o/0721/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003938876
BY XUCHANG LADY SHOW HAIR PRODUCTS CO., LTD.
TO REGISTER THE TRADE MARK:

IN CLASS 26

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 445205
BY PAUL MURRAY PLC

BACKGROUND AND PLEADINGS

1. On 27 July 2023, Xuchang Lady Show Hair Products Co., Ltd. ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 20 October 2023. The applicant seeks registration for the following goods under the above application:

Class 26 False hair; Hair curl clips; Hair extensions; Hair grips; Hair ornaments in the form of combs; Hair ornaments in the nature of hair wraps; Hair weaves; Human braiding hair; Toupees; Wigs; human hair; Human hair for use as wigs and hair pieces.

2. The application was opposed in full by Paul Murray PLC ("the opponent") on 11 January 2024 based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act ("the Act").

3. Under sections 5(2)(b) and 5(3), the opponent relies upon the following trade mark:

LaModa

UK registration no. UK00002591464
Filing date 15 August 2011.
Registration date 2 December 2011.
Relying upon some of the goods for which the earlier mark is registered, namely:

Class 21 Combs, hair combs and hairbrushes.

Class 26 Hair accessories, being hair slides; hair bands; alice bands; hair fasteners; hair bows; hair decorations; hair grips; hair pins and clips; hair nets; bun nets; hair rollers; hair curlers; hair curling pins; scrunchies; ponytail holders; barrettes; flower hair accessories; hair sleepies; hair clamps.

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion because of the "high similarity of the marks" and the identity and similarity of the respective goods.

5. Under section 5(3), the opponent claims that "the earlier mark has a valuable reputation associated with the goods relied upon", and therefore, in view of the similarity of the marks and the goods, the applicant's mark will be associated with the opponent, and "such use is likely to stimulate sales of the applicant's goods". The opponent claims that the applicant will "unfairly benefit economically", and would take "unfair advantage of the distinctive character of the earlier mark". Furthermore, the opponent claims that use of the applicant's mark "would generate negative associations or an image which conflicts with the reputation of the opponent", and that because the opponent has no control over the applicant's mark, if poor quality goods are offered by the applicant then this would result in damaging the opponent's reputation and has the "potential to diminish the power of attraction of the earlier mark". Lastly, the opponent claims that use of the applicant's mark will be "detrimental to the repute to the earlier mark" and that "the exclusivity of the earlier mark will be eroded as the public starts to associate the earlier mark with the applicant's goods, and not just the opponent's goods".

6. Under section 5(4)(a), the opponent relies upon its **LaModa** sign which it claims to have used across the UK since 31 December 2011 for combs, hair combs and hairbrushes, hair accessories, being hair slides, hair bands, alice bands, hair fasteners, hair bows, hair decorations, hair grips, hair pins and clips, hair nets, bun nets, hair rollers, hair curlers, hair curling pins, scrunchies, ponytail holders, barrettes, flower hair accessories, hair sleepies and hair clamps. The opponent claims that use of the applicant's mark would be contrary to the law of passing off.

7. The applicant filed a counterstatement denying the claims and put the opponent to proof of use of its class 26 goods.

8. The opponent is represented by Edwin Coe LLP and the applicant is represented by Marcin Ociepka of KBZ Legal. The opponent filed evidence in chief and written submissions during the evidence rounds. Neither party requested a hearing or

provided submissions in lieu. This decision is taken following a careful perusal of the papers.

RELEVANCE OF EU LAW

9. 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

10. The opponent's evidence consists of the witness statement of Maxwell John Murray dated 28 May 2024. Mr Murray is the Director of the opponent, a position which he has held since 18 April 2013. Mr Murray's statement is accompanied by 5 exhibits (MJM1-MJM5).

11. Whilst I do not propose to summarise them here, I have taken all of the evidence and submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

> "5(2) A trade mark shall not be registered if because –
>
> (a)…

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

13. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(a) of the Act as its filing date is earlier than the filing date of the applicants' mark.

14. As the opponent's mark has completed its registration process more than five years before the filing date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act. However, as noted above, in its counterstatement, the applicant only requested proof of use of the opponent's class 26 goods.

