

O/539/21

TRADE MARKS ACT 1994

IN THE MATTER OF UNITED KINGDOM TRADE MARK NO. 346024

BY ADAM REED SALONS LTD TO REGISTER

ADAM REED<sup>™</sup>  
LONDON

IN CLASSES 3, 4, 25, 26, 41, AND 44

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 420974

BY PERCY & REED PRODUCT LIMITED

## BACKGROUND AND PLEADINGS

1. On 31 January 2020 Adam Reed Salons Ltd ('the applicant') applied to register the United Kingdom ('UK') trade mark

**ADAM REED**  
L O N D O N

It was accepted and published in the UK Trade Marks Journal on 14 February 2020 in classes 3, 4, 25, 26, 41, and 44, covering the following goods and services:

**Class 3:** *Non-medicated soaps; non-medicated toilet preparations; soaps; perfumery; perfumery products; essential oils; non-medicated cosmetics; preparations for the hair, skin and scalp; shaving preparations; cosmetics; products for personal hygiene and beauty care; depilatory products; bath herbs; essential oils; bath oils; bath salts, not for medical purposes; bubble bath and other bath preparations; massage oils; hand creams, body lotions, aromatic substances and fragrance preparations; deodorants for personal use; anti perspirants; eau de cologne; perfume; aftershave; aftershave lotion; scented water; dentifrices; talcum powder; hair lotions; pomade; shampoos, conditioners, creams, oils, gels and lacquers; hair colourants; hair dye; colour-removing preparations; hair waving preparations; hair straightening preparations; hair curling preparations; cosmetic preparations; cosmetic preparations for slimming purposes; cosmetics for tanning the skin; cosmetics; cosmetic kits; make-up preparations; make-up removing preparations; toiletries; incense; pot pourri; beauty masks.*

**Class 4:** *Candles; scented candles; wicks for lighting; candles forming a part of gift sets; lamp oil.*

**Class 25:** *Clothing; footwear; headgear; bath robes; clothing accessories.*

**Class 26:** *False hair; hair pieces; plaited hair; hair curlers; hair curling pins; hair pins; hair grips and slides; hair ornaments; hair decorations.*

**Class 41:** *Education; providing of training; cultural activities relating to hair, perfume, beauty and fashion; arranging and conducting of workshops (training); educational services; teaching; publication of electronic books and journals on-line; production of shows; publication of books; instruction services; practical training (demonstration); production of shows; publication of texts, other than publicity texts; arranging and conducting of seminars.*

**Class 44:** *Hygienic and beauty care for human beings; hair salon and beauty salon services; manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being and lifestyle; solarium services; health care; sauna services; health spa services.*

2. Percy & Reed Product Limited ('the opponent') initially opposed the trade mark on the basis of several grounds. However, on 25 February 2021, the opponent confirmed that they relied on the basis of section 5(2)(b) of the Trade Marks Act 1994 ('the Act') only. The opponent opposes all of the goods and services, except those in Class 25. The opposition is made on the basis of its earlier trade mark listed below, which given that it had not been protected for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. The details of this mark, alongside the goods and services on which the opponent relies, are noted in the following table:

<b>Earlier Trade Mark</b>	UK Trade Mark no.3430765 for REED
<b>Goods and services relied upon</b>	<b>Class 3:</b> <i>Bleaching preparations and other substances for laundry use; laundry detergent; all-purpose cleaning, polishing, scouring and abrasive preparations for household use; soaps; bar soap; liquid soap; body soap; dish soap; perfumery; essential oils for aromatherapy; essential oils as perfume; cosmetics; hair lotions; dentifrices; non medicated preparations all for the care of skin, hair and scalp; depilatory products; hair waxing kits; bath herbs; oils; bath oils; massage oils; perfumeries and perfumery products;</i>

	<p><i>perfume sprays and compacts; hand creams; body lotions; aromatic substances; perfumed creams and lotions and fragrances and fragrance preparations; personal deodorants; eau de cologne; talcum powder; hair treatment preparations; shampoos; conditioning substances for use on hair; lotions; hair care products; shampoos; conditioners; masks; oils; gels; primers; smoothing preparations; volumizing preparations; texturizing preparations; waving preparations; finishing preparations; waxes; mousses; creams; lotions and hairsprays; hair colouring products; hair colouring agents and dyes for use in hair; toiletries; facial cleansers; creams; lotions; moisturisers; body cleansers; creams; lotions; moisturisers; shower gels; shaving creams; gels and foams; antiperspirants and deodorants; toothpaste; mouthwash; animal grooming preparations; aromatic extracts for use in making hair care products; beauty products; cosmetics products; abraders; room fragrancing preparations; tailors' and cobblers' wax.</i></p> <p><b>Class 44:</b> <i>Hair and beauty care for human beings; hairdressing salon and beauty salon services; manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being (healthcare) and lifestyle; hair styling; hair colouring, hair waving; hair treatment services; advisory and consultancy services, all relating to hair dressing and hair styling.</i></p>
<b>Relevant dates</b>	<p><b>Filing date:</b> 23 September 2019</p> <p><b>Date of entry in register:</b> 13 December 2019</p>

3. The opponent contends that the contested mark has a medium to high degree of similarity to its earlier mark. They submit the contested mark incorporates the earlier mark in its entirety and that the two other words in the contested mark are

descriptive (“LONDON”) and a common first name (“ADAM”). They also submit that the contested mark covers highly similar to identical goods and services.

