

O-229-11

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO 2491161

IN THE NAME OF

ALBERTO-CULVER COMPANY

OF THE TRADE MARK:

FUNKY SHAPER

IN CLASS 3

AND

THE APPLICATION FOR A DECLARATION

OF INVALIDITY THERETO

UNDER NO 83633

BY

THE WELLA CORPORATION

Trade Marks Act 1994

**In the matter of registration no 2491161
in the name of Alberto-Culver Company
of the trade mark:
FUNKY SHAPER
in class 3
and the application for a declaration of invalidity
thereto under no 83633
by The Wella Corporation**

1) An application to register the trade mark **FUNKY SHAPER** (the trade mark) was filed on 26 June 2008. The registration process was completed on 6 November 2009. The trade mark is registered for:

hair care products; hair care preparations.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The registration is in the name of Alberto-Culver Company (Alberto).

2) On 24 November 2009 The Wella Corporation (Wella) filed an application for the registration to be declared invalid. The application was made under section 47(2)(a) of the Trade Marks Act 1994 (the Act)ⁱ. Wella claims that the registration of the trade mark was contrary to sections 5(2)(b) and 5(3) of the Act. Section 5(2)(b) of the Act states:

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

.....

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

Section 5(3) of the Act states:

“(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 Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be

detrimental to, the distinctive character or the repute of the earlier trade mark.”

In respect of these grounds, Wella relies upon Community trade mark registration no 55608 of the trade mark SHAPER. The application for registration of this trade mark was filed on 1 April 1996 and the registration process was completed on 17 March 1998. The trade mark is registered for:

non-medicated hair care preparations; namely, hair spray.

The above goods are in class 3 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended. The trade mark is subject to proof of genuine use for the period from 25 November 2004 to 24 November 2009, as per section 47(2A)(a) of the Act. Wella claims that it has used the trade mark in this period.

3) Wella states, in relation to section 5(2)(b) of the Act, that the respective trade marks are similar and that the respective goods are “identical and similar”. In relation to section 5(3) of the Act, Wella states that use of the trade mark “in relation to identical goods would, without due cause, cause detriment to the distinctive character or repute” of its trade mark. It states that it will rely upon use of its trade mark in the United Kingdom to support the latter contention.

4) Alberto filed a counterstatement. It requires Wella to prove use of its earlier trade mark. Alberto states that the respective trade marks differ significantly on a visual, phonetic and conceptual basis, due to the dominant position of the word FUNKY. It states that FUNKY is the most relevant and memorable indicator to the potential customer of the commercial origin of the products in question. Alberto states that SHAPER indicates the nature of the hair care preparation, ie a product that may be used to shape hair. Alberto states that SHAPER is frequently used in the hair care sector and the average consumer is regularly exposed to the use of the word in various combinations and descriptive phrases in relation to products from numerous sources. Alberto states that there is no risk of confusion and neither will its use of the trade mark cause detriment to the “alleged” distinctive character or repute of Wella’s trade mark.

5) Both parties filed evidence.

6) A hearing was held on 3 June 2011. Alberto was represented by Ms Anna Edwards-Stuart of counsel, instructed by Marks & Clark LLP. Wella was represented by Ms Denise McFarland of counsel, instructed by D Young & Co.

Initial evidence for Wella

Witness statement of Sylvie Moreau

7) Ms Moreau is employed by Procter & Gamble International Operations SA, a fully owned company of The Procter & Gamble Company, which is a “sister company” of Wella. Ms Moreau is the marketing director and global brand franchise leader for the Sebastian brand, with which the SHAPER “trademarks” have been used.

8) Ms Moreau states that the SHAPER brand was first launched by Sebastian International Inc, the predecessors in business to Wella, in the United States of America and Latin American countries in 1985 and is now available in 40 countries; including Austria, Belgium, Cyprus, the Czech Republic, Denmark, Finland, Germany, Greece, Ireland, Italy, the Netherlands, Portugal, Spain, Sweden and the United Kingdom.

