

O-280-16

TRADE MARKS ACT 1994

TRADE MARK APPLICATION 3075390

BY KYLE MARTIN

TO REGISTER LA WEAVE AS A TRADE MARK IN CLASSES 26 & 41

AND

OPPOSITION 404291

BY ECOTRADE EUROPE LTD

Background and pleadings

1. This is an opposition by Ecotrade Europe Ltd (“the opponent”) to application 3075390 filed on 3rd October 2014 (“the relevant date”) by Mr Kyle Martin (“the applicant”) to register the trade mark **LA Weave** in relation to:

Class 26

Hair extensions, hair pieces, wigs, synthetic hairpieces, natural hair pieces, hair ornaments, articles for the hair, elasticated hair bands, hair-bands, hair curlers, artificial hair, natural hair, false hair, synthetic hair, hair clips, rollers.

Class 41

Hair Extension Training courses, arranging professional Hair Extension workshop and training courses, organisation of training Hair Extension courses.

2. The registrar initially objected to the application on the grounds that the trade mark was generic or non-distinctive. However, the application was subsequently accepted on the basis that the mark had acquired a distinctive character through use. It was published for opposition purposes on 27th February 2015.

3. The grounds of opposition are that:

- The trade mark is, and was at the relevant date, generic in the sector of the hair and beauty industry concerned with applying hair extensions for associated goods and services.
- Alternatively, the opponent says that the mark is descriptive of the geographical origin of the goods and services. This is because ‘weave’ is descriptive of a type of hair extension and LA designates ‘Los Angeles’, or France if LA is understood as the French word ‘La’.
- On either basis the opponent claims that the mark was devoid of any distinctive character at the relevant date and, contrary to the applicant’s claim, it had not acquired a distinctive character through use.

The opponent therefore request that the application be refused because registration would be contrary to section 3(1)(b) and/or(c) and/or(d) of the Trade Marks Act 1994 (the Act).

4. The applicant filed a counterstatement denying the grounds of opposition. I note, in particular that:

- It is not denied that ‘weave’ is a term commonly used in connection with a method of applying hair extensions;

- It is denied that ‘LA’ and ‘LA weave’ are commonly used in relation to the goods and services at issue:
- The applicant claims that he devised the mark in 2011; he wanted a trade mark that was short and memorable with an exotic feel to it;
- The applicant claims that he has provided training services under the mark to hundreds of people in the hair dressing industry and that, as a result of such use, the mark has become known as the applicant’s trade mark;
- The applicant licences the people trained under the mark to provide hair extension services;
- Consumers in the marketplace are well aware that third party hairdressers providing hair extension services under the mark have been trained by the applicant and are consequently using the mark under licence.

5. Both sides seek an award of costs.

Case management

6. Both parties filed evidence in chief. In accordance with usual practice, the opponent was allowed to file evidence in reply. On this occasion this led to a request from the applicant to file evidence in reply to the opponent’s evidence in reply. This was partly because the applicant wished to demonstrate that one of the parties on which the opponent relied to show that third parties were using LA Weave prior to the relevant date (Paul’s Hair World) did not in fact provide services under the mark for as long as had been claimed. Further, the applicant also wished to show that the opponent itself had not, contrary to a claim made in its evidence, provided services under the mark prior to the relevant date in 2014. In addition, the applicant wished to file more evidence from social media sites showing how little use was made of LA Weave relative to some other terms, and more evidence from people in the hairdressing industry stating their opinion that the mark was not generic.

7. A case management conference (“CMC”) was held on 16th March 2016. The applicant was represented by Ms Carin Burchell, a trade mark attorney with Branded TM Ltd. The opponent was represented by Ms Sally Cooper, trade mark attorney. Following the CMC I issued the following directions:

“(i) The applicant’s request to file further evidence in reply to the opponent’s evidence in reply is refused save for (ii) and (iii) below.

(ii) The applicant has 21 days (until 5th April) to file evidence showing

that Paul's Hair World did not offer LA Weave before late 2013.

