

**O/203/17**

**TRADE MARKS ACT 1994**

**APPLICATION No. 3138132 BY WELLA GmbH  
TO REGISTER 'JOELLE' AS A TRADE MARK IN CLASSES 3 AND 44**

**AND**

**OPPOSITION No. 406253 BY MISS JOELLE AMERY**

**AND**

**APPLICATION No. 3152182 BY MISS JOELLE AMERY**

**AND**

**OPPOSITION No. 407588 BY WELLA GmbH**

## **Background and pleadings**

1. This decision covers two consolidated oppositions. The first opposition was filed by Miss Joelle Amery (“Miss Amery”) against application 3138132 filed on 27<sup>th</sup> November 2015 (“the first relevant date”) by Wella GmbH (“Wella”) to register **JOELLE** as a trade mark in relation to:

### Class 3

Soaps, perfumery, essential oils, hair lotions, preparations for the cleaning, care and beautification of the skin, scalp and hair, hair styling products, hair tinting, bleaching, dyeing and coloring preparations.

### Class 44

Hairdresser services, hair salon services, hair care services, hair analysis and consultation services rendered in connection therewith.

2. Miss Amery claims that she had acquired goodwill in the UK under the name JOELLE as a result of her use of that name in the UK since July 2015 in relation to entertainment services. Miss Amery claims that use of the contested mark by Wella would amount to a misrepresentation to the public, which would damage her goodwill as an entertainer (singer). Therefore, use of the contested mark would be contrary to the law of passing off and, consequently, registration of the mark would be contrary to s.5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Wella filed a counterstatement denying Miss Amery’s claims and putting her to proof of her claimed goodwill and reputation.

4. The second opposition was filed by Wella against application 3152182 filed in the name of Miss Amery on 29<sup>th</sup> February 2016 (“the second relevant date”) to register **JOELLE** in relation to a wide range of goods and services in 16 classes. Wella opposes the registration of the mark in relation to goods/services in classes 3, 5, 35 and 44.

5. Wella's opposition is based on earlier filed trade mark application 3138132, which is the subject of the first opposition described above. According to Wella, the opposed goods and services in classes 3 and 44 of Miss Amery's application are identical to the goods and services covered by the earlier trade mark. Therefore, registration of Miss Amery's mark would be contrary to s.5(1) of the Act. Alternatively, Wella says that any such goods or services that are not identical are similar. Further, the goods and services covered by classes 5 and 35 of Miss Amery's application are similar to the goods and services covered by the earlier mark. The identity of the marks and the similarity of the goods/services is such as to create a likelihood of confusion on the part of the public. Consequently, Miss Amery's application should be refused under s.5(2)(a) of the Act for any of the opposed goods/services which are not identical to the goods/services covered by the earlier mark.

6. A counterstatement was filed on behalf of Miss Amery which denied Wella's grounds of opposition, principally on the basis that Wella's earlier trade mark application should be refused on the basis of Miss Amery's opposition.

7. The proceedings are obviously interconnected. Therefore, they were consolidated.

8. Both sides seek an award of costs.

### **Representation**

9. Miss Amery is represented by Trade Mark Wizards Ltd. Wella is represented by D. Young & Co. Neither party asked to be heard, but both filed evidence and written submissions.

### **The evidence**

10. Miss Amery's evidence consists of two witness statements with nine exhibits. The first statement is by Michelle Grayson, who was Miss Amery's legal guardian at

the time.<sup>1</sup> The second statement is by Miss Amery herself. This purported to be evidence in reply to Wella's evidence described below.

11. Ms Grayson's evidence is that Miss Amery, who is widely known as Joelle, is a pop singer and alopecia campaigner from London. According to Ms Grayson, Miss Amery began publicly using her forename Joelle in July 2012 when she released a music video called 'Big in L.A.' on YouTube. The video was later taken down, but was re-uploaded on 14<sup>th</sup> March 2013 and has been available ever since. Ms Grayson says that it "*went viral*" during the summer of 2013, which resulted in Miss Amery receiving international media attention from the press, TV and radio.

12. Miss Grayson claims that Miss Amery was first referred to by the name Joelle by the UK press on 13<sup>th</sup> July 2012 when her first news article was published on Yahoo! news. According to Ms Grayson, a copy of this is included in exhibit 2 to her statement, but I cannot find such an article. Miss Amery appeared on an ITV show called 'Lorraine' on 29<sup>th</sup> August 2013. Some stills from the interview are included in exhibit 1 to Ms Grayson's statement. These are entitled 'Joelle Amery'. Ms Amery's interview also appeared on her YouTube site in March 2014 when viewers were invited to "*Watch my interview with Kate Garraway live on Lorraine.*"<sup>2</sup>

13. On 24<sup>th</sup> August 2013 an article appeared on MailOnline describing how "*a schoolgirl who became an internet hit after her first pop song 'Big in L.A.' was posted on YouTube and received 200k hits, had bravely revealed that she was suffering from alopecia.*"<sup>3</sup> I note that the article refers to Miss Amery first as Joelle Amery, although subsequent references to her are as simply 'Joelle.' I also note that the title shot from the YouTube video, which is included in the article, is 'JOELLE- Big in L.A.'.

14. The website of Metro news carried an article about Miss Amery on 22<sup>nd</sup> April 2014.<sup>4</sup> The article was primarily about her alopecia condition, although it also mentioned that Miss Amery had scored a YouTube hit with Big in L.A. and was

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<sup>1</sup> Miss Amery was 17 at the time the first statement was filed in July 2016. She is now 18.

<sup>2</sup> Also in exhibit 1 to Ms Grayson's statement

<sup>3</sup> See exhibit 2 to Ms Grayson's statement

<sup>4</sup> See exhibit 2 to Ms Grayson's statement

making an album in Nashville, USA. I again note that Miss Amery was initially referred to as Joelle Amery.

15. Similar articles about Miss Amery appeared on the website of BBC Radio London on 25<sup>th</sup> April 2014 and on the website MailOnline on 8<sup>th</sup> June 2014. A video of Miss Amery (“JOELLE”) speaking about her hair loss also appears to have been published by MailOnline on 18<sup>th</sup> April 2015 as part of an online article about alopecia.<sup>5</sup> I note that this article does not expressly mention that Miss Amery is a singer.

16. Exhibit 2 to Ms Grayson’s statement also includes some coverage of Miss Amery from the USA and elsewhere. None of this appears to be relevant to her goodwill and reputation in the UK. However, it also includes an undated article from the website Alopecia Online which describes Miss Amery becoming Alopecia UK’s Youth Ambassador. The article refers to her being 15 years old and therefore appears to date from around May 2014. Again the article is primarily about Miss Amery’s own alopecia condition, but it also covers her fledgling music career after making the music video ‘Big in L.A.’ whilst on holiday in California in 2011.