9) Ms Moreau states that the SHAPER brand is applied to hairspray and is made available to hairdressers and consumers through a variety of outlets, including hair salons. She estimates that there were over 600 outlets selling SHAPER branded hairspray products in the United Kingdom as of 10 May 2010. Exhibited at SM 1 are copies of 8 invoices issued during the period 27 October 2006 to 25 April 2008. The invoices are for “Originals Shaper Plus Hairspray 400ml”, “Originals Shaper Hairspray 400ml” and “SHAPER RETAIL BAG” (an item for which no charge is made). The quantities of hairspray on the invoices are 18, 8, 3, 1, 2, 3, 3, 2 and 2. The invoices are from Selective Brands, which is described on the invoices as a division of Wella (UK) Ltd.

10) Ms Moreau states that between 2003 and 2007 Wella and its predecessors in business promoted the SHAPER trade mark in several European countries by means of public relations articles to journalists, trade advertisements and product advertisements in the trade press. She states that examples of advertisements which have appeared during this period are exhibited at SM 2. The advertisements, from the internal evidence (eg price in dollars), emanate from the United States of America and so are not pertinent to these proceedings. The use shown is for a product called the Sebastian Professional Re-Shaper, the Sebastian Professional Shaper Fierce and the Sebastian Re-Shaper.

11) Ms Moreau states that annual sales of SHAPER trade marked products (including SHAPER, SHAPER PLUS, RE-SHAPER, SHAPER ZERO GRAVITY and SHAPER FIERCE) in the United Kingdom were as follows:

2006/2007 in excess of £40,000;
2007/2008 in excess of £60,000;
2008/2009 in excess of £152,000;
2009/2010 in excess of £154,000.

The years run from July 1 to June 30. Consequently, the last two figures relate to periods after the date of application for the registration of the trade mark.

12) Ms Moreau states that the SHAPER trade mark is recognised in the hairdressing industry. In support of this claim she exhibits an article downloaded from the website behindthechair.com. The article relates to awards made in 2002 in Chicago, and so the exhibit is not pertinent to these proceedings.

13) Ms Moreau states that exhibited at SM 4 are pictures of the packaging of the products as marketed in the European Union (including the United Kingdom) between 2004 and 2009. Images of the products appear below:



Evidence for Alberto

Witness statement of Rebecca Tew

14) Ms Tew is a trade mark attorney.

15) Ms Tew states that the trade mark is used by Alberto in conjunction with the VO5 Extreme Style range of products and, in particular, in relation to styling products for creating “shapes and distorts for messy separation” in short hair and medium length hair. She states that the product is aimed at the consumer rather than the professional market and is sold throughout the United Kingdom through large retail chains such as Sainsbury’s, Boots, Tesco, Superdrug and Waitrose. The product can be purchased online from websites dealing in hair and beauty products. Exhibited at RT1 are pictures of a container for the product. On page 8 the following image can be seen:



The pages which constitute RT 1 were downloaded from the Internet on 20 September 2010.

16) Ms Tew states that Alberto’s product is a styling product which is targeted both at “the usual audience” and the male hair care market. She states that the product has a wax/cream type consistency and it is clear that in the hair care industry that there has become a tendency to refer to this type of product as a shaper. Ms Tew states that shaper is widely used by other unrelated traders, both in branding/marketing their products and as a descriptive term. Exhibit RT2 includes a Google® search for the search term shaper hair products, conducted on 20 September 2010. The search shows use of Fudge Hair Shaper, Sebastian Shaper Hair Products, Dax Wax Hair Shaper, Dax Hair Shaper. The exhibit also includes pages downloaded from the websites hairsupermarket.com, sallyexpress.com and shopwiki.co.uk. The pages relate to use in the United Kingdom. The following products appear in the pages: Fudge Shaper, Black & White Manik Shaper, Osmo Shaper Maker, Goldwell Inner Effect Resoft Shine

Shaper, Sebastian Shaper Zero Gravity, Sebastian Shaper Fierce Hairspray, Sebastian Re-Shaper Hairspray, Sebastian Shaper Fierce Ultra-Firm Finish Hairspray, Dax Wax Hair Shaper Hairdress, Beyond The Zone Hair Shaper, Osmo Shaper Maker, Hair stylingwax Shaper just for men, Label M Shaper, Fudge Mint Hair Shaper, Fudge Fat Hed Hair Shaper, Hair Shaper On The Pull Men's Hair Care Geezers and Redken Urban Experiment 4 Grit Wax Pliable Hair Shaper. All of the products referred to were available in the United Kingdom and relate to products for controlling or styling the hair. Descriptions of the products include the following:

