TRADE MARKS ACT 1938 (AS AMENDED)
AND TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 1538343 IN THE NAME OF SHARP's GLOBAL TRADING LTD

AND IN THE MATTER OF

OPPOSITION THERETO BY REGIS EUROPE LIMITED

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DECISION

1. On 10 June 1993 Sharp's Global Trading Limited applied for the registration of the trade mark HAIRXpress in respect of:

> Hair wigs and hair extension pieces.

2. As a result correspondence with the examiner the specification was subsequently revised to:

> Hair wigs, hair extension pieces, all for sale to retail outlets; all included in Class 26.

3. On 9 October 1995 Regis Europe Limited filed notice of opposition. The grounds of opposition are as follows:

> 1) the opponent is the proprietor of the trade mark HAIR EXPRESS which is registered in Classes 3 and 42 with effect from 4 April 1991 in respect of 'cosmetics, non-medicated toilet preparations, soaps, hair lotions; all included in Class 3' and 'hairdressing salon services; all included in Class 42'. The registration in Class 42 the subject to a disclaimer of exclusive rights to, separately, the words "HAIR" and "EXPRESS".
>
> 2) The mark applied for nearly resembles the mark set out above and registration is

being sought in respect of goods which are the same as or of the same description as or are associated with the goods and services in respect of which the opponent's trade marks are registered. Registration would therefore be contrary to Section 12(1) of the Trade Marks Act 1938.

3) The opponent has used the mark HAIR EXPRESS for a significant period of time and acquired a substantial reputation therein. Use of the mark applied for would therefore be liable to deceive or cause confusion and registration would therefore offend Section 11 of the Trade Marks Act 1938.

4) The Registrar should refuse the application in the exercise of his discretion under Section 17(2) of the Trade Marks Act 1938.

4. The opponent's grounds of opposition originally included a further ground based upon Section 17 of the Trade Marks Act 1938. This ground was based upon the opponent's contention that the applicant could not claim to be the proprietor of the mark applied for. This ground was not elaborated upon in the evidence and it was not pursued before me. I do not therefore intend to say any more about it.

5. The applicant admits that the opponent is the registered proprietor of the trade marks listed in the grounds of opposition, but denies all of the other grounds of opposition. Both sides ask for an award of costs.

6. The matter came to be heard on 30 March 1999 when the applicant was represented by Ms F Clark of Counsel instructed by WP Thompson & Co, Trade Mark Agents, and the opponent was represented by Mr R Wyand of Her Majesty's Counsel, instructed by Abel & Imray, Trade Mark Agents.

7. By the time this matter came to be heard the Trade Marks Act 1938 had been repealed. However, in accordance with the transitional provisions set out in Schedule 3 to the Trade Marks Act 1994, I must continue to apply the provisions of the old law to these proceedings.

Accordingly, all further references in this decision to the provisions of the Act are references of the Trade Marks Act 1938 (as amended).

8. The opponent's evidence includes a Statutory Declaration dated 12 December 1996 by Anthony William Eric Rammelt, who is the Managing Director of Regis Europe Limited (formerly Glenby Europe Limited). Mr Rammelt states:

> "The trade mark HAIR EXPRESS was first used in the United Kingdom by Regis in November 1986 when a hairdressing salon trading under that name was opened at the Selfridges store in Oxford Street in London. The trade mark has been used continuously since that date.
>
> The principal activity of all HAIR EXPRESS salons is the provision of hairdressing services. As is customary when providing hairdressing services, hair care products such as shampoo, conditioner, colouring and other goods are used and the cost of those goods is covered by the charge made for the hairdressing service. HAIR EXPRESS salons also sell hair care products separately; most of these products are sold under the trade mark REGIS.
>
> Hairdressing salons are sometimes arranged inside department stores and are sometimes arranged as separate stand alone retail units. Both arrangements are represented in salons trading under the trade mark HAIR EXPRESS.
>
> Since 1986 the number of hairdressing salons trading in the United Kingdom under the trade mark HAIR EXPRESS has grown. From 1986 to 1990 there was slow growth so that by 1990 there were 5 HAIR EXPRESS salons. Since 1990 there has been more rapid growth with the opening of 30 salons in Asda stores and 39 salons as stand alone retail units. There are therefore 84 salons currently trading in the United Kingdom under the trade mark HAIR EXPRESS."

