BL O/0235/25

O/0488/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. 3564314

BY FIVER LONDON LTD

TO REGISTER THE FOLLOWING AS A TRADE MARK IN CLASS 3:

WOW
LONDON

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 426056

BY FEDERICI BRANDS LLC

AND

IN THE MATTER OF REGISTRATION NO. UK 3310772

IN THE NAME OF FEDERICI BRANDS LLC

AND

AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO

UNDER NO. 504741

BY FIVER LONDON LTD

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY FEDERICI BRANDS LLC

AGAINST A DECISION OF LEISA DAVIES

DATED 29 MAY 2024

DECISION

Introduction

1. This is an appeal from a decision of Leisa Davies acting for the Registrar, dated 29 May 2024, in relation to consolidated opposition proceedings filed by Federici Brands LLC ("**the Appellant**") against UK Trade Mark application no.3564314 for the mark shown on the cover page of this decision ("**the Respondent's Mark**") owned by Fiver London Ltd ("**the Respondent**") and invalidity proceedings brought by the Respondent against the Appellant's UK Trade Mark registration no.3310772.(series of two) for the following mark (**"the Appellant's 772 Mark"**):

   WOW/wow

   Filed on 18 May 2018 and registered on 31 August 2018

   Class 3: Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair; hair serums; neutralizing hair preparations; hair colour removers.

2. The Appellant opposed the Respondent's Mark under s.5(2)(b) of the Trade Marks Act 1994 (**"the Act"**) relying on the Appellant's 772 Mark and also on the following EU Trade Mark (**"the Appellant's 458 Mark"**):

   EUTM no. 013911458[1]

[1] This was still a relevant earlier mark because the application for the Respondent's Mark was filed prior to IP Completion Day – see Tribunal Practice Notice 2/2020.

Filed on 26 June 2015 and registered on 16 October 2015.

> **Class 3:** Non-medicated preparations and products for use on and in connection with hair; hair bleaching preparations, shampoos, conditioners, preparations for the care and beauty of the hair; preparations and lotions for colouring, dyeing, tinting and bleaching the hair; shampoos and styling putties all having a colouring effect; hair sprays all having a colouring effect for use in styling the hair.

3. The Appellant's 458 Mark was subject to the proof of use requirements pursuant to s.6A of the Act for all of the goods relied on as it completed its registration process more than five years before the application date of the Respondent's Mark.

4. The Respondent filed an application for invalidation of the Appellant's 772 Mark pursuant to s. 3(1)(b) and s. 3(1)(c) of the Act.

5. The proceedings were consolidated. Both parties filed evidence, and a hearing took place at which the Appellant was represented by Mr Edward Bragiel of Hogarth Chambers, instructed by Antinghams Solicitors, and the Respondent was represented by Ms Georgina Messenger of 3 New Square, instructed by Mathys & Squire LLP.

The Hearing Officer's Decision

Invalidity of the Appellant's 772 Mark

6. The Hearing Officer found that the Appellant's 772 Mark consisted exclusively of a sign which may serve to designate the kind, quality and positive characteristics of the goods. This was because when viewed from the perspective of the average consumer of hair care products and colourants, the mark WOW/wow would be understood as descriptive and designating an appealing characteristic of the goods. The impression created would be that the goods enhance the appearance of the wearer to invoke a positive response, a compliment or an expression of admiration. The Hearing Officer therefore found the Appellant's 772 Mark to be prima facie objectionable under s.3(1)(c).

7. The Hearing Officer also found the Appellant's 772 Mark to be prima facie objectionable under s.3(1)(b), on the basis that where a mark is descriptive under s.3(1)(c) it must also be devoid of distinctive character under s.3(1)(b).

8. The Appellant's 722 Mark would therefore be declared invalid unless the Appellant could show that it had acquired distinctiveness though use.

9. The Hearing Officer found that the Appellant had not shown from the evidence that the Appellant had acquired distinctive character in the word WOW solus, and that any distinctive character that the Appellant had acquired was in the figurative mark (e.g. the Appellant's 458 Mark) or the other text used to combine the word WOW with other words.

10. The Appellant's 772 Mark was therefore invalidated and so could not be relied on in the opposition.

The Opposition

11. Following a review of the evidence the Hearing Officer found that the Appellant's 458 Mark had been used in respect of all of the class 3 goods relied on in the opposition.

12. The Hearing Officer found that some of the goods covered by the Respondent's Mark were dissimilar to the goods covered by the Appellant's 458 Mark, and so the opposition failed in relation to those goods. Some of the remaining goods were found to be identical, and others found to be similar to either a high, low or very low degree.

13. The average consumer was found to be members of the general public, although some of the goods may be directed at businesses, such as hairdressers, both of whom would pay an average degree of attention during the purchasing process. Visual considerations were likely to dominate as a result of exposure to the brand labels on shelves of retail premises or online or following sight of television advertisements, but aural considerations were not ruled out, for example following discussions with sales staff in a retail setting.

14. The Hearing Officer found the marks to be visually and aurally similar to a low degree. The common element of both marks, the word "WOW", would be perceived to be a laudatory statement as to the nature, intended purpose and positive characteristics of the goods. When the other elements of the respective marks were taken into account, overall the marks were conceptually similar to a medium degree.

15. The Appellant's 458 Mark had a low degree of inherent distinctiveness but the Hearing Officer found that the evidence showed that its distinctiveness had been enhanced to a medium degree through use for some of the goods covered by it.

16. The Hearing Officer concluded that there was no likelihood of direct or indirect confusion, and so the opposition failed in respect of all of the goods applied for.

The Appeal

17. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was again represented by Mr Edward Bragiel of Hogarth Chambers, instructed by Antinghams Solicitors, and the Respondent was represented by Ms Georgina Messenger of 3 New Square, instructed by Mathys & Squire LLP.

Standard of review

18. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be *"wrong"* if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was *"outside the bounds within which reasonable disagreement is possible"* (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

19. In *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

“6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.

> *“i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.*
>
> *ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.*
>
> *iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.*
>
> *iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.*
>
> *v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.*
>
> *vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract.”*

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

> *"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion".” (Re Sprintroom Ltd [2019] EWCA Civ 932)*

8. And last, as Richards J observed in Instagram, proper respect should be paid to the decision of an expert tribunal in the field in question:

> *"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is*

probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right.""

20. In *Lidl Great Britain Ltd and another v Tesco Stores Ltd and another* [2024] EWCA Civ 262, Arnold LJ stated:

> *"16. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare Magmatic Ltd v PMS International Group plc [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and Actavis Group PTC EHF v ICOS Corp [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see Re Sprintroom Ltd [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ), which was cited with approval by the Supreme Court in Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin)."*

21. I have borne those principles firmly in mind.

Grounds of Appeal

22. The Appellant claimed that the Hearing Officer misdirected herself with regard to the correct approach to each of the relevant issues which fell to be considered and decided in relation to both the invalidity and opposition proceedings. I will consider each of these grounds in turn.

Invalidity

Section 3(1)(c)

23. The Appellant argued that the Hearing Officer failed to have *"any or sufficient regard"* to the relevant authorities on the issue of when a mark should be held to consist of a sign or indication which may serve in trade to designate some characteristic of the goods.

24. In particular, the Appellant relied on the judgment in *Ford Motor Co v OHIM* Case T-67/07, a copy of which had been supplied to the Hearing Officer but which was not mentioned in the Decision. In that case, the EU Court of First Instance (now the General Court) decided that, unlike indications such as "turbo", "ABS", or "4x4", the sign "FUN" on the back of a vehicle could not serve to designate directly a land motor vehicle or one of its essential characteristics. The relevant paragraphs from the judgment are set out below:

> *"28. It is appropriate to determine, in the context of applying the absolute ground for refusal referred to in Article 7(1)(c) of Regulation No 40/94, whether, for that*

relevant public, there is a sufficiently direct and specific relationship between the sign FUN and the goods covered by the application for registration.

29. As the Board of Appeal found, and the parties did not dispute, the English word 'fun' means 'amusement' and 'source of amusement'.

30. However, the applicant submits that, in actual fact, the Board of Appeal relied on two other meanings, 'the car has a quirky design' and 'the car is particularly enjoyable to drive', which go well beyond the meaning of the mark for which registration has been requested.