Proof of use

15. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

16. Section 6A of the Act states:

"(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."

17. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five years ending on the filing date of the applicants' mark, i.e. 28 July 2018 to 27 July 2023.

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 Merken 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].”

Evidence of use

19. I note the following from the opponent’s evidence:

a) The turnover figures for products sold in the UK under the “LaModa” brand is as follows:

	Annualised Sales		
Year	UK	Other	Total
2015	602,641	73,664	676,305
2016	539,842	78,306	618,148
2017	559,721	73,338	633,059
2018	546,402	75,113	621,515
2019	509,851	99,286	609,137
2020	485,694	83,253	568,946
2021	577,089	124,415	701,504
2022	618,727	116,601	735,327
2023	615,077	118,598	733,675
2024	541,939	112,541	654,480
Total	**5,596,982**	**955,114**	**6,552,096**

b) In support of the above, **exhibit MJM1** contains screenshots from Amazon.co.uk and the opponent's website showing the sale of its goods in the UK between 2018 and 2022. I note the following from this exhibit:

a. The goods which are depicted within the amazon screenshots are La Moda detanglers, hair clamps and hair grips.
b. The amazon screenshots contain reviews of the products dated between 21 August 2018 and 14 July 2021.[1]
c. Whilst the amazon screenshots are undated, I note that the hair clamps were first available on 19 March 2018 and they are priced at £0.99p and the hair grips were first available on 25 October 2017 and they are priced at £1.89.
d. A company brochure which contains photos, names and "LM" product codes for the opponent's goods, including hair bands, clips, sleepie hair clips, clamps, alice bands, combs, grips, scrunchies, hair brushes, shower caps, hair pins, hair rollers, hair doughnuts and hairnets. However, this brochure is undated.
e. Wayback machine screenshots from the opponent's "LaModa Hair Accessories" website[2] page dated 24 October 2020 and 21 June 2021 lists grips, ponytailers (hair bands), detanglers, clips, grips, alice bands, clamps and barrettes as the goods sold under this brand.
f. The marks used on the goods are as follows:

PINK SHIMMER TRIANGLE CLIP

LM3756
NON SLIP PONYTAILERS

[1] There are also reviews that fall after the relevant date, which are dated between 11 August 2023 and 8 February 2024
[2] murrayshealthandbeauty.com

c) Mr Murray confirms that the opponent's LaModa goods have been sold through multiple independent retailers. I note that **exhibit MJM-2** contains the following invoices with "LM" product codes (which can be cross-referenced with the aforementioned brochure):

   a. Invoices dated 09/09/19, 27/07/20, 23/09/21,19/05/22 and 31/05/23 to TK Maxx in Watford showing the sale of detangle brushes and detanglers.
   b. Invoices dated 26/11/18 and 16/12/20 to Amazon in London showing the sale of detangle brushes.
   c. An invoice dated 16/01/19 to WH Smith in Swindon showing the sale of ponytailers, "ponytail shades" and rubber bands.
   d. An invoice dated 04/03/20 to WH Smith in Swindon showing the sale of ponytailers, hair clamps, hair clips, hairgrips, head bands and scrunchies.
   e. An invoice dated 16/12/20 to Amazon in London showing the sale of hairbrushes, hair combs, clamps, hairgrips, pintail combs, wet look combs, ponytailers, and scrunchie sets.
   f. An invoice dated 12/01/21 to Amazon in London showing the sale of detangle brushes, hair combs, pintail combs and paddle brushes.
   g. An invoice dated 01/07/21 to WH Smith in Swindon showing the sale of ponytailers, hair clamps, hairgrips, head bands, rubber bands and "ponytail shades".
   h. An invoice dated 31/03/22 to WH Smith in Swindon showing the sale of elastic bands, hair clamps, hair clips, hair grips, head bands, ponytailers, hairbands, rubber bands, "ponytail shades" and scrunchies.
   i. An invoice dated 25/05/22 and 03/01/23 to Tescos in Hertfordshire showing the sale of scrunchie sets.
   j. An invoice dated 14/10/22 to Amazon in London showing the sale of combs and paddle brushes.