9. Exhibit AWER4 to Mr Rammelt's declaration consists of a list of HAIR EXPRESS salons

showing the current location of the 84 salons. The opening dates of each of these salons is written in ink next to the location. It is impossible to reconcile these dates with the information provided by Mr Rammelt. In particular, the dates indicate that more than 5 stores were open by 1990 and some of the stores have dates which predate the first use claimed under the trade mark HAIR EXPRESS. At the hearing, Mr Wyand did not dissent from the suggestion made by Ms Clark for the applicant, that the dates shown reflected the opening date of the salon but not necessarily the date that the salon first operated under the trade mark HAIR EXPRESS.

10. Mr Rammelt provides annual turnover under the trade mark HAIR EXPRESS since 1990. The figures provided indicate that turnover was around £400,000 in 1990 rising to £600,000 in 1991, and standing at £2.2 million pounds by 1993. Figures are also provided for promotional expenditure. These indicate that the opponent spent around £38,000 promoting the trade mark HAIR EXPRESS in 1990. The figure for 1991 and subsequent years is similar.

11. Mr Rammelt further states:

> "Selection and fitting of hair extensions and wigs is a service that is carried out in certain hairdressing salons. Regis provide these services at certain of their hairdressing salons. At present the service is not provided at HAIR EXPRESS salons.
>
> Wigs and hair extensions are sold to companies who run hairdressing salons. Regis purchase wigs and hair extensions. By way of example a photocopy of an invoice to an Essanelle Hair Salon run by Regis and relating to the purchase of 10 hair extensions (product codes MRO2, MRO5, MRO6, MWO2, MWO5 and MWO6) is now produced and shown to me marked Exhibit AWER7.
>
> I am advised by my UK patent agents that, according to a search undertaken in October 1995, Sharp's Global Trading Limited are listed in the BT Phonebase search system as "hairdressers supps" which I take to mean hairdressers suppliers."

12. The opponent's evidence also includes a Statutory Declaration dated 12 December 1996 by Brian Lawrence Alcock, who is the National Accounts Sales Manager of Intercosmetic GB Limited (commonly known as Wella). Mr Alcock states:

> "I have been involved in hairdressing for about 20 years. Wella is a leading supplier to hairdressing salons and sells a wide range of products to hairdressing salons. In my position as National Accounts Sales Manager I have a great deal of contact with a number of different companies (including Regis Europe Limited) who operate hairdressing salons.
>
> The fitting of hair extensions is usually carried out in hairdressing salons. Hair extensions are sold to hairdressing salons by outside suppliers."
>
> ".....The fitting of a hair extension is a skilled procedure and anyone providing the service of fitting a hair extension needs to be fully training in the procedures. Many suppliers of hair extensions provide such training.

13. Exhibit BA to Mr Alcock's declaration consists of copies of seven advertisements taken from four issues of Hairdressers Journal International in 1995 and 1996. All of the advertisements are for hair extensions systems or human hair for use as hair extensions together with associated training. One copy of a classified advertisement by Banbury Postiche also includes wigs, but this advertisement appears to be aimed at wearers, sellers and makers of hair products and not just hairdressers.

14. Mr Alcock continues:-

> "A customer who has a hair extension fitted in a hairdressing salon would not usually be involved in the selection of the supplier of the hair extension. Furthermore the customer would not usually be aware of the supplier of the hair extension. A hairdressing salon will sometimes advertise the service of fitting hair extensions, but in such a case there will not usually be a reference to the brand of hair extension that are

available for fitting. Usually the customer relies upon the hairdressing salon to select the hair extension and the cost of the hair extension is covered within the charge made by the hairdressing salon to the customer for fitting those hair extensions."

15. The opponent's evidence also includes a Statutory Declaration dated 10 December 1996 by Raymond Duke, who is a Director of Regis Europe Limited. Mr Duke states that he has been a hairdresser for 29 years and has personal knowledge of making wigs, hair pieces and postiche, and also methods of attaching hair extensions. He states:

"There are currently two main methods of fitting extensions.