4. The applicant filed a counterstatement denying the grounds of opposition. They submit that their mark is not similar to the opponent’s earlier mark and that the opponent *“has listed significant numbers of goods in its opposition that are not at all similar to its registration including goods/services within classes 4, 26 and 41 for which there are no goods/services within the registration for the [earlier mark]”*. The applicant denies there is a likelihood of confusion and requests a costs award is made in its favour. The applicant also raised an argument of bad faith.
5. Both parties filed evidence and submissions, in addition to final submissions in lieu of a hearing. Whilst I will not summarise these, I will refer to them as and where appropriate during this decision.
6. No hearing was requested and, so, this decision is taken following a careful perusal of the papers to which I refer, as necessary, below.
7. Both parties have had professional representation in these proceedings. The opponent is represented by Mishcon de Reya LLP and the applicant has been represented by Rohan Solicitors LLP.
8. Although the UK has left the European Union (‘EU’), section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

## **PRELIMINARY ISSUE**

9. I note that in its submissions, the applicant makes a claim that the opponent’s earlier mark was filed in bad faith due to a previous relationship between the parties. It submits that this represents an act of unfair competition and, further, that

the opponent has abused the Tribunal in this regard. It also makes reference to earlier unregistered rights owned by the applicant of which the opponent's mark infringes. I will deal with this matter briefly. A registered trade mark has a presumption of validity. It is valid until proven otherwise through an invalidation action. No such action has been lodged so any reference to the earlier mark not being valid, or the opponent not being able to rely on it, is not relevant to my determination.

## **DECISION**

### **Section 5(2)(b) and relevant case law**

10. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

*“5(2) A trade mark shall not be registered if because-*

*[...]*

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

11. 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, *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.

### *The principles*

- (a) The likelihood of confusion must be appreciated, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

12. The opponent contends that the contested mark covers goods and services that range from identical to highly similar to their earlier mark. They provide several examples across each of the classes, some terms of which they state are complementary to one another. The opponent also states that *“Regardless of the outcome of these proceedings the Opponent submits that the Applicant should be penalised, in costs for failing to admit that certain goods and services in dispute are self-evidently identical.”*

13. The applicant states *“the Opponent has listed significant numbers of goods in its opposition that are not at all similar to its registration including goods/services within classes 4, 26 and 41 for which there are no goods/services within the registration...”*. They do not adduce any further reasoning as to why the goods and services are not similar.

14. At the outset, I find it useful to highlight that section 60A of the Act provides that whether the goods and services are in the same or in different classes is not decisive in determining whether they are similar or dissimilar. What matters is the



actual goods and services at issue and whether they are similar or not having regard to the case law that I refer to below.

15. When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “*in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade*”<sup>1</sup>. Also, that I must bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>2</sup>. As Lord Justice Arnold summarised when setting out the correct approach to interpreting broad and/or vague terms in *Sky v Skykick* [2020] EWHC 990 (Ch):

*“...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*

16. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, 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*

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<sup>1</sup>See *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

<sup>2</sup>See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267

*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”.*

17. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

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

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

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

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

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

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

18. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

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

*where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.*

19. Regarding the complementarity of goods (and, by extension, services), in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. Also, in *Boston Scientific Ltd v 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.”*