d) To support the above invoices, in **exhibit MJM-3**, I have been provided with Wayback Machine screenshots dated 4 February 2023 from Tesco's showing the sale of LaModa scrunchie sets.

e) Whilst I have been provided with photos of the opponent's goods being sold in pharmacies in **exhibit MJM-4**, I note that these photos are dated by Mr Murray as between 2013 and 2017, which fall before (and thus outside) the relevant period.

f) Lastly, **exhibit MJM-5** contains a spreadsheet showing the turnover of individual LaModa goods from 2018 to 2023. It is clear that all of the LaModa goods pertain to hair accessories, brushes and combs. I also note that the LM product codes found in the brochure and invoices are present within the spreadsheet. As there is 84 pages to this exhibit breaking down the sale of LaModa goods, I do not intend to list all of the breakdown here. However, I note the following sample of goods which had some of the highest sales between 2018 and 2023:

    a. The padded cushion hair brush which had between 4,062 and 8,931 sales per year.
    b. Black scrunchies which had between 5,420 and 6,942 sales per year.
    c. Large hair clamp which had between 5,115 and 6,098 sales per year.
    d. Elastic hair bands (clear) which had between 1,708 and 8,403 sales per year.
    e. Comfort grip ponytailers which had between 10,673 and 25,532 sales per year.
    f. Assorted alice bands 3 pc which had between 2,042 and 5,262 sales per year.
    g. Ponytail band 6 thick black which had between 6,417 and 12,038 sales per year.
    h. Hair dressing comb which had between 6,321 and 15,488 sales per year.
    i. Self-grip hair rollers small which had between 2,264 and 3,611 sales per year.
    j. Hair grips medium black which had between 8,522 and 14,467 sales per year.
    k. Silver sleepie hair clips which had between 1,792 and 4,730 sales per year.
    l. Head band black which had between 6,163 and 7,576 sales per year.

m. Brown slumber hair net which had between 1,621 and 5,312 sales per year.

g) I note that the above goods can also be cross-referenced with the aforementioned brochure and invoices.

Form of the mark

20. The evidence I have outlined above includes instances of the following variants of the opponents mark:

1. 

2. 

3. 

21. Variant 1 and 2 is the word “LaModa” presented in a standard white typeface, above the word “accessories”, which I find to be descriptive of the opponent’s hair accessory goods. I bear in mind that fair and notional use of a word-only mark covers use in any standard typeface and colour, and therefore I find that variant 1 and 2 is acceptable use of the opponent’s mark.

22. Variant 3 is also the word “LaModa” presented in a slightly stylised silver typeface. The slightly stylised silver typeface does not alter the distinctive character of the mark,[3]

[3] *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

which resides in the word “LaModa”, which is clearly visible and still continues to indicate origin.[4] Consequently, variant 3 is acceptable use of the opponent’s mark.

Assessment of genuine use

23. As I have found the mark used in the evidence to be acceptable, I will now consider an assessment of genuine use. This is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[5]

24. As indicated in the case law cited above, use does not need to be quantitively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

25. I have been provided with revenue made from UK sales under the opponent’s LaModa mark which for 2018 to 2022 amounts to £2,737,762.[6] This is supported by brochure evidence which clearly depicts the goods and a spreadsheet which shows the individual turnover generated by the opponent’s hair combs and brushes as well as its hair accessory goods including ponytailers, clips, clamps, bands, scrunchies, grips, pins, alice bands, nets and rollers.

26. I have also been provided with invoice evidence to show the sale of the aforementioned goods to a variety of retailers geographically spread across the UK from 2018 to 2022. I have been provided screenshot evidence from the opponent’s website, amazon.co.uk and tesco.com showing the opponent’s goods for sale during the relevant period. In my view, this evidence establishes genuine use of the opponent’s mark in relation to hair accessories during the relevant period.

[4] *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35
[5] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[6] I have also been provided with UK sales figures for 2023, however, as the relevant period is until 27 July 2023, I note that a proportion of these sales would fall outside the relevant period.

Fair Specification

27. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

28. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

> "iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].
>
> iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].
>
> v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.