(a) A customer's hair is shampooed and blow dried, and then sections of hair are taken where the extension is required. The extension piece is woven in with the customer's own hair and when in place is fixed by the use of a heat clamp. This type of extension is usually composed of monofibre; these extensions are often removed by cutting off adjacent to the point of attachment.

(b) Another method is to follow the above procedure, but then the extension is secured in place with a bead of resin type glue which can be removed if required with acetate. These extensions can be real hair or man made fibre.

(c) Another method which is now less prevalent is to plait or weave the extension with the customer's own hair and then use a fine thread to stitch the extension close to the root; this is often then finalised with further stitching. This was a common method for Afro-Caribbean dreadlocks."

"In my experience the fitting of a wig is commonly, but not always, carried out by a hairdresser. The fitting of a hair extension is almost always carried out by a hairdresser. I am not aware of any occasion when a hair extension has been fitted by a person other than a hairdresser. In a minority of cases a customer will arrange for a hair extension to be fitted by a mobile hairdresser at home, but usually hair extensions

are fitted in hairdressing salons."

16. The applicant's evidence consists of a Statutory Declaration dated 21 October 1997 by Ajit Bhai Patel, who is the Managing Director of Sharp's Global Trading Limited. Mr Patel states that:

"The choice of the trade mark HAIRXpress was made by Sharp's in 1992 and the first goods sold under the said trade mark in the UK was sold in June 1993. Since 1993 Sharp's have sold in excess of 1 million wigs and hair extensions under the said trade mark in the United Kingdom.

For the years 1994 to 1996 the turnover per annum for the said goods was as follows:

1994	£228,000
1995	£487,000
1996	£645,000

For 1997 I expect the corresponding figure to be about £900,000.

Since Sharp's begin selling wigs and hair extensions under their trade mark HAIRXpress in 1993 I know of no incidence of confusion having arisen as between Sharp's products and any goods or services offered by the opponent's under the trade mark HAIR EXPRESS. Indeed, I note that nowhere in the evidence filed by the opponent is there any reference to confusion having arisen or deception having taken place."

"It is necessary to distinguish between retail sale of wigs and extensions and their use in salons. These are two quite different business operations. Throughout the country there are retail shops selling wigs and hair extensions. These are usually relatively

inexpensive products, often made from synthetic materials. Because of their cost and quality they are not products which a salon would normally fit."

".....Salons on the other hand, promote particular systems, ie the products of a particular wig/extension manufacturer. Companies such as Banbury Postiche Ltd, Dome Cosmetics,, and Hair System Connect supply not just wigs and extensions to salons but also provide ancillary equipment, kits and training, ie a complete system

"We are talking here of two quite different markets. Sharp's are involved with retail sale. Regis are providing a service in their salons; they would not normally sell customers a wig or extension - they are offering a fitting service. Because Sharp's are just involved in the retail market they do not train and have no need to train fitters.

It is my further opinion that Sharp's products, which sell for just a few pounds, would not be associated by the public with HAIR EXPRESS salons, where, if fitting service was provided, the cost would probably be within the range of £100 to £400. Sharp's have regularly advertised their HAIRXpress wigs and extensions since 1993. This has been both through magazine advertising and exhibition at trade shows. As an example of magazine advertising there is attached as Exhibit ABP5 a sample page from Issue No 1 of "AfroDizziac". We have also advertised in "PS Magazine" and "Nigerian Link", and have placed regular full page advertisements in "Afro Hair and Beauty" magazine since 1994."

"In paragraph 5 of Mr Duke's declaration he states that the fitting of a wig is commonly carried out by a hairdresser and that the fitting of an extension is almost always carried out by a hairdresser. This may be true for the types of wigs and hair extension which Regis provide for their clients. The key word here is "fitting". By "fitting" I understand Mr Duke to mean the specialised service which the salon provides and for which a substantial charge is made. The HAIRXpress products produced by Sharp's are not "fitted" in this sense. They are bought over the counter and are usually just clipped into place, hence the use of "Xpress". Mr Duke totally

ignores this "other" market, and I find his statement misleading."

17. A copy of Sharp's current brochure illustrating the product range is attached to Mr Patel's declaration as Exhibit ABP6.