17. Ms Grayson says that Miss Amery uses her YouTube platform to promote her music and her alopecia campaigning. By the date of Ms Grayson’s statement (June 2016), Miss Amery’s YouTube site had received 375k ‘views’ and that she has over 3k ‘subscribers’. The music video ‘Big in L.A.’ had received 266k ‘views’ and an associated Lyric video had received over 24k ‘views’. This is borne out by pages from the site (from June 2016) in evidence, which show Miss Amery under the name ‘JOELLE’.

18. Wella’s evidence consists of a witness statement by Brigitte Grab who is a Senior Legal Manager at the company. Her evidence shows that (1) a company called Labocos is a sister company to Wella, (2) that Labocos and an Italian company registered trade marks including the word JOELLE in Italy in 1996 in relation to hairdressing services, (3) the marks were subsequently licensed for use in

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<sup>5</sup> See exhibit 2 to Ms Grayson’s statement

Italy, and (4) the marks were subsequently used in Italy. I understand that the purpose of this evidence was to show that Wella already had a legitimate interest in using JOELLE in relation to the goods/services covered by the application before Miss Amery acquired any reputation as JOELLE.

19. Miss Amery's witness statement contains a copy of an agreement dated May 2014 between herself (called 'Joelle' in the agreement) and Alopecia UK.<sup>6</sup> The agreement states that "*Joelle is first and foremost a singer*" and that "*It is from this foundation that any and all decisions must be formed pursuant to the relationship with [Alopecia UK].*" The agreement committed Miss Amery to attend at least one event. It states:

*"In addition to promoting [Alopecia UK], where possible, this event, where possible, will showcase Joelle's work."*

Miss Amery subsequently attended Alopecia UK's 'Big Weekend' event in Manchester on 12<sup>th</sup> September 2015 in her capacity as 'Young Persons Ambassador'.

20. Miss Amery says that The Belgravia Centre, which she says is a leading hair loss clinic, reported her appointment as an ambassador for Alopecia UK on its website. A copy of the relevant pages are in evidence.<sup>7</sup> I note that the article refers to Miss Amery as Joelle Amery.

21. On 21<sup>st</sup> September 2015, Miss Amery received an email from a company trading as Trendco, which sells wigs and hairpieces, which invited her to take part in an upcoming TV advertisement for such products. This appears to have followed a meeting at an alopecia conference. It seems that the advert was planned to be shot in November 2015. It is not clear whether the advertisement proceeded with Miss Amery's involvement. There is no evidence that the advertisement was broadcast.

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<sup>6</sup> See exhibit 1 to Miss Amery's statement

<sup>7</sup> See exhibit 2 to Miss Amery's statement

22. Finally, Miss Amery says that she actively promotes her “*cause in connection with alopecia, wigs and beauty care*” through her Instagram account which [in December 2016] had 11k followers.

### **Admissibility of opponent’s evidence in reply**

23. Rule 20(1) of the Trade Mark Rules 2008 states that:

“...the registrar shall specify the periods within which evidence and submissions may be filed by the parties.”

24. Rule 62(2) of the Rules states that:

“The registrar may control the giving of evidence by giving directions as to-  
(a) the issues on which evidence is required; and  
(b) the way in which evidence is to be placed before the registrar.”

25. These Rules entitle the registrar to set periods for filing evidence and to direct which evidence may be filed during those periods. In this case the registrar’s letter of 26<sup>th</sup> April 2016 directed that any evidence filed by the opponent in answer to the applicant’s evidence should be “*further evidence of fact in reply*”. The evidence of Miss Amery was purported to be in reply but, as Wella’s representative points out, it was completely unrelated to the applicant’s evidence. The applicant had filed no submissions with its evidence. So Miss Amery’s evidence was not answering any criticisms of Ms Grayson’s evidence either. Therefore, Miss Amery’s evidence was not in reply to anything the applicant had filed. It was actually further evidence in chief. This means that the registrar has the power to strike out Miss Amery’s evidence because it was not filed in accordance with the registrar’s directions. The opponent’s representative requests exactly that.

26. Whilst I am sympathetic to the opponent’s position, I have decided not to strike out Miss Amery’s evidence. This is because (1) the evidence was filed in December 2016, but the opponent did not object to it until filing written submissions on 4<sup>th</sup> April 2017, (2) the opponent has not identified any prejudice or needed to ask for

permission to file any further evidence in response to Miss Amery's evidence. I will therefore admit Miss Amery's evidence under Rule 20(4) even though it does not fall within the directions issued under Rules 20(1) and 62.

### **Restriction to the opponent's pleaded case**

27. The opponent's pleaded case is based on Miss Amery having acquired goodwill in the UK under the sign JOELLE as a result on the use of that sign from July 2015 in relation to entertainment services. The applicant's representative objects to the opponent's case being extended to cover goodwill acquired prior to this date.

28. In the circumstances of this case, one would have thought that the opponent would have been crystal clear as to the year in which Miss Amery first used JOELLE to distinguish her musical entertainment services. It is therefore very odd that the opponent pleaded commercial use of JOELLE from July 2015 and then proceeded to file evidence claiming use from 2012. On the other hand, any relevant use of JOELLE prior to July 2015 would have contributed to any goodwill that existed in July 2015 and at the relevant date. So it would be artificial to consider only the use shown after July 2015. Once again, the opponent has not shown how it would be prejudiced from taking all the evidence of use of JOELLE into account. I will therefore consider the merits of the opposition based on all the evidence filed.

### **The law**

29. Section 5(4)(a) states:

“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, or

(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.”

30. The basic requirements to establish a passing off right are well established. They are, essentially, (1) goodwill in a business identified by a sign, (2) a misrepresentation by the defendant through the use of a sign similar enough to the claimant’s sign to deceive (intentionally or otherwise) a substantial number of the claimant’s customers or potential customers into believing that the defendant’s goods or services are those of the claimant, or are connected with the claimant, and (3) damage to the claimant’s goodwill caused by the defendant’s misrepresentation.

31. In *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*,<sup>8</sup> Lord Macnaughten explained the meaning of goodwill like this:

“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 custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

32. So goodwill is “*the attractive force which brings in custom*” and it is usually associated with an established business. The law of passing off protects professionals in the entertainment business as much as any other kind of business.<sup>9</sup> Further, the law protects well-known individuals with established goodwill from false claims that they have endorsed or approved third party goods or services, even where these are in a different field of trade to that of the individual concerned.<sup>10</sup> However, in such a case it is necessary to demonstrate that the reputation of the individual concerned constitutes goodwill with commercial value. For example, in *Irvine v Talksport Ltd* the successful claimant was a famous racing driver with

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<sup>8</sup> [1901] AC 217 (House of Lords)

<sup>9</sup> See, for example, *Hines v Winnick* [1947] 64 RPC 113, in which Vaisey J. accepted that goodwill was attached to the made up name for the conductor of an orchestra which had performed on a BBC radio station for a period of 2-3 months.