20. Additionally, 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.”*

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.”*

21. With the above factors in mind, the goods and services for comparison are as follows:

<p><b>Opponent's goods and services</b></p>	<p><b>Class 3:</b> <i>Bleaching preparations and other substances for laundry use; laundry detergent; all-purpose cleaning, polishing, scouring and abrasive preparations for household use; soaps; bar soap; liquid soap; body soap; dish soap; perfumery; essential oils for aromatherapy; essential oils as perfume; cosmetics; hair lotions; dentifrices; non medicated preparations all for the care of skin, hair and scalp; depilatory products; hair waxing kits; bath herbs; oils; bath oils; massage oils; perfumeries and perfumery products; perfume sprays and compacts; hand creams; body lotions; aromatic substances; perfumed creams and lotions and fragrances and fragrance preparations; personal deodorants; eau de cologne; talcum powder; hair treatment preparations; shampoos; conditioning substances for use on hair; lotions; hair care products; shampoos; conditioners; masks; oils; gels; primers; smoothing preparations; volumizing preparations; texturizing preparations; waving preparations; finishing preparations; waxes; mousses; creams; lotions and hairsprays; hair colouring products; hair colouring agents and dyes for use in hair; toiletries; facial cleansers; creams; lotions; moisturisers; body cleansers; creams; lotions; moisturisers; shower gels; shaving creams; gels and foams; antiperspirants and deodorants; toothpaste; mouthwash; animal grooming preparations; aromatic extracts for use in making hair care products; beauty products; cosmetics products; abraders; room fragrancing preparations; tailors' and cobblers' wax.</i></p> <p><b>Class 44:</b> <i>Hair and beauty care for human beings; hairdressing salon and beauty salon services; manicure, pedicure, massage, reflexology, aromatherapy, electrolysis,</i></p>
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	<p>waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being (healthcare) and lifestyle; hair styling; hair colouring, hair waving; hair treatment services; advisory and consultancy services, all relating to hair dressing and hair styling.</p>
<p><b>Applicant's goods and services</b></p>	<p><b>Class 3:</b> Non-medicated soaps; non-medicated toilet preparations; soaps; perfumery; perfumery products; essential oils; non-medicated cosmetics; preparations for the hair, skin and scalp; shaving preparations; cosmetics; products for personal hygiene and beauty care; depilatory products; bath herbs; essential oils; bath oils; bath salts, not for medical purposes; bubble bath and other bath preparations; massage oils; hand creams, body lotions, aromatic substances and fragrance preparations; deodorants for personal use; anti perspirants; eau de cologne; perfume; aftershave; aftershave lotion; scented water; dentifrices; talcum powder; hair lotions; pomade; shampoos, conditioners, creams, oils, gels and lacquers; hair colourants; hair dye; colour-removing preparations; hair waving preparations; hair straightening preparations; hair curling preparations; cosmetic preparations; cosmetic preparations for slimming purposes; cosmetics for tanning the skin; cosmetics; cosmetic kits; make-up preparations; make-up removing preparations; toiletries; incense; pot pourri; beauty masks.</p> <p><b>Class 4:</b> Candles; scented candles; wicks for lighting; candles forming a part of gift sets; lamp oil.</p> <p><b>Class 26:</b> False hair; hair pieces; plaited hair; hair curlers; hair curling pins; hair pins; hair grips and slides; hair ornaments; hair decorations.</p>

	<p><b>Class 41:</b> <i>Education; providing of training; cultural activities relating to hair, perfume, beauty and fashion; arranging and conducting of workshops (training); educational services; teaching; publication of electronic books and journals on-line; production of shows; publication of books; instruction services; practical training (demonstration); production of shows; publication of texts, other than publicity texts; arranging and conducting of seminars.</i></p> <p><b>Class 44:</b> <i>Hygienic and beauty care for human beings; hair salon and beauty salon services; manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being and lifestyle; solarium services; health care; sauna services; health spa services.</i></p>
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22. I will make the comparison with reference to the applied for goods/services, grouping them together when it is relevant to do so<sup>3</sup>.

*Non-medicated soaps; soaps; perfumery; perfume; perfumery products; depilatory products; dentifrices; talcum powder; massage oils; toiletries; preparations for the hair, skin and scalp*

23. These are various types of goods used in the health care and beauty industry that are each within the remit of the opponent's coverage of "soaps; perfumery; depilatory products; dentifrices; talcum powder; massage oils; toiletries; non medicated preparations all for the care of skin, hair and scalp". The respective terms are either self-evidently identical or identical on the principle outlined in *Meric* above.

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<sup>3</sup> See *Separode Trade Mark BL O-399-10 (AP)*

### *Eau de cologne*

24. Eau de cologne is a type of perfume. Therefore, on the principle outlined in *Meric*, it is identical to the opponent's coverage of "*perfumery*", of which includes eau de cologne.

### *Essential oils*

25. Essential oils are derived from plants and are used for their scent, flavours and health benefits. As Class 3 terms, the opponent's "*oils*" and "*bath oils*" may encompass essential oils and, therefore, there is identity between the terms on the principle outlined in *Meric*.

### *Hand creams, body lotions, aromatic substances and fragrance preparations; aromatic substances and fragrance preparations; incense; pot pourri;*

26. The above terms cover a range of beauty and aromatic goods. Since both parties have coverage of "*hand creams*", "*body lotions*" and "*aromatic substances*", these terms are self-evidently identical. Whilst the applicant's "*fragrance preparations*" is wider than the opponent's "*room fragrancng preparations*", since the applicant's term also includes room fragrancng, there is identity between these terms on the principle outlined in *Meric*.

