

**DECISION OF THE CONTROLLER OF INTELLECTUAL PROPERTY
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 260422 and in the matter of an Opposition thereto.

Baycal Limited

Applicant

Blow Limited

Opponent

The Application

1. On 10 August 2017 Baycal Limited (hereinafter “the Applicant”), of 114 Lesson Street, Dublin, Ireland made application (No. 2017/01761) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the sign below (hereinafter “Blow Salons”) as a trade mark in respect of “*Hairdressing; Beauty care; Beauty treatment; Beauty salons; Beauty salon services; Nail salon services; Nail care services; Skin care salons; Skin care salon services*” in Class 44.



2. When considering the application, the Trade Mark Examiner raised an objection to its acceptance based on Section 10(2)(b) of the Act on the grounds that the mark applied for would be likely to cause confusion with the earlier European Union Trade Mark (EUTM) no. 012129094. The Applicant sought to rely on Section 12 of the Act (which allows the Controller to waive certain objections based on claims of honest concurrent use) and convinced the Examiner, by providing the necessary evidence, to waive the objection on the grounds that the Applicant’s mark had existed in the Irish marketplace for many years during which it was honestly used at the same time as EUTM no. 012129094 was used in the EU. The application was then accepted for registration and advertised accordingly under No. 260422 in Journal No. 2380 dated 6 March 2019, with the Journal entry stating: “*The application for registration is proceeding based on honest concurrent use with European Union Trade Mark No. 012129094*”.

3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 5 June 2019 by Blow Limited (hereinafter “the Opponent”) of 81 Farrington Street, London, United Kingdom. The Applicant filed a counter statement on 10 September 2019 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”). Both parties filed written submissions in lieu of attending a hearing in the matter, and the Opponent filed submissions in reply to the Applicant’s written submissions.
4. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. In so deciding, I fully and carefully considered all the materials and arguments advanced by both parties, and relevant caselaw and precedents. I will refer to these materials as and when appropriate and necessary below.
5. The parties were informed of my decision by way of letter dated 27 May 2021. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Applicant in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996.

Grounds of the Opposition

6. In its Notice of Opposition, the Opponent refers to its proprietorship of European Union Trade Mark (EUTM) No. 012129094 (the mark upon which the Examiner had earlier



based objections) relating to which was applied for on 10 September 2013, in respect of the following goods and services:

Class 3: Toiletries; cosmetics; make-up products; hair care preparations; hair styling preparations; shampoos; hair colouring preparations; skin care preparations.

Class 41: Education and training in relation to hairdressing and beauty care.

Class 44: Hairdressing services; hairdressing salon services; beauty care services; beauty salon services; consultancy services relating to hair styling, hair care, hairdressing; beauty makeovers.

The Opponent states it has made substantial use of the trade mark in the European Union in respect of the goods and services for which it is registered and that, as a consequence of such use, its mark has acquired a substantial reputation in connection with the Opponent's goods and services. The Opponent then raises objection to Baycal Limited's application under Sections 10(2)(b) and 10(3) of the Act which concern a likelihood of confusion on the part of the public or a likelihood of association with the Opponent's trade mark; and the Applicant's mark taking unfair advantage of or being detrimental to the distinctive character or reputation of the Opponent's mark, respectively.

Counter Statement

7. In its Counter Statement the Applicant describes itself as the owner and operator of a number of hair salons in Ireland that also provide off-site salon services. The salons commenced trading in 2002 under the name BLOW and have continued to trade under this name ever since.
8. The Applicant explains how the business name BLOW was registered in 2002 by BJS Salons (the operators of the BLOW business prior to the Applicant) and that BJS Salons also registered a BLOW device trade mark in 2003, as well as registering the domain name www.blow.ie in 2002. The earlier registered BLOW device trade mark was removed in 2013 as a result of an administrative error on the Applicant's part. [*The Trade Mark Register shows the status of the registration as "removed due to non-payment of the trade mark renewal fee"*].
9. The Applicant goes on to state that in addition to its registered rights it has accrued common law rights given that the business has been trading under the name BLOW in Ireland since 2002. The brand name has been continuously used in signage, artwork, headed paper, on its website, on the BLOW App and in general advertising since that time.
10. The Applicant then makes statements regarding its use of the word BLOW in trade, and its turnover and marketing relating to its mark, which I shall return to later.
11. The Applicant notes the Opponent is seeking to rely on its EUTM, claiming it has made substantial use of the EUTM in the EU. But the Applicant states that, according to online