29. As noted above, the applicant only requested proof of use of the opponent's class 26 goods. Therefore, the opponent can rely on all of its class 21 goods being combs, hair combs and hair brushes without having to prove that it has been genuinely used the earlier mark in relation to those goods.

30. Clearly, the evidence shows that the opponent has sold a range of hair accessory goods during the relevant period, including ponytailers, clips, clamps, bands, scrunchies, grips, alice bands, nets and rollers. I note that the opponent's ponytailers are hair bands (see paragraph 19(b)(f) for an example photo from the opponent's brochure). I therefore find that the opponent has shown use for "hair bands", "alice bands", "hair grips", "hair nets", "scrunchies" and "hair clamps".

31. I note that the opponent has the term "hair pins and clips" in its specification. I note that the word "pins" and "grips" are used interchangeably to describe the same item, which is a hair accessory which is used to pin/grip the hair in place. On this basis, I find that the opponent has also shown use of this term.

32. I note that the opponent's class 26 specification has the terms "hair decorations" and "hair fasteners". I find that these are broader categories which would cover clips, pins and hair ties/bands. I accept that the majority of the opponent's above goods fall within this category, and thus, I consider that the opponent has demonstrated use of these terms. I also find that the term "ponytail holders" in the opponent's specification is a broad term which would cover bands, ties and scrunchies. These are all goods which the opponent has shown use for and therefore I find is entitled to rely on this broader term.

33. As noted in paragraph 19(f)(k) above, the "silver sleepie hair clips" are listed within the **exhibit MJM5** spreadsheet. I also note that photos of these are contained within the brochure evidence. On this basis, I find the opponent has shown use of the term "hair sleepies".

34. Whilst the spreadsheet of goods in **exhibit MJM5** shows the sale of hair slides, barrettes and flower hair accessories (such as flower grips and sleepies), these sales are very minimal. Therefore, without any further supporting evidence (such as brochure or invoice evidence), I do not consider the spreadsheet evidence alone is enough for the opponent to rely on the terms "hair accessories, being hair slides", "flower hair accessories" and "barrettes". I also note that the opponent has not provided any evidence showing the use of the terms "hair bows", "bun nets", "hair curlers" or "hair curling pins".

35. Therefore, taking the above into account, I consider a fair specification for class 26 to be:

Class 26 Hair accessories, being hair slides; hair bands; alice bands; hair fasteners; hair decorations; hair grips; hair pins and clips; hair nets; hair rollers; scrunchies; ponytail holders; hair sleepies; hair clamps.

Section 5(2)(b) - case law

36. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki*

Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

37. The competing goods are as follows:

Opponent's goods	**Applicant's goods**
Class 21 Combs, hair combs and hairbrushes. Class 26 Hair accessories, being hair slides; hair bands; alice bands; hair fasteners; hair decorations; hair grips; hair pins and clips; hair nets; hair rollers; scrunchies; ponytail holders; hair sleepies; hair clamps.	Class 26 False hair; Hair curl clips; Hair extensions; Hair grips; Hair ornaments in the form of combs; Hair ornaments in the nature of hair wraps; Hair weaves; Human braiding hair; Toupees; Wigs; human hair; Human hair for use as wigs and hair pieces.

38. When making the comparison, all relevant factors relating to the services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

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

39. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and, in particular, whether they are or are likely to be found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance, whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

40. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court ("GC") stated that:

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

41. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

42. In *Kurt Hesse v OHIM,* Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the GC stated that "complementary" means:

> "… there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking."

Hair ornaments in the form of combs.

43. I find that the applicant's above goods fall within the broader categories of "hair fasteners" and "hair decorations" in the opponent's specification. The goods are identical on the principle outlined in *Meric*.

Hair grips.

44. The above term appears identically in both parties specifications.

Hair curl clips.

45. The applicant's above goods are clips that are used to hold the hair whilst it cools, in order for the shape to hold and last for longer. I note that the opponent's "hair pins and clips" can be used for the same purpose, and overlap in nature. The goods will overlap in method of use, in that they are clipped into the hair, and they will overlap in user. The goods will also likely be sold from the same undertakings in the same aisles of beauty retail outlets and pharmacies. They are not complementary but they may be in competition. On this basis, I find that the goods are similar to a high degree.