27. Incense and pot pourri are both placed in a room and used for their fragrance. Incense is an aromatic material that is alit for its aroma whilst pot pourri is a mixture of dried plant materials that are usually placed in bowl to infuse the room with their natural scent. As incense and pot pourri are both aromatic substances, there is also identity under *Meric* between these terms and the opponent's "*aromatic substances*". If I am incorrect in making this finding, then I find the goods are of a medium similarity. Even if they do not include the exact same goods, the purpose and trade channels will nevertheless be similar and there could be a level of competition.

### *Shaving preparations*

28. The above goods are used on human skin to prepare it for shaving. The opponent's "*shaving creams*" in its ordinary and natural meaning refers to cream applied to the area before shaving and it is, thus, a shaving preparation. There is, therefore, identity on the principle outlined in *Meric* between the applicant's "*shaving preparations*" and "*shaving creams*".
29. Nevertheless, if I am incorrect in finding the terms identical, they are highly similar even from the perspective of other forms of shaving preparation. In this case there would be an overlap in purpose, users, channels of trade in addition to a key complementary relationship.

### *Aftershave; aftershave lotion*

30. Aftershave is a substance applied to the skin after shaving to sooth and seal the skin and, more often than not, apply a fragrance. It is typically a lotion, though it can be of other natures – such as a liquid, oil and gel. The opponent's "*perfumed creams and lotions and fragrances and fragrance preparations*" are similarly a range of substances applied to the skin in order to fragrance it. On a wider interpretation of the opponent's term, it may be deemed to include aftershave, since in essence it is a perfumed substance/fragrance, alongside other goods like perfume, eau de toilette and fragranced creams. On this interpretation, there is identity between the parties' goods.
31. If my above interpretation is incorrect and the opponent's term is interpreted more narrowly so as not to include aftershave, which has the additional soothing and sealing purpose, there is still a high similarity between the parties' goods. Both are applied to the skin and both are fragranced. There is also an overlap in the trade channels through which the respective goods reach the market – both can be purchased from supermarkets and other retail establishments, including online. The respective goods may additionally be located in close proximity to one another and may be produced by the same undertakings. Nevertheless, there is some difference in purpose and use, where aftershave may be purchased for its



additional soothing qualities whereas, fragrances, being typically of higher concentration scent, would not. The respective goods are not important or indispensable to the use of one another and are, therefore, not complementary. Whilst there is not a strictly competitive relationship, I consider it possible that the average consumer may decide to purchase aftershave over another type of fragrance, and vice versa. For these reasons, I consider the respective goods are similar to a high degree

*Non-medicated cosmetics; cosmetics; cosmetic preparations; cosmetic preparations for slimming purposes; cosmetics for tanning the skin; cosmetics; cosmetic kits; make-up preparations*

32. The above goods are various types of cosmetics and make-up, of which are a form of cosmetics (for instance, including lipstick and mascara). As the opponent has coverage of “*cosmetics*”, there is identity between these terms.

*Make-up removing preparations*

33. These goods include a range of articles that are used to remove make-up from the skin, including cleansers that clean the make-up residue. As the opponent has coverage of “*facial cleansers*” it encapsulates the applicant’s “*make-up removing preparations*”, the terms are identical on the principle outlined in *Meric*.

*Beauty masks; products for personal hygiene and beauty care*

34. These goods cover beauty products – whether specifically of masks, or broadly of products of personal hygiene and beauty care. The opponent’s “*beauty products*” would include a range of beauty care products (for instance, creams, lotions and masks), so there is identity between these terms. The opponent also has coverage for “*non medicated preparations all for the care of skin, hair and scalp*”, which would likely include products for personal hygiene and, thus, covering identical goods to the applicant’s products for personal hygiene.

*Bath herbs; bath oils; bath salts, not for medical purposes; bubble bath and other bath preparations*

35. Both “*bath herbs*” and “*bath oils*” are contained within the opponent’s specification, so these terms are identical. Whilst the applicant’s “*bath salts, not for medical purposes; bubble bath and other bath preparations*” are of a different nature to bath herbs and oils, there is nonetheless an overlap in the method of use and their general nature insofar as the respective goods will be sprinkled/poured into a bath. Similarly, there is an overlap in the intended purpose (to cleanse/relax) and the respective goods will be sold in supermarkets and other retail establishments, including spas etc. Bath herbs and oils may be used together and chosen instead of bath salts and bubble bath. Therefore, I find “*bath salts, not for medical purposes; bubble bath and other bath preparations*” are similar to the opponent’s “*bath herbs*” and “*bath oils*” to a high degree.

*Deodorants for personal use; anti perspirants*

36. These goods are used for personal hygiene and are self-evidently identical to the opponent’s “*antiperspirants and deodorants*”.