<sup>10</sup> See *Irvine v Talksport Ltd* [2002] EWHC 367 (Ch) and *Robyn Rihanna Fenty v Top Shop Ltd*, [2013] EWHC 2310 (Ch), both upheld on appeal to the Court of Appeal.

companies that commercialised his endorsements. Unless it can be shown to have acquired commercial value here, mere reputation in the UK is not enough.<sup>11</sup>

### **Miss Amery's goodwill**

33. The evidence in support of Miss Amery's case conspicuously fails to expressly identify any sales or income generated by services provided under the sign JOELLE (or any other sign). The high point of Miss Amery's claim to have acquired commercial goodwill under JOELLE appears to be Ms Grayson's evidence that Miss Amery's YouTube site has 3k 'subscribers'. However, there is no evidence as to any income generated from these subscriptions, nor is it clear which services the subscribers received in return for their subscriptions, or what proportion of these subscribers are based in the UK. Further, Miss Grayson's evidence goes to the position in June 2016. This is around 7 months after the first relevant date, which is when I must assess the existence of Miss Amery's passing off right. It is not therefore clear how many of Miss Amery's 3k subscribers are (1) based in the UK, or (2) subscribed by the first relevant date.

34. These omissions are even more important than usual in this case because after initially coming to the public's attention in 2013 through her YouTube music video, Miss Amery subsequently appears to become known for campaigning in relation to alopecia. The subscriptions to her YouTube platform are only material to the extent they show that Miss Amery had acquired goodwill in relation to the pleaded 'entertainment services'. Without clearer evidence, it is impossible to know whether the subscribers to Miss Amery's YouTube platform subscribed to gain access to information about her alopecia campaigning, or to her music, or to both. The last two possibilities would be relevant to Miss Amery's pleaded case: the first would not. For all these reasons, I do not accept that the evidence of subscriptions to Miss Amery's YouTube account establishes that goodwill existed in the UK under the sign JOELLE at the first relevant date in relation to entertainment services.

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<sup>11</sup> See *Starbucks (HK) Limited and Another v British Sky Broadcasting Group Plc & Others* [2015] UKSC 31

35. I acknowledge that there is evidence of many more 'views' of Miss Amery's music video 'Big in L.A.' at earlier dates. According to Ms Grayson, this music video had received 266k 'views' at the date of her statement in June 2016. According to the media report described in paragraph 13 above, 200k of these 'views' took place before August 2013. If so, the bulk of the interest was generated over 2 years before the first relevant date. Again it is not clear how many of the viewers of the video were based in the UK.

36. Even if the 200k viewers of the video, or a substantial proportion of them, were based in the UK, I doubt whether the mere posting of a music video in 2012/2013 for others to view on a public platform, such as YouTube, is likely to have created commercial goodwill at the first relevant date in 2015. There is no evidence that viewers paid for access to the video, or that it generated any advertising income, or created any other kind of commercially valuable goodwill. In this connection, I acknowledge that there is a media report in evidence which states that Miss Amery was making an album in the USA in April 2014. However, there is no evidence about the subsequent release, or any sales, of such an album.

37. I am doubtful whether the use of JOELLE shown in the evidence is (taken as a whole) sufficient to establish the existence of a protectable goodwill at the first relevant date. In *Hart v Relentless Records*,<sup>12</sup> Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a

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<sup>12</sup> [2002] EWHC 1984 (Ch)

trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

38. In my view, the evidence shows, at most, that Miss Amery had a small degree of reputation in the UK at the first relevant date, initially generated by her music video in 2013, and later perpetuated by her campaigning activities for alopecia. However, Miss Amery's limited reputation as a singer at the first relevant date has not been shown to have had any significant commercial value. I acknowledge the evidence that in 2015 Miss Amery was asked to appear in an advertisement for wigs and hairpieces. However, this seems to have been as a result of her campaigning activities on alopecia. Miss Amery's pleaded case is that her goodwill is in relation to entertainment services. If she had established UK goodwill in relation to such services by the first relevant date, I find that the extent of it is too uncertain and/or too small to establish a passing off right.

39. If I am right so far, Miss Amery's case falls at the first hurdle. If I am wrong, then I would hold that Miss Amery has not established that JOELLE alone was distinctive of any goodwill she had established by the first relevant date. Although there is evidence of her calling her music video ‘Joelle – Big in L.A.’, and others referring to her informally as Joelle, the evidence falls short of establishing that JOELLE was used and recognised as a single word name, like Madonna or Rihanna. In my view, the evidence as a whole is more consistent with ‘Joelle Amery’ having become distinctive of Miss Amery's music.

### **Misrepresentation**

40. In case I am wrong to find that Miss Amery's case fails for lack of the necessary goodwill, I will also consider misrepresentation. In doing so I must necessarily assume, contrary to my primary findings, that Miss Amery's evidence crosses the threshold for establishing goodwill.

41. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 184 provides the following guidance on the law of passing off with regard to misrepresentation.

"In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

42. Applying this guidance I find that:

- Miss Amery's goodwill and reputation in the UK as a singer providing entertainment services was, at best, limited at the first relevant date.
- As an entertainer, Miss Amery was in a different field of activity compared to traders in the goods/services covered by Wella's application.

- Miss Amery's was known to some in the UK as a singer affected by alopecia and who campaigned on that issue.
- Miss Amery appears to have become known (to the extent that she had become known) as Joelle Amery. JOELLE AMERY has some similarity to JOELLE, but the names do not necessarily identify the same person or business. Most of Miss Amery's customers or potential customers would realise that.
- Customers for musical entertainment services are likely to overlap with customers for beauty products in class 3 and hairdressing services etc. in class 44. However, the relevant class of persons would not usually expect to purchase the respective goods/services from the same place, or from the same commercial source.

43. I remind myself that it is not sufficient to establish passing off to show that a substantial number of Miss Amery's 'customers or potential customers' may have wondered whether or not Miss Amery was connected with the goods/services covered by the application.<sup>13</sup> Rather, it is necessary to show that a substantial number of such persons would have made this assumption. However, even if Miss Amery was known to some of her UK based 'customers or potential customers' as a singer who suffered from and/or campaigned on alopecia, I do not find it likely that a substantial number of them would have assumed a relevant connection. After all, an endorsement type connection is only likely to be assumed where a product or service is marketed under the name or image of a person with a substantial reputation in their field. It follows that Miss Amery's case on misrepresentation would have failed, even if I had found that the evidence filed in support of her case crossed the threshold for establishing commercial goodwill.