searches it has conducted, the Applicant found no evidence of use of the Opponent's EUTM outside of England, specifically the cities of London, Birmingham, and Manchester. The Applicant claims that it is the Applicant that has built a reputation in the name BLOW.

12. The Applicant then goes on to argue against the two grounds of opposition. In doing so, the Applicant highlights the differences between the parties' marks, the different business models, the Applicant's long-standing and continuous use of its mark in Ireland, the Applicant's reputation in its mark, and the Opponent's lack of presence in the Irish market.

Rule 20 Evidence

13. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration and 16 accompanying exhibits (labelled FM1 to FM16), dated 13 March 2020, of Fiona McIntosh of Farrington Street, London, United Kingdom (UK), creative director and co-founder of the Opponent. Ms McIntosh states the Opponent began trading in 2013 and since then its core business has been providing hair and beauty services delivered through a number of stores in the UK as well as an at-home service. She says the Opponent relies heavily on a mobile application it developed through which customers can book either service.

14. Ms McIntosh states the Opponent's services have expanded and include catering for the hair and beauty requirements of specific events, such as weddings, private parties and corporate functions. Also, the Opponent sells its own beauty and hair related products in its online store and publish an online magazine. She says the Opponent has at all times, and for all goods and services, traded under the name "BLOW".

15. Ms McIntosh mentions the Opponent has financial backing from Unilever Ventures and Debenhams (a well-known department store operating in the UK and Ireland, and elsewhere) and is in the process of planning to expand internationally, including in Ireland.

16. Ms McIntosh says the Opponent is the largest home visit beauty and hairdressing service provider in the UK, operating predominantly in London, Birmingham, and Manchester.

Three of its four stores are located in Debenhams branches. She attaches at Exhibit FM1 images of the Opponent's stores, which she states opened on the following dates:

Convent Garden, London – 11 November 2013

Canary Wharf, London - 3 November 2014 (closed on 28 August 2019)

Oxford Street (Debenhams), London – 23 October 2017

Manchester (Debenhams) – 30 October 2017

Birmingham (Debenhams) – 6 November 2017

17. Ms McIntosh states that significant numbers of Irish citizens are exposed to the “BLOW” brand on a frequent basis given that there are in excess of 2.1 million visitors from Ireland to the UK each year. Also, in 2018 there were reported to be on average of 1098 flights per week from Ireland to the UK, of which 403 are from Dublin to London, 79 are from Dublin to Birmingham and 82 are from Dublin to Manchester.
18. Sticking with the visitor theme, Ms McIntosh says Covent Garden is one of the most popular tourist attractions in the world and is a popular destination for tourists from Ireland, many of whom would frequent the area's retail outlets, bars, and restaurants. The Opponent's salon is a two-minute walk from Covent Garden Tube Station and within a five-minute walk of various popular destinations like the Apple Store and various popular bars like the Porterhouse. She says Irish visitors to the area would be exposed to the Opponent's salon and its “BLOW” trade mark as they pass these outlets. These statements were supported by material attached at Exhibits FM2 and FM3.
19. Ms McIntosh makes similar statements regarding Irish visitor to the UK being exposed to the Opponent's “BLOW” brand when they frequent Debenhams stores in Birmingham and Manchester and the flagship Debenhams store on Oxford Street in London (material relating to the Opponent's presence in the Oxford Street store was included in Exhibit FM4).
20. Ms McIntosh attaches at Exhibit FM5 screenshots from the Wayback Machine archive service showing pages from the Opponent's website (www.blowltd.com) as they were between 2013 and March 2019. Also included in the exhibit are emails from June 2017 informing customers of changes to the website. All this shows the Opponent's had a web presence under the “BLOW” brand up to the date of application of the contested mark.