“gooey type shaper enabling you to design your hair and rework it later”;
“[t]his product will give you the effect of waxes or shaper but without the shiny, wax look”;
“[a] versatile cream shaper, for moulding, styling, texturising whilst adding shine and control”;
“[s]etting sebastian's mind in picture-perfect motion. Now for the hair that holds till dawn, the ultra-firm, shaper fierce. Firm all day dry-hold shapes hair into any fashion”;
“[s]crunch, mold, slick and style – It's not called Shaper for nothing”;
“[w]ith this great styling shaper you can achieve a matt look with control to ensure your style stays firm”;
“with this advanced ultra fibrous shaper”;
“good value for money a versatile cream shaper for moulding styling texturising”.

17) Exhibit RT3 contains details of various products which were downloaded from the Internet on 20 September 2010. These include:

- Trevor Sorbie Professional Curl Shaper, which is promoted as holding “tonged curls for longer”.
- Fudge Hair Shaper, which is promoted as a styling tool and a product that “[a]dds strong hold to finished styles”.
- Alberto VO5 Extreme Style Funky Shaper.
- Chill ed Shaper. The description of the product includes the following: “This shaper type product retains all the features of a sticky, gooey type shaper enabling you to design your hair and rework it later”.
- Osmo Shaper Maker, which is promoted as a “versatile cream shaper, for moulding, styling, texturising whilst adding shine and control”.
- Goldwell Inner Effect Resoft Shine Shaper, which is described as a “light modelling cream”.
- Black & White Manik Shaper, which is promoted as being “the strongest toughest manik shaper.
- A page from sallybeauty.com upon which the following appears:

“Q: What is the difference between spritz and shaper spray?”

A: It is easy to confuse spritz with shaper spray, but there is an important difference. Spritz has holding resins like all styling support products. They add body and texture to a style. Shaper spray or styling spray are hairsprays that help you create your style and also have “memory” resins, which cause hair to “remember” the way it was styled and to return it to that style after it has been combed or fluffed.”

18) Ms Tew states that market research in the hair care industry indicates that purchases are driven by fashion/trends and marketing campaigns to which the consumer is frequently exposed. She states that the average consumer will recognise that shaper is used within distinctive brand names in order to create an allusion to the nature of the product or alternatively to offer a description of it. Ms Tew states that, therefore, the average consumer would not expect the presence of shaper in various combinations to be an indication of common origin. She states that the material exhibited at RT4 consists of “[e]xtracts from relevant market survey articles and publications relating to the hair styling industry”. RT4 consists of two items; the first is a copy of an article from *ECM* of September 2009 headed *UK Set for a fall*. The article refers to “a growing trend for natural hair” which is affecting sales of styling products. The following appears in the article:

“A new gum line in the VO5 Extreme Style stable is the FunkyShaper gum”.

..... “Also going on in the UK styling market was the relaunch of the Sebastian brand, which is well known in the US and starting to make a name for itself more and more in the UK.”

The second item is a copy of a page from the Internet promoting a publication called *Beauty And Personal Care in the United Kingdom*, published in June 2010.

19) Ms Tew goes on to comment on Wella’s product mainly being distributed through hair salons whilst Alberto’s product is mainly distributed through supermarkets and pharmacy chains.

20) Exhibited at RT7 is a copy of *Market Information 2009* which gives, inter alia, annual turnover figures for hair spray in the United Kingdom. In the weeks ending 27 December 2008 and 26 December 2009 the market was worth £92 and £97.9 million respectively.

Further evidence for Wella

First witness statement of Angela Claire Thornton-Jackson

21) Ms Thornton-Jackson is a trade mark attorney.