## **Damage**

44. In the light of my findings on goodwill and misrepresentation, there is no need to address the issue of damage.

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<sup>13</sup> Per Jacob L.J. in *Phones 4U Ltd v Phone 4U.co.uk Internet Ltd* [2007] RPC 5 at 16–17

## **Outcome of Ms Amery's opposition to Wella's application**

45. The opposition fails. Subject to appeal, Wella's application 3138132 will proceed and JOELLE will be registered in classes 3 and 44.

## **Wella's opposition to Miss Amery's application**

46. Wella's opposition is based on earlier trade mark 3138132 and ss.(1) and (2)(a) of section 5 of the Act. These are shown below.

"5. - (1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

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

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

(b) -

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

## **Identity or similarity of goods/services**

47. According to the written submissions filed on behalf of Wella on 4<sup>th</sup> April 2017, the goods/services shown below in classes 3 and 44 of Miss Amery's application are identical or similar to those in the same classes of the earlier trade mark.

*Bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; **soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;** nailcare cosmetics; **perfume; fragrances;** deodorants; anti-perspirant deodorants; **cosmetics; cosmetic***

**preparations; milks [cosmetics];\_skincare cosmetics; haircare cosmetics; moisturisers [cosmetics]; eyebrow cosmetics; mousses [cosmetics]; tanning oils [cosmetics]; tanning milks [cosmetics]; body creams [cosmetics]; non-medicated cosmetics; tissues impregnated with cosmetics; cosmetics for eye-brows; cosmetics for personal use; colour cosmetics for the skin; colour cosmetics for the eyes; liners [cosmetics] for the eyes; cosmetics for bronzing the skin; temporary tattoo transfers for use as cosmetics; cosmetics all for sale in kit form; cosmetics in the form of eye shadow; *teeth whitening strips impregnated with teeth whitening preparations [cosmetics]*, **glitter in spray form for use as a cosmetics;** make-up removing preparations; **make-up foundations; make-up primer; make-up for the face and body; body lotions; body shampoos; body scrub;** body masks; **body milks; body moisturisers; body oil; abrasive preparations for use on the body; hand scrubs; hand soaps; hand creams; skin moisturisers; skin cleansers; lip balm; lip gloss; make-up; make-up preparations,** pencils and crayons;\_**make-up foundations and powders; skin make-up; eye make-up; eye liner,** sticks, pencils, crayons, **lotions, shadow, creams and gels;** cosmetic skin masks, **moisturisers, body cream, milks and night creams; eyebrow and eye-lash cosmetics;** eyebrow pencils; false nails, eyebrows, hair and eyelashes; lipsticks; adhesives for affixing false eyelashes; **hair waving preparations; hair care and styling preparations;** adhesives for affixing false hair; **cosmetics for the use on the hair; ethereal essences and oils;** bath salts; aromatherapy oils and preparations; **cosmetic preparations for baths; toiletries; flower extracts; shower foams, soap, gel and creams; hair oil; shampoos; conditioners;** hair masks; hair serums; cosmetics for treating hair loss; cosmetics for stimulating hair growth; hair moisturiser, scalp conditioner, scalp moisturiser, intensive deep hair conditioner, hair volumiser, hair shiner, curl activator, styling gel, hair spray, hairdressing cream, non-medicated cream for stimulation of the scalp, sun protection hair spray, sun protection hair cream, anti-dandruff shampoo, cream and conditioner.**



Class 44

**Hygienic and beauty care for human beings or animals;** therapeutic treatment of the face; therapeutic treatment of the body; massage and therapeutic shiatsu massage; health care relating to therapeutic massage; personal therapeutic services relating to hair regrowth; healthcare services; alopecia advisory services; healthy consultancy; counselling related to alopecia; providing alopecia information; health advice and information services; consultancy relating to alopecia; information services relating to alopecia; medical testing, research education and guidance in connection with alopecia; **provision of haircare and hair and scalp treatment services, all provided at counters, clinics and advisory centres; hairdressing services; consultancy and advisory services for the aforementioned.**

48. I will keep in mind that the terms used in the parties' specifications should be given their ordinary and natural meanings.<sup>14</sup>

49. In *Gérard Meric v OHIM*,<sup>15</sup> the General Court stated that:

“29. .... 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 fur 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”.

50. Applying this approach I find that all the descriptions of goods/services in Miss Amery's application which are shown in bold in the list in paragraph 47 above, must be considered to be identical to the one of more of the descriptions of goods/services covered by the earlier mark. Taking some examples in class 3, *preparations for the cleaning, care and beautification of the skin, scalp and hair* in Wella's application is a wide term: wide enough to cover *cosmetics, make-up preparations* and *moisturisers* in Miss Amery's application. Similarly, Wella's *perfumery* and *essential oils* are wide

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<sup>14</sup> See *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J.

<sup>15</sup> Case T-133/05

enough to cover Miss Amery's *flower extracts*. Wella's *soaps* is covered by Miss Amery's *toiletries*. Therefore, all these goods must be considered identical. I think it is obvious why the terms I have shown in bold in class 44 of Miss Amery's application must be considered to be identical to the corresponding services in class 44 covered by Wella's earlier mark.

51. Turning to the question of similarity of the class 3 and 44 goods/services, the CJEU provided the following guidance in *Canon*:<sup>16</sup>

“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”.

52. Applying this guidance I find that all the goods/services shown in the list at paragraph 47 above, apart from those shown in bold or italics, are similar to at least a medium degree to the goods/services covered by the earlier mark. So far as class 3 is concerned, I find that Wella's *preparations for the cleaning, care and beautification of the skin, scalp and hair* are similar to at least a medium degree to Miss Amery's *abrasive preparations for use on the body, cleaning, polishing, scouring and abrasive preparations, nailcare cosmetics, tissues impregnated with cosmetics, temporary tattoo transfers for use as cosmetics body masks; make-up pencils and crayons; make-up removing preparations, eye sticks, pencils, crayons; cosmetic skin masks, eyebrow pencils; false nails, eyebrows, hair and eyelashes; lipsticks; adhesives for affixing false eyelashes*. This is because all of these terms cover products for beautification of the body which are sold to the same consumers through the same channels. Further, some of the respective goods are likely to be complementary, e.g. *hair styling products* and *hair adhesives for affixing false eyelashes*.