21. Ms McIntosh mentions traffic from Ireland in general, and Dublin in particular, to the Opponent's website and attaches (at Exhibit FM6) related figures. She states that this resulted in 47 appointments from Irish customers being made in the period January 2017 to July 2017, with a further 203 appointments between September 2017 and February 2020. She says that, overall, 282 customers with either an Irish email address or telephone number made a total of 499 bookings, of which 140 customer reviews were received (details of which were attached at Exhibit FM7).
22. Ms McIntosh attaches, at Exhibit FM8, material relating to the Opponent's use of social media and its presence on Facebook, Twitter and Instagram, all of which date back to 2013 and show use of the Opponent's "BLOW" trade mark. Exhibit FM9 contains records of the use of these social media accounts and the number of followers for each. Exhibit FM10 contains links to three videos and screenshots from the Opponent's YouTube channel.
23. Ms McIntosh attaches, at Exhibit FM11, articles from fashion magazines and newspapers that cover or advertise the Opponent's business, most of which have a publication date prior to the relevant date for these proceedings. She says the publications are available in Irish newsagents and are read widely in Ireland, both in print and online. Ms McIntosh attaches customer reviews at Exhibit FM12, many of which date from before 10 August 2017.
24. Ms McIntosh provides figures for the number of services and customers catered to by the Opponent in the period 2014 to 2019. These figures show continuous year-on-year growth, with 2017 (the year in which the Applicant applied for the opposed mark) figures showing that over 77,000 services were delivered to over 36,000 customers. Ms McIntosh also provides details of income and marketing expenditure from 2014 to 2019. These figures show combined income of over £2.425 million of which over £1 million was generated in the Opponent's two London stores. Revenue for on-demand services exceeded £1.3 million in 2017, while the sale of products realised a further £0.14 million. Expenditure associated with marketing the Opponent's business amounted to over £530,000 in 2017, a significant proportion of which was spent on social media.
25. Ms McIntosh attaches (at Exhibit FM14) the report of two surveys carried out on the Opponent's behalf by third parties in November 2018 and July 2019. While these were

conducted after the relevant date, Ms McIntosh states the positive results show a recognition of the Opponent's brand would have accrued over many years.

26. Ms McIntosh then turns to the Applicant's use of the term "BLOW" and attaches (at Exhibit FM15) screenshots from various online platforms tracking the Applicant's use of its BLOW logo, from the form registered in 2002 to a variety of different forms in recent years, many of which, in her opinion, are very different to the opposed mark. She states she has not seen the Applicant use the opposed mark in the form for which registration has been sought. Ms McIntosh states she has also seen the Applicant use "BLOW!" and attaches (at Exhibit FM16) an extract from a business name registration form showing it in that format.
27. Ms McIntosh also mentions that, given the Opponent is part owned by Debenhams (who have 12 stores in Ireland), the registration of the disputed mark by the Applicant would preclude the Opponent from expanding into Ireland via Debenhams stores. She says the proximity of the Applicant's in-store outlet in Dunnes Stores, which is across the street from Debenhams' flagship store in Dublin, would make confusion inevitable. [While the Opponent's future expansion plans are noted, they are irrelevant to these proceedings and must be ignored.]
28. She says confusion would also arise as a result of Irish consumers being aware of the Opponent through coverage in magazines and social media, and as a result of visits to the UK.
29. Ms McIntosh also provides arguments as to the significant inconvenience that would be caused to the Opponent if the Applicant's mark were registered.