22) Ms Thornton-Jackson states that she undertook market research to determine the extent to which so-called professional hair products were available to the public through retail channels. She states that when she was shopping at a branch of Boots in Southampton she was given a £2 professional hair care voucher which could be used to purchase the following brands: Toni & Guy, Trevor Sorbie, Umberto Giannini, John Frieda, Charles Worthington, Mark Hill, Lee Stafford and James Brown. Exhibited at ACTJ1 is a copy of the voucher. The exhibit also includes pages from the Internet which list the salons of Trevor Sorbie, the "salon experts" of John Frieda, a list of Toni & Guy salons and a list of Umberto Giannini salons. Exhibited at ACTJ2 are the first two pages of a Google® search for the term professional hair care. Ms Thornton-Jackson refers to the number of hits shown, however, owing to the absence of Boolean operators, the number of hits lacks any indicative value. Ms Thornton-Jackson specifically identifies the hits relating to salon-collective.co.uk and shoprush.co.uk; pages from these websites are exhibited at ACTJ3. Ms Thornton-Jackson notes that the websites sell products bearing the trade marks KMS, Tigi, Paul Mitchell, Wella, Goldwell and L'Oréal. Ms Thornton-Jackson draws the conclusion that professional branded hair care products are available from a wide range of retail outlets.

Second witness statement of Angela Claire Thornton-Jackson

23) Ms Thornton-Jackson states:

"I believe that the Registered Proprietors sought to differentiate the party's respective products on the basis that the Applicant for Invalidity's product is a hair spray whereas the Registered Proprietor's product is a wax/cream type of hair styling product."

In fact, taking into account the specifications and the nature of the goods, nothing will turn upon this alleged differentiation. Consequently, it is not necessary to summarise this part of the witness statement. Ms Thornton-Jackson also returns to this issue of "professional brands".

24) Ms Thornton-Jackson states that the SHAPER brand alone was used exclusively in the United Kingdom until 2009; ACTJ7 is exhibited in support of this statement. The exhibit consists of three pages from *Aurical Angel* for spring/summer 2008. There is no internal evidence as to from where the publication emanates and where it was distributed and Ms Thornton-Jackson gives no indication as to these matters. At the bottom of the first page "SEBASTIAN® PROFESSIONAL" appears. The second page contains no trade mark matter. The third page includes the following wording:

"An edgy Perfectly Imperfect cut
consisting of a filtered bob,
undercut and shaped for maximum

styling versatility.

The shapeshifting power of Sebastian Originals Shaper, provides a firm flexible hold that can be manipulated and shaped to suit any style.”

This page also displays an image of the product:



25) Exhibited at ACTJ8 is a copy of the agreement dated 15 April 2003. **This exhibit has been granted confidentiality.** (All references to this exhibit are redacted in the public version of the decision. **Paragraphs 11 and 12 of Ms Edwards-Stuart’s skeleton argument refer to ACTJ8 and so are added to the confidentiality order.**)

26) Redacted.

Witness statement of Emma Watts

27) Ms Watts is a paralegal secretary.

28) Ms Watts visited five hair salons in Southampton where she asked what products were offered for sale to customers. Ms Watts was advised that the salons sold products by TiGi, Fudge, KMS, Wella, Goldwell, Schwarzkopf, Trevor Mitchell, Regis, Catwalk, Paul Mitchell, L'Oréal and Vogueti.

Proof of genuine use

29) Ms Edwards-Stuart accepted that Wella had established genuine use of its trade mark in respect of the goods for which it is registered in the European Union from 25 November 2004 to 24 November 2009, as per section 47(2A)(a) of the Act.

Section 5(3) of the Act

30) To benefit from the provisions of section 5(3) of the Act the trade mark must be known by a significant part of the public concerned by the products coveredⁱⁱ. The Court of Justice of the European Union (CJEU) in *General Motors Corporation v Yplon SA* stated how a party would establish this reputation:

“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.”

In her skeleton argument Ms Edwards-Stuart wrote:

- “14. This ground of attack is simply not open to Wella on their own evidence. Wella have fallen far short of demonstrating that the Wella Mark has acquired a reputation in the Community (or for that matter the United Kingdom).
15. Wella’s evidence in support of its claim that the Wella Mark has acquired the necessary reputation can be summarised as follows:
- (1) the SHAPER brand is now available in a number of countries within the European Union (Moreau, para 2);
 - (2) between 2003 and 2007 the SHAPER brand was significantly promoted in several European Union countries (Moreau, para 3);
 - (3) the SHAPER brand has enjoyed very substantial success in the EU and in particular the UK (Moreau, para 4).
16. However, these assertions do not withstand scrutiny. Ms Moreau gives no evidence as to *when* the SHAPER brand was launched into the various EU countries she refers to at paragraph 2. Her statement is dated 10 May 2010, almost two years after the filing date of the Registered Mark (26