*Scented water*

37. Scented water is a fragranced liquid applied to the human body for its fragrance. There is, thus, an identical purpose, use and user as the opponent’s “*perfumeries and perfumery products*”, which are similarly fragranced liquids used on humans to give a pleasant smell. There are also shared trade channels and it is anticipated the goods would be listed in a similar section and found nearby in supermarkets. Whilst the goods are not complementary in a trade mark sense, they are somewhat competitive in that the average consumer may choose to purchase one instead of the other. There is a high degree of similarity between these respective goods.

*Hair lotions; shampoos, conditioners, creams, oils, gels and lacquers; hair colourants; hair dye; colour-removing preparations; hair waving preparations*

38. The applicant's above goods are all types of haircare or hairstyling products used on humans. They are identical to the opponent's coverage of "*shampoos; conditioners; gels; waving preparations; lotions and hairsprays; hair colouring products*" on the principle outlined in *Meric*.

*Pomade*

39. Pomade is a wax or water-based substance used to style hair. It, therefore, falls within the remit of the opponent's "*waxes*" and is identical on the basis outlined in *Meric*.

*Hair curling preparations; hair straightening preparations*

40. These goods are each used on hair to create/maintain curls or straighten it. The opponent's "*hair care products*" include coverage of products that also fulfil the same function and can, therefore, have an identical purpose, method of use, nature etc. Therefore, these terms are identical under the principle outlined in *Meric*.

*Candles; scented candles; wicks for lighting; candles forming a part of gift sets; lamp oil*

41. The above goods are illuminates, including candles, wicks and lamp oil. The opponent submits that these are highly complementary to a variety of their class 3 goods, such as "*aromatic substances*" and "*room fragrancng preparations*", and "*manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services*".

42. I find that "*aromatic substances*" and "*room fragrancng preparations*" are most similar on the basis that candles and oils are similarly used to these goods (except "*wicks for lighting*") for the smell that they give off. Thus, there may be a shared use, user and level of competition. Trade channels may be shared, though the

goods are not complementary. On this basis, there is a low level of similarity between the applicant's "*Candles; scented candles; candles forming a part of gift sets; lamp oil*" and the opponent's "*aromatic substances*" and "*room fragrancng preparations*".

43. When I compare the above goods to the opponent's services, they are also comparable insofar as the illuminates may be used during the service provided. For instance, that candles and wicks are lit during a massage. Whilst some users may be shared, the uses and nature of the goods and services differ. The trade channels may overlap where the applicant's goods can be purchased at a beauticians/spa etc, however in my experience, they are not typically available to purchase at the same time as a beauty treatment. The goods and services are neither complementary in a trade mark sense nor competitive. For these reasons I do not find any similarity between the applicant's above goods and the opponent's "*manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services*".

44. In my view, none of the opponent's other services or goods improve their position and, in fact, any similarity would be of a lesser (or no) degree.

*False hair; hair pieces; plaited hair; hair curlers; hair curling pins; hair pins; hair grips and slides; hair ornaments; hair decorations*

45. The applicant's above goods are all related to hair – whether being hair/false hair itself or accessories. The opponent's "*hairdressing salon and beauty salon services*" cover a range of hair-related services, including attaching extensions (false/hair pieces etc) and using hair accessories to style the hair. Whilst there is a difference in nature and method of use between the respective parties' goods and services, the purpose (to style hair), user and trade channels can be shared (for instance, at hair salon). The goods and services can also be considered complementary to a degree. I consider the applicant's "*false hair; hair pieces; plaited hair;*" could be competitive with the opponent's services where the goods

are purchased to apply at home instead of visiting a salon for hair extensions etc to be applied.

46. It follows that I find that there is a low to medium degree of similarity between the applicant's above goods and the opponent's "*hairdressing salon and beauty salon services*". In my view, none of the opponent's other services or goods improve their position and, in fact, any similarity would be of a lesser (or no) degree.

*Education; providing of training; cultural activities relating to hair, perfume, beauty and fashion; arranging and conducting of workshops (training); educational services; teaching; instruction services; practical training (demonstration); production of shows; arranging and conducting of seminars*

47. The above services relate to education (including training, instruction and seminars), cultural activities and the production of shows. The field of the services are mostly unspecified so can cover any industries/subjects, except the cultural activities are in relation to hair, perfume, beauty and fashion. Education, training and demonstration etc are performed/undertaken to increase one's knowledge of the industry/subject matter being taught – there can similarly be shows educating and presenting information (for instance, on the latest hairdressing trends and styling techniques). In a similar vein, the opponent's "*advisory and consultancy services, all relating to hair dressing and hair styling*" are used to advise and increase the participant/user's knowledge of hair dressing and styling. When providing training and information regarding hair dressing, advice can be incidentally given. Although the nature of the parties' services differ, there is an overlap in purpose. Whilst users have a shared interest in the hairdressing industry, they may differ where the user of the applicant's services are aimed more at trade professionals whereas the opponent's services may be the general public seeking advice on hair (for example, for a wedding). The trade channels may also be shared – via a salon, for instance. Although there is a degree of complementarity, the services can also be provided without one another. The services could be competitive.