Rule 21 Evidence

30. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 19 August 2020, of Noelle McCarthy, Director of the Applicant, and eleven accompanying exhibits ("NMC 1" to "NMC 11"). She states the Applicant is the owner-operator of a number of hair and beauty salons in Ireland which commenced trading in 2002 (at that time the business was owned by BJS Salons Limited) and at all times have traded under the name BLOW. She attaches (at Exhibit "NMC 2") a copy of the BJS

Salons Limited registration for the original version of the BLOW trade mark -



31. Ms McCarthy provides details of the Applicant's four outlets (all in Dublin) and states the Applicant also regularly provides off-site services at homes and business addresses across Ireland. She says the Applicant has provided services to more than 85,000 customers since 2002 and was chosen to provide services to the annual KPMG partners conference for over 10 years.
32. Ms McCarthy states the Applicant has invested a significant amount of time and money developing its business and is well-known within the Irish market. She says the Applicant has recently partnered with Dunnes Stores (the major Irish retail operator) and intends to expand into various Dunnes Stores locations across the country. She attaches at (Exhibit "NMC 4" and Exhibit "NMC5") materials relating to this venture. [As these plans had not come to fruition by the relevant date, they have no bearing on the matter at hand.]
33. Ms McCarthy states the Applicant is the owner of the domain name www.blow.ie which was registered in 2002 by its predecessor in title and has been in continuous operation since then. She says the website is the number 2 on Google search results for the term "BLOW" (attached at Exhibit "NMC6" is a screenshot of the first page of a Google search). She also mentions the Applicant developed a mobile phone app in 2015 (usage numbers attached at Exhibit "NMC7") and provides details of the Applicant's social media presence (profiles and reviews attached at Exhibit "NMC8").
34. Turning to advertising and promotion, Ms McCarthy lists the activities undertaken by the Applicant, which include audience giveaways for the popular Irish chat-shows – The Late Late Show and Saturday Night with Miriam. Ms McCarthy also provides details of annual revenue (at Exhibit "NMC11) showing a growth from €501,000 in 2011 to €1,307,000 in 2017.
35. The remainder of Ms McCarthy's evidence comprises legal argument which I need not detail here.

Written Submissions

36. Material filed by the Opponent under Rule 22 was not considered to be evidence as it was confined strictly to legal argument. The Opponent resubmitted this material as its formal Written Submissions, filed in lieu of attending at a Hearing. The Applicant also filed Written Submissions, following which the Opponent lodged further submissions in reply.

37. In its Written Submissions the Opponent highlights the objections raised by this office when examining the opposed application and that the European Union Intellectual Property Office (EUIPO) rejected a similar application from the Applicant, both of which were on the basis of a likelihood of confusion with the Opponent's earlier EUTM. Thus, the Opponent argues, registration would be appropriate only in the case of the Controller finding there had been honest concurrent use of the opposed trade mark. The Opponent then goes on to argue the evidence submitted by the Applicant is not sufficient to support such a finding, its main points being:

- i. There is no actual evidence of the Applicant using the mark in the form applied for at, or prior to, the relevant date.
- ii. The mark in the form applied for does not appear anywhere in Ms McCarthy's Statutory Declaration.
- iii. The bulk of the evidence of use of the Applicant's mark, in the form applied for, post-dates the relevant date.
- iv. The Applicant's evidence of use that predates the relevant date shows use of marks that are different to the opposed mark, this includes use of the BJS Salons Ltd mark that was removed from the Trade Mark Register.
- v. The Applicant concedes that its app was downloaded by consumers in the UK. But, since the Applicant does not provide any services in the UK, such downloads must constitute evidence of actual confusion by potential customers of the Opponent.

38. In its Written Submissions the Applicant compares the respective parties' marks using well-established criteria, supported by references from decisions of the Controller and the Courts. In doing so, it notes the following:

- i. The visual, verbal and conceptual differences.

- ii. The shared element “BLOW” is a common, laudatory word which is devoid of distinctive character, as it is used ubiquitously in the hair and beauty industry.
- iii. The opposition must fail because the Opponent’s mark is neither distinctive nor has it earned distinctiveness through the use made of it.
- iv. The Opponent’s mark is used only in specific areas of England. It has no presence whatsoever in Ireland or elsewhere in the EU.
- v. At most the Opponent has a reputation in its mark in specific regions of the UK, but none whatsoever beyond its border.
- vi. Despite coexistence and use of their respective marks over many years there is no evidenced instances of confusion.