(iii) The applicant has 21 days (until 5th April) to file evidence showing that the courses the opponent provided between 23/06/14 and 29/09/14 did not offer training in LA Weave as claimed in Ms Qayyum's statement.

(iv) The opponent's witnesses, Jennifer Harrison, Gemma Craven, Nicola Purcell, Daniel Wilkinson, Martin Williams, Abigail Turner & Zara Qayyum, should attend the hearing for cross examination.

(v) The issues for cross examination shall be limited to when the witnesses first became aware of use of LA Weave and whether and when they first used that term themselves in relation to which goods/services.

(vi) Mr Kyle Martin should attend the hearing for cross examination.

(vii) The opponent has permission to cross examine Mr Martin on the issues of (a) whether LA Weave was already in common use at the date it was adopted by the applicant (and, if so, in relation to what), and (b) the nature of the applicant's licences.

(viii) The witness statement of Zephyr Beau-Bradley should be treated as a supporting letter to Mr Williams second statement (to which it is exhibit MW R-23) and therefore as hearsay evidence.

(ix) The cross examination of the opponent's witnesses should be limited to 15 minutes each, apart from Mr Williams which should be limited to 30 minutes.

(x) The cross examination of Mr Martin should be limited to 30 minutes.

(xi) The hearing will take place at the IPO's London office at 10am on 21st April. One day has been allocated for the hearing."

8. I explained my reasons for these directions as follows:

"I refused the applicant's request to file internet evidence to contextualise the opponent's evidence of LA Weave being used on social media sites. As I understood it, the further evidence would consist of extracts from WIKIPEDIA showing a nil return for LA Weave and search reports showing that other terms for affixing hair extensions appear far more frequently on social media. I did not consider that evidence of this kind would be of material weight. The

fact that other terms, which the parties agree are generic, appear more frequently on social media does not mean that LA Weave is not in customary use and/or *bona fide* and established use. Further, the appearance of the term on social media was raised in the opponent's evidence in chief. The applicant had the opportunity to respond to this evidence in its evidence in chief. Taking into account all of the above, I was not satisfied that the further instances of use of LA Weave on social media sites included in the opponent's reply evidence justified the applicant's request to file additional evidence of 'context'.

I refused the applicant's request to file additional statements from independent witnesses attesting to the non-generic nature of LA Weave. Firstly, I was not satisfied that the proposed witnesses were really independent (they are licensees of the applicant's mark and therefore have an interest in the outcome of this opposition). Secondly, it appeared to me that this evidence was really in response to the statements in the opponent's evidence in chief. This could have been filed in the applicant's evidence in chief. Thirdly, allowing such evidence would require me to permit the opponent to file evidence in reply, which the opponent's representative made clear would be used to file more statements from individuals stating that the mark was descriptive/generic. Therefore this course was likely to lead to further costs and delay. Fourthly, the onus is in the opponent to establish that the term LA Weave was in customary use etc. at the relevant date. Cross examination of the opponent's witnesses seemed to me to be more likely to cast light on that matter than more statements of belief from individuals stating that they do, or don't, regard the mark as a description and/or generic term.

[Ms Burchell] indicated that if I found that one or more of the grounds of opposition applied *prima facie*, the applicant relied on acquired distinctiveness through use and therefore that the proviso to s.3(1) applied. I permitted the cross examination [of Mr Martin] on this basis. In particular, I thought it was justified to test whether the claimed use of the mark by the applicant's licensees supports the applicant's claim that the mark had acquired a distinctive character through use at the date of the trade mark application.

Ms Cooper opted to have Ms Beau-Bradley's statement treated as hearsay. The alternative would have required her to attend for cross examination.

In accordance with Rule 62, I direct that the failure to appear of any of the witnesses listed at points (iv) and (vi) above, will result in their evidence also being treated as hearsay. This may affect the weight given to their evidence, particularly where there is no documentary support for [their] statements."

The Hearing

9. The hearing took place on 21st April. The parties were represented as before. Five of the opponent's witnesses - Jennifer Harrison, Nicola Purcell, Daniel Wilkinson, Martin Williams and Zara Qayyum - attended the hearing for cross examination on their evidence. The applicant, Mr Kyle Martin, also attended for cross examination.