31. In this respect, the contested decision shows that the Board of Appeal found that, used in connection with a land motor vehicle, the word 'fun' would be perceived by the relevant public as an indication that the car had a quirky design or was enjoyable to drive. Contrary to what the applicant claims, the Board of Appeal did not give another meaning to the word 'fun', but showed how the relevant consumer would understand that word used in connection with the goods covered by the application for registration.

32. However, according to the case-law, to come within the scope of Article 7(1)(c) of Regulation No 40/94, a word mark must serve to designate in a specific, precise and objective manner the essential characteristics of the goods and services at issue (see, to that effect, Case T-334/03 Deutsche Post EURO EXPRESS v OHIM(EUROPREMIUM) [2005] ECR II-65, paragraph 41 and the case-law cited).

33. The fact that an undertaking wishes to give its goods a positive image, indirectly and in an abstract manner, yet without directly and immediately informing the consumer of one of the qualities or specific characteristics of the goods, is a case of evocation and not designation for the purposes of Article 7(1)(c) of Regulation No 40/94 (see, to that effect, Case T-24/00 Sunrider v OHIM(VITALITE) [2001] ECR II-449, paragraph 24; Case T-360/00 Dart Industries v OHIM(UltraPlus) [2002] ECR II-3867, paragraph 27; and EUROPREMIUM, paragraph 32 above, paragraph 37).

34. In connection with land motor vehicles, the sign 'FUN' may be understood as indicating that they can be amusing or that they can be a source of amusement. The sign 'FUN' can thus be viewed as giving the goods a positive image, like an image for promotional purposes, by giving the relevant consumer the idea that a car can be a source of amusement. None the less, although, in some cases, a land motor vehicle can be a source of amusement for its driver, the sign 'FUN' does not go beyond suggestion.

35. Accordingly, it must be held that the link between the word 'fun', on the one hand, and land motor vehicles, on the other hand, is too vague, uncertain and subjective to confer descriptive character on that word in relation to those goods.

36. Unlike some indications that are descriptive of the characteristics of a vehicle, such as 'turbo', 'ABS' or '4x4', the sign 'FUN' on the back of a vehicle cannot serve to designate directly a land motor vehicle or one of its essential characteristics. If the sign is placed in that position, the relevant consumer will perceive it as designating the commercial origin of the goods.

37. Consequently, the Board of Appeal's finding that the consumer will perceive the word 'fun' in relation to the goods concerned as indicating that a car has a quirky design or is enjoyable to drive is not enough to confer on the mark 'FUN' descriptive character within the meaning of Article 7(1)(c) of Regulation No 40/94.

38. It follows from all the foregoing that the relationship between the sign 'FUN' and land motor vehicles is not sufficiently direct and specific to enable the relevant public to immediately perceive, without further thought, a description of the goods or one of their characteristics. Consequently, the sign 'FUN' is not caught by the prohibition in Article 7(1)(c) of Regulation No 40/94."

25. The Appellant also relied on the EU General Court's judgment in *Dart Industries v OHIM* (cited in the extract from *Ford Motor Co* set out in the previous paragraph) which related to the mark ULTRAPLUS for plastic ovenware. The relevant paragraphs are set out below:

"23. In the present case, the Board of Appeal found, on the basis of English-language dictionaries, that the sign consists of, first, the prefix 'ultra', which means 'going beyond, surpassing, transcending the limits of...' or 'exceeding in quantity, number, scale, minuteness, ...' and, second, the suffix 'plus', which means that the product is 'of superior quality; excellent of its kind'. It considered that those two words are laudatory terms used to claim the excellence of the products in question. Thus, it found that 'UltraPlus' is descriptive for any type of goods or services.

24. In that regard it should be noted, on the basis of those definitions and the lexical rules applying to them, that if the term consisted of, for example, the prefix 'ultra' and an adjective, it could indeed be held that the adjective directly and immediately informs the consumer about a characteristic of the product and that, since the prefix merely reinforces the characterisation thus given to the product, a sign composed in this way is descriptive.

25. However, in the present case, the word 'ultra' does not designate a quality, quantity or characteristic of the ovenware which the consumer is able to understand directly. That word, as such, is only capable of reinforcing the designation of a quality or characteristic by another word. Likewise, the word 'plus' does not in itself designate a quality or characteristic of the plastic ovenware concerned which the consumer is able to understand directly and which could be reinforced by the word 'ultra'.

26. In that regard, it is not apparent from the contested decision that the relevant public would immediately and without further reflection make a definite and direct association between plastic ovenware and 'UltraPlus' (see, to that effect, Case T-359/99 DKV v OHIM (EuroHealth) [2001] ECR II-1645, paragraph 35).

27. When an undertaking extols, indirectly and in an abstract manner, the excellence of its products by way of a sign such as 'UltraPlus', yet without directly and immediately informing the consumer of one of the qualities or specific characteristics of the ovenware, it is a case of evocation and not designation for the purposes of Article 7(1)(c) of Regulation No 40/94 (see, to that effect, Case T-24/00 Sunrider v OHIM (VITALITE) [2001] ECR II-449, paragraph 24)

28. In that regard, the Office's arguments that 'UltraPlus' designates the very good quality of the goods, and in particular - as was alleged at the hearing - the excellence of the plastic which makes the products light and resistant to changes in temperature, do not make it possible to characterise the sign as descriptive. Such characteristics are neither indicated nor singled out by the sign at issue and remain, where the public might imagine that they are alluded to, too vague and indeterminate to render that sign descriptive of the goods in question (see, to that effect, Case T-87/00 Bank für Arbeit und Wirtschaft v OHIM (EASYBANK) [2001] ECR II-1259, paragraph 31).

29. It follows from the above considerations that, in failing to relate its analysis to the goods in question and in failing to show that 'UltraPlus' may serve to designate those goods directly, the Board of Appeal infringed Article 7(1)(c) of Regulation No 40/94."

26. The Appellant submitted that the word "WOW" in relation to hair products was *"at most laudatory and extolling of the products but in a vague and indeterminate way"*, and therefore was not sufficiently direct and specific to enable the relevant public to immediately perceive, without further thought, a description of the goods or one of their characteristics.

27. The Appellant sought to criticise the Hearing Officer for finding the Appellant's 772 Mark to be descriptive despite having concluded in paragraph 33 of the Decision that *"It is my view the evidence adds very little to the claim that as at the date of application the '772 Mark has been shown to have been <u>used</u> descriptively"*. The Appellant submitted that the Hearing Officer's decision was *"against the weight of the evidence"*.

28. The evidence filed by the Respondent for the purposes of establishing whether or not the word WOW was descriptive of a characteristic of the goods covered by the Appellant's 772 Mark consisted of the evidence of two witnesses, Mr Dumlupinar and Ms Drzeweiecka.

29. The Hearing Officer described Mr Dumlupinar's evidence to be largely made up of:

    a. evidence of use that the Respondent had made of its own mark,

    b. various dictionary definitions of the word WOW,

    c. numerous examples of third party trade marks on the UKIPO Register that included the word WOW for similar or identical goods.

30. Ms Drzeweiecka's evidence was described by the Hearing Officer in paragraph 29 of the Decision as including:

a. various dictionary and etymology definitions of the word WOW.

b. 30 examples of over 8,000 registered trade marks comprising the word WOW from the WIPO global brands database.

c. Extracts taken from a list of 671 trade marks published on the UKIPO Register which were said to use the word WOW commercially.

d. printouts of various adverts that used the word WOW in a way that was said by the Respondent to emphasis the positive qualities of the products *"conveying to the consumer the feeling that these qualities are so unusually good that they make the consumer feel surprised or amazed"*.

e. Examples of the word WOW being used widely in the commercial world *"to make the consumer feel surprised or impressed by the properties of the product where the word WOW is intended to highlight yielding expressions like 'The Wow effect' or 'WOW factor'"*.

f. Printouts showing third parties *"commonly using the word WOW descriptively as a term of compliment"*, and as a brand name both in the cosmetics industry and for hair products.

g. Use of the word WOW on packaging and promotional materials, particularly in the cosmetic and hair industries, *"which will be viewed as an advertising slogan to emphasis* [sic] *the positive qualities of the products"*.

31. The Hearing Officer was critical of the bulk of this evidence, on the basis that it was either undated, referred to dates after the relevant date, appeared to be targeted to consumers outside of the UK, did not relate to the cosmetic/toiletry industry, gave no indication of circulation, readership or sales figures, or was "state of the register" evidence which told her nothing about what was happening in the marketplace. Accordingly, she concluded that the Respondent had failed to show that the word WOW was *"a laudatory or a promotional statement as to the nature, intended purpose and positive characteristics of the goods or was shown to be in general use at the date Federici applied to register its mark either in commerce generally or more specifically in the cosmetic/hair/toiletries industry"*.