39. In its submissions in reply the Opponent emphasised the unitary character of its EUTM, which is valid and affords the Opponent rights in Ireland. It stresses the high degree of similarity between the marks and the identity of the services. It reemphasises the outcome of the already settled and identical proceedings before the EUIPO wherein the Opponent successfully opposed the Applicant’s EUTM application.

40. The Opponent points to what it claims is actual confusion resulting from UK consumers downloading the Applicant’s app, in circumstances where the Applicant has no presence whatsoever in the UK marketplace. The Opponent submits that it is not possible for both marks to co-exist in the marketplace for identical services without consumer confusion. It argues the inconvenience to the opponent that would result from the registration of the Applicant’s mark would be significantly greater than that of the Applicant who has failed to produce any evidence at all of use of the mark, *in the form applied for*, prior to the date of application.

Honest Concurrent Use

41. Before dealing with the two specific grounds of opposition I will address the issue of honest concurrent use. As already mentioned, the Examiner raised an objection to the registration of the Applicant’s mark on the basis of the Opponent’s earlier EUTM. To overcome the objection the Applicant persuaded the Examiner to allow the application to proceed to advertisement by claiming honest concurrent use under Section 12 of the Act.

42. This statutory provision exists to allow the Controller to exercise discretion and allow an application to proceed to advertisement despite the existence of an earlier trade mark, that appears to be confusingly similar. The Controller exercises this discretionary power when evidence submitted by an Applicant enables him to form a view that the Applicant is using the trade mark in question at such a level that, rather than refuse the application unilaterally, advertisement should be allowed. The Controller does this in the knowledge that a subsequent opposition may arise, and the Controller will then have an opportunity to decide the opposition with the benefit of evidence and argument submitted by the parties involved.
43. I must stress that allowing advertisement in these circumstances is not a determination on the issue of a likelihood or confusion. Nor does a claim to honest concurrent use provide an applicant with a cast-iron defence in opposition proceedings grounded on earlier trade mark rights.
44. Furthermore, even though an applicant may have relied upon specific evidence to support its claim of honest concurrent user at examination stage, there is no restriction on what evidence the Applicant can file in defence of their application during opposition proceedings. It can lodge more, less or the same evidence. I do not have visibility of the evidence furnished by the Applicant during the examination of the application at issue, nor it is of any interest to me. The only evidence of concern to me is that which was put before the Controller in these proceedings alone.
45. Looking at that evidence it is clear the Applicant did not commence using the opposed mark until around the date of application for its registration. The Applicant speaks at length about trading under, and having rights in, the “blow” name since 2002, but it has failed to show use of the contested mark prior to the relevant date. A different “BLOW” mark was registered in 2002, which was subsequently removed from the Register in 2013. Four years later, when seeking to obtain registered trade mark rights, the Applicant chose not to re-establish rights in its earlier removed “BLOW” mark but decided to seek registration of a different “BLOW” mark. While the business may have traded continuously between 2002 to 2017, it did so under different versions of its “BLOW” brand name.

46. The Opponent raised these points in its submissions, stressing that in such circumstances the Applicant is not entitled to rely on the honest concurrent use defence provided for in Section 12 of the Act. These issues were not adequately addressed by the Applicant. In fact, while the application was allowed to proceed to advertisement on the basis of honest concurrent use, the Applicant did not mention honest concurrent use at all in its Counter Statement, Statutory Declaration or Written Submissions. Therefore, I am satisfied that should I find in favour of the Opponent with regards to its grounds of opposition, the Applicant has not demonstrated with cogent supporting evidence, that it would be justifiable for that finding to be set aside by virtue of honest concurrent use.

Decision

Section 10(2)(b) – *likelihood of confusion and association*

47. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:

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

- (a).....*
- (b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.

48. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that (i) there must be “an earlier trade mark”, (ii) the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and (iv) there must be a resultant likelihood of confusion on the part of the public.

49. The first two of these conditions are clearly fulfilled in this case. The Opponent’s mark was registered as of 4 February 2014 and by virtue of Section 11(1)(b) of the Act, is an earlier trade mark for the purposes of Section 10. The services of the application for

registration are identical to the goods and services for which the Opponent's earlier trade marks is registered, as both relate to hairdressing services, hairdressing salon services, beauty care services and beauty salon services in Class 44.

Comparison of the marks

50. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the services for which the Applicant is seeking registration. Notwithstanding the detailed comparisons I make below, I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)¹ that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

51. As both marks (reproduced side-by-side below) contain the word 'BLOW' there is clearly some visual and aural similarity. This word is, without doubt, the most dominant element of both marks. With regards to the Applicant's mark, I would go further and say the word dominates the mark, in that it stands way above all other components to such a degree that it renders the other components insignificant or negligible. But I find that is not the case with the Opponent's mark.



52. The Applicant's mark also contains the word 'SALONS', written in upper-case, but in a significantly smaller font size than the "Blow" element. Both words are in purple and are shown on a solid black background. But the colours, fonts and background are not

¹ Paragraph 23 of decision dated 11 November, 1997

significant, nor is the word 'SALONS' as it merely indicates the common name for a business premises in the hair and beauty trade.

53. The Opponent's mark consists of the verbal element 'blow' written in lower case using a standard font. It is followed by a black dot (full stop) and the letters LTD (the standard abbreviation for "limited") which, while written in upper case, is barely legible. These elements appear above a black line, below which are the words 'FAST BEAUTY', depicted in a smaller font than that used in the word 'blow'. Therefore, there are elements in each mark that are not reproduced in the other. Visually, all elements considered, I find the marks share a medium degree of visual similarity.
54. Aurally, all clearly identifiable word elements (all bar the LTD element of the Opponent's mark) would be given equal sounding. So, on the one hand there is "blow salons", and on the other "blow fast beauty". I find the marks share a less than medium degree of aural similarity.
55. Conceptually both marks will be understood to convey a message relating to a key service of the hair and beauty trade, namely blow-drying. Taken literally, the Applicant's mark designates the service and the premises in which it will be delivered, while the Opponent's mark designates the service will be delivered in a speedy fashion. But, in my opinion, the correct concept behind the 'FAST BEAUTY' element of the Opponent's mark does not relate to speed.
56. I understand the term to mean what 'fast' means in the food industry; not that the food itself can be prepared or eaten fast, but that it is convenient, available when the consumer wants it, and is accessible in a manner that fits with the consumer's lifestyle. The concept of fast food has been around for some time, and in recent years 'fast fashion' - the mass production of cheap, poor quality, disposable clothing, that takes advantage of the latest, but often short-lived trends, has appeared. In both of these industries the term 'fast' has received bad press, whether it be the lack of nutrition and high calorie count in many fast-foods, or the poor quality, dodgy labour practices, rampant counterfeiting, and the extraordinary waste and environmental damage resulting from the over-production associated with fast-fashion.