10. Two of the opponent's witnesses, Abigail Turner and Gemma Craven, did not appear for cross examination. Consequently, I will treat their written evidence as hearsay. The same applies to the written evidence of Ms Beau-Bradley. This means that I shall consider the matters set out in Section 4 of the Civil Evidence Act 1995 in deciding what weight to give their evidence. In particular, I will bear in mind that their statements were produced for these proceedings, that it was reasonable for the opponent to have produced them as witnesses at the hearing, and that without cross examination it is not possible to be sure of the extent of their interest in the outcome of these proceedings (if any, in the case of Gemma Craven).

The evidence

Jennifer Harrison

11. Jennifer Harrison is the owner of Envy Hair Extensions in Cheshire. Ms Harrison provided a short witness statement in support of the opposition in which she made these points:

- She has worked in the hair extensions business since 1994;
- Ms Harrison first heard of an LA Weave method of applying hair extensions in 2008;
- Her business has used the term for a method of applying hair extensions since 2008;
- Ms Harrison was not trained by the applicant or by his business;
- She had spoken to "*a number of the clients of Envy Hair Extensions*" who have extensions using the LA Weave application method and none of them had heard of the applicant or his business.

12. The applicant filed evidence in reply to Ms Harrison's written evidence, which included a witness statement by Beverly Robinson. Ms Robinson is a trainee trade mark attorney with Branded TM Ltd (i.e. the opponent's legal representatives). In November 2015, Ms Robinson conducted internet research into the use of LA

Weave on the websites, Facebook and Twitter accounts used by Envy Hair Extensions¹. Essentially, Ms Robinson says that she found examples of numerous promotions for hair extension services using different attachment methods, such as micro bonds, micro rings, weaves (“*Plait method*” and “*Ring Method*”), and hand tied wefts, but none for LA Weave. She also found promotions for hair extension training services in a number of different fitting methods, but once again none of these were listed as LA Weave. When searching the opponent’s website beautyworkspro.co.uk, Mr Robinson discovered that Ms Harrison had worked for the opponent as an ‘educator’ (trainer). According to a post on the website of Envy Hair Extensions, Mr Harrison was ‘head hunted’ by the opponent towards the end of 2013 to head up its newly established (hair extensions) Training Academy.

13. In cross examination, Ms Harrison said that she first became aware of LA Weave whilst in California on a training course for hair extensions in 2008. She has used it in her salon ever since. In the USA, LA Weave was used as the name of two slightly different methods of attaching hair extensions, both using wefts of hair and micro rings. Ms Harrison explained that different application methods suited different people. The LA Weave method could be used to fit hair extensions in one hour, as opposed to the more usual three or four hours. Provided your hair was suitable, using LA Weave could save time. When asked how she used the mark in her salon, Ms Harrison said she used the name in her salon, mobile hairdressers, and in training other hairdressers. She explained that LA Weave was used to explain one of the different methods of applying hair extensions. This was necessary because customers often just ask for hair extensions, and the various fitting methods available have to be explained to them. Her salon used a mannequin to visually demonstrate the different methods. When I asked her to clarify her answer, Ms Harrison explained that customers were given a consultation which covered the pros and cons of the different methods, including the LA Weave method. A decision was then made about the appropriate method for the customer and a copy of the consultation report was provided to the customer. The original was retained by the business. Consequently, Ms Harrison said that the customers from her salon leave “*knowing that they have been told about bond rings, rings, nano rings, the plaited weave and the LA weave*”. Ms Harrison said that hair extensions had become much more popular since she first became involved in this side of her business in 1997, and some customers ask for their preferred fitting method by name. Finally, she confirmed that her witness statement had been drafted by Ms Cooper following telephone conversations about these proceedings.