18. In response to Mr Patel's evidence the opponent filed evidence in reply. This includes a further Statutory Declaration dated 20 April 1998 by Anthony William Eric Rammelt. Attached to Mr Rammelt's declaration as exhibit AWER9 are copies of the financial accounts of Sharp's Global Trading Limited for the years ending 31 July 1994 and 31 July 1995. Mr Rammelt notes that the Director's report indicates that the principal activity of the company is that of importers, exporters and wholesalers of Afro products. The profit and loss accounts for the periods concerned show turnover equivalent to the use claimed by the applicant for the years 1994 and 1995. Mr Rammelt expresses surprise that the turnover under the mark in the United Kingdom accounts for all of the trade of Sharp's Global Trading Limited including any export business.

19. In response to Mr Patel's observation that the opponent does not and does not appear to have any plans to provide a service for fitting hair extensions and wigs, Mr Rammelt states that in fact such a service has already been provided at a small number of HAIR EXPRESS salons. In particular Mr Rammelt explains that the manageress of the HAIR EXPRESS salon in Catford took the initiative of offering such a service over a year before. He explains that he was not aware of this when he completed his earlier declaration. He also indicates that two other branches of HAIR EXPRESS salons have offered similar services since the summer or autumn of 1997 and he provides the addresses of these other salons.

20. The opponent's evidence in reply also includes a further Statutory Declaration dated 20 April 1998 by Raymond David Duke. Attached is Exhibit RDD1 to Mr Duke's declaration is a copy of the Summer 1996 edition of "Black Beauty and Hair". Mr Duke draws attention to a number of advertisements in this publication which show hair salons offering the services of fitting hair extensions. One or two of these appear to offer a full range of hairdressing services. The majority of those advertising appear to specialise in fitting hair extensions. A

number describe themselves as 'hair extensions centres'. Mr Duke notes that one of these offers to retail human hair as well as fitting extensions.

21. The opponent's evidence in reply also includes a Statutory Declaration dated 21 April 1998 by Sandra Rosemary Johnson, who is the Manager of the HAIR EXPRESS salon in Catford. Ms Johnson states:

> "Before joining Regis Europe Limited, I had learned how to fit hair extensions and when I started working in the Catford salon I thought there was a good business opportunity to offer customers the service of fitting Afro hair extensions. More than one third of our customers in Catford are of Afro-Caribbean origin and many of them like to use hair extensions."
>
> "The hair salon in Catford does not at present stock hair extensions. Sometimes customers who want a hair extension fitted purchase their own hair extension and bring it to the hair salon for fitting. At other times, by arrangement in advance, I select a hair extension and buy it locally on behalf of Regis Europe Limited. It is easy to purchase hair extensions in Catford and elsewhere in South London. Friends and colleagues of mine who work as hairdressers in other companies also buy hair extensions for their customers and then fit them in a salon.
>
> I am familiar with the HAIRXpress range of products and I fitted HAIRXpress extensions for customers when they have wanted me to do so. When I have a free choice I prefer to buy a slightly higher quality of product. For example, in a typical case I would spend roughly £28 per bunch of hair where as an equivalent HAIRXpress product would cost approximately £10 to £15 per bunch of hair. The amount of hair in a bunch would be about the same in each case and it is not unusual to need three bunches."
>
> "Soon after I started work at HAIR EXPRESS I told a colleague of mine, April Wilson, who is a hairdresser, that I work at HAIR EXPRESS. April Wilson

thought that my new job involved selling HAIRXpress extensions at a hair shop.

On 10 and 17 March 1998 I attended an ethnic hair training course arranged for me and other employees of Regis Europe Limited. That training course covered lots of different points concerning ethnic hair including some training about bonding (a key part of the process of fitting hair extensions)."

22. That completes my review of the evidence and I now turn to the decision. I propose to deal with the ground of opposition under Section 12(1) of the Act first. Section 12(1) of the Act is as follows:

> 12 (1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:
>
> (a) the same goods
>
> (b) the same description of goods, or
>
> (c) services or a description of services which are associated with those goods or goods of that description.

23. Section 68(2A) and (2B) are also relevant. They are also follows:

> (2A) For the purposes of this Act goods and services are associated with each other if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business, and so with descriptions of goods and descriptions of services.
>
> (2B) Reference in this Act to a near resemblance of marks are references to a

resemblance so near as to be likely to deceive or cause confusion.