Hair ornaments in the nature of hair wraps.

46. Without any submissions on the contrary before me, I find that a synonym for "ornaments" is "decorations" and therefore, I consider that the applicant's above hair wrap ornaments fall within the opponent's broader term "hair decorations". The goods are identical on the principle outlined in *Meric*.

False hair; Hair extensions; Hair weaves; Human braiding hair; Toupees; Wigs; human hair; Human hair for use as wigs and hair pieces.

47. Clearly, the applicant's above goods do not overlap in nature with the opponent's hair brushes in class 21. The goods also do not overlap in method of use and purpose as the applicant's above goods are used to improve the length, thickness or colour of the user's hair whereas a brush is used to untangle hair. Nonetheless, I consider that there would be an overlap in trade channels, with the same hair extension and wig undertakings selling all of the above goods to the same users. The brushes themselves may even have softer bristles in order to care for, or be gentler on, the applicant's above goods. I also consider that hair and beauty shops will sell these goods in close proximity, to the same users. However, the goods are not in competition nor complementary. Taking the above into account, I consider that the goods are similar to between a low and medium degree.

The average consumer and the nature of the purchasing act

48. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the

manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J (as he then was) described the average consumer in these terms:

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

49. The average consumer for the goods will be members of the general public. However, I do not discount that it could also include a professional user such as a hairdresser. The cost of the goods in question is likely to vary, with wigs and hair extensions being more expensive purchases, whereas hair ornaments are likely to be cheaper purchases. However, on balance, the purchase of all the goods is likely to be relatively low. The goods will also be purchased relatively frequently. The average consumer will take various factors into consideration, such as the cost, aesthetic appearance and quality of the goods. I therefore find that the level of attention paid during the purchasing process for the goods will be medium.

50. The goods are also likely to be obtained by self-selection from the shelves of a general retail outlet, beauty retail outlets, pharmacies, salons (including hairdressers) or their online equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from a hairdresser, sales assistant or representative, or via recommendations given through word-of-mouth.

Comparison of the trade marks

51. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to

analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

> "… it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."

52. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

53. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
LaModa	LEmoda

54. The opponent's word mark consists of the singular word "LaModa". There are no other elements to contribute to the overall impression which lies in the word itself.

55. The applicant's mark consists of the word "LEmoda". The applicant submits that the letter "E" is "bold and highly stylised, as it has an elongated top part up to the letter 'o' and the shape thus formed resembles the silhouette of a woman with long, loose

hair". The opponent also submits that the letter "E" is "a representation of a female with long hair". I agree with the parties' submissions, and note that, this element is allusive of the applicant's goods, which are used on hair (to brush/detangle or accessorise). This element will therefore play a lesser role in the overall impression of the mark, with the word "LEmoda" playing a greater role.

56. Visually, both marks are six letters long, starting with the letter L, and ending with the letters M, O, D and A. These all act as visual points of similarity. However, the only visual point of difference between the words is their second letter, which is the letter "A" in the opponent's mark and the highly stylised letter "E" in the applicant's mark which depicts a woman with long hair. While I bear in mind that letter "M" is capitalised in the opponent's mark, I bear in mind that normal and fair use of a word mark means that it may be used in any standard typeface, which covers all upper or lower-case lettering, as well as a combination of the two.[7] Therefore the presentation of the opponent's mark as "Lamoda" would be encompassed by fair use. Taking the above into account, I find that the parties marks are visually similar to between a medium and high degree.

57. Aurally, the applicant submits that the opponent's mark will be pronounced as LA-MO-DA and that its mark will be pronounced as LE-MO-DA. I agree that the parties' marks will likely be pronounced this way and that the stylisation of the letter "E" in the applicant's mark will not affect its pronunciation. I also find that as the second and third syllables of the marks are aurally identical, and the "L" element at the beginning of the marks is an aural point of identity, this results in the marks as a whole being aurally similar to a high degree.

