdryers, heated hair rollers, hair brushes, hair wavers, crimpers, hot hair stylers, curling wands, storage bags, stands for holding hair drying and styling tools, parts and fittings for hair drying or hair styling items and in relation to information and guidance on hair styling.”

11) Exhibit PB1 contains a selection of invoices issued by the applicant. Some do not carry the DIVA name at all, those that do also carry other trade marks. However, Mr Barton explains that the DIVA brand is the primary brand or house mark and even though other trade marks may appear, the DIVA mark is always present. Promotional figures are provided for the three and a quarter years ending on 31 December 2011; annual spend has risen from over £100,000 to close to £300,000 per year. The promotional spend is used in relation to advertisements, road shows, exhibitions, trade shows, public relations, website activity, leaflets and brochures. Exhibit PB2 contains some sample invoices relating to such promotional costs.

12) Exhibit PB3 contains examples of the mark used on packaging. Exhibit PB4 contains examples of the mark used on the goods. Exhibit PB5 contains a warranty document showing the mark. Even though the majority of the goods are sold under particular brand names (such as Bullet and Rapida) the words DIVA PROFESSIONAL STYLING also appear, most often in the following format:



13) Mr Barton states that the applicant's goods are sold to salons, salon wholesalers and to the public. Members of the public can buy through salons or from its website. Extracts from its website are shown in Exhibit PB6 showing the mark in use (most often in the above format). References are made on the website to payments and shipping, so the products can clearly be purchased. Mr Barton then refers to Sally Salon Services, a trade distributor and direct retailer who, Mr Barton states, are the largest nationwide group of its type. Sally Salon Services are said to sell from its website and from convenient high street locations. The applicant's goods feature in catalogues, brochures etc, examples of which are shown in Exhibit PB7. Website extracts are also provided which feature the word DIVA alongside a product description or sub-brand. Trade shows organized by Sally Salon Services have been attended to promote the goods. Examples of other promotional materials issued by Sally Salon Services are provided in Exhibit PB11 showing the mark (as either DIVA alone or in the format above). Other exhibitions have been attended to promote the goods including the Salon International Trade Show in London in 2008-2011. The applicant's goods have also appeared in the HJ Hairdressers trade journal, examples are shown in Exhibit PB3. This publication is said to have an extensive UK audience and has been in circulation for over 120 years.

14) Exhibit PB14 contains other promotional materials which have been provided to distributors of the applicant's goods. The mark is used most often in the logo format as above. References are made to "releasing your inner Diva". The applicant has won a number of industry awards for its products.

15) Mr Barton comments on the proprietor's mark. The applicant was highly concerned when it became aware of the proprietor's registration given that it is "highly similar". He considers that the mark will be read as DIVA with the missing "I" being overlooked. He says this is more likely because of DLBB's name. He states that the public have already been educated to associate the DIVA name with its beauty and hairstyling products. He states that the proprietor's website (this is a reference to DLBB's website) has a strong association with hair related products. Exhibit PB16 is a web print – Mr Barton notes that DVA is used in association with the word BEAUTIQUE rather than COSMETICS. Most of these prints relate to eyebrow shaping and colouring. Exhibit PB17 are further prints from the website showing hair chalking, a process for providing temporary colour for hair. Mr Barton considers the actual logos used by the parties to be similar and notes that both use descriptive subsidiary elements.

The proprietor's evidence

16) This comes from a director of DLBB, Mr Vaishali Patel. The company was incorporated in 2009. The business began in May 2010 in a kiosk environment in Westfield Shopping centre. The aim was to provide lash (I assume eye lash) and brow (I assume eyebrow) services to "time poor individuals". With the success of the business, it was apparently a natural step to introduce a range of complementary beauty products. Another kiosk was launched in 2010 in Lakeside shopping center in Thurrock. An opportunity then arose to have a kiosk in Westfield shopping centre in Stratford in late 2011; this was opened at the expense of the Lakeside kiosk which closed. It does not appear that DVA was used in relation to these services. I say this because Mr Patel explains his plan to grow the business and that he briefed a design team to come up with a branding identity. They came up with the DVA mark, although it is not clear when. This is said to be a simple but effective name with "a unique character like MAC cosmetics". This is, therefore, how the DVA BEAUTIQUE and DVA COSMETICS marks came to be and which were introduced along with a range of false eyelashes and semi permanent eyebrow powders. Other cosmetic lines have also been introduced, but, again, it is not clear when. Cosmetic services were also offered under the mark focusing, in the main, on eyelash and eye brow treatments.