- June 2008). Reputation acquired since 26 June 2008 is irrelevant but Ms Moreau makes no attempt to say whether the “the SHAPER brand” had been launched in each country identified before or after 26 June 2008. Nor does she provide any evidence as to the levels of sales that were being enjoyed in those countries as at 26 June 2008.
17. Ms Moreau exhibits at SM-2 “*examples of advertisements which have appeared during this period*”. The period is said to be 2003-2007 and are supposed to relate to promotions in several EU countries (Moreau, para 3). However, all but one of these promotions are outside this period (and indeed after the filing date) see for example pages 13, 14 and 15 (all September 2008), page 16 (August 2008), and page 18 (November 2008). The date is not clear on the only remaining advert (page 17). Nor do they appear to be directed to EU countries. The magazines at pages 13, 15 and 16 (are either priced in US dollars or contains products priced in US dollars) and the magazines at page 14 appears to have been delivered to an address in New York. So none of the adverts in fact appear to have been directed to the EU market. Similarly the award relied on (namely Behindthechair.com are also US based) and so not illustrative of the UK (or EU) market. This distinction is important, as can be seen from the reports exhibited at RT-4, the markets in different countries are different.
 18. Finally the figures quoted at paragraph 4 of Ms Moreau’s statement do not support her contention that the SHAPER brand has enjoyed very substantial success. Sales figures for four years are given although 2008/2009 and 2009/2010 are both after the filing date and so irrelevant. That leaves 2006/2007 (£40,000) and 2007/2008 (£60,000). However, the hairspray market alone was worth £92.0m in 2008 and £97.9m in 2009. Figures for 2007 are not available but even assuming a market of £90m, Ms Moreau’s sales figures amount to 0.04% of the UK market for 2006/2007 and 0.07% of the UK market for 2007/2008. Ms Moreau indicates that the UK was the biggest market suggesting that sales elsewhere were even less impressive.
 19. Further, the SHAPER element is used in conjunction with the mark SEBASTIAN in various forms (SHAPER, SHAPER PLUS, RE-SHAPER, SHAPER ZERO GRAVITY). Ms Moreau’s evidence does not state whether the figures providing relate to sales figures quoted at paragraph 17 relate to sales under the mark SHAPER simpliciter or one of the variants (i.e. SHAPER PLUS, RE-SHAPER, SHAPER ZERO GRAVITY) and whether or not those sales were made under the SEBASTIAN brand.
 20. In short Ms Moreau’s evidence fails to establish that the Wella Mark had established a reputation whether in the UK or the Community, less still that the use of the Registered Mark would be detrimental to that reputation.”

31) It is considered that Ms Edwards-Stuart's submissions correctly summarise the position in relation to the claimed reputation. Wella has put in evidence to show that there is no clear demarcation between so called professional and non-professional brands of hair spray. At the date of application for registration, Wella's market share was minimal and the product was not sold in the main retail establishments. **At the date of application for registration, Wella's trade mark did not have a Chevy reputation and so the grounds of invalidation under section 5(3) of the Act are dismissed.**

Likelihood of confusion – section 5(2)(b) of the Act

Average consumer, nature of purchasing decision and standard for likelihood of confusion

32) The average consumer "is deemed to be reasonably well informed and reasonably circumspect and observant"ⁱⁱⁱ. The average consumer of the goods of the trade marks will be the public at large. The goods could be cheap and could be bought without a great deal of care. Consequently, the effects of imperfect recollection are likely to be increased. They may be bought from a hair salon, where it is likely that they would be pointed out by the purchaser or requested verbally. There is no evidence to show that salons sell a significant amount of the products that they use. In the main, the goods will be bought from the self-service areas of shops and so, in the average purchasing situation, visual similarity will be more important than aural similarity.

Comparison of goods

33) Ms Edwards-Stuart accepted that the respective goods are identical.

Comparison of trade marks

34) The trade marks to be compared are FUNKY SHAPER and SHAPER.

