

O/0707/26

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 4081585
IN THE NAME OF SALON PROFESSIONAL BRANDS LIMITED
TO REGISTER THE FOLLOWING TRADE MARK:**

pHinish

IN CLASS 3

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 450828
BY AVEDA CORPORATION**

BACKGROUND AND PLEADINGS

1. On 30 July 2024, Salon Professional Brands Limited (“the applicant”) applied to register the trade mark **pHinish** in the UK, under no. 4081585 (“the applicant’s mark”). Registration is sought for the following goods:

Class 3: Hair care preparations; shampoos and conditioners; hair styling products and preparations; hair styling gels, waxes, creams and lotions; mousses and sprays for hair styling; hair straightening preparations hair dyes; hair colorants; tints for the hair; hair colour removers; hair waving preparations; hair cosmetics; hair lotions; hair bleaching preparations; hair gels, hair mousse, hair sprays, hair dressings, hair lacquers, hair moisturisers, hair oils, hair tonic, hair creams, hair wax; hair preservation treatments; hair desiccating treatments.

2. Details of the application were published for opposition purposes on 16 August 2024. On 18 November 2024, Aveda Corporation (“the opponent”) opposed the applicant’s mark under sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. For the purposes of its claims under sections 5(1), 5(2)(a) and 5(3), the opponent relies upon its UK trade mark no. 800919293, **PHINISH** (“the opponent’s mark”).¹ The opponent’s mark was filed on 12 March 2007 and became registered on 17 March 2008. It stands registered for the following goods:

Class 3: Hair care creams; hair care lotions; hair care preparations; hair cleaning preparations; hair conditioners; hair creams; hair lotions; hair shampoo.

¹ The opponent’s mark is a comparable mark based upon its international registration designating the EU no. 919293. This mark was automatically created on 1 January 2021 in accordance with article 56 of the Withdrawal Agreement between the UK and EU.

4. The opponent's mark qualifies as an 'earlier trade mark' in accordance with section 6 of the Act. As it had completed its registration process more than five years before the filing date of the applicant's mark, it is subject to the use requirements specified in section 6A of the Act.

5. Under sections 5(1) and 5(2)(a) of the Act, the opponent relies upon all the goods of its mark, save for *hair shampoo*. The opponent contends that the competing marks are identical and that the parties' goods are identical. In addition, or in the alternative, the opponent argues that the competing marks are identical and that the parties' goods are similar, resulting in a likelihood of confusion.

6. Under section 5(3), the opponent claims that it has a reputation in the UK in respect of all the goods of its mark, save for *hair shampoo*. It argues that use of the applicant's mark, without due cause, would take unfair advantage of, and be detrimental to, the repute and distinctive character of its mark. The opponent also claims that the relevant public will mistakenly believe that there is an economic connection between the parties.

7. As for section 5(4)(a), the opponent claims that it has substantial goodwill in its business in relation to which it has used the sign **PHINISH** throughout the UK since 2010. The sign is said to have been used in relation to *hair care preparations*. The opponent contends that use of the applicant's mark would constitute passing off.

8. The applicant filed a counterstatement, denying the grounds of opposition. It did not deny that the competing marks were identical or that the parties' goods were identical or similar. However, it put the opponent to proof of use in respect of its mark, denied that the opponent has a reputation, and denied that the opponent has goodwill.

9. Only the opponent filed evidence, though the applicant filed written submissions during the evidence rounds. A hearing was requested and held before me, by video conference, on 8 July 2026. The opponent was represented by Ian Bartlett of Beck Greener LLP. The applicant has been represented throughout the proceedings by Novagraaf UK but did not attend the hearing, instead relying on written submissions in lieu.

RELEVANCE OF EU LAW

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

EVIDENCE AND SUBMISSIONS

11. The opponent's evidence is given in the witness statement of Laura Maxwell, dated 8 May 2025, and three exhibits (LM1-LM3). Ms Maxwell has been employed by Estee Lauder Companies ("ELC"), of which the opponent is part, since 2007. Ms Maxwell served as General Manager of the Aveda brand, amongst others, from January 2024 until February 2025, when she became UK Vice President and General Manager. Ms Maxwell provides evidence of use of the opponent's mark/sign.

12. The applicant filed written submissions in the evidence rounds on 8 July 2025. It also filed written submissions in lieu of attending the hearing on 1 July 2026.²

13. I have taken all the evidence and submissions (including those made orally at the hearing) into account in reaching my decision and will refer to them below where necessary.

MY APPROACH

14. At the hearing, Mr Bartlett confirmed that the opponent was content for the opposition to be determined on the basis of its claims under sections 5(1) and 5(2)(a) of the Act only. The other grounds, namely sections 5(3) and 5(4)(a), therefore form no part of this decision.

