

O-292-14

**TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION NUMBER 2642189  
BY JEMELLA GROUP LTD  
TO REGISTER THE FOLLOWING TRADE MARK  
IN CLASSES 03, 08, 09, 11, 16, 21, 38 AND 41:**

**GOOD HAIR DAY, EVERY DAY**

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## **GOOD HAIR DAY, EVERY DAY**

### **Background**

1. On 14 November 2012, Jemella Ltd ('the applicant') applied to register trade mark application number 2642189 consisting of the phrase 'GOOD HAIR DAY, EVERY DAY' for the following goods and services in classes 3, 8, 9, 11, 16, 21, 38 and 41:

Class 3: Soaps; perfumery; essential oils; cosmetics; preparations for the skin, scalp, hair and body; hair lotions; shampoos; hair dyes; hair colourants; hair conditioners; hair styling products.

Class 8: Hair irons; electric hand-operated implements and appliances for styling hair; non-electric hand-operated implements and appliances for styling hair; scissors; hairbrushes; razors; electric razors and hair cutters; cases, parts, fittings and accessories all for the aforesaid goods.

Class 9: Electric hand-operated implements and appliances for styling hair; teaching apparatus; computer software; downloadable electronic publications; pre-recorded data media; plugs; cases, parts, fittings and accessories all for the aforesaid goods.

Class 11: Hair dryers; apparatus for drying or heating hair; cases for the same; parts, fittings and accessories all for the aforesaid goods.

Class 16: Paper, cardboard and goods made from these materials; printed matter; stationery; printed publications; packaging.

Class 21: Brushes; combs; comb cases; hairdressing, hair care and hair styling products included in this class; parts, fittings and accessories for all the aforesaid goods.

Class 38: Broadcasting; communications by computer terminals; communications by telephone; electronic bulletin board services; electronic mail; radio broadcasting; satellite transmission; television broadcasting.

Class 41: Education and training services; arranging and conducting conferences, congresses, seminars, symposia and workshops; publication of books; online styling tutorials; non-downloadable electronic publications; organisation of competitions; entertainment; vocational guidance.

2. On 28 November 2012 the IPO issued an examination report raising objection under section 3(1)(b) on the basis that the sign is devoid of distinctive character because it would be perceived by the average consumer as merely a promotional statement suggesting that the goods and services will help them achieve a good hair day, every day.

3. At a hearing on 2 July 2013 with the attorney, Ms Amanda Mallen of Walker Morris LLP, I clarified that, notwithstanding the applicant's claim via correspondence to significant reputation in the sign, she nonetheless contested the *prima facie* case. In fact, I have only the *prima facie* case to consider as no plea or formal evidence of acquired distinctiveness has been filed.

4. In submission at the hearing and in correspondence, Ms Mallen says:

- It is impossible to ignore the fact that 'GOOD HAIR DAY' is already a registered trade mark (UK Registration Number 2527066), and is perfectly capable of functioning as a trade mark;
- There has been no third-party challenge to that earlier registration which dates back to 2009;
- Whilst it is accepted that 'good hair day' is a known expression in everyday speech, this does not rule it out from also being registered;
- In this regard, the sign is at best allusive only of the goods and services;
- There are a number of other marks on the register such as e.g. 2569133, 2609502, 9875186 and 5627203, all of which contain the words 'every day' in succession to a descriptive term, thus illustrating the capability of such a phrase to function as a trade mark;
- It is established case law that the first words in a phrase such as this are focussed upon by the consumer as having most 'significance' in a trade mark sense, and in this case those first words already have the recognition afforded by registration.

5. At the hearing I reserved my decision, but by letter of 5 July 2013 I gave my decision in the *prima facie* case which was to maintain the objection under section 3(1)(b), and to allow a period for the applicant to consider formalising and filing evidence in relation to any possible plea of acquired distinctiveness. No reply having been received to my letter and decision of 5 July 2013, I sent a further letter dated 7 October 2013 marked 'final response', stating that if no reply was made by 9 December 2013, then the application would be formally refused. The application was duly refused on 27 January 2014, and the applicant has since filed a form TM5, being a request for a full statement of grounds. This is the statement of grounds and, as I have said, I have only the *prima facie* case to consider.