57. The term 'fast beauty' has only very recently begun to emerge in the beauty industry, but it is not associated with the delivery of beauty services, it relates to the production of beauty products. The term applies to producers that dramatically cut the time required to take a product from conception to consumer, which enabled them to keep step with the hectic change in trends. It too has received bad press for its negative impact on the environment.
58. No evidence was adduced to suggest the term 'fast beauty' was in common usage when the Opponent's EUTM application was made. Clearly the Opponent does not wish its use of 'fast' or 'fast beauty' to be viewed in the negative terms associated with fast-food, fast fashion or the more recent definition of fast beauty. Nor does it wish to convey the message that it completes hair and beauty services faster than other providers because consumers do not want a service provider to attempt to complete a hair-do, or beauty procedure in 20 minutes that normally takes an hour. Consumers want a quality service, delivered with due care, precision and attentiveness, irrespective of how long it takes. Therefore, I see the 'FAST BEAUTY' element of the Opponent's mark as indicating the Opponent can do what most other hair and beauty providers may not be able to do, namely, provide the service at a time, place and in a manner that is most convenient to the customer.
59. The concept of 'fast beauty' was unlikely to have been in common usage when the Opponent applied for its EUTM. Therefore, at that time, the term would have had a degree of inherent distinctiveness. Despite the later entry of the term 'fast beauty' into the mainstream, in my opinion, its meaning in the context of the Opponent's mark has not changed. Therefore, I find the respective marks convey a different overall conceptual message, but nonetheless both messages still inform the consumer about aspects of 'blow' services. Therefore, I am satisfied that there is a more than medium conceptual similarity between the two marks.
60. To sum up the results of my assessment of the verbal, visual and conceptual comparison of the respective marks, I find that, overall, the two marks share a medium level of overall similarity.

Likelihood of confusion

61. The question is whether that similarity is sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment should be made have been enunciated in a number of decisions of the European Court of Justice² in this area and they include the following:

- a. the more distinctive the earlier mark, the greater will be the likelihood of confusion,
- b. in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings,
- c. in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations,
- d. a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed,
- e. the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,

² Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- f. the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.
- g. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa,

Inherent distinctiveness of the earlier mark

62. The Opponent's mark has a small level of inherent distinctive, but nonetheless has the capacity to identify the goods and services for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.

Additional distinctiveness acquired through use

63. The Opponent claims to have earned additional distinctiveness through the use it has made of its mark. As the Opponent is relying on an earlier EUTM, it must show it has acquired such distinctiveness in the EU. However, as of the relevant date, the Opponent could only point to operating two hair and beauty salons (both in London) and providing off-site services. I accept the Opponent's plans for opening salons in Manchester and Birmingham must have being well advanced at the relevant, as these salons were opened within 3 months of the disputed application being filed. But the Opponent could not point to any trade outside of England. Therefore, the evidence submitted to support its claim falls well short of the want is needed for me to conclude that additional distinctive has been acquired by the Opponent.

Overall impression created by the marks

64. The wording in the marks is somewhat different, the appearance of the marks is somewhat different and the concept is somewhat different. However, despite the clear differences across all three criteria the overall impression the marks make on me is that they are similar to a medium degree.

Use and investment

65. Nothing was adduced by the Opponent to suggest it holds a significant share of the market in the EU. At the relevant date the Opponent operated two salons which can equate only to a tiny sliver of the UK market, in which there must be tens of thousands of hair and

beauty salons. The Opponent points to media coverage in magazines and newspapers, some of which are read by Irish consumers. In reality consumers do not travel internationally for hair or beauty treatments – they typically stay local. It is unlikely that Irish consumers would read or notice advertisements in UK produced magazines or newspapers for UK-based hair and beauty service providers. So, the commercial impact of such advertising on Irish consumers is likely to be negligible.

66. All investments in the mark appears to be targeted specifically at UK consumers. The Opponent has not provided any evidence regarding use of its mark in any other EU Member State or of any advertising specifically targeting EU consumers. Therefore, the geographical spread of the use of the Opponent’s mark is particularly narrow and I am satisfied that the mark has not been used and is not known outside of the UK.

The average consumer

67. The mark is registered in respect of the contested services (hair and beauty), which are provided to the public at large - though some are targeted specifically towards the female population. So, for the purposes of these proceedings, the average consumer is the general public, who is deemed to be reasonably well informed and reasonably observant and circumspect. In view of the services at issue the average consumer’s degree of attention is likely to be average.

Recognition of the Opponent’s Mark

68. The Opponent argues strongly that Irish consumers would have been exposed to its mark based on the number of Irish visitors to the UK, particularly to the Covent Garden area of London; that Irish consumers read UK publications in which the Opponent has placed advertisements; and also through accessing the Opponent’s website and social media channels. In support of this argument the Opponent points to 282 customers with either an Irish email addresses or telephone number having made a total of 499 bookings over the years. But this is a miniscule level of custom compared to the millions of hair and beauty treatments that must be purchased by Irish consumers on an annual basis. The fact that some Irish visitors to the UK seek hair and beauty services from the Opponent while there does not translate into the Opponent’s mark being “known” to Irish consumers.