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<sup>16</sup> Case C-39/97 at paragraph 23 of the judgment

53. Further, the following of the parties' respective goods in class 3 are plainly highly similar:

*Perfumery, essential oils – against - aromatherapy oils and preparations*

*Hair lotions, hair styling products and preparations for the cleaning, care and beautification of the skin, scalp and hair – against - hair masks; hair serums; cosmetics for treating hair loss; cosmetics for stimulating hair growth; hair moisturiser, scalp conditioner, scalp moisturiser, intensive deep hair conditioner, hair volumiser, hair shiner, curl activator, styling gel, hair spray, hairdressing cream, non-medicated cream for stimulation of the scalp, sun protection hair spray, sun protection hair cream, anti-dandruff shampoo, cream and conditioner.*

54. This leaves Miss Amery's *bleaching preparations and other substances for laundry use; dentifrices; teeth whitening strips impregnated with teeth whitening preparations [cosmetics]*. Wella submits that these are similar goods to its own goods in class 3. However, I see no similarity between Wella's goods and *bleaching preparations and other substances for laundry use*. The purpose of the respective goods appears different, they are not in competition or complementary, and they would not be sold on the same shelves in a supermarket. I accept that *dentifrices; teeth whitening strips* are – like Wella's goods - for cleaning and beautification purposes, but they are not for beautification of the skin, scalp or hair. Further, I am not satisfied that products for cleaning and whitening the teeth are commonly sold in proximity to products for cleaning or beautifying the rest of the body and/or marketed by the same undertakings. My own impression as a consumer is that *dentifrices* tend to have their own distinct market compared to other cosmetic products and cleaning preparations. I therefore find that Wella has not established that these are similar goods.

55. Turning to class 44, I find that Wella's *hair analysis and consultation services rendered in connection therewith* are highly similar to Miss Amery's *medical testing...and guidance in connection with alopecia, alopecia advisory services; healthy consultancy; counselling related to alopecia; providing alopecia information;*

*health advice and information services; consultancy relating to alopecia; information services relating to alopecia.* This is because all these descriptions cover, at the least, services for assessing hair density and hair growth. Wella's services also appear similar to a medium degree to Miss Amery's *personal therapeutic services relating to hair regrowth.* This is because they appear to be complementary services, which are liable to be provided by the same undertaking. As the latter description of services falls within the wider terms *therapeutic treatment of the body and healthcare services* it follows that the same finding also applies to these descriptions of services.

56. This leaves Miss Amery's *therapeutic treatment of the face and massage and therapeutic shiatsu massage* services. The ordinary meaning of 'face' does not cover the hair. Therefore, I see no similarity between Wella's services in class 44 and Miss Amery's services for *therapeutic treatment of the face.* However, I see a complementary relationship between these services and Wella's *preparations for the cleaning, care and beautification of the skin* in class 3. It appears to me that the goods are important for the use of the services, are liable to be used together on the same consumer, who may reasonably regard them as the goods and services of the same undertaking. There is therefore a medium degree of similarity between these goods and services. Similarly, *essential oils* are complementary goods to *massage and therapeutic shiatsu massage* services. Therefore, these goods and services are also similar to a medium degree. This means that all of the opposed services in class 44 of Miss Amery's application are identical or similar to Wella's goods/services.

57. According to Wella's written submissions of 4<sup>th</sup> April 2017, the following goods in class 5 of Ms Amery's application are similar to the goods/services covered by its earlier trade mark.

Medicated hair lotions; hair growth stimulants; medicated hair care preparations; medicinal preparations for stimulating hair growth; medicinal hair growth preparations; homeopathic supplements.

58. I find that all of these goods, save for *homeopathic supplements*, are similar to a medium degree to Wella's *hair lotions and preparations for the cleaning, care and*

*beautification of the skin, scalp and hair* in class 3. Admittedly, Wella's goods are not for medical purposes, but the nature of the goods is similar and the method of use is the same. Further, the users of the respective goods are likely to overlap. Further still, the respective goods may be found in the same stores, e.g. chemists. Other than by way of a general assertion that the opposed goods/services "*essentially all relate to the beautification or care of the body and hair*", Wella has not explained why *homeopathic supplements* should be considered similar to its goods/services. I see no obvious similarity. It is for Wella to make out its case. Therefore, I find that Wella has not established that *homeopathic supplements* are similar to any of its goods/services.

59. According to Wella's written submissions of 4<sup>th</sup> April 2017, the following services in class 35 of Ms Amery's application are similar to the goods/services covered by its earlier trade mark.

Retail services connected with preparations for the care of the hair and the scalp, nutritional supplements, printed matter, books, hairbrushes and combs; wholesale services connected with preparations for the care of the hair and scalp, nutritional supplements, printed matter, books, hairbrushes and combs; retail and online retail services in relation to the sale of bleaching preparations and other substances for laundry use, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, nailcare cosmetics, perfume, fragrances, deodorants, anti-perspirant deodorants, cosmetics, cosmetic preparations, milks [cosmetics], skincare cosmetics, haircare cosmetics, moisturisers [cosmetics], eyebrow cosmetics, mousses [cosmetics], tanning oils [cosmetics], tanning milks [cosmetics], body creams [cosmetics], non-medicated cosmetics, tissues impregnated with cosmetics, cosmetics for eye-brows, cosmetics for personal use, colour cosmetics for the skin, colour cosmetics for the eyes, liners [cosmetics] for the eyes, cosmetics for bronzing the skin, temporary tattoo transfers for use as cosmetics, cosmetics all for sale in kit form, cosmetics in the form of eye shadow, teeth whitening strips impregnated with teeth whitening preparations [cosmetics], glitter in spray form for use as a cosmetics, make-up removing preparations, make-up foundations, make-up

primer, make-up for the face and body, body lotions, body shampoos, body scrub, body masks, body milks, body moisturisers, body oil, abrasive preparations for use on the body, hand scrubs, hand soaps, hand creams, skin moisturisers, skin cleansers, lip balm, lip gloss, make-up, make-up preparations, pencils and crayons, make-up foundations and powders, skin make-up, eye make-up, eye liner, sticks, pencils, crayons, lotions, shadow, creams and gels, cosmetic skin masks, moisturisers, body cream, milks and night creams, eyebrow and eye-lash cosmetics, eyebrow pencils, false nails, eyebrows, hair and eyelashes, lipsticks, adhesives for affixing false eyelashes, hair waving preparations, hair care and styling preparations, adhesives for affixing false hair, cosmetics for the use on the hair, ethereal essences and oils, bath salts, aromatherapy oils and preparations, cosmetic preparations for baths, toiletries, flower extracts, shower foams, soap, gel and creams, hair oil, shampoos, conditioners, hair masks, hair serums, cosmetics for treating hair loss, cosmetics for stimulating hair growth, hair moisturiser, scalp conditioner, scalp moisturiser, intensive deep hair conditioner, hair volumiser, hair shiner, curl activator, styling gel, hair spray, hairdressing cream, non-medicated cream for stimulation of the scalp, sun protection hair spray, sun protection hair cream, anti-dandruff shampoo, cream and conditioner, pharmaceuticals, medical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances adapted for medical or veterinary use, food for babies, dietary supplements for humans and animals, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, medicated hair lotions, hair growth stimulants, medicated hair care preparations, medicinal preparations for stimulating hair growth, medicinal hair growth preparations, homeopathic supplements.