24. The classic test under Section 12 is set down in the Smith Hayden case (1946) 63 RPC 97 at page 101. Adapted to the case at hand, the test may be expressed as follows:

> 'Assuming user of HAIR EXPRESS in a normal and fair manner for any of the goods or services covered by the registrations of that mark, is the tribunal satisfied that there will be no reasonable likelihood of deception or confusion amongst a substantial number of persons if HAIRXpress is also used normally and fairly in respect of wigs and hair extensions all for sale to retail outlets.'

25. It is well established that the onus under Section 12 is on the applicant for registration. However, a mere possibility of confusion is not enough; the tribunal must be satisfied that there is a real tangible danger of confusion if the mark which it is sought to register is put on the Register (per Farwell J in ERECTIKO 52 RPC 136 at 153).

26. Ms Clark submitted that Section 68(2A) ought not to be construed widely. In support of this submission she referred me to paragraph 11-67 of the Trade Mark Registry's Work Manual under the 1938 Act which is as follows:

> "Goods associated with services for the purposes of Section 12 conflict is not to be interpreted in its widest sense. The new subsection (2A) to Section 68 (see Section 1(5)(b) of the 1994 Act) interprets this association to mean "... if it is likely that those goods might be sold or otherwise traded in and those services might be provided by the same business...". This likelihood, must, however, be a realistic one in that the public would reasonably believe a connection exists between a supplier of goods and the provider of a service if the same or nearly resembling marks are used in respect of goods and services. Such an association clearly exists between pumps and the service of repairing pumps, carpets and the service of carpet laying, but not, for example, between adding machines and accountancy, stitching machines and shoe repair."

27. I accept Ms Clark's submission. In my view the relationship envisaged by Section 68(2A) of the Act relates to the sort of goods and services which go 'hand in glove' with each other. It should be noted that the requirement is for the goods to be of the sort sold or otherwise traded in by suppliers of the services in question. It is not therefore sufficient for the goods in question to be merely used in the course of providing the service. On the other hand, the words "or otherwise traded in" indicate that it is not necessary for the goods at issue to be actually offered for sale by the type of service provider in question. Nevertheless, there must in some sense be a trade in the goods at issue by providers of the services in question.

28. Ms Clark drew my attention to the evidence of a lack of any actual confusion in the years that the applicant's mark has been used after the date of application. It was Ms Clark's submission that if I came to the view that hairdressing salon services and wigs and hair extensions were goods associated with services within the meaning of that term in Section 68(2A) of the Act, and that the respective marks were nearly resembling, but that the resultant risk of confusion was negligible, I should take this into account as a special circumstance under Section 12(2) of the Act and allow the registration. In support of this submission Ms Clark referred me to a footnote in Kerly's at page 155 which is as follows:

> "Since this definition of associated goods and services brings only one of the matters which have been held to determine whether goods are "of the same description", and that one in a very loose form, there must inevitably be cases where the amended Section 12(1) excludes registration although the likelihood of confusion is negligible. This could be considered a "special circumstance", allowing registration by virtue of Section 12(2)."

29. In my view this is not the correct approach. It presupposes that the term "associated goods and services" is to be given a broad interpretation, which as I have already indicated, I do not believe is appropriate. Further, I think it is clear from the Smith Hayden test set out above, that there has to be a reasonable likelihood of deception or confusion before Section 12(1) applies. The degree of similarity of the trade marks and of the respective goods and services must be taken into account in determining the likelihood of confusion or deception.

A negligible risk of confusion may not amount to a reasonable likelihood of confusion or deception for the purposes of Section 12(1) of the Act. Either way I do not think that Section 12(2) of the Act has any part to play in my decision.

30. I now move on to consider the facts. The opponent's case under Section 12 is based upon their two earlier registrations details of which are set out above. Both registrations are for the same mark - HAIR EXPRESS. The first is in Class 3 for a range of cosmetics. The second is in Class 42 for hairdressing salon services. I can deal quite briefly with the case put forward on the basis of the first registration. Mr Wyand contended that cosmetics and wigs and hair extensions are goods of the same description. I understood him to base his case primarily on the basis that these sorts of goods are commonly found together in hairdressing salons. It is well established that in order to determine whether goods are of the same description one needs to consider the purpose of the goods, the respective channels of trade and the nature of the respective goods. See Jellinek's application (1946) 63 RPC 59. Even if I were to accept Mr Wyand's submission that the respective channels of trade overlap at certain points, it appears to me that the nature and purpose of these goods is completely different. In my view they are clearly not goods of the same description. The opposition based upon registration of trade mark registration No 1460441 therefore fails.