32. However, while she did not find the Appellant's 772 Mark had been shown to have been used descriptively, she went on to consider whether it was capable of being used descriptively in the future:

> *"34. Given the wording of section 3(1)(c), however, this is not necessarily fatal to Fiver's case as it is still necessary for me to consider whether the term 'may serve in trade' which requires consideration as to whether it was or could have become descriptive as at the relevant date, to include any future position."*

33. She was right to do so, as Arnold J (as he then was) confirmed in *Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc [2013] FSR 29* at paragraph 91 when he said:

> *"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 Case C-80/09 P Mergel and Others v OHIM, paragraph 37)."*

34. In order to assess whether the mark could be used in a descriptive manner in the future, she did take into account the Respondent's evidence that she had reviewed as referred to above. Again, she was entitled to do so. For example, the fact that businesses outside the UK may have used the word WOW in a descriptive manner suggests that it is quite likely that UK businesses may also choose to do so. It was therefore useful evidence to demonstrate the ways in which the Appellant's 772 Mark could be used in the future in a descriptive manner, even though she did not accept it as evidence that that had actually happened in practice in the UK. She was also careful to recognise its *"limited value"* in paragraph 41 of the Decision.

35. The evidence also included various definitions of the meaning of the word "WOW", in respect of some of which the Hearing Officer was critical, saying the following:

> *"35. Despite the difficulties with Ms Drzeweieck's evidence regarding use of the word 'wow', she has provided dictionary and etymology definitions of the term (accessed as at 2022), which is shown to mean:*
>
> > *"**An indication of** excitement, **surprise**, astonishment or pleasure i.e. "Wow I sure was surprised!"* [*Wikipedia*] *and*
> >
> > *"**An expression of** amazement, **awe, or admiration**."* [Etymology dictionary]
> >
> > *"Used sarcastically to express disapproval of something."* [Merriam Webster]

> *36. These definitions are taken from sources which are open to being amended (Wikipedia) or consist of those attributed to the US or from less common dictionary sources. Mr Dumlupinar has also provided definitions taken from the Cambridge dictionary. These definitions are in keeping with my own understanding of the term or more importantly what would be understood as the meaning from the perspective of UK consumers. I do not consider that those definitions have altered over the years either and therefore the meaning attributed to the word would be the same in 2018 as it would now. Those definitions include:*
>
> > *1.(i) EXCLAMATION - **an exclamation of admiration**, amazement, etc Also: wowsers*
> >
> > *(ii) NOUN (slang) - a person or thing that is amazingly successful, attractive, etc*
> >
> > *(iii) VERB (transitive) slang - to arouse great enthusiasm in. Word origin - originally Scottish, **expressive of surprise**, amazement, etc* [taken from the Collins online dictionary]
> >
> > *2. Now chiefly **expressing** astonishment or **admiration**. An exclamation, variously **expressing** aversion, **surprise or admiration**, sorrow or commiseration, or mere asseveration"* [taken from the Oxford online dictionary, although the Hearing Officer reversed the order of the two sentences]
>
> [emphasis added as referred to below].

36. The Appellant submitted that these definitions demonstrated that the meaning of the word was ambiguous, and did not always have to convey a positive response (e.g. *"an exclamation of sorrow or commiseration"*). It is interesting that, despite acknowledging these various definitions, the Hearing Officer reached a conclusion as to the meaning of the word which appeared to be selective of only some of these definitions, without further explanation of the reasons behind her selection, when she said:

> *"The dictionary definitions show that the meaning attributed by consumers to the word 'wow' would be perceived as an expression of admiration, surprise or awe as to the quality and positive effects of the goods when used."* [38]

37. I have added in bold emphasis the parts of the definitions set out in paragraph 35 above which reflect the definition chosen by the Hearing Officer.

38. Furthermore, in paragraph 111 of the Decision, she appears to have expanded her decision on the meaning of the word to also include an exclamation of amazement or astonishment, or to show pleasure, when she said:

> *"As I have already found the word WOW is a dictionary word and will be understood to mean and to be used as an expression/exclamation of amazement, astonishment or admiration, or used to show surprise and sometimes pleasure."*

39. However, a mark can fall within s.3(1)(c) even if it has more than one meaning (see Arnold J (as he then was) at [92] in *Starbucks*) , provided that it

> *"may serve in normal usage from the point of view of the relevant public to designate, either directly or by reference to one of their essential characteristics, the goods or services in respect of which registration is sought"* (*Procter & Gamble v OHIM* [2001] Case C-383/99 P).

40. It is therefore important to assess the meaning of the word in the context of the mark and in relation to the goods and services covered by it. The Hearing Officer was required to reach her conclusion as to how she considered the meaning of the word WOW would be perceived by the average consumer of the hair products covered by the Appellant's 772 Mark. For example, she was correct to rule out the possible negative meanings of the word when used as a brand name, as that would not be a logical or realistic message for a producer of hair products to convey.

41. However, where a word may have several meanings to the consumer of the goods in question, that may affect whether or not the alleged descriptive meaning was one which the consumer would reach immediately and directly, and without further thought, as is required for it to fall within s.3(1)(c). I must therefore decide whether the Hearing Officer's conclusion that the Appellant's 772 Mark fell foul of s.3(1)(c), applying the meaning of the word WOW as summarised by her in paragraph 38 of the Decision, was wrong in light of the guidance on the application of s.3(1)(c) from the various authorities.

42. The Hearing Officer's reasoning was set out in paragraphs 39 to 42 of the Decision as follows:

> *39. I remind myself of the findings of Mummery LJ in the Now TV case, Starbucks HK Limited v. BSB Group plc [2013] EWCA Civ 1465 at paragraphs 96 to 99, where the figurative mark "NOW" was invalidated in respect of primarily TV and telecommunication services. In his judgment Mummery LJ drew conclusions including that:*
>
> > *"(i) [...] the claimants chose as their trade mark a commonplace, easily understood, ordinary English word, which was also used by other undertakings in relation to other products or services;*
> >
> > *(ii) [...] it must have been obvious to the claimants that, in making that choice, they were running the risk of invalidity on the ground that the message that was conveyed or could be conveyed by the everyday word to the average consumer designated a characteristic of that service.*
> >
> > *(iii) [...] The trade mark would attract the custom of all those viewers who "want it now." The attraction is of having immediate and instant access to programmes of choice on demand rather than having to settle for waiting.*

> *(iv) […] when viewed from the position of the hypothetical average consumer of the claimants' service, the mark NOW would be understood as designating that attractive instant and immediate characteristic of the service for which it was registered. The mark NOW refers to more than just the service itself. It refers to something about the service, an appealing characteristic that will pull in the punters. What is that something if it is not the characteristic of delivering programmes of choice instantly on demand?"*
>
> *40. Taking note of these comments, I consider that when viewed from the perspective of the average consumer of hair care products and colourants the mark WOW/wow would be understood as descriptive and designating an appealing characteristic of the goods. An impression would be created that the goods enhance the appearance of the wearer to invoke a positive response, a compliment or an expression of admiration. I consider that this meaning would be direct and specific and would not require any further thought process in the analysis. On this basis I find that the mark consists exclusively of a sign which may serve to designate the kind, quality and positive characteristics of the goods.*
>
> *41. As set out in the caselaw the general interest underlying section 3(1)(c) is of ensuing that descriptive signs relating to one or more characteristics of the goods in respect of which registration as a mark is sought may be freely used by all traders offering such goods. Taking account of the clear meaning of the mark 'wow' and the evidence filed (even accepting its limited value), the term is clearly capable of being used or likely to be used descriptively in relation to identical or similar goods and it is clear that other traders should be free to use this word in respect of their goods. The fact that evidence has been filed of third parties using the word descriptively in 2022 reaffirms my view that the term will be viewed as designating a characteristic of the goods.*
>
> *42. I find that prima facie the '772 mark is objectionable under section 3(1)(c).*

43. The Hearing Officer's statement in paragraph 40 of the Decision that the meaning she had attributed to the word WOW would be "*direct and specific and would not require any further thought process in the analysis"* shows that she understood the need from the authorities for the meaning to be understood by the average consumer directly and immediately and without the need for further reflection to make a direct association between the word and the relevant goods. In paragraph 25 of the Decision, she had already reproduced the extract from the judgment in *Puma SE v Nike Innovative C.V.* [2021] EWHC 1438 (Ch) which set out those requirements. I therefore do not agree with the Appellant that the Hearing Officer failed to have any regard to these requirements. As a result, I do not consider that the Hearing Officer made an error in identifying the relevant law.