69. The Opponent claims that Irish visitors to the popular tourist area of Convent Garden would be exposed to the Opponent's mark are unsustainable. In my opinion and experience, tourists do not pay much, if any, attention to the brands used on hair and beauty premises. There must be dozens of hair and beauty salons within a kilometre radius of Covent Garden, and I doubt any Irish visitor, who was not specifically seeking hair or beauty treatment, would notice any of them. Irish consumers would use bars, cafes and restaurants in the area far more frequently than hair and beauty salons, but few would be able to recall the name of any food or drink establishments they visited, because there is rarely any reason or need to remember them.
70. I have found that the only similarity between the marks is the word 'blow'. In its written submissions the Applicant argues: "*The word 'blow' is a common, laudatory word which is devoid of distinctive character. Indeed, the word is used in the relevant industry ubiquitously*". The Applicant argues the opposition must fail because the only common element is non-distinctive.
71. I disagree with the Applicant assessment that the word blow is laudatory, but I agree the word is descriptive. I accept it can be argued that 'blow-dry' is the more correct and commonly used term, but I am satisfied consumers would immediately and instinctively understand 'blow', when used for the services at issue, to be a direct reference to that particular hair treatment. A "wash, cut and blow" is, in my opinion, precisely the same as a "wash, cut and blow-dry". Therefore, I find the only element common to both marks is entirely descriptive and lacking in inherent distinctiveness.
72. Consumers see trade marks as a whole and are not inclined to be confused simply because two marks contain a shared element that directly refers to a specific characteristic of the services on offer. In this case and equally important, I am satisfied the 'FAST BEAUTY' element of the Opponent's mark would not go unnoticed. In my opinion, and for reasons outlined above, I find it plays a significant role in the identity of the Opponent's mark. I am satisfied that should the average consumer of hair and beauty treatments encounter both marks they would appreciate the differences and not see them as identifying a single undertaking or economically linked undertakings.
73. In light of the above, I find there is no likelihood of confusion arising and I dismiss the opposition on this ground.

74. I acknowledge that my findings regarding what elements of the respective parties' marks are descriptive and non-distinctive are completely at odds with the EUIPO opposition decision concerning the same two marks. As a direct result of that I have reached a different conclusion regarding likelihood of confusion. But competent authorities in EU Members States must reach their own determinations and, while they may note corresponding third-party decisions with interest (which I have in this case), are not obliged to follow them.

Section 10(3) – take unfair advantage of, or be detrimental to, the Opponent's mark

75. Section 10(3) of the Act provides as follows:

“A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”

76. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, the earlier mark(s) must have a reputation in the State (or in this case in the Community); thirdly, the use of the later trade mark must be without due cause; and fourthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

77. I have already found that the marks share a medium level of similarity, but that similarity is confined to the descriptive term 'blow'. Also, I have found that the Opponent's mark does not have a reputation in the EU. The onus is on the Opponent to prove its mark has the type of reputation that Section 10(3) seeks to protect, but there is nothing in the evidence submitted by the Opponent by way of proof that consumers in the EU know and recognise the Opponent's mark, let alone regard it as a trade mark of repute. It is well established that the reputation which Section 10(3) seeks to protect is that of an extremely well-known trade mark that would be defined as such under the Paris Convention. Such a

reputation is expected to extend beyond the limited class of consumers of the Opponent's services and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's goods. It is clear the reputation the Opponent has in its mark does not come anywhere near that level and I must dismiss the opposition under Section 10(3).

78. For these reasons, I have decided to dismiss the opposition in its entirety and to allow the Applicant's mark to proceed to registration.

Dermot Doyle

Acting for the Controller

10 August 2021