31. The position with regard to earlier registration No 1460442 in Class 42 is more complex. Ms Clark was constrained to accept that the term "Hairdressing Salon Services" would now include the fitting of a wig or hair extension. However, Ms Clark pointed out that there was no evidence that this was the position at the date of application in 1993. Mr Wyand, for his part, took the position that there was no evidence that the position was any different in 1993, and he pointed out that the applicant had had the opportunity of filing evidence to substantiate this point and had failed to do so. I accept Mr Wyand's submission. The fitting of hair extensions and wigs is hardly a new development, at least there is no evidence to that effect. It does not seem to me to be very likely that the position in 1993 would have been substantially different to the position as at the date of the evidence, which is 1995-97.

32. It appears to me from the evidence of Mr Alcock and Mr Rammelt, that it is relatively

common practice for hair extensions to be supplied to the public via hairdressing salons. Mr Rammelt indicates that the opponent provides a service of selection and fitting of wigs and hair extensions at other hairdressing salons within their business. I note that exhibit AWER7 which is intended to illustrate this point relates solely to hair extensions. Mr Alcock provides evidence that hair extensions are sold to hairdressing salons by outside suppliers and that both hair extensions and wigs are fitted in hair dressing salons.

33. Given the methods of fitting hair extensions described in Mr Duke's evidence I find it unsurprising that the extensions he describes are fitted in salons. The attachment of individual strands of hair to a customer's own hair by weaving, gluing or stitching is clearly a skilled activity which one would expect to be carried out by a trained professional. Further, it appears quite natural for the salon to provide the hair for these extensions as indicated in the evidence. I have therefore come to the view that the evidence establishes a sufficient likelihood of "trade" in such goods by hairdressing salons for me to find that the fitting service undoubtedly provided by such salons is an "associated" service within the meaning of Section 68(2A) of the Act.

34. The position with regard to wigs is less clear. There is evidence that wigs are "commonly" fitted by hair dressing salons (which I do not doubt), but the opponent's evidence that wigs are sold through or selected in (which may amount to "traded in") hairdressing salons is more flimsy. Nevertheless, Mr Patel's evidence for the applicant appears to accept that wigs are promoted and selected through hairdressing salons and therefore , at least for the purposes of this decision, I am prepared to accept that salons also trade in these goods.

35 .In assessing the likelihood of confusion, I do not believe that I am required to go as far as to assume use of the opponent's mark in respect of the type of establishments (such as those described in the evidence as 'Hair Extension Centres') that specialise in fitting hair extensions or wigs. As Jacob J indicated in Avnet Inc v Isoact Ltd (1998 FSR 16 @ 19), specifications of services should not be construed widely but should be confined to the core of the possible meanings attributable to the terms used. I am therefore required to assume notional use of the mark HAIR EXPRESS in respect of a 'normal' range of hairdressing salon services, which I

have found includes the fitting of wigs and extensions.

36. In view of the close similarity of the respective trade marks, I am not satisfied that there is no reasonable likelihood of confusion if the mark HAIRXpress is used normally and fairly in respect of the sort of wigs and hair extensions which are designed to be fitted by a trained professional and which may be selected in a hairdressing salon. For example, the public would be likely to assume a trade connection if they saw the applicant's goods being made available for fitting at one of the opponent's salons. And they may also have cause to wonder whether there was a trade connection with the opponent if they saw wigs and hair extensions under the mark HAIRXpress being promoted through a salon with a different name, which they might assume to be another member of the Regis group even though it is in fact unconnected with the opponent.