44. The Hearing Officer referred to the general interest underlying s.3(1)(c) of ensuring that descriptive signs relating to one or more characteristics of the goods in respect of which

registration is sought may be freely used by all traders offering such goods. This was confirmed by Arnold J (as he then was) at first instance in *Starbucks* when he said:

> *"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)."*

45. The Hearing Officer was therefore right to take that factor into consideration as part of her overall assessment.

46. However, I have decided that she erred in her application of the law. A consumer seeing the word WOW on one of the goods covered by the Appellant's 772 Mark would not immediately and directly attribute that word to a characteristic of the goods without requiring further thought. The Hearing Officer found the word WOW in this context to *mean "an expression of admiration, surprise or awe as to the quality and positive effects of the goods when used"*. That covers a wide range of possible messages for the average consumer. For example, there is a real difference between the meaning of the words "*admiration"* and *"surprise"*. The word WOW could be interpreted to be a description of the way in which the product works (e.g. its speed of acting, or ease of use), the nature of the colours produced by the products or (as the Hearing Officer interpreted it) the effect that the products have on the appearance of the user.

47. The adverts referred to in paragraph 30(d) above included use of the word WOW in a laudatory manner but which by itself told the reader nothing about the particular characteristic of the product to which the word WOW related, such as *"WOW It's a Roadmaster … Wow hardly covers his Christmas joy"* (used in relation to a bicycle), *"Let's create WOW Memories"* (used in relation to a bottled drink) or *"WOW the world"* (used separately in relation to a laptop and a car). They also included use to suggest surprise or amazement in respect of a certain characteristic which is only identified by other wording, for example, surprise or awe at the low cost or discount available for the product, such as *"WOW! Everyday value"* (used in relation to pizzas), or the taste of a product: *"WOW! Cadbury's 5 Star The Energy Bar Fab New Taste!"*

48. The examples referred to in paragraph 30(f) above did include examples from the cosmetics industry which appeared to use the word WOW in reference to the effect the use of the product would have on the user, such as *"WOW Eyes … for eyes that wow"* (used in relation to eyeshadow), *"Nail blush. Wow!"* (used in relation to nail polish), *"You*

too deserve the WOW effect!" and *"WOW effect"* (used separately in relation to cosmetics). However, they also featured indeterminate use of the word WOW, such as *"WOW" Or Waste?", "Apocalips WOW"* and *"Now … Wow!"*(used separately in relation to cosmetics), and another example of use suggesting surprise in relation to the value of the product - *"WOW Sale"*(used in relation to beauty and cosmetic items).

49. These examples demonstrate the various different impressions that the use of the word WOW could give to consumers when used in relation to cosmetic and hair products, such that it is not possible for a consumer immediately and directly to attribute a specific descriptive meaning to a characteristic of the goods in question, without further thought.

50. I therefore consider that the Hearing Officer erred in finding that there was *"a clear meaning of the mark 'wow'"* which would be *"direct and specific and would not require any further thought process in the analysis*" that the goods will *"enhance the appearance of the wearer to invoke a positive response, a compliment or an expression of admiration."*.

51. In reaching this conclusion, I would contrast the meaning of WOW in this case with the meaning of NOW as discussed in *Starbucks* [2013] EWCA Civ 1465 which the Hearing Officer referred to. In his judgment, Mummery LJ described the word NOW as referring to:

> *"something about the service, an appealing characteristic that will pull in the punters. What is that something if it is not the characteristic of delivering programmes of choice instantly on demand?"*

52. In that case, the word NOW would inevitably denote the characteristic of delivering TV programmes instantly, without having to wait for them. In this case, the word WOW has a number of different possible meanings, each of which could describe a different characteristic of the goods, or the effect the goods give to the user. The description of the characteristic of the goods in this case cannot be described as immediate or direct, without the need for further thought.

53. Furthermore, given the way in which the word WOW is freely and commonly used by the public with no particular meaning beyond a positive expression of some sort, it is the sort of word to which a consumer would attribute no particular immediate or direct meaning to a characteristic of goods such as the hair products covered by the Appellant's 772 Mark.

54. I therefore allow the appeal in relation to the s.3(1)(c) ground.

Section 3(1)(b)

55. Where a trade mark is found to be descriptive within the meaning of s.3(1)(c), it will also be devoid of any distinctive character for the purposes of s.3(1)(b), which is what the Hearing Officer found. However, a trade mark may be devoid of distinctive character for the purposes of s.3(1)(b) for reasons other than the fact that it may be descriptive (see, for example, Case C-363/99 *Koninklijke KPN Nederland NV* [2004] ECR I-1619 at paragraph 86).

56. In its skeleton argument for the hearing before me, the Appellant stated that at the hearing before the Hearing Officer "*the case under Section 3(1)(b) rested only on the argument that Federici's word mark was descriptive within Section 3(1)(c)*". This position appeared to be confirmed by the Hearing Officer in paragraph 45 of the Decision where she said "*Given that Fiver have not pleaded any alternative case other than descriptiveness …*". However, in fact both of these statements were incorrect. The Respondent's Form TM26(I) did contain reasons in support of s.3(1)(b) which were not limited to descriptiveness, and when I checked the transcript of the hearing before the Hearing Officer, it was clear that counsel for both the Respondent and the Appellant had made submissions to the Hearing Officer in relation to those other reasons.

57. Following the hearing before me I therefore issued a direction pursuant to Rules 62 and 73(4) of the Trade Mark Rules 2008 that each party be permitted to provide written submissions on the issue of whether the Appellant's '772 Mark was objectionable under s.3(1)(b) for reasons other than those under s.3(1)(c). I also gave each party the opportunity to request a further hearing before me within 7 days of receiving the other party's written submissions. Both parties filed written submissions, and neither party requested a further hearing.

58. Before I consider the "other reasons", I first need to address submissions made by the Appellant that:

    a. there would be *"an element of unfairness"* if I were to allow the Respondent to make submissions in relation to the "other reasons" when they did not include those arguments in a respondent's notice or address the point at the hearing before me;

    b. I did not have the power to make my direction as it would *"override the need to serve a respondent's notice"*; and

c. In the absence of a respondent's notice, s.3(1)(b) was only "in play" to the extent that the Appellant's 772 Mark offended against s.3(1)(c).

59. The Trade Mark Rules say the following in respect of respondent's notices:

> *"71(4) Where any person other than the appellant was a party to the proceedings before the registrar in which the original decision was made ("the respondent"), the registrar shall send to the respondent a copy of the notice [of appeal] and the statement and the respondent may, within the period of 21 days beginning immediately after the date on which the notice and statement was sent, file a notice responding to the notice of appeal.*
>
> *71(5) The respondent's notice shall specify any grounds on which the respondent considers the original decision should be maintained where these differ from or are additional to the grounds given by the registrar in the original decision."*

60. The respondent's notice therefore gives notice to the other party and the appointed person of any additional grounds which the respondent intends to rely on at the hearing before the appointed person in support of the maintenance of the hearing officer's decision. This avoids the possibility of the other party being taken by surprise and not being able to prepare submissions in response to any additional grounds which the respondent wishes to make.

61. However, there is nothing in the rules which prevents any additional grounds being raised by the appointed person themselves.

62. I gave my direction for the exchange of written submissions together with the ability of either party to request a hearing once they had seen the other side's submissions in order to remove the possibility of any unfairness to either party. Both parties were therefore given advanced notice of the "other reasons" issue, given the opportunity to make written submissions in relation to it, and given the opportunity to respond to those submissions to the same extent that they would have had had the issue been raised and argued at the original hearing before me. I therefore do not consider that there has been any unfairness to either party as a result of my direction, which is supported by the fact that neither party requested a hearing after reading the other party's submissions.