60. I will first consider the similarity between Wella's goods in class 3 and the services it opposes in class 35 of Miss Amery's application. In *Oakley, Inc v OHIM*,<sup>17</sup> the General Court held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be

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<sup>17</sup> Case T-116/06 at paragraphs 46-57

complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

61. In *Tony Van Gulck v Wasabi Frog Ltd*,<sup>18</sup> Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. On the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>19</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>20</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>21</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

62. Approaching the matter with this guidance in mind, I find that there is at least a low degree of similarity between Wella's goods and the following services:

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<sup>18</sup> Case BL O/391/14

<sup>19</sup> Case C-411/13P

<sup>20</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>21</sup> Case C-398/07P

Retail services connected with preparations for the care of the hair and the scalp, hairbrushes and combs; wholesale services connected with preparations for the care of the hair and scalp, hairbrushes and combs; retail and online retail services in relation to the sale of cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions, nailcare cosmetics, perfume, fragrances, deodorants, anti-perspirant deodorants, cosmetics, cosmetic preparations, milks [cosmetics], skincare cosmetics, haircare cosmetics, moisturisers [cosmetics], eyebrow cosmetics, mousses [cosmetics], tanning oils [cosmetics], tanning milks [cosmetics], body creams [cosmetics], non-medicated cosmetics, tissues impregnated with cosmetics, cosmetics for eye-brows, cosmetics for personal use, colour cosmetics for the skin, colour cosmetics for the eyes, liners [cosmetics] for the eyes, cosmetics for bronzing the skin, temporary tattoo transfers for use as cosmetics, cosmetics all for sale in kit form, cosmetics in the form of eye shadow, glitter in spray form for use as a cosmetics, make-up removing preparations, make-up foundations, make-up primer, make-up for the face and body, body lotions, body shampoos, body scrub, body masks, body milks, body moisturisers, body oil, abrasive preparations for use on the body, hand scrubs, hand soaps, hand creams, skin moisturisers, skin cleansers, lip balm, lip gloss, make-up, make-up preparations, pencils and crayons, make-up foundations and powders, skin make-up, eye make-up, eye liner, sticks, pencils, crayons, lotions, shadow, creams and gels, cosmetic skin masks, moisturisers, body cream, milks and night creams, eyebrow and eye-lash cosmetics, eyebrow pencils, false nails, eyebrows, hair and eyelashes, lipsticks, adhesives for affixing false eyelashes, hair waving preparations, hair care and styling preparations, adhesives for affixing false hair, cosmetics for the use on the hair, ethereal essences and oils, bath salts, aromatherapy oils and preparations, cosmetic preparations for baths, toiletries, flower extracts, shower foams, soap, gel and creams, hair oil, shampoos, conditioners, hair masks, hair serums, cosmetics for treating hair loss, cosmetics for stimulating hair growth, hair moisturiser, scalp conditioner, scalp moisturiser, intensive deep hair conditioner, hair volumiser, hair shiner, curl activator, styling gel, hair spray, hairdressing cream, non-medicated cream for stimulation of the scalp, sun protection hair spray, sun protection hair cream, anti-dandruff



shampoo, cream and conditioner, medicated hair lotions, hair growth stimulants, medicated hair care preparations, medicinal preparations for stimulating hair growth, medicinal hair growth preparations.

63. However, I find that any complementarity between Wella's goods and the services set out below is insufficiently pronounced that, from the consumer's point of view, the undertaking offering these services is unlikely to be taken as being responsible for the goods covered by class 3 of Wella's application.

Retail and wholesale services connected with nutritional supplements, printed matter, books; retail and online retail services in relation to the sale of bleaching preparations and other substances for laundry use, dentifrices, teeth whitening strips impregnated with teeth whitening preparations [cosmetics] and homeopathic supplements.

64. I see no similarity between the services covered by class 35 of Miss Amery's application and those covered by class 44 of Wella's application.

65. A degree of similarity between the respective goods and services is essential in order to succeed in an opposition under s.5(2) of the Act.<sup>22</sup> Consequently, Wella's opposition fails in respect of the following goods/services.

Class 3

Bleaching preparations and other substances for laundry use; dentifrices; teeth whitening strips impregnated with teeth whitening preparations [cosmetics]

Class 5

Homeopathic supplements

Class 35

Retail and wholesale services connected with nutritional supplements, printed matter, books; retail and online retail services in relation to the sale of

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<sup>22</sup> *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

bleaching preparations and other substances for laundry use, dentifrices, teeth whitening strips impregnated with teeth whitening preparations [cosmetics] and homeopathic supplements.

### **Comparison of marks**

66. Miss Amery's mark is identical to Wella's earlier trade mark JOELLE. This means that the opposition succeeds under s.5(1) in relation to all the goods/services in Miss Amery's application which I have held are identical to the goods/services covered by Wella's earlier trade mark. These are shown in bold in the list at paragraph 47 above.

### **Likelihood of confusion**

67. I next consider whether the use of JOELLE by Miss Amery in relation to the goods/services I found are similar to the goods covered by Wella's earlier trade mark<sup>23</sup> will result in a likelihood of confusion. The following principles 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.

#### *The principles*

(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

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<sup>23</sup> The goods/services shown in italics in the table in paragraph 47.

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 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;

(d) 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;

(e) 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;

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

(g) 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.

### **Average consumer**

68. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*.<sup>24</sup>

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<sup>24</sup> Case C-342/97

69. I find that most of the goods/services that Wella opposes in Miss Amery's application are everyday goods likely to be purchased by the general public whilst paying an average or normal degree of attention. However, because of their possible side effects, certain goods/services for treating alopecia are likely to be selected with an above average degree of attention.

### **Distinctive character of earlier mark**

70. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,<sup>25</sup> 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).”

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<sup>25</sup> Case C-342/97

71. There is no evidence of use of Wella's earlier trade mark in the UK. Consequently, I only need to consider the degree to which JOELLE is inherently distinctive in relation to the opposed goods/services in Miss Amery's application.