14. Ms Harrison appeared to be an honest and helpful witness. However, I am troubled by the fact that she did not disclose her commercial relationship with opponent in her written statement. In her enthusiasm to be helpful, Ms Harrison’s answers tended to be rather long and sometimes lacked precision and clarity. I

¹ See exhibits BR5 – BR8.

accept her evidence that she first heard of LA Weave in 2008 whilst in the USA. I am less convinced about her claim to have used it ever since. This is not supported by the information from her business's website and social media pages that the applicant has provided in evidence. Further, I note that despite her explanation that LA Weave is explained to clients as part of a consultation process, and that records are kept of such reports, none have been provided in evidence showing that LA Weave was discussed with clients as a fitting option. I accept that Ms Harrison may have made some informal use of LA Weave with her clients, but the weight of the evidence points towards the conclusion that she has not used it as the generic name of a fitting method, such as micro bond.

Nicola Purcell

15. Ms Purcell is the General Manager of Paul's Hair World Ltd. She provided a short witness statement in support of the opposition in which these points were made:

- Ms Purcell has worked in the hair extensions business since 2001;
- She first heard of an LA Weave method of applying hair extensions in 2010;
- Her business has used the term since November 2010 for a method of applying hair extensions;
- Ms Purcell was not trained by the applicant or by his business;
- She had spoken to "*a number of the clients of Pauls Hair World Ltd*" who have extensions using the LA Weave application method and none of them had heard of the applicant or his business.

16. Mr Kyle Martin responded to this evidence in his first witness statement. He challenged the truth of Ms Purcell's claim that her business had used the term for a method for applying hair extensions since November 2010. He suggested that Paul's Hair World became interested in using LA Weave after an employee called Abigail Turner attended a training course provided by his business. This point was further elaborated in a witness statement by Kathy Gill, who works for Mr Martin's business as a senior trainer. Ms Gill explained that she held a training course in Manchester in February 2013 attended by Ms Turner. Although Ms Turner was being taught other methods for fitting hair extensions, another person on the same course was being taught LA Weave². According to Ms Gill, Ms Turner became very interested in this method and asked lots of questions about it. Ms Gill believes that she took the

² A copy of the resulting diploma is in evidence as exhibit KG4. This shows that a Victoria Mather was trained in 'KM Micro Ring Weft & LA Weave'. The certificate is dated 1st March 2013.

answers back to Pauls Hair World and this was the beginning of their interest in using LA Weave.

17. Mr Martin filed a second witness statement dated 5th April 2016 which again challenged the truth of Ms Purcell's claim that Paul's Hair World had been using LA Weave since 2013. This evidence consists mainly of copies of posts on Facebook³ which Mr Martin claims show that until August 2013 Paul's Hair World was only a supplier of hair extensions. It was only from this date that it started to offer hair extension fittings in its own salons. To support this point, Mr Martin provided copies of Facebook posts by Paul's Hair World from November 2013, which refer to LA Weave as "*the newest way of fitting hair extensions*"⁴.

18. In cross examination, Ms Purcell was asked when she first heard of LA Weave. Her answer was "*around 2010*" when customers started "*asking about the method, requesting the method, or buying hair to have that method fitted asking for hair extensions for application by the LA Weave method*". She was unsure whether these customers were members of the public, hairdressers, or other shops to whom Paul's Hair World sells hair extensions.

19. Ms Purcell confirmed that the name LA Weave is not used by Pauls Hair World in relation to hair extensions as goods. She said that Pauls Hair World provides a hair extension fitting service and uses LA Weave on price lists for this service at its three salons. Also, since the company opened its new store at the Manchester Arndale Centre, the name has been used on social media to advertise the service. The company currently has 12 stylists who provide fitting services under the name LA weave (as well as the names of other fitting methods). Her staff were trained in LA weave by Beauty Works (which is a trading name of the opponent) or, prior to that, by Connect-2-Hair. Ms Purcell said that she was trained in LA weave by Beauty Works about 18 months ago (i.e. late 2014). However, this was mainly so she understood what her staff were doing. She does not herself provide fitting services for hair extensions. Asked about her witness statement, Ms Purcell said that she had written it herself.

20. Ms Purcell was asked about a post by Pauls Hair World's on Facebook in November 2013, which described LA weave as the "*newest way of fitting hair extensions*". This implied that it was something new to Pauls Hair World. Ms Purcell sought to diminish the potential significance of this post by suggesting that "*newest*" meant 'most popular'. With further thought she suggested that it might mean 'relatively new' by comparison with other methods of fitting hair extensions. However, in re-examination it became apparent that Ms Purcell had not written the post, and she not know who did.