48. Bearing the above analysis in mind, I find the applicant's above services have a medium level of similarity to the opponent's "*advisory and consultancy services, all relating to hair dressing and hair styling*". In my view, none of the opponent's other services or goods improve their position and, in fact, any similarity would be of a lesser (or no) degree.

*Publication of electronic books and journals on-line; publication of books; publication of texts, other than publicity texts*

49. The above services relate to publication of books, texts and journals in general. They can be of any matter, including being advisory texts etc in the field of beauty and hairdressing. As explored above in paragraphs 47-48, the opponent's "*advisory and consultancy services, all relating to hair dressing and hair styling*" include advising and increasing the participant/user's knowledge. Similar to that explored above, although there may be some overlap in the use and users, the nature of the services differ. The trade channels may overlap where an entity providing hair-related advisory and consultancy service also publish related texts, though it is generally expected a publication house would publish the applicant's above services, in contrast to a salon providing the opponent's services.

50. For these reasons, I find that there is a low degree of similarity between the applicant's above services and the opponent's "*advisory and consultancy services, all relating to hair dressing and hair styling*". In my view, none of the opponent's other services or goods improve their position and, in fact, any similarity would be of a lesser (or no) degree.

*Manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being and lifestyle*

51. The opponent also has coverage of "*manicure, pedicure, massage, reflexology, aromatherapy, electrolysis, waxing, tinting, make-up, grooming, colour diagnosis and body treatment services; services relating to personal appearance, well-being and lifestyle*", so these terms are identical.

*Hygienic and beauty care for human beings; hair salon and beauty salon services*

52. The applicant's above services are related to hygiene, beauty and hair. The opponent's "*hairdressing salon and beauty salon services*" encompass a range of beauty and hair-related services, so there is identity between this term and the applicant's above services.

*Solarium services*

53. Solariums are specially equipped units with ultraviolet lamps that are used to tan the individual using it. They are typically provided at a tanning salon specifically created for that purpose. The opponent's "*services relating to personal appearance, well-being (healthcare) and lifestyle*" cover a range of services and as tanning is used to alter an individual's personal appearance, solarium services fall within their remit. There is, therefore, identity between these terms.

54. However, if I am incorrect in making the above analogy, since the opponent's personal appearance services include tanning services (such as spray tans provided at a beauty salon), there is an overlap in use and user. Whilst the nature and trade channels may nonetheless differ, due to the overall similarities, there would otherwise be a medium degree of similarity between these services.

*Sauna services; health care; health spa services*

55. I understand that a "*health spa*" offers a variety of health and beauty treatments through various means – including saunas, steam rooms, massages and facials etc. Health care is the provision of medical care, to improve one's health. Saunas are rooms/areas heated to a high temperature which individuals sit in for the health benefits the heat can bring; they are often situated in health spas. The opponent's "*services relating to personal appearance, well-being (healthcare) and lifestyle*" cover a range of services I would expect to cover a similar ambit to those offered at a health care/spa outlet. It is also my understanding that sauna services are sometimes offered as part of a well-being service. Since the applicant's above

terms are contained and overlap with the opponent's "*services relating to personal appearance, well-being (healthcare) and lifestyle*", there is identity between the respective services on the principle outlined in *Meric*.

56. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion<sup>4</sup>, the opposition must fail in respect of the applicant's "*Wicks for lighting*", of which I have found to be dissimilar to the opponent's goods and services.

### **Average consumer and the purchasing act**

57. 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 and services in question<sup>5</sup>.

58. 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."*

59. The opponent submits that the goods and services will largely be self-selected via high street retail outlets or via online shopping, though word of mouth will also be relevant. I do not have any submissions from the applicant on this point.

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<sup>4</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

<sup>5</sup> See *Lloyd Schuhfabrik Meyer*, Case C-342/97.



60. In my experience, the average consumer for the competing goods/services will most likely be a member of the general public. The applied for goods and services range in price, from relatively low cost (for instance, for soaps and hand cream) to a more medium cost (such as beauty treatments and training). The regularity of the purchase depends considerably on the goods and services – they can be frequent and infrequent. The average consumer will, nevertheless, consider factors such as the cost, compatibility, colour and ingredients when purchasing the goods. The average consumer is likely to consider the qualifications held by the staff, the range of treatments offered, the quality and suitability of those treatments to the user's desired purpose for the service when the services are selected. I consider the average consumer will pay either a low or a medium degree of attention to the selection of the respective goods/services, depending on which are chosen.