72. JOELLE is obviously a female forename and would be recognised as such by relevant consumers. Forenames are rarely unique. They are relatively common trade marks, particularly in the field of beauty products for women. On the other hand, JOELLE is a relatively uncommon name. Overall, I find that JOELLE is a mark of normal distinctiveness.

73. It is necessary to consider the earlier mark to have been used in relation to all the goods/services covered by the registered specification. As Kitchen L.J. stated In *Roger Maier and Another v ASOS*:<sup>26</sup>

“78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

74. Similarly, it is necessary to consider all the circumstances in which the mark applied for might be used if it were to be registered.<sup>27</sup> Approaching the matter in this way, I find that there was a likelihood of confusion at the second relevant date. In particular, I find that the identity of the [normally distinctive] marks was liable to cause consumers to believe that goods/services marketed under Miss Amery's mark

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<sup>26</sup> [2015] EWCA Civ 220

<sup>27</sup> See *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the CJEU, at paragraph 66 of the judgment

came from the same undertaking, or from one that was economically-linked, to the undertaking that markets similar goods/services under the earlier mark.

75. I have taken into account that some of Miss Amery's similar goods/services are likely to be selected by consumers paying an above average level of attention but, given the identity of the marks, I do not find this factor sufficient to exclude the likelihood of confusion, which includes the likelihood of association.

76. This means that the opposition succeeds under s.5(2)(a) in relation to all the opposed goods/services in classes 3, 5, 35 & 44, except those shown in paragraph 65 above.

77. It follows from what I have said that if I had found that any of the goods/services covered by Miss Amery's application were similar, rather than identical, to the goods/services covered by Wella's application, the opposition to the registration of Miss Amery's mark in relation to those goods/services would have succeeded under s.5(2)(a), even if it had not succeeded under s.5(1).

### **Overall outcome**

78. Miss Amery's opposition to Wella's applications fails.

79. Wella's opposition to goods/services in classes 3, 5, 35 and 44 of Miss Amery's application mostly succeeds.

80. Miss Amery's application may proceed to registration only in respect of the unopposed goods/services and those goods/services in respect of which Wella's opposition failed. This means all the goods/services published in classes 9, 14, 16, 18, 20, 21, 25, 26, 36, 38, 41 and 43 and;

#### **Class 3**

Bleaching preparations and other substances for laundry use; dentifrices; teeth whitening strips impregnated with teeth whitening preparations [cosmetics].

## Class 5

Pharmaceuticals, medical and veterinary preparations; sanitary preparations for medical purposes; dietetic food and substances adapted for medical or veterinary use, food for babies; dietary supplements for humans and animals; plasters, materials for dressings; material for stopping teeth, dental wax; disinfectants; homeopathic supplements; vitamin supplements; nutritional supplements.

## Class 35

Advertising; business management; business administration; office functions; advertising and promotion services and consulting services relating to music, arts, performing, talent and entertainment; advertising and publicity services; advertising services provided via the internet; production of television and radio advertisements; advertising services promoting the interests of musicians, singers, songwriters, musical performers and artists; business management; provision of business information; management of musical shows; organisation, promoting and conducting trade shows in the field of music; promoting the concerts of others; promoting the goods and services of others by arranging for sponsors to affiliate their goods and services with concerts and musical events; conducting on-line tradeshow exhibitions in the field of music, musical concerts and videos; advertisements via electronic magazines accessed through a global computer network; providing business information about the goods and services of others in the fields of music and entertainment via a global computer network; computerised online ordering featuring general merchandise and general consumer goods; computerised on-line gift ordering services which matches the gift giver's requirements with the gift recipient's wants and needs; demonstration of goods; on-line advertising on a computer network; sales promotion for others production of video recordings for advertising, publicity and marketing purposes; retail services connected with nutritional supplements, printed matter, books; wholesale services connected with nutritional supplements, printed matter, books; retail and online retail services in relation to the sale of bleaching preparations and other substances for laundry use, dentifrices, teeth

whitening strips impregnated with teeth whitening preparations [cosmetics], pharmaceuticals, medical and veterinary preparations, sanitary preparations for medical purposes, dietetic food and substances adapted for medical or veterinary use, food for babies, dietary supplements for humans and animals, plasters, materials for dressings, material for stopping teeth, dental wax, disinfectants, homeopathic supplements, vitamin supplements, nutritional supplements, scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking [supervision], life-saving and teaching apparatus and instruments, apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, apparatus for recording, transmission or reproduction of sound or images, magnetic data carriers, recording discs, compact discs, dvds and other digital recording media, data processing equipment, computers, computer software, apparatus, instruments and media for recording, reproducing, carrying, storing, processing, manipulating, transmitting, broadcasting, retrieving and reproducing music, sounds, images, text, and information, reproductions of sound and/or video in electronic and digital form, all supplied by means of multimedia, remote computers or on-line from databases or from facilities provided on the internet (including websites), sound storage media, image storage media and data storage media, all being pre-recorded, downloadable mp3s, digital media, computer software for access to databases relating to music, entertainers, performers, entertainment products, entertainment services and music-related products, computer programs for managing communications and data exchange relating to music, audio and visual data, multimedia software for downloading music, audio and visual data, cds, dvds, audio tapes (all being sold together with booklets), pre-recorded vinyl records, sound and/or video recording on corresponding recording carriers, sound and/or video cassettes, cassettes for the storage of, or containing, tapes for or bearing sound or video recordings, parts and fittings for all the aforesaid goods, precious metals and their alloys, jewellery, precious stones, horological and chronometric instruments, personal jewellery, pewter jewellery, fake jewellery, fashion jewellery, costume jewellery, jewellery boxes and cases, agates, amulets, ankle bracelets, artificial gem stones, artificial jewellery, bands for watches, bangles, beads for