37. The applicant's case is primarily that the goods for which he seeks registration do not fall within the description of hair extensions and wigs given in the opponent's evidence. The applicant states that his goods are of the 'ready-to-wear' variety of hair extension and wig. They are not the sort of goods that require the skill of a hairdresser in order to fit them. It appears from the applicant's evidence that the bulk of his goods are of the pre-styled 'ready-to-wear' type. Ms Clark very properly pointed out that Exhibit ABP6 to Mr Patel's declaration, which consists of a copy of the applicant's brochure offering wigs and hair extensions for sale, includes an example of a bunch of hair which was not of the 'ready-to-wear' type of hair extension. However, Ms Clark submitted that this was the exception to the rule and would not fall within the registration sought. This last point reflects the applicant's interpretation of the limitation to the specification of the application effected by the addition of the words "all for sale to retail outlets". My Wyand criticised this limitation. He pointed out that hair dressing salons are retail outlets and the limitation was therefore meaningless. I believe that Mr Wyand is right about this. If this limitation did not achieve the effect intended by the applicant, Ms Clark proposed that the specification of the application be further amended to something along the lines of:

> "Wigs, hair extensions; all being elasticated, clip-on or for attachment by clips."

38. Mr Wyand did not dispute that there was a distinction between the kind of wigs and hair extension pieces covered by the above description and those fitted by hairdressing salons. Indeed, he suggested that it was possible that one of the reasons why there was no significant evidence of confusion in the face of the applicant's use of his mark, was that the applicant had so far restricted his use of the mark mainly to goods which fell within the above description. However, he did not concede that the revised specification avoided any likelihood of confusion. Mr Wyand also pointed out that it was somewhat late in the day for the applicant to put forward a further and alternative specification of goods for consideration.

39. Section 18(7) of the Act provides the Registrar with the power to accept an amendment to an application at any time before or after acceptance. I do not, therefore, believe that I am prohibited from considering the applicant's proposal. Any detriment that this may cause the opponent should be reflected in any award of costs that is made.

40. It appears to me that a revised specification of:

> "Pre-styled, ready-to-wear wigs and hair extension pieces; all being elasticated, or clip-on or for attachment by clips."

- does reflect a real distinction in the marketplace and also has a bearing upon the likelihood of confusion and whether the applicant's goods can be considered to be associated with the services for which the opponent's mark is registered. In the absence of any fitting requirements that present the need for the services of a hairdresser, there is little possibility of such goods being selected in or otherwise traded in by hairdressing salons. I do not believe that these goods can therefore be considered to be associated with the opponent's services for the purposes of Section 68(2A) of the Act. Nor can I see any reason why the public should expect such goods to be connected in trade with a hairdressing salon operating under a similar name.

41. It follows from this finding that the restriction to the specification of goods put forward at the hearing has a direct bearing on my findings as to whether the respective goods and services

are associated within the meaning of Section 68(2A) of the Act; and even if they are, whether there is a likelihood of confusion under Section 12(1). I will return to the question of the amendment to the specification after I have dealt with the opponent's ground of opposition under Section 11 of the Act.

42. Section 11 of the Act is as follows:

> 11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

43. The test under Section 11 of the Act also comes from the Smith Hayden case referred to above as adapted by Lord Upjohn in Bali (1969 RPC 472 @ 496). With regard to the matter at hand it can be expressed as follows:

> "Having regard to the use of the name HAIR EXPRESS is the tribunal satisfied that the mark applied for, if used in a normal and fair manner in connection with any goods covered by the registration proposed, will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?"

44. As with Section 12, the matter must be judged as at the date of the application. Unlike Section 12 the enquiry under Section 11 is not constrained by the requirement that the respective goods and services are associated within the meaning of Section 68(2A) of the Act. But if the respective goods and services are not associated, the registration of the later mark is only likely to be prohibited where the nature and/or extent of use of the earlier trade mark is sufficient to cause persons to wonder whether there may be a trade connection between the parties. As under Section 12, a mere possibility of confusion is not sufficient. There must be a real tangible risk of confusion (as per Romer J in Jellinek's application in 1946 63 RPC 59 at page 78).

45. It appears from Mr Rammelt's evidence that the opponent had five hair salons operating under the name of HAIR EXPRESS by 1990. It is clear from the turnover figures that the number of salons operated under that name would have been greater by 1993. It is not clear how much greater - the opponent's evidence is not clear on this point. Further, it is important to consider the nature of the opponent's use. The promotional material and price list exhibited to Mr Rammelt's declaration show that the opponent provides a smallish range of typical hairdressing services, such as 'cut and blow dry', 'perms' and hair colouring services. The one unusual feature of the service is that the opponent's salons are operated without an appointment system. This is no doubt reflected in the choice of the trade mark HAIR EXPRESS. There is no suggestion that the opponent has provided a selection and fitting service for wigs or hair extensions of any description under the mark before the relevant date. And apart from what appears to be ad hoc activity carried on by a couple of individual salons, there is no evidence that the opponent has provided a wig or hair extension fitting service under the mark after the date of the application either.