³ See exhibit KM-R1

⁴ See exhibit KM-R2

21. Ms Purcell was clearly out to support the opposition. Her quickness to suggest possible explanations for the Facebook post by her company in 2013, that LA Weave was as the “*newest way of fitting hair extensions*”, was plainly intended to counter the obvious inference that Pauls Hair World regarded LA weave as new in 2013. However, the explanations she offered (particularly the first one) were not persuasive, or it transpired, based on her own knowledge. Further, given the similarity between the wording of her witness statement and those of Ms Harrison and Mr Wilkinson, all of which were drawn up around the same time, I do not believe that Ms Purcell literally wrote her own statement. Nothing much turns on this provided that the information in the statement came from Ms Purcell and she believed it to be true. However, it was another example of Ms Purcell giving what she thought would be the ‘right’ answer from the opponent’s perspective. I do not therefore consider Ms Purcell to be a reasonably objective witness. Apart from her evidence that customers used LA weave in communications to Pauls Hair World from “*around 2010*”, Ms Purcell provided no specific evidence of any use of LA weave by Pauls Hair World in relation to a fitting service for hair extensions from November 2010 (as claimed in her written evidence). Consequently, on the basis of Mr Purcell’s evidence I cannot find any such use prior to November 2013.

Daniel Wilkinson

22. Mr Wilkinson is the Director of Sallys Glitz and Glam Ltd, which fits hair extensions. He provided a short witness statement in support of the opposition in which these points are made:

- Mr Wilkinson has worked in the hair extensions business since 1995;
- He first heard of an LA Weave method of applying hair extensions in 2008;
- His business has used the term for a method for applying hair extensions since 2009;
- Mr Wilkinson was not trained by the applicant or by his business;
- He had spoken to “*a number of the clients of Sally’s Glitz and Glam*” who have extensions using the LA Weave application method and none of them had heard of the applicant or his business.

23. Ms Robinson also did some research into the website used by Mr Wilkinson’s business, including using the Wayback machine to review pages on 23 different

dates going back to March 2010⁵. She also reviewed the business's Facebook and Twitter accounts⁶. Ms Robinson says that the business appears to be a retailer of hair pieces. She found no references to hair extension fitting services and no mention of LA Weave. Ms Robinson notes that Sallys Glitz and Glam is listed in Mr Williams's first witness statement as having had 4 trainees trained in LA Weave by Beauty Works (the opponent) in March 2015⁷, i.e. after the relevant date.

24. In cross examination, Mr Wilkinson explained that he did not fit hair extensions himself, but had three staff who did so. Apart from one staff member who trained in London (Mr Wilkinson could not recall who trained her) the staff that joined "*more recently*" were trained by Beauty Works (the opponent). Mr Wilkinson said that every new client gets a consultation about the methods available and which is best suited for them. A report of each such consultation is retained. His shop fits hair extensions using the LA weave method. Mr Wilkinson said that he first heard about the method in 2008/2009 when customers started coming in to the shop and asking about it. Mr Wilkinson said that the demand for his business's services was such that he did not advertise, except on social media. Like Ms Harrison, he said that he had provided the information in the witness statement, but had not written it himself.

25. I accept Mr Wilkinson's evidence that he first heard about LA Weave when customers started coming into his shop asking him about it. However, I am not convinced that Mr Wilkinson could say with any accuracy that this was in 2008/9. The documentary evidence suggests that Sallys Glitz and Glam did not offer hair extension fitting services under the name LA Weave (or at all) prior to the relevant date. Further, I note that despite Mr Wilkinson's evidence that copies of consultation reports are retained and that these cover the fitting methods discussed with clients, no such records have been filed as evidence. I do not therefore accept Mr Wilkinson's evidence that his business offered hair extensions by reference to the name LA Weave from 2009.

