

O-172-16

TRADE MARKS ACT 1994

**IN THE MATTER OF REGISTRATION No. 2606437
STANDING IN THE NAME OF
GIANNI GIUDICIANNI**

AND

**IN THE MATTER OF A REQUEST FOR A DECLARATION
OF INVALIDITY THERETO UNDER No.500686
BY TEOXANE S.A.**

BACKGROUND

1) The following trade mark is registered in the name of Gianni Giudicianni (hereinafter GG):

Mark	Number	Filing & registration date	Class	Specification
RA	2606437	09.01.12 06.07.12	3	Preparations for the body, hair, scalp and skin; cosmetics; make-up; preparations for the colouring, tinting, dyeing, relaxing, bleaching and setting of hair; hair lacquers and shampoos; hair tonics, hair conditioners; hair sprays, setting lotions, setting foams, permanent wave solutions and neutralizers; essential oils; toiletries, fragrances.
			44	Hairdressing services; hairdressing salons; manicuring; massage services.

2) By an application dated 28 November 2014 Teoxane S.A. (hereinafter TSA) applied for a declaration of invalidity in respect of this registration. The grounds are, in summary, that TSA is the registered proprietor of the following mark:

Mark	Number	Filing & registration date	Class	Specification
RHA resilient hyaluronic acid	M1104083	International registration date and Date of Designation of the EU: 18.10.11 Date Protection Granted in EU: 04.12.12 Priority date: 19.04.11 Priority country: Switzerland	3	Cosmetic products; gels, creams, milks, masks, lotions; moisturizing gels, moisturizing creams, moisturizing milks, moisturizing masks, moisturizing lotions; preparations for cleaning the body and the face; preparations for cleaning, polishing and scouring the skin; soap; perfumery, essential oils, hair lotions, dentifrices.
			5	Dermatological and pharmaceutical products injected into or under the skin, into or under mucous membranes for filling in wrinkles, cutaneous depressions for remodelling, increasing the volume of the face or any other part of the body, for moisturizing the skin or mucous membranes, for increasing the volume of the lips.

- a) TSA contends that the marks, and goods, are identical or similar such that there is a likelihood of confusion and that the mark in suit therefore offends against section 5(2)(b) of the Act. They refer to GG's opposition to the designation of the TSA

mark during which GG contended that the goods and services in classes 3 & 44 were similar to TSA's goods in classes 3 & 5.

3) GG provided a counterstatement, dated 4 February 2015, in which he denies the above grounds. He states that RHA stands for "resilient hyaluronic acid" as the mark states whereas the other mark is the name of an Egyptian god. He states that RHA is a product which occurs in the human body but can also be produced and is used as a medicine for various joint disorders, in eye surgery and also as a lip filler. He accepts that the class 3 goods of both parties are identical and/or highly similar. He also accepts that the class 5 goods of TSA are similar to its class 3 goods. He further accepts that the class 44 services of its mark are similar to the class 3 goods of TSA. He denies that the marks are identical or similar. GG states that he previously owned trade mark 2291062 (RA and device) registered on 24 January 2002, which he claims to have used since the date of its registration on hair and skin products.

4) Both sides filed evidence. Both sides ask for an award of costs. Neither side wished to be heard. Both parties provided written submissions which I shall refer to as and when necessary in my decision.

TSA's EVIDENCE

5) TSA's Trade Mark Attorney filed a letter dated 15 July 2015 which was headed Evidence and submissions. However, it did not include a witness statement merely submissions and exhibits.

Broadly the submissions and exhibits show that when TSA sought a CTM designation based upon its International Registration GG opposed. As part of this opposition GG contended that the marks RHA/RA are "visually, phonetically and conceptually identical". The opposition by GG also stated that the goods in Class 3 were identical and that the services in class 44 were similar to the goods in class 3. Much the same concessions have been made in the TM8 in the instant case, other than the marks. I note that TSA's mark in the instant case is different to that in the opposition mentioned in that the instant case has the words "resilient hyaluronic acid" after the letters RHA.

GG's EVIDENCE

6) GG filed a witness statement, which is undated but was filed on 26 November 2015. The statement is by Mr Giudicianni himself. He describes himself as a hairdresser and states that he has worked in London since 1976. He states that he has used his trade mark in various forms since 2002 when he applied for the mark shown below:



7) He states that he decided to file the plain word version which is the subject of these proceedings. He states that the marks have been used on various pomades which are used to keep hair in place, and also conditions the hair. He states that more recently the

mark has also been used on shampoos and conditioners. No details of sales etc. are provided.