17) Mr Patel states that promotion then began (when is not clear) and he refers to promotions via Groupon, Wowcher, KGB, etc – the evidence relating to this is either clearly from after the relevant date or at least cannot be placed before it. The promotions relate primarily to services (and some goods) for eyelashes/eyebrows. Reference is made to flyers and marketing materials issued

at the kiosks. Exhibit VP2 contains a flyer, packaging material and website prints showing the mark applied for. None can be placed before the relevant date. Reference is made to the blog of Danielle Lineker in the Daily Mirror which recommends the products – an example is provided from after the relevant date in Exhibit VP3.

18) A third kiosk is proposed to be opened in Liverpool Street station in September 2013. An online shop is also operated. Evidence of goods shipped (over 14,000 items) via Royal mail is provided. The period of these shipments is after the relevant date. Website statistics are provided showing, for example, that in July 2013 the website received over 5000 unique visitations. The goods are also sold through small independent distributors.

19) It is stated that the mark is referred to as D-V-A. It is said that this was a deliberate choice to distinguish ourselves from all the DIVA brands, a word which is popular in the beauty industry. Reference is made to the type of items that the applicant sells with the types of items DLBB sells. Reference is made to the different customer base.

The applicant's reply evidence

20) This comes, again, from Mr Barton. He notes an acceptance by Mr Patel that the elements DVA/diva are the dominant parts of the marks. He notes that the applicant's mark must be considered for all of its specification, which is wider than the goods it currently sells. In any event, he states that many traders sell a wide range of goods used in both fields (examples are provided in exhibit PB18). Reference is made to Sally Salon Services and evidence provided showing that as well as stocking its goods, it also stocks goods for use with eyebrows etc. It is also highlighted that the proprietor sells goods for the hair.

21) Reference is made to Mr Patel's statement that DVA was chosen to distinguish itself from DIVA brands in the sector. He takes from this that DIVA was in mind when the name was selected. The reference to avoiding association with DIVA brands has, it is said, little weight given the name of the proprietor at that time (its name includes the word DIVA).

22) Mr Barton disagrees with a statement made by Mr Patel that the proprietor's customers are only in the trade. He repeats his earlier evidence that the goods are also sold to the public. Further evidence about the sale of its goods to the public is provided, but I do not consider it necessary to summarize this in detail.

SECTION 5(2)(b) OF THE ACT

Section 5(2)(b) - the legislation and the leading case-law

23) Section 5(2)(b) of the Act reads:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

24) The Court of Justice of the European Union (“CJEU”) has issued a number of judgments which provide guiding principles relevant to this ground. In *La Chemise Lacoste SA v Baker Street Clothing Ltd* (O/330/10), Mr Geoffrey Hobbs QC, sitting as the Appointed Person, quoted with approval the following summary of the principles which are established by these cases¹:

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

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

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

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

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion."

The average consumer

25) The average consumer is deemed to be reasonably observant and circumspect. However, the degree of care and attention the average consumer uses when selecting goods and services can, of course, vary depending on what is involved.

26) The conflict focuses upon cosmetic products (the subject trade mark and the earlier mark covers such goods) and, also, cosmetic devices (which are covered by the earlier mark). Ms Hutchinson picked up on the reference in the proprietor's evidence to "time poor individuals". However, I agree with Ms Seymour that this is indicative of little because the reference was made in the context of the provision of its kiosk service in shopping centres which does not reflect the normal way in which the applied for goods will be sold. The goods are purchased reasonably frequent. They will be purchased by a member of the general public. The cost of the goods covered by the specifications vary, some cosmetics can be very expensive whereas others are much lower in cost, this applies even when the same product is purchased (e.g. some face creams or hair lotions cost just a few pounds, but others cost much more). This does not apply to all goods, for example, cotton wool will always be a relatively cheap. Perhaps with the exception of items such as cotton wool (which will likely be purchased relatively casually) the goods will be purchased with a reasonable degree of care and

attention, but certainly no higher than the norm. The more the price rises the greater the care that will be used. But as Ms Hutchinson stated, the notional use of the marks will include use at the cheaper end of the spectrum, so the likelihood of confusion must be considered there. The goods will most often be purchased from a shelf (or the online equivalent), however, cosmetics are often purchased after discussion with a salesperson so aural similarity still has a role to play.