Zara Qayyum

26. Ms Qayyum filed a witness statement which included the following points:

- She was trained in hairdressing in 2008 at a hair loss clinic called Hair Solved;
- Ms Qayyum was trained in the LA Weave method in 2010 by Maria Masip of Hair Solved;

⁵ See exhibit BR2

⁶ See exhibit BR3

⁷ See exhibit MW2

- Between 2010 and June 2014, when Ms Qayyum joined the opponent's business, she estimates that she provided 50 clients with hair extensions using the LA Weave method;
- During this period, the Hair Solved salon provided more than 100 clients with hair extensions using the LA Weave method;
- Between 23rd June 2014 and 29th September 2014, the opponent (under its trading name of Beauty Works) provided 21 training courses to 102 people, all of whom were trained in LA Weave⁸.
- In August 2014, the opponent applied to the Hair and Beauty Salon Authority for approval for a course called 'pre-bonding/wefting' which included training in the LA Weave method.

27. The applicant filed evidence in reply to Ms Quayyum's written evidence, which included internet research by Ms Robinson into, inter alia, Beauty Works provision of hair extension training services and its use of LA Weave. Essentially, Ms Robinson's searches of historical pages from Beauty Works website using the Wayback Machine, and of its Facebook account pages, revealed no use of LA weave, and only one training course in wefting and pre-bonded methods prior to the relevant date.

28. In cross examination, Ms Qayyum said that she first heard the name LA weave from an American client who told her that that was the name used in New Jersey for the fitting method she was using. Asked about her own use of LA Weave, Ms Qayyum said she used it when teaching because it was widely known and this made it easier for her trainees to sell their services. However, she did not use it for her own marketing purposes. This was because she preferred to decide what method was best for her clients. Like the opponent's other witnesses, Ms Qayyum described a consultation process for selecting the most appropriate fitting method for each client, and confirmed that records are kept of such consultations. Ms Qayyum said that she was the sole trainer for Beauty Works. The training she provides on its behalf includes training on the appropriate consultation process and use of consultation cards. Ms Qayyum's evidence is that she teaches five different fitting methods: pre-bonded flat tips, micro ring stick tips, the LA weave, the micro ring weft and the braided weft. Asked why the application made to the Hair and Beauty Salon Authority in 2014 only mentioned pre-bonded and wefting, Ms Qayyum said that wefting included several methods involving the application of wefts of hair, including the LA Weave method.

⁸ See exhibit ZQ3

29. Ms Qayyum was also asked about the contents of some emails she exhibited to her statement about a training course she held in Glasgow in June 2014⁹. In essence, the question was why exhibit ZQ3 to her statement showed that all eight people who attended the course had been trained in LA Weave when the associated emails suggested that the method had been dropped from the course. Ms Qayyum's response was that there had been some discussion about dropping LA Weave, but in the end she taught all five of her methods during the day. Ms Qayyum explained that there were regional preferences for different types of hair extensions. In the more affluent South, more expensive fitting methods, such as pre-bonded and complete micro rings, were popular. Less expensive methods, such as weaves, were more popular in the Midlands, the North of England and North Wales. The 'wefted' course was most popular in Scotland.

30. I found Ms Qayyum to be an honest and helpful witness. She was candid about her own use of LA Weave, volunteering that she only used the term when training others. This means that she would not have used it in trade prior to joining the opponent's business as a trainer in June 2014. I accept her evidence that LA Weave had been known to her for some years before that as the name of a method of fitting hair extensions. I also accept that she taught a fitting method under this name at the Beauty Works training course held in Glasgow in June 2014. I am less confident about the accuracy of her evidence as to the number of people she says she trained in LA Weave on this date, and generally between June and September 2014. I note that the email exchanges preceding the course on 24th June indicate that only 5 attendees were expected, whereas 8 are shown in the exhibit to Ms Qayyum's statement. However, I am satisfied that this was an error rather than an attempt to mislead or exaggerate. After all, if it was a deliberate exaggeration one would hardly exhibit email evidence that undermined the number claimed. The content of these emails support Ms Qayyum's evidence that LA Weave was amongst the courses being offered by the opponent during this period.