63. With regard to the question of whether or not the "other reasons" aspect of s.3(1)(b) was "in play", it is clear that the Notice of Appeal appealed the Hearing Officer's decision under both s.3(1)(b) and 3(1)(c). It is correct that the Appellant's grounds of appeal in relation to s.3(1)(b) only referred to the Hearing Officer's finding that the mark was devoid of distinctive character because she had found the Appellant's 772 Mark to be

descriptive within the meaning of s.3(1)(c). That was unsurprising in light of the Hearing Officer's conclusion in paragraph 45 that she found the mark to be devoid of distinctive character *"for the same reasons"* as she gave in relation to her conclusion under s.3(1)(c). Nevertheless, once the Hearing Officer's decision under s.3(1)(b) had been appealed, I consider that the application of s.3(1)(b) was "in play" and it is therefore necessary for me to consider any "other reasons" which may be relevant to the application of s.3(1)(b).

64. I find support for that conclusion from the decision of Mr Phillip Johnson sitting as the Appointed Person in *CHOPLIFE*, BL O/0974/24. In that case, the appellant had argued that the hearing officer had reached their decision on an issue which had not been pleaded or argued by the parties, namely the possibility of co-branding. Mr Johnson dismissed the appeal, finding that the issue of co-branding was in play as part of the likelihood of indirect confusion. As I have discussed above, there is no dispute that the Respondent in the case before me had pleaded s.3(1)(b) and made oral submissions to the Hearing Officer on the "other reasons" under s.3(1)(b). Mr Johnson said the following:

> *"13. It has long been acknowledged that a judge (or arbitrator) can raise points independently of the parties. This was explained by Bingham J in Zermalt Holdings SA v Nu-Life Upholstery Repairs Ltd [1985] 2 EGLR 14 at 15:*
>
> > *[T]he rules of natural justice do require ... that matters which are likely to form the subject of decision, in so far as they are specific matters, should be exposed for the comments and submissions of the parties. If an arbitrator is impressed by a point that has never been raised by either side then it is his duty to put it to them so that they have an opportunity to comment. If he feels that the proper approach is one that has not been explored or advanced in evidence or submission then again it is his duty to give the parties a chance to comment.... It is not right that a decision should be based on specific matters which the parties have never had the chance to deal with, nor is it right that a party should first learn of adverse points in the decision against him.*
>
> *14. The rule was put succinctly by Lord Hamblen and Lord Burrows in RAV Bahamas Ltd v Therapy Beach Club Incorporated (Bahamas) [2021] UKPC 8, [46]:*
>
> > *An arbitrator will not have acted fairly if a party is learning for the first time in the award about findings and matters in the decision of the arbitrator which that party has not had the opportunity to address."*

65. By making the direction referred to above, I ensured that there was no question of either party having been taken by surprise, not having been given the opportunity to deal with the issues or first learn of adverse points in my decision.

66. Mr Johnson continued at paragraph 16:

> *"However, the duty to refer a point back to the parties does not extend to "each and every legal inference": OAO Northern Shipping Company v Remolcadores De Marin SL (Remmar) [2007] EWHC 1821 (Comm), [22]. The appropriate approach is that identified by Tomlinson J in ABB AG v Hochtief Airport GmbH [2006] EWHC 388 (Comm), [2006] 2 Lloyd's Rep 1, [72] where he stated that what is important is whether "all of the essential elements" leading to the conclusion "were fairly in play or, to use a different expression, in the arena.". This approach was explained further by Popplewell J in Reliance Industries Ltd v The Union of India [2018] EWHC 822 (Comm), [32]:*
>
> > *"However where a point of construction is squarely in play and addressed by both parties, the tribunal is not obliged to put to the parties all aspects of the analysis in support of its conclusion in order to fulfil the ...duty of fairness. As is well known, construction is an iterative process involving consideration of the particular wording in question, the other provisions of the contract taken as a whole, and the commercial consequences which follow from the rival constructions. The relevant provisions may be lengthy and admit of many nuances in the analytical argument. If provisions are relevant, and have been adverted to and addressed in argument, it is not necessarily unfair for the tribunal to use them to support its reasoning, even where the other party has not done so in the same way as the tribunal. It is always important to keep in mind the distinction between a lack of opportunity to deal with a case and a failure to recognise or take such opportunity. It is commonplace in judicial decisions on points of construction that a judge may fashion his or her reasoning and analysis from the material upon which argument has been addressed without it necessarily being in terms which reflect those fully expressed by the winning party. There is not perceived to be, and is not, anything which is unfair in taking such a course. It is enough if the point is "in play" or "in the arena" in the proceedings, even if it is not precisely articulated. To use the language of Tomlinson J, as he then was, in ABB AG v Hochtief Airport [2006] 2 Lloyd's Rep 1 at [72], a party will usually have had a sufficient opportunity if the "essential building blocks" of the tribunal's analysis and reasoning were in play in relation to an issue, even where the argument was not articulated in the way adopted by the tribunal. Ultimately the question which arises ...[is] whether there has been a reasonable opportunity to present or meet a case, is one of fairness and will always be one of fact and degree which is sensitive to the specific circumstances of each individual case. That applies to points of construction as much as to other points in dispute.""*

67. I consider that the "other reasons" under s.3(1)(b) are part of the *"essential building blocks"* to be considered as part of the appeal, particularly where both parties had made representations to the Hearing Officer on those very issues at the hearing before the Hearing Officer, and so are "in play" in the appeal before me. Again, I consider the issue of fairness has been fully covered by the wording of my direction as explained above.

68. I am also conscious of the public interest in preventing marks which do not meet the registrability requirements under the Act from remaining on the register. That public interest would not have been fulfilled had I refused to consider the "other reasons" under s.3(1)(b) and allowed the Appellant's 772 Mark to remain on the register as a result of a mistake made by the Hearing Officer, which the Appellant accepts was a mistake, just because the issue was not raised by the Respondent in a respondent's notice.

69. I therefore reject the Appellant's submissions that I should not consider the "other reasons" on this appeal.

70. For completeness, I would add that I do not consider that this issue is one which should be remitted to the Hearing Officer, or another hearing officer, to be decided. Neither party made such a request in their written submissions. I have had the benefit of those submissions, together with the opportunity of reading the transcript of the hearing before the Hearnig Officer, where both parties had and took the opportunity to make submissions on the "other reasons" to the Hearing Officer. Finally, neither party requested a further hearing before me. I have therefore decided that I should decide the issue now rather than incur the further costs and delay of remitting the issue back to a hearing officer.

"Other reasons"

71. In its written submissions after the hearing before me, the Appellant submitted that the reason why the Hearing Officer may have mistakenly referred to the Respondent as only having pleaded s.3(1)(b) on the basis that the Appellant's 772 Mark fell foul of s.3(1)(c) was because of the way the Respondent argued its case.

72. In particular, it referred to the Respondent's Counterstatement to the Opposition where it described the word WOW as *"a universal laudatory term that describes the positive quality of the goods and services and is non-distinctive, such that no single entity can obtain exclusive rights in it."*.

73. However, the first point to note is that the Hearing Officer would be looking at the content of the Respondent's Form TM26(I) for its arguments in relation to s.3(1)(b), and not the Counterstatement in relation to the Oppostion.

74. Secondly, the extract set out in paragraph 72 could equally be an argument under s.3(1)(b) for reasons other than descriptiveness under s.3(1)(c). As has been discussed above, a mark will only fall foul of s.3(1)(c) if it is descriptive of a particular characteristic

of the goods or services covered by the mark, and that that message must be immediate and direct, without requiring further thought. A word can be a laudatory term that describes the positive quality of goods or services, without being an immediate and direct description of a particular characteristic, but may still lack distinctiveness. Such marks may fall foul of s.3(1)(b).

75. In fact, the thrust of the Respondent's Counterstatement to the Opposition was not that the word WOW was descriptive of a particular characteristic of goods, but rather that by itself it was a non-distinctive, laudatory and descriptive word, commonly used to show surprise or pleasure. The Respondent referred to numerous other registered trade marks which featured the word WOW in respect of the same or similar goods and services to argue that it was a commonly used element in class 3 such that it was unlikely that use of the word WOW in a non-stylised form would be seen as an indication of trade origin .

76. The Appellant also submitted that *"the Hearing Officer found that Fiver's evidence had **not** established that the word WOW was laudatory"* [33]. The Hearing Officer said:

> *"I am not satisfied that Fiver's evidence has demonstrated that the word 'WOW/wow' **was shown** to be a laudatory or a promotional statement **as to the nature, intended purpose and positive characteristics of the goods** or was shown to be in general use at the date Federici applied to register its mark either in commerce generally or more specifically in the cosmetic/hair/ toiletries industry."* [emphasis added]

That is not the same as saying that the word WOW did not have a laudatory meaning. It was limited to what the Respondent's evidence showed.