² The applicant's written submissions in lieu were originally filed on 30 June 2026. However, a corrected version was filed on 1 July 2026 with a request to disregard the previous version.

DECISION

15. Before considering the opponent's claims under sections 5(1) and 5(2)(a), I must first determine whether, or the extent to which, there has been genuine use of the opponent's mark. The relevant statutory provisions are as follows:

"6A – (1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

16. Moreover, section 100 of the Act states that:

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

17. Pursuant to the above provisions, the relevant period for the present assessment is the five-year period ending with the filing date of the applicant’s mark, i.e. 31 July 2019 to 30 July 2024.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology*

Inc v Laboratories Goemar SA [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns:

Ansul at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

19. I am also guided by *Awareness Limited v Plymouth City Council*, BL O/236/13, in which Daniel Alexander QC, sitting as the Appointed Person, stated that:

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

20. Furthermore, in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, BL O/404/13, Geoffrey Hobbs QC, sitting as the Appointed Person, stated that:

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

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors.

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

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

21. The hair and skin care brand Aveda was founded in 1978.³ According to Ms Maxwell, it was acquired by ELC in 1997. She says that, throughout the relevant period, Aveda supplied its products to a network of independent hair and beauty salons throughout the UK. She confirms that there were over 390 of these salons in 2023.

22. Ms Maxwell explains that one of Aveda’s products is called ‘PHINISH’, a hair conditioner for use following the professional colouring of hair. Ms Maxwell says that it was introduced in 2006 and discontinued in the UK sometime in 2024. The packaging of the product was as follows:

³ Exhibit LM1



23. As a “*specialist preparation*” primarily intended for professional use, Ms Maxwell says that the ‘PHINISH’ product was not sold directly to the public or marketed on Aveda’s main UK website (aveda.co.uk). However, Ms Maxwell confirms that the ‘PHINISH’ product was promoted and sold to the salons it supplied throughout the UK during the relevant period. The product is said to have been marketed to its network of salons through the UK section of another of Aveda’s websites (avedapurepro.com). Ms Maxwell provides printouts of the same.⁴ These are not dated within the relevant period but, rather, reflect the position at the date of Ms Maxwell’s statement. She says that printouts of the website were not available from an internet archive, but confirms that the printouts she has provided are indicative of how it appeared at the filing date of the applicant’s mark. There is no use of ‘PHINISH’ in the printouts. Ms Maxwell explains that information about the ‘PHINISH’ product would have been available on this website, behind a login page, during the relevant period.

24. Ms Maxwell provides the following turnover figures for sales of ‘PHINISH’ products in the UK:

⁴ Exhibit LM2

Year	Units	Turnover (£)
2019	796	7,888
2020	600	5,986
2021	342	3,642
2022	268	2,803
2023	55	602
Total	2,061	20,921

25. Examples of sales invoices are provided in support.⁵ They are dated 2 June 2021, 29 July 2021, 1 July 2022 and 6 March 2023. They show the sale of six products described as “*COLOR CONSERVE PHINISH BB*” in total to three hair salons in Essex, Yorkshire and Lincolnshire. The total value of the sales shown in these invoices was £66.96.

26. I recognise that an assessment of genuine use is a global assessment which involves looking at the evidential picture as a whole.⁶ Nevertheless, the assessment is forensic and stringent.⁷ Genuine use cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the mark on the market concerned.⁸ In my view, the evidence is light on detail and limited in a number of ways. For instance, there are no details of the size of the relevant market or any evidence demonstrating the share of that market held by the ‘PHINISH’ product at any time during the relevant period. Moreover, there is no information regarding any amounts spent on advertising or promoting the mark in the UK, and no direct evidence of any such activities being conducted. Other than the approximate number of them as of a certain year, no information is given regarding the salons in the network. This is all evidence which is likely to exist but has not been provided by the opponent. In addition, whilst I accept that there is no requirement to provide any particular kind of documentation, there is no evidence that the opponent promoted the ‘PHINISH’ product through social media, the press, at trade fairs or

⁵ Exhibit LM3

⁶ *New Yorker SHK Jeans GmbH & Co. KG v OHIM*, Case T-415/09

⁷ *W Sternoff LLC v Peter Kertels*, BL O/0984/25, paragraph 15

⁸ *easyGroup*, paragraph 107

exhibitions. There is also no evidence of, for example, consumer or industry recognition.