TSA’s EVIDENCE IN REPLY

8) TSA filed a witness statement, dated 15 October 2015, by Victoria Anne Bennett its Trade Mark Attorney. She provides a copy of a decision by OHIM in respect of an invalidity action brought by TSA against the CTM of GG. The action was brought on the basis of TSA’s French trade mark. The decision was therefore written in French, but a translation has been provided. I note that the goods in class three relied upon by TSA were identical to its class 3 goods shown at paragraph 2 above with the following changes: “preparations for cleaning, polishing and scouring the skin” was amended to “preparations for cleaning, polishing and exfoliating the skin”; “soap” was amended to “soaps” and “dentifrices” was amended to “toothpaste”. These changes do not, in my opinion, make any difference to the specification.

9) The class 3 of GG’s CTM were slightly different to those in the instant case. The difference were as follows:

CTM specification	Instant case
preparations for colouring, dyeing, straightening, bleaching and setting of hair;	preparations for the colouring, tinting, dyeing, relaxing, bleaching and setting of hair;
“shampoos and hair sprays”	“hair lacquers and shampoos”
“setting foams, styling mousses”	“setting lotions, styling lotions”
“perm solutions and neutralizers;”	“permanent wave solutions and neutralizers;”
“personal care items”	“toiletries,”

10) To my mind these changes do not alter the essential character of the goods in the instant case. OHIM found that the class 3 goods of both parties were identical. They also compared the class 3 goods of TSA to the class 44 services of RA. They found that “Hairdressing services; hairdressing salons; manicuring; massage services” in class 44 were similar to “cosmetics, hair lotions, moisturising milks, essential oils” in class 3. It was stated that:

“It is true that there is a clear difference between the products and services in terms of nature and method if use. However, in this case, they have links in terms of intended purpose and public. Moreover, it is usual for hairdressing, manicure and massage salons to offer various types of care products for sale, in addition to the care service. There is therefore also a coincidence in terms of distribution channels. Finally there is also a relationship of complementarity between these products and services. Given the foregoing, the abovementioned services are deemed similar to the earlier *cosmetics, hair lotions, moisturising milks, essential oils*.

Given the existence of a link between the goods and services at issue as regards their relevant public, distribution channels, intended purpose and complementarity, these products and services are considered similar.”

11) The marks which were compared in the OHIM decision were as follows:

TSA's mark	GG's mark
RHA	RA

12) The relevant territory was France and OHIM commented as follows:

“**Visually**, the signs are similar insofar as they both use the letters “R-A”. In addition, they differ by the presence of the letter “H” in the earlier trademark and by a slight design of the letters of this same trademark.

Phonetically, the pronunciation of the trademarks coincides by the syllable “RA”, as the letter “H” is silent in French. The signs are therefore phonetically identical. In fact, it is likely that the majority of the French public would pronounce the earlier trademark in a single syllable, and not letter by letter.

Conceptually, while the public of the relevant territory would perceive the contested sign as “the chemical symbol for Radium” or as “a serious beats [sic] on a drum, with the two hands alternatively, strongly emphasising the last”, <http://www.larousse.fr/> the other sign is devoid of any meaning, the signs are not similar conceptually.

Given the visual and phonetic coincidences mentioned above, it is considered that the signs at issue are similar.”

13) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

14) The only ground of invalidity is based on section 5(2)(b) which reads:

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.”

15) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

16) TSA is relying upon its trade mark listed in paragraph 2 above which is clearly an earlier trade mark due to its priority and filing date.

17) When considering the issue under section 5(2)(b) I take into account the following principles which are 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

18) 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 these goods are likely to be selected by the average consumer in the course of trade. 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. 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.”

19) Both parties' specifications in classes 3 and 44 cover beautification products and services, which would be purchased by members of the public and also professional beauticians /hairdressers. The level of attention would vary considerably but overall would be purchased with an average level of attention. The products are likely to be selected visually whether that be from the sign outside the premises, the shelves of supermarkets, or in the case of professionals, cash and carry outlets; or from advertising /catalogues/pages on the internet or in printed matter. I must not ignore the possibility of word of mouth recommendations or the fact that advice could be sought from a shop assistant. Aural considerations must therefore also be taken into account. The class 5 goods of TSA are far more specialised but are not required in my comparison.

Comparison of goods

20) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

21) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

22) In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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 that the responsibility for those goods lies with the same undertaking”.

23) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

24) Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

25) In his counterstatement GG accepts that the goods of the two parties in class 3 are either identical or highly similar. He also accepts that his class 44 services are similar to the class 3 goods of TSA. In order to assist comparison I have listed below the specifications of both sides with my own views on similarity.