58. Conceptually, the opponent submits that "neither mark has a meaning in English and so they are neither conceptually similar nor dissimilar". I agree that the words "LaModa" and "LEmoda" will not evoke any conceptual meaning to the average consumer, and will therefore be recognised as invented words. On this basis, these

[7] I also bear in mind the case of *Mr Heron* BL O/954/22 where at paragraph 15 Mr Iain Purvis KC stated that the monopoly of a word work is not limited by any features such as fonts or capitalisation appearing on the Register, listing MR HERON, mr heron, Mr Heron, Mr HERon, and Mr HERON (in a stylised typeface) as all being identical to the word mark "mr heron".

words are conceptually neutral. However, as noted by both parties, the letter “E” in the applicant’s mark is stylised so that it represents a woman with long hair. On this basis, I find that that it creates a conceptual point of difference between the marks, making them dissimilar as a whole. However, given the nature of the goods concerned, which are hair accessories, the concept of a woman with long hair has little distinctiveness.

Distinctive character of the earlier trade marks

59. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger [1999] ECR 1-2779, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

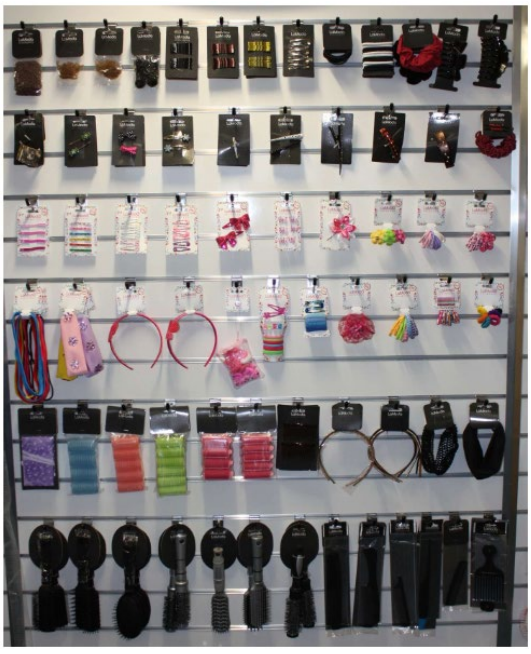
60. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

61. I will begin by assessing the inherent distinctive character of the opponent's mark. As noted above, I find that the word "LaModa" will not evoke any conceptual meaning and will therefore be recognised as an invented word to the average consumer. It is inherently distinctive to a high degree.

62. I will now assess whether the evidence filed by the opponent is sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

63. I have summarised the opponent's evidence in paragraph 19 above. However, I also note that **exhibit MJM-4** contained evidence that fell before the proof of use period. Mr Murrary dates the photos contained within this exhibit between 21 February 2013 and 16 November 2017, which shows the opponent's goods being sold in Co-Operative pharmacy, and the Well pharmacy in Merseyside, Stevenage, Nottingham, Leicester, Sheffield, Bridgend, Southampton, Chippenham, Hampshire and Durham. This exhibit included some of the following photos of the opponent's goods:



64. I have been provided with the revenue made in the UK under the opponent's mark, from 2015 to 2022 which amounts to £4,439,966.[8] This is supported by invoice evidence, photographic evidence of the goods being displayed in pharmacies across the UK, and brochure evidence, which confirms that the opponent sells hairbrushes, combs and a range of hair accessories such as hair bands, ponytailers, scrunchies, pins, grips, clamps and barrettes. The spreadsheet evidence also confirms the individual sales made of the aforementioned goods.

65. I also bear in mind the opponent was not put to proof of use for its class 21 goods, that being combs, hair combs and hairbrushes. However, as noted in my assessment of the evidence above, I have included evidence which pertains to the sale of the opponent's detangle brushes, detanglers (which are a type of hairbrush), paddle brushes and combs. The only evidence that was omitted was the 6 invoices dated 20/06/18, 09/09/19, 27/07/20, 23/09/21,19/05/22 and 31/05/23 which only shows the sale of detangle brushes and detanglers to TK Maxx in Watford. I note that the quantity of these goods sold range from 675 to 2,400 per item.