## **Decision**

6. As stated, this case has been decided on a *prima facie* basis only and under the provisions of section 3(1)(b) of the Act, which reads:

*“3.-(1) The following shall not be registered –*

*(a) ...*

*(b) trade marks which are devoid of any distinctive character,*

*(c) ...*

*(d) ...*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b),(c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”*

### **The relevant legal principles - section 3(1)(b)**

7. The European Court of Justice (‘CJEU’) has emphasised the need to interpret the grounds for refusal of registration listed in Article 3(1) of Directive 2008/95/EC (‘the Directive’, being the codified version of the original Directive 89/104/EEC) and Article 7(1) of Council Regulation (EC) No 207/2009 (‘the Regulation’, being the codified version of original Council Regulation 40/94), in the light of the general interest underlying each of them (Case C-37/03P, *Bio ID v OHIM*, para 59 and the case law cited there and, e.g. Case C-273/05P *Celltech R&D Ltd v OHIM*).

8. The general interest to be taken into account in each case must reflect different considerations according to the ground for refusal in question. In relation to section 3(1)(b) (and the equivalent provisions referred to above upon which section 3(1)(b) is based) the Court has held that *“...the public interest... is, manifestly, indissociable from the essential function of a trade mark”* (Case C-329/02P ‘SAT.1’ *Satelliten Fernsehen GmbH v OHIM*). The essential function thus referred to is that of guaranteeing the identity of the origin of the goods or services offered under the mark to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin (see Para 23 of the above mentioned judgment). Marks which are devoid of distinctive character are incapable of fulfilling that essential function. Moreover, the word ‘devoid’ has, in the UK at least, been paraphrased as meaning ‘unpossessed of’ from the perspective of the average consumer.

9. The question then arises as to how distinctiveness is assessed under section 3(1)(b). Para 34 of the CJEU Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (‘Postkantoor’) reads as follows:

*“A trade mark’s distinctiveness within the meaning of Article 3(1)(b) of the Directive must be assessed, first, by reference to those goods or services and, second, by reference to the perception of the relevant public, which consists of average consumers of the goods or services in question, who are reasonably well informed and reasonably observant and circumspect (see inter alia Joined Cases C-53/01 to C-55/01 *Linde and Others**

[2003] ECR I-3161, para 41, and Case C-104/01 Libertel [2003] ECR I-3793, paras 46 and 75).”

10. So the question of a mark being devoid of distinctive character is answered by reference to the goods and services applied for, and the perception of the average consumer in relation to those goods or services.

11. Given the submission by Ms Mallen concerning a ‘minimum level’ of distinctiveness in this case, it is worthwhile noting that there is no obligation on my part to rule on the possible dividing line between the concept of lack of distinctiveness and minimum distinctiveness when assessing the registrability of a sign under section 3(1)(b) - see, for example, CJEU Case C-104/00P *Deutsche Krankenversicherung AG V OHIM (“Companyline”)* [2002] ECR I-7561 at Para 20. The examiner simply asserts lack of distinctiveness and that is the question to be determined.

12. It is also a well established principle these days that the Registrar’s role in examination will involve a full and stringent examination of the facts, underling the Registrar’s frontline role in preventing the granting of undue monopolies, see, to that effect, CJEU Case C-51/10 P, *Agencja Wydawnicza Technopol sp. z o.o. v. OHIM* [2011] ECR I-1541. Whilst this case was, technically speaking, in relation only to section 3(1)(c) or its equivalent in European law, the principle about the ‘prevention of undue monopolies’ must hold good whether section 3(1)(b) and/or (c) applies.

13. In applying these principles to this case, it is nonetheless important I am convinced that the objection applies to all the goods and services applied for. If there are goods or services specified which are free of objection under section 3(1)(b), then they must be allowed to proceed. In CJEU case C-239/05 *BVBA Management, Training en Consultancy v Benelux-Merkenbureau*, the question being referred to the Court was whether the Directive, on which the Act is based of course, must be interpreted as meaning that the competent authority is required to state its conclusion separately for each of the individual goods and services specified in the application. The Court answered, and in Para 38 said that the competent authority was required to assess the application by reference to individual goods and services. However, where the same ground of refusal is given for a category or group of goods or services, the competent authority may use only general reasoning for all the goods and services concerned. It is plain from this judgment that the Court had in mind purely practical considerations which had to be balanced against a legal provision in the Trade Marks Directive which allowed refusal only in relation to goods and services where objection applied. Put simply, the proper functioning of the trade mark registration system at large had to be safeguarded which, if any relevant authority was compelled to give reasons for refusal against each individual item of goods and services, would very quickly grind to a halt.

#### **Application of legal principles – section 3(1)(b)**

14. The average consumer in this case will be the general public who is deemed to be reasonably circumspect. The goods and services are of an everyday nature and are purchased in wide variety of retail outlets, including online. There is no question in this case of specialist goods or services being involved.