GG's specification	TSA's specification	
Class 3. Preparations for the body, hair, scalp and skin; cosmetics; make-up;	Class 3. Cosmetic products; gels, creams, milks, masks, lotions; moisturizing gels, moisturizing creams, moisturizing milks, moisturizing masks, moisturizing lotions; preparations for cleaning the body and the face; preparations for cleaning, polishing and scouring the skin;	Identical
preparations for the colouring, tinting, dyeing, relaxing, bleaching and setting of hair; hair lacquers and shampoos; hair tonics, hair conditioners; hair sprays, setting lotions, setting foams, permanent wave solutions and neutralizers;	hair lotions, soap;	Identical
essential oils;	essential oils,	Identical
toiletries,	dentifrices.	Identical
fragrances.	perfumery,	Identical
44. Hairdressing services; hairdressing salons;	hair lotions, soap;	Similar to a medium degree
manicuring;	Cosmetic products; preparations for cleaning, polishing and scouring the skin;	Similar to a medium degree
massage services.	essential oils.	Similar to a medium degree

26) It is clear that with regard to the class 3 goods of both sides the descriptions are either identical or encompass the other sides goods. In respect of the class 44 services I accept that hairdressers usually offer a range of hair products, which in the case of top class salons will be own label products. Similarly manicure and massage services use items such as cleaners, polishers and oils as a routine part of the provision of the service. In my view there is a degree of similarity in purpose and a complementary relationship. As GG has accepted that his services in this class are similar to the goods of TSA I accept his professional opinion. The goods in class 3 are identical; whilst the services in class 44 have a medium degree of similarity to the goods of TSA in Class 3.

Comparison of trade marks

27) The two marks are as follows:

GG's mark	TSA's mark
RA	RHA resilient hyaluronic acid

28) TSA contends that in other cases between the parties GG has contended that the marks of the two parties were identical or similar and that OHIM agreed with this finding. However, the OHIM case compared TSA's French trade mark which is significantly different to the mark being relied upon here. Also, as the full facts of the other cases referred to are not known, I do not intend to take any submissions from these proceedings into account in deciding the issue in the UK, as the average consumer was the French public and in French the letter "h" is said to be silent.

29) TSA's mark is registered in the form shown above, in a single line with the letters RHA in upper case and the other words in lower case. Visually, whilst both marks share the same initial letter "R" they differ significantly thereafter. GG's mark consists of two letters "R" and "A" whereas TSA's mark consists of twenty six letters. The visual differences far outweigh any similarity due to the initial letter being identical. Aurally GG's mark consists of a single syllable if pronounced as a word "RA" or two syllables if pronounced as letters "R" and "A". Because of the presence of the explanatory wording I have no doubt that the average consumer will pronounce the first three letters in TSA's mark separately, then add the words. Thus, TSA's mark will consist of fourteen syllables. There is no aural similarity other than the first letter. Conceptually GG's mark will be seen as either, the letters "R" and "A" or the word "RA" suggesting the hawk headed Egyptian sun-god. TSA's mark will be seen as the letters "R", "H" and "A" which stand for "resilient hyaluronic acid". The marks are not similar conceptually. Overall there is no similarity between the marks other than the fact that they both start with the letter "R" and have a letter "A". If one regards the letters "RHA" as being the dominant element of TSA's mark then there is less of a difference as they share two letters. However there is still a difference between a two and a three letter mark, and the difference comes in the second letter of TSA's mark. Whilst the descriptive wording may be seen in this instance of playing a lesser role it cannot be ignored altogether. Overall, the marks are not similar.

Distinctive character of the earlier trade mark

30) 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, 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 promoting 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).”

31) TSA’s mark is the letters “RHA” and three words which provide the descriptive element to the acronym. I assume that the chemical is a major ingredient in the goods and could be said to describe the product itself. It therefore has at the very best an average level of distinctiveness. As TSA has not filed evidence of any use it has made of its earlier trade mark anywhere, it cannot benefit from enhanced distinctiveness through use.

Likelihood of confusion

32) In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is both members of the public and also professional beauticians /hairdressers who will select the goods by both visual and aural means and who will pay an average level of attention when doing so;
- the goods in class 3 of the two parties are identical, whilst GG’s services in class 44 are similar to a medium degree to TSA’s class 3 goods;
- there is no similarity between the marks other than the fact that they both start with the letter “R” and have a letter “A”.
- the opponent’s earlier trade mark is possessed, at best with an average degree of inherent distinctive character, but does not benefit from an enhanced distinctiveness by the use made of it.

33) In view of the above and even allowing for the concept of imperfect recollection, there is no likelihood of consumers being confused into believing that GG’s goods in class 3 and services in class 44 are those of TSA or provided by some undertaking linked to them, or vice versa. **The opposition under Section 5(2) (b) therefore fails.**

CONCLUSION

34) The invalidity action under Section 5(2)(b) was unsuccessful. The registration will remain upon the Register.

COSTS

35) As GG has been successful he is entitled to a contribution towards his costs.

Preparing a statement and considering the other side's statement	£300
Submissions and considering the other side's evidence and submissions	£600
TOTAL	£900

36) I order Teoxane S.A. to pay the sum of £900 to Gianni Giudicianni. This sum to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 6th day of April 2016

**G W Salthouse
For the Registrar
the Comptroller-General**