66. Nonetheless, I note that I have not been provided with any evidence of marketing or marketing figures. The opponent has also not provided evidence of its market share, and based on the sales figures provided, I find that it would only amount to a small proportion of the hair brush and hair accessory market (which I consider to be large sectors). Therefore, taking all of the above into account, I do not consider the evidence sufficient to establish enhanced distinctiveness.

Likelihood of confusion

67. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether

[8] I have also been provided with UK sales figures for 2023, however, as the relevant period is until 27 July 2023, I note that a proportion of these sales would fall outside the relevant period.

there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

68. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a medium and high degree.
- I have found the marks to be aurally similar to a high degree.
- The words “LaModa” and “LEmoda” in the parties marks are conceptually neutral, but the stylised “E” in the applicant’s mark presented as a woman with long hair means that the marks are conceptually dissimilar. However, given the nature of the goods concerned, which are hair accessories, the concept of a woman with long hair has little distinctiveness.
- I have found the earlier mark to be inherently distinctive to a high degree.
- I have identified the average consumer as members of the general public and professionals such as hairdressers, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties’ goods to range from being identical to similar to between a low and medium degree.

69. The conceptual dissimilarity between the marks could point in favour of the applicant. In *Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

> "20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law."

70. However, I recognise that conceptual differences do not always overcome visual and/or aural similarities.[9] For example, in *Diramode S.A. v Richard Turnham and Linda Turnham* (BL O/566/19), Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person, overturned a decision that the conceptual differences between PIMKIE and PINKIE were sufficient to outweigh the visual and aural similarities between them. Mr Geoffrey Hobbs Q.C. found that:

> 'Even though one of the marks in issue refers to a clear and immediately apparent concept and the other does not have a clear meaning which can be immediately perceived by the relevant public, the degree of visual and aural similarity between them may still be sufficient to give rise to the existence of a likelihood of confusion'.

71. Whether or not the conceptual differences are sufficient to outweigh the visual and aural similarities must be decided on the facts of each particular case. However, in this case, the conceptual difference between the marks arises from the highly stylised letter "E" in the applicant's mark which depicts a woman with long hair. I have found that this stylisation plays a lesser role on the basis that it is allusive of the applicant's goods which are used on hair (to brush/detangle or accessorise), and that the concept of a woman with long hair (in relation to hair accessories) has little distinctiveness. I therefore find it unlikely that the conceptual differences between the marks will offset the visual similarities, particularly as I have found the purchasing process to be predominantly visual. I also bear in mind that the opponent's mark is composed of the invented word "LaModa", which is inherently distinctive to a high degree, and conceptually neutral to the invented word "LEmoda". The only difference between

[9] *Nokia Oyj v OHIM*, Case T-460/07

these invented words are their second letters (A vs E).[10] However, I consider that these letters could be easily overlooked or imperfectly recalled by the average consumer. In my view, this results in a likelihood of direct confusion on all of the parties' goods, including those which are similar to between a low and medium, due to the effect of the interdependency principle.

Section 5(3)

72. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> > (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

73. Section 5(3A) of the Act states:

> "Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected."

74. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

[10] As noted above the difference in upper-case and lower-case lettering has no impact on my visual comparison as the opponent's mark is a word mark and therefore normal and fair use of the mark covers use of the registration in all upper-case, all lower-case, or a combination of the two.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42.*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40.*

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

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

76. The relevant date for the assessment under section 5(3) is the date of application of the applicant's mark i.e. 27 July 2023.

Reputation

77. In *General Motors*, Case C-375/97, the CJEU held that:

> "25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.
>
> 26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.
>
> 27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.
> 28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

78. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must take all of the evidence into account including "the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it."

79. Earlier in my decision, I found that the distinctive character of the opponent's mark had not been enhanced through use. I recognise that reputation is not the same as enhanced distinctive character, but the same factors are to be taken into account in both assessments.

80. The strongest evidence provided by the opponent is the revenue made in the UK under its mark from 2015 to 2022, which amounts to £4,439,966. This is supported by invoice evidence which shows that its sales were geographically spread to retailers across the UK, and its spreadsheet evidence which confirms the individual sales made of the aforementioned goods. I note that this has also been supported by brochure and photographic evidence showing that the opponent sells hairbrushes, combs and a range of hair accessories such as hair bands, ponytailers, scrunchies, pins, grips, and clamps under its earlier mark.