61. The class 44 services are most likely provided through tanning, hair salons and/or spas and potentially at consumer and beautician's homes by way of house calls. Whilst the class 41 services may also be provided here, this is in addition to various other outlets such as conferences, offices, online and at make-up counters. The services on offer will be displayed on the premise's frontage, a treatment list or on a display board in salons where they will be viewed and selected by the consumer. The services provided may also be displayed on websites, where a similar process will apply in that the consumer will be able to view a list of services (whether treatment/workshops etc) and book an appointment directly through the website. The goods are most likely to be the subject of self-selection from traditional bricks and mortar retail outlets (and their online equivalents) (ranging from specialised beauty outlets/make-up counters to supermarkets), catalogues and websites. They may also be bought directly from beauticians/health and wellness spas. I consider that the selection of such goods and services will predominantly be made on a visual basis. Though I agree with the opponent that aural considerations are also important - consumers may receive word of mouth recommendations or discuss the purchases with a sales assistant.


## Comparison of marks

62. It is clear from *Sabel BV v Puma AG* (particularly paragraph [23]) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph [34] of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

64. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
REED	 The contested trade mark consists of the words "ADAM REED" in a large, bold, serif font, with "LONDON" in a smaller, all-caps, sans-serif font centered below it.

65. The opponent submits that the respective marks have a medium to high degree of similarity within which the contested mark incorporates the earlier mark in its entirety. They submit that the “LONDON” element of the contested mark is an indicator of the geographical origin of the goods and services, that is “entirely

*lacking in trade mark significance”, and “ADAM” is a “short, common first name”. They state that the “REED” element “retains at the very least an independent distinctive role”.*

66. The applicant denies that the respective marks are similar. They submit that it is unclear whether the earlier mark is *“meant to represent the name of a person or the plant. As a surname, Reed is common in all English speaking countries”* whereas the contested mark is *“clearly a single individual’s full name”*. They submit that there are no conceptual, aural or visual similarities.

### Overall impression

#### *The applicant’s contested mark*

67. The contested mark is a lightly stylised black and white device comprising the words *“ADAM REED”* in a thin uppercase typeface, with the word *“LONDON”* centralised and below in a much smaller uppercase typeface. The words *“ADAM REED”* play the greatest role in the overall impression. The word *LONDON* plays only a very minor role, a descriptive one at that, in the overall impression of the mark.

#### *The opponent’s earlier mark*

68. The opponent’s mark is a word mark consisting solely of the word *“REED”* in normal black font. The overall impression lies in the word itself.

### Visual comparison

69. There is clearly some similarity between the two marks as they both contain the word *“REED”*. Though, the shared word is the whole of the earlier mark, yet it comprises one of three words in the contested mark. The contested mark also has the word *“ADAM”* preceding the common word, in addition to light stylisation and *“LONDON”* beneath (albeit in smaller letters and having a less significant role in

the overall impression). Weighing the similarities and differences, I consider the visual similarity to be of a medium degree.

### Aural comparison

70. The opponent's "REED" mark will be articulated as that word alone. I consider the average consumer will most likely articulate the contested mark as "ADAM REED" or, albeit less likely, with the addition of "LONDON" on the end. There is a medium aural similarity as both marks share an identical "REED"; though the contested mark will be articulated with a very different word preceding and, potentially, succeeding the common word (if "LONDON" is articulated).

### Conceptual comparison

71. The word 'reed' has various definitions, including a plant, an arrow and an instrument<sup>6</sup>, along with being a surname. In the contested mark, "ADAM" is a fairly common male first name and "LONDON" evokes a conceptual reference to the capital of the United Kingdom. There is some conceptual similarity between the marks for those that see the earlier mark "REED" as a reference to a person with that surname, given that the contested mark will also (and unequivocally) be seen as a reference to a person with that surname. However, one relates to a specific person of that name, Adam Reed, whereas the other does not. The "LONDON" element pushes the mark further away conceptually, but only marginally so given the role this word plays in the mark. The overall conceptual similarity is low.

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

72. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer & Co. GmbH* the CJEU stated that:

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<sup>6</sup> See the definition of 'Reed' by Collins Dictionary  
<<https://www.collinsdictionary.com/dictionary/english/reed>> Accessed 12 July 2021

*“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).”*

73. Registered trade marks can possess various degrees of inherent distinctive character, ranging from the low, because they are suggestive or allusive of a characteristic of the goods and services, to those with high inherent distinctive character, such as invented words. The distinctiveness of a mark can be enhanced by virtue of the use made of it. No evidence has been filed regarding enhanced distinctiveness, so I only have the inherent characteristics of the mark to consider.

74. The opponent submits that they have demonstrated that their earlier mark has a high level of inherent distinctiveness. This is by way of the 4 February 2021 witness statement of Ms Caroline Beynon (the Finance Director of the opponent since January 2013) and the 2 accompanying exhibits. Ms Beynon refers to a series of Google searches dated 2 February 2021 undertaken by the opponent’s representatives to support her view that the mark “*REED*” has no relationship to beauty and hair care products or services. The searches are for the word “*REED*”

alone, in addition to the word in conjunction with various Class 3 terms (such as “shampoos” and “conditioners”). The results show that when the word is searched alone, the results mostly relate to a UK-based recruitment agency ‘Reed’, though when the word is searched with Class 3 terms, the majority of the results are for “Percy & Reed” haircare products.