77. The Appellant relied on the Court of Justice of the EU's judgments in *Audi v OHIM* Case C-398/08 P and *OHIM v Erpo Mobelwerk* Case C-64/02 P in support of its contention that the fact that WOW might be a laudatory phrase does not prevent it from having distinctive character. This is correct as far as it goes, but the mark must still be capable of acting as an indication of commercial origin of goods or services in order to be distinctive.

78. The Court of Justice of the EU in *Erpo* made it clear that for a trade mark to be distinctive, the mark must make it possible:

> *"to identify the product for which registration is sought as originating from a given undertaking and therefore to distinguish the product from those of other undertakings and, therefore, is able to fulfil the essential function of the trade mark.... According to the case-law, that distinctiveness must be assessed, first, in relation to the goods or services in respect of which registration is applied for*

> *and, second, in relation to the perception of the relevant public, which consists of average consumers of the products or services in question, who are reasonably well informed and reasonably observant and circumspect"* (paragraphs 42 and 43).

79. The mark which was the subject of the *Audi* judgment was "*Vorsprung durch Technik*", which meant, among other things, advance or advancement in technology. The Court found that the General Court had erred in finding the mark to lack distinctive character because the mark was perceived as a promotional formula, and held that *"the mere fact that a mark is perceived by the relevant public as a promotional formula, and that, because of its laudatory nature, it could in principle be used by other undertakings, is not sufficient, in itself, to support the conclusion that that mark is devoid of distinctive character"*. In reaching the conclusion that the mark was distinctive, the Court held that the combination of words "*Vorsprung durch Technik*":

> *"suggests, at first glance, only a casual link and accordingly requires a measure of interpretation on the part of the public. Furthermore, that slogan exhibits a certain originality and resonance which makes it easy to remember. Lastly, insomuch as it is a widely known slogan which has been used by Audi for many years, it cannot be excluded that the fact that members of the relevant public are used to establishing the link between that slogan and the motor vehicles manufactured by that company also makes it easier for that public to identify the commercial origin of the goods and services covered."*

80. It is therefore necessary to look at all the relevant factors, in addition to its laudatory nature, in order to decide whether WOW is lacking in distinctive character.

81. The Respondent argued that the number of trade marks on the UKIPO and WIPO registers which included the word WOW showed that it was difficult for any entity to acquire an exclusive reputation in the word. The Hearing Officer was right to reject the state of the register evidence as giving no indication of how those marks were actually used in the marketplace, if at all [30]. However, the evidence filed by the Respondent was of some relevance to the issue of how the word WOW would be perceived, and so can therefore also be taken into account when considering the application of s.3(1)(b), giving it the appropriate weight in light of the Hearing Officer's criticisms of it.

82. It is relevant that in overturning the Hearing Officer's decision in relation to s.3(1)(c), I did not find that the Appellant's 772 Mark was not descriptive. On the contrary, I found that the evidence demonstrated how it could be used in several different ways, each of which were descriptive in one sense or were used in accordance with one of the ordinary and common meanings of the word WOW. Just because those descriptive meanings did not

cause the consumer to immediately and directly attribute a single, specific meaning to the word WOW to a characteristic of the goods in respect of which the mark was used, does not mean that the word WOW does not lack distinctiveness.

83. The Appellant referred to the fact that the Hearing Officer had been given a number of different definitions of the word WOW such that it was *"not unequivocally laudatory"*. I accept that the fact that a word has a number of different meanings is a relevant factor which must be taken into account in the overall assessment under s.3(1)(b)*(*see the judgment of 16 June 2021*, Magnetec v EUIPO (CoolTUBE), T-481/20,* not published*, EU:T:2021:373,* paragraph 37*).* However, the fact that the word WOW has several potential meanings does not mean it does not lack distinctiveness when considered in the context of the goods for which the Appellant's 772 Mark is registered.

84. My comments on the evidence above in relation to how the mark WOW may be perceived by the average consumer are relevant to the assessment of distinctiveness under s.3(1)(b). The Appellant's 772 Mark consists of a short, single word which is commonly used in a laudatory manner as an expression of amazement or surprise, or as part of common phrases such as *"the WOW effect"* or *"the WOW factor"*. It is a word which other traders should be free to use, particularly in the cosmetics and hair industries where the appearance of the user is closely related to the products in relation to which the mark would be used, which makes its laudatory message particularly apt.

85. Taking all these factors into account, I consider that the average consumer of the cosmetic and hair products covered by the Appellant's 772 Mark will perceive the word WOW as conveying a laudatory message regarding those goods, and will not perceive it as an indication of the commercial origin of those goods.

86. The appeal therefore fails in relation to s.3(1)(b) because I have found that the Appellant's 772 Mark is devoid of any distinctive character, not for the reasons given by the Hearing Officer, but for the other reasons set out above. The Appellant's 772 Mark should therefore be declared invalid unless the Hearing Officer was wrong to find that the Appellant's 772 Mark had not acquired distinctiveness through use.

Acquired Distinctiveness

87. In paragraph 69 of the Decision the Hearing Officer found as follows in respect of acquired distinctiveness:

"63. Taking account of Federici's evidence, I find that the use has been geographically widespread and its sales and promotional activity have been longstanding. However, the use of the mark is largely not for the mark as registered, namely the word only mark WOW/wow but rather predominantly for the figurative '458 mark and for the words COLOR WOW. Some use is shown for the words COLOR WOW COLOR or WOW COLOR WOW. Other than the reviews and the advert stills, very little if any other evidence is shown referencing Federici's word only WOW mark being used as an indicator of trade origin. The reviews themselves are not determinative, given that it is difficult for consumers to reproduce a device when referring to a mark in text and also it would be unnecessary for them to refer to the mark in full for the purposes of distinguishing a provider, when a comment is being left next to that provider's own goods. Furthermore, a number of entries show the word 'wow' being used descriptively as an exclamation rather than as a trade mark.

64. The assessment regarding the claim to acquired distinctive character must take into account the use that is being made of the mark. If the mark in use is in a form which does not alter the distinctive character of the mark to the form in which it is registered, this is permissible. It is necessary therefore to consider in what does the distinctive character of the mark lie.

65. I have found that the word WOW solus is descriptive and is non-distinctive.

66. By contrast the figurative mark frequently used by Federici does have some distinctive character, by virtue of the additional elements COLOR WOW and its particular stylisation (although the stylisation is not overly remarkable). These elements will clearly affect the way in which the mark is perceived by consumers as an indicator of trade origin, such that they will not see that the distinctiveness of the mark resides in the word WOW solus. Even when it is referred to in text, it is referred to predominantly as COLOR WOW or in some instances as WOW COLOR WOW. Even when used in text form as WOW COLOR WOW, the distinctiveness lies in the repetition of the word WOW and the combination of these elements. The use of the mark COLOR WOW by Federici is distinctive only because of the combination/juxtaposition of these words, notwithstanding that the word COLOR is also a non-distinctive element when used in relation to hair colourants and hair dyes. I do not find that Federici has shown that it has acquired distinctive character in the word WOW solus. On this basis whilst it has shown acquired distinctiveness, it is not in the mark which is the subject of this invalidation and is not in a variation which could be said does not alter the distinctive character of the mark.

67. As was stated by Ms Emma Himsworth sitting as the Appointed Person in 'The Cannabis Clinic' (BL O/777/21), at paragraph 57, where she was considering the use of devices and other elements in the assessment of distinctiveness:

> *"In the context of an assessment of an application that is comprised of several elements where one or more of such elements are such as to designate a characteristic of the goods or services it is necessary for the decision taker to consider whether the other elements are such as to divert the average consumer's attention away from or to modify the descriptive element or elements of the mark. That this is appropriate is confirmed both in the judgment of Arnold J. as he then was in Starbucks (HK) Ltd v. British Sky Broadcasting Group Plc [2013] FSR 29; and Case T-*

> *223/17 Adapta Color, SL v. EUIPO which were cited by the Hearing Officer. Any suggestion that the Hearing Officer should not have referred to the judgment of Arnold J. in this context is in my view unfounded."*
>
> *68. Whilst this case related to the assessment of distinctiveness of a stylised mark, the same is true here. If the additional elements and stylisation divert attention away from or modify the descriptiveness of the simple word, then the distinctiveness of the mark is altered. I find this to be the case here.*
>
> *69. I do not find that the evidence establishes that, by the relevant date, the word WOW/wow solus was factually distinctive of Federici to a substantial proportion of the relevant public for hair care products. Any distinctive character that Federici has acquired is not in the word WOW solus but is in the figurative mark or the other text used which combine the word WOW with other words."*

88. The Appellant acknowledged in its skeleton argument for the hearing before me that the evidence filed in support of acquired distinctiveness was *"chiefly as part of the device mark or a close variant thereof"* but submitted that the Hearing Officer gave *"no sufficient weight"* to the evidence and failed to apply the correct approach in assessing it.