46. Given this situation and the nature of the goods in respect of which the applicant has used the trade mark HAIRXpress, I do not find it surprising that there is little evidence of the applicant's trade after the date of the application having caused any confusion. Mr Wyand argued that the absence of any substantial evidence of confusion should not be taken to indicate that no such confusion has occurred. The opponent also points out that the applicant's turnover figures under the trade mark in the UK reflect the total turnover of the applicant as shown in the company's accounts, although the applicant describes itself as being engaged in the export trade The implication being that the applicant's trade in the UK is smaller than claimed. Of course, describing oneself as an importer, exporter and retailer does not necessarily mean that one has actually engaged in the export of goods.

47. Mr Wyand also questioned the reliability of the sales figures given in the applicant's evidence. He pointed out that the total sales figures claimed for 1994 through to 1997 amounted to something over £2 million. He pointed out that the applicant had claimed to have sold in excess of 1 million wigs and hair extensions during this period. If that is correct this would suggest that the applicant's wigs and hair extensions were sold for a price of little

more than £2 an item. I agree with Mr Wyand's suggestion that this seems a little unlikely, although I note that in Mr Patel's evidence it is said that the applicant's products "sell for just a few pounds".

48. Taking the applicant's evidence as a whole, I think it is clear that the applicant has a significant business in the UK in wigs and hair extension pieces under the trade mark HAIRXpress. It is of course possible that there has been confusion between the applicant's mark and that of the opponent but that this has not come to light. Nevertheless, I regard the absence of any real evidence of confusion as consistent with the finding that, at the date of the application, there was no reasonable likelihood of confusion arising from the applicant's use of the mark HAIRXpress in relation to the sort of wigs and hair extensions described in para 40 above, in the face of the opponent's earlier use of the mark HAIR EXPRESS in respect of a limited range of hairdressing services. In coming to this view I take due note of the fact that both marks, to some extent, allude to the nature of the respective goods and services - 'instant' hair extensions and wigs on the one hand and a fast 'no appointment necessary' service on the other. I believe this makes it even less likely that the public will wonder whether the choice of similar marks signals some sort of trade connection between the parties.

49. I have not overlooked the evidence of Ms Johnson and her account of the conversation with a colleague of hers, April Wilson, who she says thought that her new job involved selling HAIRXpress extensions in a hair shop. I bear in mind that this is first-hand hearsay evidence and, although admissible, this should be reflected in the weight that I attach to it. It is not clear to me from Ms Johnson's evidence whether her colleague had any knowledge of the HAIR EXPRESS salons operated by the opponent when she made this statement. Further, it is not clear to me what is meant by a "hair shop". This could of course refer to a salon but it appears to me to be as, or possibly more, applicable to the type of establishment which specialises in the sale of wigs and hair extensions. I conclude that there is no evidence of the applicant's trade in wigs and hair extensions causing any confusion with the hairdressing salons operating by the opponent.

50. The opposition under Sections 11 & 12 will therefore fail if, within one month of the date

of this decision, the applicant files Form TM21 restricting the specification of goods to that shown at para 40 above. If this is not done the application will be refused.

51. There remains the question of the Registrar's discretion under Section 17 of the Act. I see no reason to exercise that discretion adversely to the applicant and I decline to do so.

52. There is also the question of costs. As I have already indicated, the opposition will succeed if the amended specification of goods put forward at the hearing is not followed through. It is possible that the matter may have been settled earlier if this amendment had been put forward in a timely fashion. As it was the amendment came forward at a very late stage in the proceedings and I intend to take this into account in determining costs. In these circumstances, I believe that the opponent is entitled to a contribution towards its costs. I therefore order the applicant to pay the opponent the sum of £800.

Dated this 25 Day of May 1999

Allan James
for the Registrar
the Comptroller General