75. The applicant also filed a witness statement in the name of Adam Reed dated 5 April 2021. Mr Reed states he is “*the Director and founder of Adam Reed Salons Limited, the Applicant & Adam Reed Limited and formerly a director and founder of the Opponent*” and he adduces evidence of Google searches dated 1 April 2021. This includes a search for “*Reed Hair*”, of which the majority of results are in reference to a “*Reed Hair*” salon seemingly based in Maldon, England, whilst one of the results (the 5<sup>th</sup> entry) is for Percy & Reed.

76. Whilst I bear the evidence in mind, the mark “*REED*” in whichever definition or concept ascribed is not suggestive or allusive of any of the goods and services. Nevertheless, from my own assessment, I am aware the earlier mark is an everyday word and surname, of which is fairly common. I therefore pitch the distinctiveness of the mark at medium. For the avoidance of doubt, the evidence does not enhance its distinctive character since it is not use of the mark, nor do the results of the Google searches demonstrate that, from an inherent perspective, the word is highly distinctive.

### **Likelihood of confusion**

77. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. I point particularly to the principles I referred above in paragraph 11. One of these 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.

78. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and the

nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

79. There are two types of possible confusion: direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). The distinction between these was explained by Mr Iain Purvis Q.C (sitting as the Appointed Person) in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C.:

*“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.*

*17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:*

*(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).*

- (b) *where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)*
  
- (c) *where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”*

80. I also find it useful to highlight the following decisions. In *Annco, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

*“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.*

*49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.*

*50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (SABEL, paragraph 18 above, paragraph 22; see, also, Case C-120/04 Medion [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or*



*lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue.”*

81. Also, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

82. Additionally, in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

*“18 The judgment in Bimbo confirms that the principle established in Medion v Thomson is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.*

*19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In Medion v Thomson and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.*

20 *The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).*

21 *The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”*

83. Notwithstanding the principle of imperfect recollection, and taking all of the above factors into account, I consider that the differences between the marks are sufficient to enable the average consumer, even with a likely low or medium degree of attention, to differentiate between the parties' marks, even on goods and services that I have found are identical. Quite simply, the average consumer will recall that one mark is merely the word “*REED*” whilst the other consists of three words, including the name “*ADAM REED*”, in particular. I do not consider there is a likelihood of direct confusion.

84. Upon considering whether there is a likelihood of indirect confusion, I first highlight that the three categories of indirect confusion identified by Mr Purvis QC above are just illustrative – he stated that indirect confusion “*tends*” to fall in one of them. Although the earlier mark (“*REED*”) has a medium degree of distinctive character, when viewed in the contested composite mark, I do not consider that this common element has a distinctive significance independently of the whole. Rather, “*ADAM REED*” will be read as a unit indicating a person whose forename is ‘Adam’ and surname is ‘Reed’. The situation is alike the “*BARBARA BECKER*” example Mr Purvis QC referred to. Having borne the above in mind, and whether the goods and services are of a low level of similarity or are identical, I come to the view that

the average consumer would not believe that they come from the same or a related undertaking. In making that finding I have considered whether the forename or the surname stands out more due to their unusualness, something which could have impacted on my finding. However, neither 'Adam' nor 'Reed' are particularly unusual names. I am satisfied that there is no likelihood of confusion.

## **CONCLUSION**

85. The opposition has been unsuccessful and the application may proceed to registration for all the goods and services applied for.

## **COSTS**

86. As the applicant is successful in this opposition, it is entitled to a contribution towards its costs. In making this cost award I have borne in mind the applicant's submissions that the opponent had acted in bad faith, misused the process and was "*behaving disrespectfully to the tribunal to try and prevent fair competition*". However, I do not have enough information evidencing this that warrants reflection in the costs award. I also acknowledge the opponent's request that the applicant's failure to "*...admit that certain goods and services in dispute are self-evidently identical*" should be reflected in costs. Whilst it would have been helpful if the applicant provided an analysis on the goods and services at issue, including admissions of identity, it does not appear that their failure to do so has materially increased the costs on the opponent.

87. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Using that TPN as a guide and bearing the aforementioned in mind, I award the applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement: £200

Preparing evidence and considering and commenting on the other side's evidence £500

Preparing final written submissions in lieu of a hearing: £300

88. I order Percy & Reed Product Limited to pay Adam Reed Salons Ltd the sum of £1000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 19<sup>th</sup> day of July 2021**

**B Wheeler-Fowler  
For the Registrar**