making jewellery, body-piercing rings and studs, boxes of precious metal, bracelets, broches, cases adapted to contain items of jewellery and watches, jewellery charms, chronographs, clip earrings, tie clips, clocks and watches, cuff links, pearls, cultured pearls, diamonds, cut diamonds, decorative pins of precious metal, diving watches, earrings, gems and gemstones, gold and its alloys, jades, jewellery cases and caskets of precious metal, jewellery in the form of beads, jewellery incorporating diamonds, jewellery incorporating pearls, jewellery made from gold, bronze or silver, fancy key rings of precious metals, key chains, key charms, key rings, key fobs, lapel pins, necklaces, jewellery ornaments, pendants, platinum and its alloys, rings, wedding rings and bands, jewellery made from ruby and sapphires, silver jewellery, tiaras, paper, cardboard and goods made from these materials, namely leaflets, brochures, flyers, posters, business cards, publications, instructional and teaching materials and manuals, bookbinding material, photographs, stationery, adhesives for stationery or household purposes, artists' materials, paint brushes, typewriters and office requisites (except furniture), instructional and teaching material (except apparatus), plastic materials for packaging (not included in other classes), printers' type, printing blocks, posters, calendars, temporary tattoos, stickers, decals, bumper stickers, iron-on and plastic transfers, blank cards, gift and greeting cards, motivational cards, occasion and note cards, place, record, score and trading cards, postcards, scrapbooks, stationery, note pads, paper note tablets, writing tablets, note books, folders, bookmarks, paper pennants, binders, writing paper, envelopes, address and appointment books, desk pads, paper tags, passport cases, covers and holders, desk top and personal organizers, organizers for stationery use, stationery-type portfolios, paper flags, mounts for stamps, rubber stamps, stamp albums, stamp pad inks, stamp pads, sleeves for holding and protecting stamps, paper banners, holders for desk accessories, document holders, letter openers, racks and trays, pen and pencil cups, pens, pencils, crayons, colouring crayons, marking crayons, pastels [crayon], wipe-off boards for use with crayons, markers, pen and pencil sets, erasers, drafting and drawing rulers, pencil sharpeners, bookends, book covers and holders, checkbook covers, checkbook holders, checkbook and passbook wallets, coin and photograph albums, bulletin boards, photographic, picture or

art mounts, photographic prints, photographs, lithographs, decorative paper centerpieces and pencil-top ornaments, picture books, globes, paperweights, paper clip and sign holders, printed paper signs, clip boards, paper party favors, paper emblems, printed emblems, paper identification tags, paper name badges, paper illustration boards, paper flower pot covers, clip boards, paper cloths for polishing and cleaning, paper handkerchiefs, tour books, printed concert programs, books, magazines, leaflets, journals, newsletters, booklets, pamphlets and brochures, leather and imitations of leather, and goods made of these materials and not included in other classes, animal skins, hides, trunks and travelling bags, make up bags and cases, pouches for holding make-up, and other personal items, hand bags and travel bags, cosmetic cases, beauty cases, cases for carrying make up brushes, key cases, wallets and purses, household or kitchen utensils and containers, combs and sponges, brushes [except paintbrushes], brush-making materials, articles for cleaning purposes, steelwool, unworked or semi-worked glass [except glass used in building], glassware, porcelain and earthenware, cups and mugs, coffee mugs, ceramic mugs, porcelain mugs, earthenware mugs, china mugs, mugs made of plastic, mugs of precious metal, electrically heated mugs, cosmetic brushes, cosmetic cases sold filled with cosmetic brushes, kabuki brushes, puffs and sponges, foundation brushes, concealer brushes, powder brushes, bronzer brushes, fan powder brushes, contouring brushes, blending brushes, eye shadow brushes, applicators for applying eye make-up, cosmetics applicators, make-up removing appliances, eyeliner brushes, smudger brushes, eyebrow definer brushes, lip brushes, shader brushes, bath brushes, bath products, namely, loofah sponges, bath sponges, body scrubbing puffs, bottles, sold empty, facial buffing pads, facial cleansing sponges, facial sponges for applying make-up, powder puffs, washing brushes, nail brushes, cosmetic bags and cases, containers for cosmetics, compacts sold empty, hair and brush combs, clothing, footwear, headgear, articles of clothing, namely men's wear, ladies' wear, clothing for children, shirts, t-shirts, polo shirts, rugby shirts, sports shirts, trousers, jeans, shorts, sports shorts, swimwear, underwear, lingerie, tracksuits, articles of outerwear, coats, jackets, ski jackets, waterproof and weatherproof jackets and coats, ski wear, suits, jumpers and cardigans, pullovers, twinsets, knitwear, leggings,

neckties, pyjamas, waistcoats, headbands and wristbands, slacks, skirts, wraps, jerseys, blouses, dresses, sleepwear, robes, sweatshirts, bibs, stockings, ties, tuxedos, vests, kilts, shawls, blazers, headbands and wristbands, overalls halter tops, tank tops, crop tops, shirts, pants, shorts, sweaters, capris, skirts, dresses, blazers, blouses, jackets, coats, slacks, suits, jeans, vests, sweatpants, sweatshirts, sweat shorts, sweat suits, jogging suits, underwear, lingerie, nightwear, leisurewear, sleep shirts, sleep pants, sleep tops, pyjamas, pyjama sets, baby doll nightdresses, nightdresses, robes, gowns and wraps, t-shirts, hoodies, jackets, tops, pants, capri pants, sarongs, camisoles, chemises, slips, boxer shorts, eye masks, bras, sport bras, bralets, bustiers, body suits, bra accessories, namely bra straps, bra extenders, bra pads, self-adhesive support tapes for wear, nipple covers, slips, panties, g-strings, thongs, boylegs, bikinis, briefs, boxer shorts, garter belts, girdles, sarongs, camisoles, lingerie, negligees, pyjamas, nightgowns, bathrobes, chemises, teddies, sleep shirts, sleep pants, baby dolls, capri sets, boxer sets, kimonos, underpants, undershirts, underwear, swimwear, beach cover-ups, towelling dress, headbands, ties and belts, scarves, shawls, gloves, mittens, belts (being articles of clothing), aprons, beachwear, bikinis, swimming costumes, fitted swimming costumes with bra cups, gloves, mittens, socks, stockings and hosiery, footwear, namely, boots, shoes, slippers, sandals, trainers, booties, workout shoes and running shoes, socks and hosiery, stockings, pantyhose, tights, leotards, beach shoes, football shoes, soles for footwear, ski boots, headgear, namely, hats, caps, berets, earmuffs, top hats, visors, baseball caps, headbands, beanies, saris, head scarves.

#### Class 44

Medical services; veterinary services; agriculture, horticulture and forestry services; therapeutical pilates; consultancy and advisory services for the aforementioned.

## **Costs**

81. Wella has successfully defended its own application and its opposition to Miss Amery's application has mostly succeeded. Wella is therefore entitled to a contribution towards its costs. In the circumstances I award Wella the sum of £1600. The sum is calculated as follows:

£250 - considering Miss Amery's notice of opposition and filing a counterstatement;

£450 – filing a notice of opposition to Miss Amery's application and considering her counterstatement;

£600 – filing evidence and considering Miss Amery's evidence and written submissions

£300 – filing written submissions in lieu of a hearing.

82. I therefore order Miss Joelle Amery to pay Wella GmbH the sum of £1600. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of those proceedings.

**Dated this 28th day of April 2017**

**Allan James**

**For the Registrar**