27) Similar considerations apply to the other goods covered by the earlier mark (such as the beauty utensils and implements); cost can, again, vary, for example, goods such as hair straighteners will likely be more expensive than a cosmetic product, they will also be purchased less frequently, so suggesting a more considered purchase, but still not of the highest degree possible. I will bear all these variations in mind when I make my determinations.

Comparison of the goods

28) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

30) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

31) In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying to rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in *Boston* is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to *Boston*.”

32) In relation to understanding what terms used in specifications mean/cover, the case-law informs me that “in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade”¹ and that I must also bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning². I also note the judgment of Mr Justice Floyd in *YouView TV Limited v Total Limited* where he stated:

“..... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the

¹ See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281

² See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IPTRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of "dessert sauce" did not include jam, or because the ordinary and natural description of jam was not "a dessert sauce". Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

33) The proprietor's goods in class 3 carry the qualification "all the aforesaid being alone, in combination and/or in gift sets comprised of some or all of these items" – whether sold alone or in gift sets, this has no material effect on the comparison with the goods of the earlier mark (which could also be sold alone or in gift sets etc.) so I do not consider it necessary to factor this qualification into my findings.

34) I have already made reference to the partial surrender and that I must consider both the pre and post surrender position. I will go through the terms (or groups of terms) as per the proprietor's specification, I will then consider the impact of the post surrender exclusion on those terms. For some terms the exclusion does not really apply because it is clear from their very nature that they are not of the excluded type – in such circumstances it will be unnecessary to make further comment.

35) Before making the assessment, I must comment upon the skeleton argument provided by Ms Seymour on behalf of the proprietor. It contained a 39 page table which appeared to give the proprietor's position on whether the terms of its registration were similar or not to the various goods of the earlier mark, both from a pre and post surrender perspective. Many of the goods appeared to have been accepted as being similar from the pre surrender perspective, less so, but still some, from the post surrender perspective. Understandably, Ms Hutchinson relied on this when making her submissions as there was little point in arguing about something which had been accepted as similar by her opposite number. However, when Ms Seymour subsequently gave her submissions, she stated that the table was not meant to represent any form of concession but was merely to indicate where similarity was arguable. I found this singularly unhelpful. If this was what she was intending to do, the manner in which she presented her table was strange to say the least. In the circumstances, I directed that Ms Seymour provide in writing a list of goods which she accepted as being similar (which she duly did) and for Ms Hutchinson to have the opportunity to provide further submissions in writing on the residue (which she also duly did). Ms Hutchinson additionally argued that the proprietor should not be permitted to backtrack from its skeleton argument – whilst I can understand her frustration, I decline this

request, but will take this matter into account in relation to costs. I will now make the assessment:

Cosmetic products; cosmetics

36) These terms covers cosmetic products for use on the hair and, so, must be considered identical to the “preparations for the hair” covered by the earlier mark.

37) Identity would, however, be removed post surrender in view of the exclusion. However, cosmetic products would still cover goods such as body washes which conflict, in my view, with preparations for the hair (which would cover items such as shampoo) as they are similar in nature, similar in purpose and have similar trade channels; with the advent of 2-1 body/hair washes the link is even closer. Post surrender the goods are still reasonably similar.

Non-medicated toilet preparations; toiletries; body and beauty care preparations; shower and bath preparations

38) I consider that these terms include the same type of goods as assessed above. Therefore, pre surrender the goods can be considered identical, and post surrender the goods are still reasonably similar.

Artificial eyelashes; false eyelashes

39) These goods are clearly not identical to “preparations for the hair”. In fact, I consider there to be little similarity between the respective class 3 goods. However, the earlier mark includes goods such as tweezers, curling irons and brushes, all of which could be used for the beautification of a person’s eyelashes. Consequently, the respective goods both serve a cosmetic purpose associated with eyelashes, they will be aimed at the same users, are likely to be sold through the same trade channels. There could also be a degree of competitiveness as a person may choose to purchase either goods to beautify existing (real) eyelashes or to buy false or artificial ones instead. Either way, they form part of a person’s eyelash paraphernalia. I consider the goods to be reasonably similar.

40) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Adhesives for cosmetic purposes

41) Such goods will include adhesives for the affixing of false eyelashes. Therefore, these goods will also be considered as part of a person’s eyelash paraphernalia and, for similar reasons as given above, are reasonably similar to goods such as tweezers, curling irons and brushes covered by the earlier mark.

42) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Skin care preparations

43) These goods include body washes and, so, as per my findings in paragraph 37, there is a reasonable degree of similarity with hair care preparations in class 3 of the earlier mark. If I am wrong on that, and skin care preparations would only cover goods such as skin lotions and creams, I still consider there to be a moderate degree of similarity with hair care preparations, which would include hair lotions and creams – thus, the nature will be very similar, the purpose reasonably similar (albeit used on different parts of the body), the method of use reasonably similar (being rubbed into or applied directly from the bottle). The channels of trade, whilst not completely remote, are not that close; they are likely to be sold in different aisles, although not completely different areas of a supermarket.

44) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Skin moisturizers; powders, creams and lotions, all for the face, hands and body

45) As per my fall-back finding in paragraph 43, I consider there to be a moderate degree of similarity.

46) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Soaps

47) Soap is a basic product used for cleaning the face and body. Hair care preparations would include goods for cleaning the hair. There is similarity in nature (particularly when considering liquid soap), some similarity in purpose (both are for cleaning parts of the body/hair) and methods of use. The goods will not be sold in particularly close proximity to each other, nevertheless, I still consider the goods to be similar to at least a moderate level.

48) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Beauty masks

49) Comparing beauty masks and hair care preparations, there is no real similarity between the nature and methods of use of the goods. The purposes are different. Ms Hutchinson argued that all of the goods at issue form part of a person's beauty care or personal grooming regime – I agree with this to an

extent. However, I consider that the net effect to be that any similarity must be of only a very low degree. There is no greater degree of similarity with the other goods of the earlier mark.

50) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Talcum powder

51) I come to the same conclusion here as with beauty masks. Any similarity must be pitched at a very low degree.

52) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Nail polish; enamels for manicure

53) These goods are for application to the nails in order to beautify them. There is little similarity with hair care preparations in terms of purpose and methods of use and the goods will not be located together. However, the earlier mark covers goods in class 8 for manicuring purposes. It seems to me that there is an obvious complementary relationship with such goods, a similar purpose and a closer link in trade. I consider that the goods are reasonably similar.

54) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

False nails

55) This represents a similar assessment as above. In addition, there could also be a competitive relationship with some consumers purchasing false nails as opposed to purchasing goods for manicuring their own nails. I consider that the goods are reasonably similar.

56) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Eye/brow makeup remover; nail polish remover

57) These goods are for removing make-up and nail polish. There is little similarity with hair care preparations. The best one gets is the argument that these goods form part of a person's beautification paraphernalia along with the goods of the earlier mark in classes 8 and 21. Any similarity must be pitched at a very low degree.

58) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Eye shadow, eye liner, mascara

59) As observed earlier, some of the goods in classes 8 and 21 of the earlier mark may be used to beautify the eye area of a person. It seems to me that there is an obvious complementary relationship with such goods, a similar purpose and a close link in trade. I consider that the goods are reasonably similar. I note that Ms Seymour, in her further written submissions, accepted that eye shadow was similar to brushes in class 21.

60) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Lipstick, lip liner, lip gloss

61) The above goods have little similarity with hair care preparations. The class 8 goods of the earlier mark do not appear to be used in relation to the lips. The class 21 goods of the earlier mark include brushes, but there is no evidence before me (and neither is it an obvious fact) to indicate that brushes are bought for applying lip liner etc. Most goods have a built in application tool. Therefore, the best one gets, again, is that these goods form part of a person's beautification paraphernalia. Any similarity must therefore be pitched at a very low degree.

62) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment

Blusher

63) Ms Seymour, in the submissions I directed her to file, accepted that blusher was similar to brushes on a complementary basis. I agree, there is at least a moderate degree of similarity.

64) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Make-up foundation

65) I think it an obvious fact that make-up, including foundation, is commonly applied with a brush and that such goods are purchased separately. I agree with Ms Hutchinson that if blusher and brushes are similar then brushes are also similar to these goods. I consider there to be a moderate degree of similarity.

66) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Tissues impregnated with cosmetic lotions; cotton sticks for cosmetic purposes; cotton wool for cosmetic purposes

67) I consider, again, that the best one gets is the argument that these goods form part of a person's beautification paraphernalia along with the goods of the earlier mark in classes 8 and 21. Any similarity must be pitched at a very low degree.

68) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Preparations for cleaning, moisturising, colouring and styling the hair;

69) The goods are all preparations for the hair and must, therefore, be considered as identical to the class 3 goods of the earlier mark. The goods are both deleted and excluded from the subject mark so there is no need to comment on the post exclusion position.

Preparations for cleaning the teeth

70) Ms Hutchinson referred to "brushes" in the class 21 specification of the earlier mark. Brushes would include within its ambit toothbrushes and I agree with Ms Hutchinson that there is a clear aspect of complementarity. The purpose is similar (both are aimed at cleaning the teeth), the method of use is similar as are the trade channels. **There is a reasonable degree of similarity.**

71) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Shaving [preparations]

72) Ms Hutchinson has referred to "shavers" and "razors" in the class 8 specification of the earlier mark which, self-evidently, would be used for shaving. I agree with Ms Hutchinson that there is a clear aspect of complementarity. The purpose is similar (both are aimed at shaving), the method of use is similar as are the trade channels. **There is a reasonable degree of similarity.**

73) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Aftershave preparations; perfumes, fragrance, toilet waters, eau de colognes; Essential oils (cosmetic)

74) I consider, again, that the best one gets is the argument that these goods form part of a person's beautification paraphernalia along with the goods of the earlier mark in classes 8 and 21. Any similarity must be pitched at a very low degree.

75) The post-surrender exclusion cannot sensibly apply to these goods so there is no need for further comment.

Comparison of the marks

76) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The visual, aural and conceptual similarities of the marks must be assessed by reference to their overall impressions, bearing in mind their distinctive and dominant components. The marks to be compared are:



&

divA professional styling

77) The DVA/divA elements of the marks form the respective dominant and distinctive components. The other aspects will be perceived merely as descriptive terminology, although, I must continue to bear in mind the whole mark comparison.

78) There was much discussion at the hearing as to whether the average consumer would see, and hear, the DVA element as the word DIVA. Ms Hutchinson argued that the absence of the letter I in the DVA mark would be overlooked. She highlighted the prevalence of text speak that made such a conclusion more likely. Reference was made to the fact that the original proprietor of the mark had the word DIVA in its name and that this would be included on its stationery etc. She also referred to the comments of Mr Patel in his evidence when he stated, regarding the coining of the DVA mark:

“this was a deliberate choice to distinguish ourselves from all the DIVA brands, a word which is popular in the beauty industry”

79) Ms Hutchinson felt that, at the very least, this indicated that the word Diva was in mind when the mark was coined and that it was intended for DVA to be seen as DIVA. Ms Seymour felt that this could not be read into the words of Mr Patel and she re-enforced his comments that the mark is referred to as D-V-A not DIVA. She said that it was not a hugely imaginative step simply to drop the I, but that it was now a D-V-A mark not a DIVA mark. In relation to text speak, she argued that this was not a known abbreviation.

80) I bear in mind that the eye will sometimes see what it is expecting to see and it may, thus, overlook the absence of things. However, I am not persuaded by the text speak argument. This is not a known or commonly used text abbreviation. Further, absent the context of use in a communications setting such as a text message, or absent the context of a phrase or longer sentence, I see no reason why the average consumer would regard DVA as a text speak style contraction. I also agree with Ms Seymour that little can be read into the words of Mr Patel. Whilst I agree that his words are somewhat unclear, I do not agree that they demonstrate a clear intention for DVA to be seen as some form of DIVA mark. In any event, I must focus upon what the average consumer will perceive regardless of the intention that may lie behind the mark. In relation to the use of DIVA as part of a company name, this is not, in my view, a relevant consideration. I must consider the notional and fair use of the respective marks and I do not consider that such notional and fair use would include use alongside a company name. All things considered, it is my view that the average consumer will perceive the DVA element of the mark as simply three letters, D-V-A; this is how it will be seen, spoken and conceptualised.