89. In particular, the Appellant argued that the Hearing Officer applied the wrong test, when she stated in paragraph 64 of the Decision:

> *"If the mark in use is in a form which does not alter the distinctive character of the mark to the form in which it is registered, this is permissible. It is necessary therefore to consider in what does the distinctive character of the mark lie."*

90. I agree with the Appellant that the Hearing Officer may have been referring inadvertently in the penultimate sentence of that paragraph to the test for whether there has been genuine use of a mark.

91. It is possible for a trade mark to acquire distinctiveness through use of the mark as part of or in conjunction with a registered trade mark, and the correct test where a trade mark may have been used as part of another mark was confirmed by Kitchin LJ in *Societe des Produits Nestle SA v Cadbury UK Ltd* [2017] EWCA Civ 358:

> *"52. The applicant must prove that, as a result of the use he has made of the mark, a significant proportion of the relevant class of persons perceive the goods designated by that mark, as opposed to any other mark which might also be present, as originating from a particular undertaking. Put another way, the mark must have come to identify the relevant goods as originating from a particular undertaking and so to distinguish those goods from those of other undertakings."*

and by Floyd LJ in his judgment in the same case:

> *"102. The test for whether a mark which has no inherent distinctiveness has nevertheless acquired a distinctive character must now be regarded as settled. It is that a significant proportion of the relevant class of consumers perceive goods designated by the mark applied for as originating from a particular undertaking. It*

is a requirement of Article 3(3) of the Directive that there has been use of the mark applied for before the date of application. But there is no requirement that the use should be of the mark on its own: the use may be in conjunction with another mark or marks.".

92. Relevant criteria to be taken into consideration were laid down in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee [1999] ECR I-2779, paragraphs 49 and 51*

> *"49 In determining whether a mark has acquired distinctive character following the use made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking, and thus to distinguish that product from goods of other undertakings.*
>
> ...
>
> *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."*

93. While the Hearing Officer may have inadvertently referred to the genuine use test in paragraph 64 of the Decision, she did set out paragraphs 51-53 from the *Windsurfing* judgment in paragraph 49 of the Decision, and it is clear from the paragraphs which deal with her analysis of the evidence that, in fact, she did take the correct issues into account.

94. In particular, she noted that the screenshots of products included in the evidence of Mr Federici *"show the use of the '458 mark on the products themselves and of the words COLOURWOW but not the word WOW solus"* [53].

95. She also referred to a code CW *"used internally and on invoices when describing these goods"*, which Mr Federici explained in his evidence was used to refer to "*color wow*". She noted that a screenshot of an internet search for *"wow hair products UK"* showed the various outlets where the Appellant's products were sold, saying *"The majority of the results refer to Federici's goods as COLOR WOW or by reference to the figurative '458 mark rather than the word WOW solus"* [55].

96. She referred to the table showing UK sales figures, noting that they were not broken down by product type, which therefore gave her no assistance in breaking down the sales

figures into sales which may have been relevant evidence in support of use of the word WOW as having acquired distinctiveness [56].

97. She described the evidence of press and media coverage which showed use of the Appellant's 458 Mark and noted that when the mark was referred to in text, it was as COLOUR WOW rather than WOW solus [58].

98. She referred to the marketing activities on social media, which included numbers of followers but with no indication of where those followers were located [59]. She also referred to TV commercials which included stills of the Appellant's *"Everybody say WOW"* advertising campaign from 2016 for its Root Cover Up product. The stills showed the Appellant's 458 Mark on the product itself and the text referred to the *"Color Wow Ad"*. The Appellant sought to criticise the Hearing Officer for only referring to the stills which had been exhibited as part of the evidence and for not having clicked on the link to the advert which had been provided. This is an unfair criticism as the Trade Mark Rules make it clear that hearing officers are not expected to click on links.

99. The Hearing Officer also referred to 29 customer reviews from Amazon UK dated between 2014 and 2022 which were exhibited to Mr Federici's second statement [61]. These were said by the Appellant to show its products being referred to as WOW, including comments such as *"WOW the name says it all"*, *"I seen [sic] the wow product recommended in a magazine and I was not disappointed …"*, *"Used WOW on advice of my hairdresser …"*, *"They gave this product the right name, yes WOW"*, and *"OMG no wonder they call this WOW!!!!!"*. Images of the goods were not shown appearing alongside the reviews.

100. The Appellant criticised the Hearing Officer's comments in relation to these adverts, saying that they were *"not readily comprehensible."*. The Hearing Officer said:

> "*the reviews themselves are not determinative, given that it is difficult for consumers to reproduce a device when referring to a mark in text and also it would be unnecessary for them to refer to the mark in full for the purposes of distinguishing a provider, when a comment is being left next to that provider's own goods.*".

101. I read those words as the Hearing Officer saying that where a review is being left in a text-only format, it would have been impossible for the consumer posting the review to reproduce an image of the Appellant's 458 Mark or another device mark used by the Appellant in relation to the goods in issue. As such, the consumer has no choice but to refer to the product using a form of shorthand such as the word "WOW", even though

they may perceive the brand to be all the elements of the Appellant's 458 Mark or another device mark taken together, rather than the word WOW alone. Similarly, the Hearing Officer was saying that it may be quicker for the reviewer to use that form of shorthand when used next to an image of the goods which shows the brand in full, as it would be obvious to the reader what brand was being referred to by the shorthand. I consider both of these points to be valid.

102. Nor do I accept the Appellant's criticisms of the Hearing Officer that paragraph 66 of the Decision shows that she erred *in "focusing on the elements of the device mark as registered as she perceived them rather than on assessing the likely effect on the average consumer of the way in which the device mark was actually used on Federici's products as shown in the evidence …".* She referred in paragraph 66 of the Decision to the way in which the elements additional to the word WOW *"will clearly affect the way in which the mark is perceived by consumers as an indicator of trade origin, such that they will not see that the distinctiveness of the mark resides in the word WOW solus"*, and described how the mark was used as it appeared in the evidence.

103. I also reject the Appellant's assertion that the Hearing Officer was wrong to refer to *'The Cannabis Clinic'* decision because it was a decision on inherent distinctiveness. The extent to which the word WOW, when used with other elements, would be perceived as descriptive was a relevant issue for the Hearing Officer to consider as part of her overall assessment. Her comments in paragraphs 68 and 69 of the Decision confirm that she was considering the extent to which the WOW element would be perceived by consumers on its own as a badge of origin, without the additional elements which she found did alter the distinctiveness of the word WOW.

104. The Appellant also criticised the Hearing Officer for failing to mention the evidence of Graeme Riddick in the section of the Decision on acquired distinctiveness, stating that this showed that she gave no weight to it. The Hearing Officer is not required to refer to every piece of evidence in the Decision, and her not mentioning it in that section of the Decision does not mean that she did not take it into account as part of her overall assessment – see the extract from *Tiktok* in paragraph 19 above. Nevertheless she referred to Mr Riddick's evidence in paragraph 15 of the Decision, acknowledging that the Appellant's evidence sought to *"introduce evidence that UK consumers refer to and know Federici's goods solely by reference to the word WOW"*, and stated in paragraph 16:

> *"I have read and considered all the evidence and authorities filed by the parties and taken them into account in coming to this decision. Whilst I have not summarised these documents, I shall refer to them to the extent I consider necessary during my decision."*.

I therefore reject this criticism of the Hearing Officer.