81. However, I have not been provided with any evidence of the opponent's market share, and based on its above sales, I consider that it would only amount to a small proportion of the hair brush and hair accessory market (which I consider to be large sectors). I have not been provided with UK advertising figures or examples of its advertising, including any evidence of social media accounts (which could have demonstrated an online following), or any examples of their goods being advertised in third party publications. Therefore, the evidence is, for the reasons set out above, insufficient to establish a reputation in the UK. On this basis, without having found a reputation, the opposition based upon section 5(3) fails.

Section 5(4)(a)

82. Section 5(4)(a) of the Act states as follows:

> "5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –
>
> a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,
>
> aa)…
>
> b) …

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

83. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

84. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

85. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

> “43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’”

86. As the applicant has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 27 July 2023.

Goodwill

87. The House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

> “What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

88. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> “27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the

enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by BALI Trade Mark [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

89. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

"[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

90. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided by Mr Murray that the opponent's company has been trading under the "LaModa" sign since 2015. I have also been provided with the revenue made in the UK under the opponent's sign, from 2015 to 2022 which amounts to £4,439,966.[11] This is supported with invoice evidence showing the sale of the opponent's goods to

[11] I have also been provided with UK sales figures for 2023, however, as the relevant period is until 27 July 2023, I note that a proportion of these sales would fall outside the relevant period.

retailers geographically spread across the UK, alongside photographic evidence of its goods being sold in pharmacies between 21 February 2013 and 16 November 2017. I have also been provided with spreadsheet evidence showing the breakdown of the opponent's different goods sold under its sign, including brushes, combs, ponytailers, clips, clamps, hair bands, scrunchies, grips, alice bands, hair nets and rollers. On this basis, taking the evidence as a whole into account, I am satisfied that the opponent has demonstrated a modest degree of goodwill prior to the relevant date in relation to hair combs and hairbrushes, hair bands, alice bands, hair fasteners, hair decorations, hair grips, hair pins and clips, hair nets hair rollers, scrunchies, ponytail holders and hair clamps (all being terms that the opponent relies upon under section 5(4)(a)). Examples have been provided of the mark being used on the opponent's goods in its Amazon listings, within its brochure and the aforementioned photographic evidence. In light of this, I am also satisfied that the "LeModa" sign was distinctive of the opponent's goodwill at the relevant date.

Misrepresentation and damage

91. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc*. [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

92. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails "deception of a substantial number of members of the public" rather than "confusion of the average consumer". However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

93. The goods for which the opponent has shown goodwill (that being hair combs and hairbrushes, hair bands, alice bands, hair fasteners, hair decorations, hair grips, hair pins and clips, hair nets, hair rollers, scrunchies, ponytail holders and hair clamps) are identical or similar (to a high degree or between a low and medium degree) to all of the applicant's class 26 goods, for the same reasons set out in paragraphs 43 to 47 above.

94. I also bear in mind that the only difference between the parties' invented words "LaModa" and "LEmoda" is their second letters (A vs E) and the stylisation of the letter "E" in the applicant's mark depicting a woman with long hair (which is allusive of the applicant's goods which are used to brush/detangle or accessorise the users hair). I therefore find that these elements could be easily overlooked or misremembered as each other.

95. Therefore, taking the closeness of the parties' fields of activity into account, as well as the marks being similar, I consider that a substantial number of members of the

relevant public would be misled into purchasing the applicant's goods in the mistaken belief that they are the goods of the opponent. Damage through diversion of sales is easily foreseeable.

96. The opposition under section 5(4)(a) succeeds.

CONCLUSION

97. The opposition is fully successful under sections 5(2)(b) and 5(4)(a) and the application is refused in its entirety.

COSTS

98. The opponent 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 opponent the sum of £1,100 as a contribution towards the costs of the proceedings.

99. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£250
Preparing and filing evidence and written submissions	£650
Official Fee	£200
Total	**£1,100**

100. I therefore order Xuchang Lady Show Hair Products Co., Ltd. to pay Paul Murray PLC the sum of £1,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of August 2025

L FAYTER

For the Registrar