81) Measured from the above perspective, there is some visual similarity on account of both marks including the letters D, V and A. However, the absence/addition of the letter "I" reduces this similarity. There are further differences on account of the additional wording and, also, the stylisation of the DVA mark; however this should not be overplayed as such aspects are not overly significant in the overall impressions of the marks which, as I observed earlier, will be dominated by the DVA/divA components. There is also some aural similarity, one mark will be pronounced as DEE-VEE-AY (plus cosmetics) and the other as DEE-VUH (plus professional styling). Both have the same beginning sound DEE and both have a V sound (albeit VEE rather than VUH); the difference in the V sound plus the additional syllable AY reduces this similarity to a low level.

82) Given my observations in paragraph 81, there is a clear conceptual difference.

The distinctiveness of the earlier mark

83) The degree of distinctiveness of the earlier mark(s) must be assessed. This is because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24).

84) From an inherent perspective, I bear in mind that the word DIVA will likely be perceived as a reference to a female of a somewhat pampered or indulgent nature. In relation to the goods of the earlier mark, it is somewhat mildly suggestive of the intended user of the goods. This is supported by some of its own publicity material which refers to the bringing out of one's inner diva. The suggestiveness is, though, mild and I do not agree with Ms Seymour that the earlier mark is one of low distinctiveness. I pitch the degree of distinctiveness at a moderate to normal level.

85) In terms of the use made of the mark, it is clear that the mark is a used one in relation to certain goods for styling the hair. However, the evidence lacks the context of market impact and share. I am willing to infer from the evidence that the use made of the mark may have had some impact upon its distinctiveness, but not to the degree that it has become a highly distinctive trade mark. The net effect is that the mark is reasonably distinctive in relation to goods for styling the hair, and for the rest of the goods it has a moderate to normal level of distinctiveness.

Likelihood of confusion

86) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

87) I will consider the matter from the pre-surrender position in the first instance, and then in relation to the cosmetic products of the subject trade mark which I have found to be identical to the goods of the earlier mark in class 3. That the goods are identical is in favour of the applicant because this may off-set a lower degree of similarity between the marks. I bear in mind the level of distinctiveness of the earlier mark as I have assessed already and the nature of the purchasing process and the variations of price of the competing goods (some of which may be quite modestly priced). I must also take into account the principle of imperfect recollection. Having considered all this, it is my finding that there is no likelihood of the DVA mark being mistaken or seen as the word DIVA (or vice versa). Even for an average consumer purchasing low costs variations of the goods, the DVA

mark will simply be seen as a string of three letters. I do not think that the DIVA mark (or word) will even be brought to mind, even for consumers who may have encountered the earlier mark. This is so even measured from the perspective of the most casually purchased goods of the application; DVA will not be seen/recalled as DIVA, or vice versa. Whilst conceptual differences are not always sufficient to avoid a likelihood of confusion. I consider in this case that any similarity on a visual or aural basis is off-set by the conceptual difference so that confusion is not likely. Given that this is my finding in relation to identical goods, the applicant is in no better position with regard to the other goods of the subject trade mark. **The ground under section 5(2)(b) of the Act fails.**

OTHER GROUNDS OF OPPOSITION

88) Whilst I have fully considered the other grounds, it seems to me that the applicant is in no better position. Even if one accepts the existence of a reputation for the purposes of section 5(3), my findings are indicative that a link will not be made by the relevant public for similar reasons to that assessed under section 5(2), together with the fact that the reputed goods are further away than the goods assessed under section 5(2)(b). The earlier mark will not be brought to mind. This also informs the decision under section 5(4) as even if one accepts the existence of a protectable goodwill, the earlier business and sign will not be brought to mind and there will be no misrepresentation. **The other grounds of invalidation fail.**

COSTS

89) The proprietor has been successful and is entitled to an award of costs. I will, though, make a deduction on account of the additional costs it has caused to the applicant to incur due to its unhelpful skeleton argument. I hereby order Salon UK Ltd to pay DVA Beautique (London) Limited the sum of £900. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£300

Considering and filing evidence
£500

Attending the hearing
£400

Minus sum for additional submissions from the proprietor
£300

90) The above sum should be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful

Dated this 19th day of March 2014

**Oliver Morris
For the Registrar,
The Comptroller-General**

ⁱ The leading judgments are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, Case C-3/03 *Matrazen Concord GmbH v GmbGv Office for Harmonisation in the Internal Market* [2004] ECR I-3657 *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).