105. The Hearing Officer undertook a thorough review of the evidence and concluded that it did not demonstrate sufficient use of the word WOW in order to be able to decide that consumers identify the Appellant as the source of the relevant goods from the word WOW alone as opposed to the other words which the Appellant uses, and/or the device elements such as those which feature in the Appellant's 458 Mark. The Hearing Officer did not err in her assessment of that evidence in order to reach that conclusion. Accordingly, even though she may have incorrectly referred to the genuine use test in the penultimate sentence of paragraph 64 and the second half of the final sentence of paragraph 66 of the Decision, the questions which she asked herself and the conclusions she reached in assessing the evidence of use of the word WOW meant that in actuality she did apply the correct test. She was entitled to find that the evidence relied on did not demonstrate the actual impact of the use of the word WOW in relation to the products on the UK market, or the actual knowledge of that particular mark by the relevant public.

106. The appeal in respect of acquired distinctiveness therefore fails.

Opposition

107. Since the appeal against the Hearing Officer's cancellation of the Appellant's 772 Mark was unsuccessful, I will go on to consider the Appellant's grounds of appeal in relation to the Hearing Officer's rejection of the opposition relying solely on the Appellant's 458 Mark.

108. The Appellant argued that the Hearing Officer wrongly concluded that there was no likelihood of confusion by misdirecting herself by not correctly applying the relevant tests as to assessing whether the marks were similar and as to whether a likelihood of confusion would be present.

Visual similarity

109. On visual similarity, having found the word WOW to be non-distinctive, and that the word LONDON was a geographical indicator, the Appellant submitted that the Hearing Officer erred in concluding that *"neither word particularly dominates"* in the Respondent's Mark, and that in the Appellant's 458 Mark the *"overall impression of the*

mark resides in its totality". The Appellant submitted that the Hearing Officer should have found the marks to be visually similar to *"no less than a low to medium degree",* rather than low.

110. There is no suggestion that the Hearing Officer applied the incorrect legal test, having set out the relevant cases and principles in paragraphs 86, 105 and 106 of the Decision. As such, in order to persuade me that the Hearing Officer erred in finding a low degree of similarity, the Appellant must persuade me that her conclusion was *"outside the bounds within which reasonable disagreement is possible"*.

111. I consider that her assessment that the Respondent's Mark "c*onsisted of two non-distinctive words WOW LONDON presented in a black unremarkable font in capitals one above the other*" was a fair description of the mark and although, as she acknowledged, the word WOW is larger than the word LONDON, her conclusion that *"the overall impression of the mark as a whole therefore resides in the two non-distinctive elements in combination"* was one a reasonable tribunal could have reached. The same can be said for her conclusion that the overall impression of the Appellant's 458 Mark *"resides in the combination of the words WOW COLOUR WOW and the particular presentation/configuration of the first WOW element"*. As a result, her conclusion that the respective marks were only similar to a low degree, due to the differences in the particular presentation of the marks, *"vertically as opposed to laterally and the additional words present in each"*, was one she was entitled to reach.

Aural similarity

112. On aural similarity, the Appellant argued that because the Hearing Officer had acknowledged that the word WOW would be more likely to be the first element seen and read in both marks, she erred in finding only a low degree of aural similarity, arguing again that she should have found the marks to be aurally similar to *"no less than a low to medium degree"*. Again, I find no error in the Hearing Officer's assessment or conclusion on aural similarity when comparing WOW with WOW COLOR WOW.

Conceptual similarity

113. On conceptual similarity, the Appellant said that the Hearing Officer was inconsistent by finding that the marks were only conceptually similar to a medium degree when she found in the same paragraph ([113]) that *"Given that the subject matter of the marks is WOW and this is the meaning that dominates, then, overall, the respective marks are*

similar conceptually to a medium degree" and *"The common element WOW is conceptually identical"*. I do not consider that there is any inconsistency. The Respondent's Mark included the word LONDON and the Appellant's 458 Mark included the word COLOR. Each word would have contributed some conceptual meanings to the respective marks which differed from each other, such that when considered overall, the marks were not conceptually identical.

114. Lord Justice Arnold recently said the following in *TVIS Limited v Howserv Services Limited and others* [2024] EWCA Civ 1103 when dealing with the appellant's submission that the judge had erred by simply holding that the marks in issue in that case were visually and aurally *"similar"* rather than *"highly similar"*:

> *"34. I do not accept this argument for two reasons. The first is that no error of principle on the part of the judge has been identified. The assessment of the degree of visual and aural similarity between a sign and a trade mark is a matter for the first instance tribunal. Nor can it be said that the judge's assessment is plainly wrong.*
>
> *35. The second and more fundamental reason is that, while it is conventional for first instance tribunals in trade mark cases to articulate their assessment of the degree of visual and aural similarity between signs and trade marks using words such as "high", "medium" or "low", there is no legal requirement for tribunals to do so. All that is required is for the tribunal to assess the nature and extent of any similarities. This is because what matters is not the verbal label that is applied to the assessment, but whether the similarities in conjunction with the other factors which must be taken into account lead to a likelihood of confusion. It is possible for there to be no likelihood of confusion despite a relatively high degree of visual and aural similarity. Equally it is possible for there to be a likelihood of confusion despite a relatively low degree of visual and aural similarity. It depends on the other factors that are in play."*

115. I therefore find no error in the Hearing Officer's assessment of the visual, aural or conceptual similarity of the respective marks.

<u>Likelihood of confusion</u>

116. In addition to the alleged incorrect approach to the issues of visual, aural and conceptual similarity, which I have rejected, the Appellant argued that the Hearing Officer erred by:

    a. Failing to give sufficient regard to the evidence of extensive use of the Appellant's 458 Mark by only increasing its distinctive character from low to medium as a result of such use;

b. Failing to give sufficient regard to her finding that some of the goods covered by the Respondent's Mark were identical and others were highly similar to those covered by the Appellant's 458 Mark;

c. Failing to give any or adequate or proper consideration to how the Respondent's Mark would be perceived by the average consumer, in particular bearing in mind that visual considerations were likely to dominate, imperfect recollection and notional and fair use, including how the Respondent had actually used its mark; and

d. Failing to have any regard to the decision in *WOW Skin Science* BLO/550/21, where a likelihood of indirect confusion had been found.

117. On the evidence issue, the Hearing Officer found that the Appellant's 458 Mark only had a low degree of inherent distinctiveness, but found that the distinctiveness had been enhanced through use to a medium degree in respect of hair preparations, lotions, serums and sprays, shampoos, conditioners as well as for hair colourants in various forms and hair products with colouring effects. I found the Hearing Officer's review of the evidence to be thorough and there is nothing to suggest that her conclusion that the distinctiveness should be enhanced from low to medium was *"rationally insupportable"*.

118. The fact that some of the goods were found to be identical is just one of the factors which the Hearing Officer had to take into account in her overall assessment of the likelihood of confusion, so her ultimate conclusion of no finding of a likelihood of confusion does not represent any error of principle or law.

119. The same applies equally to the points raised under paragraph 116(c) above, and the fact that visual considerations were likely to dominate does not assist the Appellant when I have found that the Hearing Officer was entitled to find that the respective marks only shared a low degree of similarity in respect of both their visual and aural similarity.

120. Finally, the Hearing Officer was not bound by the decision in *WOW Skin Science*, which in any event related to a different trade mark.

121. I agree with the Hearing Officer's conclusion that the average consumer would notice the differences between the respective marks such that there was no likelihood of direct confusion. Further, I do not find any error in the reasoning set out in paragraphs 126 to 131 of the Decision where the Hearing Officer explains how she arrived at her conclusion that there was no likelihood of indirect confusion.

122. I therefore reject the Appellant's appeal in respect of the Opposition.

Conclusion

123. The Respondent's Mark shall proceed to registration for all of the goods applied for, and the registration of the Appellant's 772 Mark shall be deemed never to have been made and shall be removed from the register.

Costs

124. While the Appellant was ultimately unsuccessful, I did find that the Hearing Officer erred in respect of s.3(1)(c). I will therefore make an appropriate reduction in the total costs to be awarded to the Respondent in respect of the appeal, and will reduce the amount ordered by the Hearing Officer to be paid in respect of the proceedings before her from £2,500 to £2,000. I therefore order that the Appellant shall pay the sum of £1,000 to the Respondent in respect of the appeal, to be added to the £2,000 in respect of the proceedings below, giving a total sum of £3,000 to be paid within 21 days of the date of this decision.

Simon Clark
The Appointed Person
17 March 2025

Representation:

Appellant: Edward Bragiel, instructed by Antinghams Solicitors.

Respondent: Georgina Messenger, instructed by Mathys & Squire LLP.