15. The fact that the Registrar has already accepted for registration 'GOOD HAIR DAY' and that this registration has remained unchallenged since 2009 can create no presumption that any derivative which may include the phrase registered will be likewise registered. This is the case notwithstanding the presumption of validity which must be retained in relation to the earlier registration.

16. The fact is, and I understood Ms Mallen to accept this and thus have taken on the basis of judicial notice, 'good hair day', is a very well-known phrase in everyday use; it is 'in the common' so to speak. People are said to be having a 'good hair day' when their hair looks its best. The addition of the words 'every day' in the sign, in my opinion, simply amplify the fact that it is possible to have 'good hair day' on a permanent basis; in other words 'every day' can be a good hair day.

17. It has been asserted in the original examination report that the sign is a 'promotional statement'. I prefer not to state, conclude or infer the sign is inevitably a 'slogan' *per se*; this is especially difficult in an *ex parte* analysis based only on inherent characteristics and thus devoid of context. Regardless then, as to whether a sign may be categorised as a 'slogan', still-relevant case law such as e.g. CJEU Case C-398/08P *Audi AG v OHIM (VORSPRUNG DURCH TECHNIK)* at paragraph 47 says that semantic characteristics such as "*having a number of meanings*", "*being a play on words*", or being perceived of as "*imaginative, surprising and unexpected*", such that the sign in which they reside can be easily remembered, are, as a rule, likely to endow it with distinctive character. Admittedly, the Court nonetheless notes that such characteristics are not essential pre-requisites for a finding of distinctive character.

18. In this case, it is most unlikely those qualities will be apparent to the average consumer given that the phrase 'good hair day' is one that is already firmly entrenched and understood in the common vernacular. As I have said, the additional words 'every day' simply amplify and stress the permanence of effect, so to speak, and without detracting from easy comprehension of the primary term, 'good hair day'.

19. Additionally, the sign is especially apt in relation to goods and services of the application which are connected with hair, its styling or its enhancement. Finally, the phrase is one which is more than capable of expressing a positive attribute or effect of the products involved. These are products capable of giving you (i.e. the consumer) a 'good hair day, every day' (my emphasis). The phrase, or the *effect* of the phrase, is therefore (and will be seen as) laudatory in nature.

20. As required also, I have considered whether the objection properly applies to all goods and services. Certain goods are not obviously related to hair, such as 'soaps', 'perfumery' and 'essential oils' in Class 3, and 'software', 'plugs' and 'electronic publications' in Class 9. Certain services also, such as 'broadcasting' in Class 38 and 'education' in Class 41 potentially include services removed from those relating to hair. That said, I do not think in this case, there is merit in exploring the option of partial refusal and/or exclusion based on the possibility of a category of goods or services for which it can safely be said the sign would not be non-distinctive. Firstly, this is because of the nature of the sign especially, being a phrase readily and meaningfully understood; secondly, although certain goods are not obviously related to hair, they are nonetheless closely allied, as in e.g. soaps, essential

oils and perfumery; thirdly, the possibility of a legally-certain exclusion in relation to broader terms such as 'broadcasting' is, in my opinion, remote. In short, this is a case, in my opinion, where an overly fine analysis could result in the kind of criticism levelled in *FeedbackMatters* (BL O/185/12) at paragraph 35, which reads as follows:

*"In relation to the comments at paragraph 21 about "office functions", I would not have separated these services out from the rest of the specification as giving the Mark more chance of being accepted. The power of the Mark to individualise office functions, even if restricted to something like photocopying services or phone answering services, as suggested by the hearing officer, seems to me to be no greater than for the other services. Although the Mark is less obviously potentially descriptive of what the services entail, it nevertheless remains lacking in the ability to denote origin without first being used in a way that would educate business people that this is its purpose."*

21. Finally, I need to deal with the question of the other acceptances by the registry which Ms Mallen says are 'on a par'. Such a claim is easily dismissable on the same basis that the applicant's own earlier registration has been treated; namely, it can create no binding precedent. That said, I have looked at the earlier cases and am of the view that none can be said to suggest the bar has been set too high on this case. That is to say, the presence of the word(s) 'every day' alongside distinctive matter in various other registered marks cannot be said to be even remotely comparable with the totality of the sign in front of me.

### **Conclusion**

22. In this decision I have considered all the papers filed and submissions made. For the reasons given above, the application is refused under section 3(1)(b) in relation to all goods and services

**Dated this 2nd day of July 2014**

**Edward Smith  
For the Registrar  
The Comptroller-General**