35) The average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details^{iv}. The visual, aural and conceptual similarities of the trade marks must, therefore, be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components^v. Consequently, there cannot be an artificial dissection of the trade marks, although it is necessary to take into account any distinctive and dominant components. The average consumer rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind and he/she is deemed to be reasonably well informed and reasonably circumspect and observant^{vi}. The assessment of the similarity of the trade marks must be made by reference to the perception of the relevant public^{vii}.

36) Redacted.....There is only one element of Wella's trade mark so as a matter of logic it must be the dominant component, however, owing to the nature of the component it cannot be described as a distinctive component. Alberto's trade mark also includes the word FUNKY; which Ms McFarland characterised as being a laudatory term, especially for young folk. This submission of Ms McFarland is accepted. So, Alberto's trade mark consists of a laudatory word and a descriptive word. Consequently, it cannot be considered that either part of the trade mark is distinctive or dominant.

37) The presence of the word SHAPER in the trade mark of Alberto leads inevitably to a good degree of visual, phonetic and conceptual similarity.

Conclusion

38) Ms Edwards-Stuart made reference to the absence of confusion in the market place. There is a tranche of case law to the effect that lack of confusion in the market place is indicative of very little: *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283, *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch), *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 and *Aceites del Sur-Coosur SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-498/07 P*. In *The European Limited v The Economist Newspaper Ltd* Millet LJ stated:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark.”

In this case the products have been sold in different types of undertakings. One trade mark has been clearly sold by reference to Sebastian and the other by

reference to VO5 stylised. Consequently, the absence of evidence of confusion in the market place is without pertinence.

39) In *L'Oréal SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-235/05 P* the CJEU stated:

“43 It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

45 The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

However, balanced against this, is the nature of a likelihood of confusion.

40) There is a presumption of validity in relation to the earlier trade mark. The evidence demonstrates that Wella's trade mark, at the date of application for registration of Alberto's trade mark and at the date of the application for invalidation, was directly descriptive of the goods. At the date of application for registration of Alberto's trade mark, Wella's trade mark lacked all distinctive character and the evidence of use does not establish that it had gained any distinctive character from use. The evidence leads to the conclusion that the average consumer will see the trade mark as being used to describe a particular type of product, a shaping product, emanating from Sebastian. A presumption of validity does not lead to a presumption of confusion because of similarity. A case under section 5(1) of the Act is based purely on fact: are the trade marks and goods identical? The fundamental premise of likelihood of confusion, section 5(2) of the Act, is that the average consumer of the goods concerned will believe

that the parties are the same or economically linked as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* Case C-39/97:

“30. The answer to be given to the second part of the question must therefore be that there may be a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive even where the public perception is that the goods or services have different places of production. By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings.”

The respective goods are identical. The respective trade marks have clear visual, aural and conceptual similarities. However, neither trade mark at the date of application for registration will be seen by the average consumer as indicating origin; consequently, the average consumer will not believe that the respective goods come from the same undertaking or economically linked undertakings. **Consequently, there is not a likelihood of confusion and the grounds of invalidation under section 5(2)(b) of the Act are dismissed.**

COSTS

41) Alberto having been successful is entitled to a contribution towards its costs. Costs are awarded on the following basis:

Preparing statements and considering the statements of Wella:	£500
Preparing evidence and considering the evidence of Wella:	£750
Preparing for and attending the hearing:	£500
Total:	£1,750

The Wella Corporation is ordered to pay Alberto-Culver Company the sum of £1,750. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of June 2011

**David Landau
For the Registrar
the Comptroller-General**

ⁱ "47. - (1).....

.....(2) The registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2A)* But the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration, (b) the registration procedure for the earlier trade mark was not completed before that date, or (c) the use conditions are met.

(2B) The use conditions are met if –

(a) within the period of five years ending with the date of the application for the declaration 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) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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.

(2D) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community. (2E) 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.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

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

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

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

ii *General Motors Corporation v Yplon SA* Case C-375/97.

iii *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* Case C-342/97.

iv *Sabel BV v Puma AG* Case C-251/95.

v *Sabel BV v Puma AG* Case C-251/95.

vi *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* Case C-342/97.

vii *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.