27. Whilst I accept that the mark was displayed on product packaging, evidence of actual use of the mark, showing how the mark was encountered in the marketplace, is extremely limited. For instance, there is no evidence of how the mark was displayed on the website during the relevant period. I appreciate that Ms Maxwell says that dated printouts of the website from between 2019 and 2024 were not available through internet archiving facilities. However, there are not even representative marketing materials showing the 'PHINISH' product to combine with the printouts of the website as it looked at the date of her statement and her narrative evidence confirming that this is how it appeared during the relevant period. There is also no information about how many individuals logged in or used the website during the relevant period (albeit out of a maximum of around 390 salon owners). Such evidence could have assisted with demonstrating how consumers encountered the mark and indicating how many consumers were exposed to it through the website during the relevant period. The issues with the website evidence are of particular concern, given that it appears to have been the only way that the mark was presented to potential consumers.

28. Turnover figures have been provided which show that between £13,033 and £20,921 was generated during the relevant period from the sale of 2,061 'PHINISH' products.⁹ Without details of the relevant market, it is difficult to contextualise those figures or assess their significance. However, it is my impression that there must be an extremely large number of hair salons in the UK, and I do not consider it controversial to suggest that hair conditioner is a product that such undertakings are likely to purchase regularly for ongoing use. In the circumstances, the turnover figures indicate a low volume of trade. In addition, the turnover figures are low at the beginning of the relevant period and diminish further throughout, until the point at which the opponent discontinued the product altogether. Only four invoices have been provided and, whilst I acknowledge that they are merely examples, it is difficult to properly ascertain how intensive, geographically widespread and longstanding use of the mark

⁹ The relevant period begins part way through 2019, meaning that some of the sales for that year are likely to have occurred before the relevant period. As such, I have given a minimum and a maximum figure.

was from them. They represent a very low level of business, with the sample sales also being limited to three customers in three locations in England.

29. The goods are not niche or truly specialist; there is no evidence that, target consumer aside, the nature of hair conditioners used in salons materially differs from those purchased by the general public. Ms Maxwell does not explain the basis on which she says that 'PHINISH' was a specialist product. The product was not marketed to the wider professional market, which is itself a narrower potential customer base than the general public to begin with. It seems that the opponent has elected to limit its own market by only selling the 'PHINISH' product to professional salon owners who were part of its network. On the basis of the evidence before me, it seems that they were the only potential consumers who could have purchased the product, with the mark having been exclusively marketed to them behind a login page. I say none of this to criticise the opponent for its commercial strategy. Rather, it is to highlight that the opponent was not limited to only around 390 professional consumers because of the nature of the goods or features of the market.

30. I appreciate that the task at hand is not to assess whether there has been large-scale commercial success. I also acknowledge that, as the authorities indicate, use does not have to be quantitatively significant for it to be deemed genuine and there is no *de minimis* rule. However, it is not the case that any use within the relevant period which is not token use means that a finding of genuine use must follow; it must be justified in the economic sector concerned.¹⁰ The smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use.¹¹ As I have said, the sales information indicates a low level of commercial activity. That activity was confined to the opponent's own salon network and promoted through a restricted-access website. Again, whilst I do not criticise the opponent's commercial approach, it necessarily limited the extent to which the mark was exposed to potential consumers. In such circumstances, and bearing in mind the low level of commercial activity shown by the sales figures, one might reasonably expect more extensive supporting evidence

¹⁰ See Arnold LJ's seventh and eighth points in *easyGroup*, set out above, and *The Little Brown Box Pizza, LLC v Rashid Ray*, BL O/0870/24, paragraphs 16-17.

¹¹ *easyGroup*, paragraph 107

demonstrating the extent to which the mark was used. However, there is very little other evidence with which to place the figures in their proper commercial context.

31. Taking all the evidence into account, I am not satisfied that the opponent has demonstrated that the use shown was sufficient to create or maintain a market for the goods relied upon during the relevant period. In my view, although the evidence certainly establishes some sales of a product bearing the mark during that time, it falls short of demonstrating genuine use.

32. The consequence of this finding is that the opponent's mark may not be relied upon to support the opponent's claims under sections 5(1) and 5(2)(a) of the Act. These grounds must inevitably fail.

CONCLUSION

33. The opposition has failed in its entirety. Subject to any appeal against this decision, the applicant's mark will proceed to registration in the UK for all the specified goods.

COSTS

34. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of **£1,300**, which is calculated as follows:

Considering the opponent's statement and preparing a counterstatement	£350
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Considering and commenting upon the opponent's evidence ¹²	£450
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¹² Whilst the award for this activity falls below the scale minimum, this part of the scale is for "*preparing evidence and considering and commenting on the other side's evidence*". The applicant filed no evidence of its own and, although it would have reviewed the opponent's evidence and commented upon it through its written submissions, both were very light.

Preparing written submissions in lieu of
a hearing

£500

35. I order Aveda Corporation to pay Salon Professional Brands Limited the sum of **£1,300**. This sum is to be paid within 21 days of the expiry of the appeal period, or within 21 days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 10th day of August 2026

James Hopkins
For the Registrar