Martin Williams

31. Mr Williams has been the Operations Manager of the opponent since 2010. As I have already noted, the opponent trades as Beauty Works. Its main business is selling hair extensions, but it also provides training in fitting such extensions. Mr Williams' written evidence was that the opponent has been involved in such training since 2010¹⁰. He says that the opponent has provided training in the LA Weave method since June 2014¹¹. He exhibited undated extracts from his company's Wefting Training Manual, a Lesson Plan for Luxury Hair and a Scheme of Work (for trainers), all of which show use of LA Weave as the name of a method for applying

⁹ See exhibit ZQ4 and 5

¹⁰ Williams 2, paragraph 5.

¹¹ Williams 1, paragraph 3.

hair extensions¹². Mr Williams also provided a list of the venues at which his company provided training in the LA Weave fitting method prior to (and after) the relevant date¹³. Some of these locations include the names of hairdressing salons.

32. Mr Williams' written evidence also included copies of pages of search results obtained from using the advanced search facility on Twitter¹⁴. This shows that there were about 20 results for 'laweave' dated between 2009 and 2012. All the posts appear to be from individuals. None are obviously related to the applicant. It is not clear whether any of the people are based in the UK. Some are obviously based in the USA. Most appear to be from the Afro-Caribbean ethnic group, which Mr Williams says supports his view that LA weave came from the *"Afro-Caribbean side of the hairdressing industry"*.

33. Mr Williams did a further search on Instagram which returned about 50 results showing use of LAweave prior to the relevant date¹⁵. I note that a number of these are multiple posts by the same people. A few are obviously from the UK because they reference UK locations. All refer to 'LAweave' or 'laweave'. The context appears to be as a method of applying hair extension. Most of the posts are from people offering hair extensions. I note that two of the posts are by Pauls Hair World, the earliest of which is dated 25th February 2014. The nature of social media posts makes it difficult to contextualise these posts any further. Mr Williams provided further posts from social media in his second witness statement. One of these shows that a few hairdressers posted tweets on Twitter in June and July 2014 after attending training courses on LA Weave run by Beauty Works¹⁶. Another shows that Pauls Hair World posted tweets on social media between October and December 2013 which stated that LA Weave was available at its Manchester Weave Bar and Liverpool salon¹⁷. Mr Williams also provided historical pages from Pauls Hair World's website obtained using the WaybackMachine. These show that in August/September 2014 Pauls Hair World advertised its hair extension fitting services, including LA Weaves.

34. Mr Williams also provided a print of an entry on YouTube posted in March 2012. This shows that 'Topdesigners Ashton' offered to fit hair extensions using LA weave/beaded weave¹⁸. I note that prices for the service are expressed in pounds, indicating that this advertisement was targeted at a UK audience.

¹² See MW1

¹³ See MW2

¹⁴ See MW6

¹⁵ See MW6

¹⁶ See MW – R7. More evidence of a similar kind is exhibited as MW – R9

¹⁷ See MW – R15

¹⁸ See MW8

35. Ms Robinson also did some research into Mr Williams' evidence. She examined the websites and social media pages of 7 of the hairdressing businesses at which Mr Williams claims that Beauty Works provided training in LA weave prior to the relevant date. Four of the businesses had no website, or it was under construction at the time of her search. Ms Robinson could not find any reference to LA weave on the websites of the others, or on any of the businesses' Facebook pages. Ms Robinson also did some internet research into the website of Top Designers Ashton using the Wayback Machine. She found no reference to LA Weave prior to September 2014 when the website featured a relevant article referring to "*this new so-called LA Weave*"¹⁹.

36. In cross examination, Mr Williams' evidence was that he had first heard of LA weave in 2010 when his company started trading. He and his staff visited around 100 hair salons and shops in the first 6 months, including Pauls Hair World, and this is how he came across LA Weave. Mr Williams said that the business of fitting hair extensions had grown significantly over the previous 5 years. Prior to that it was a back street business, but now it had become mainstream. He said that there are now 35k registered salons as well as many more independent hairdressers providing fitting services. He estimated that there were probably 100k businesses in the UK fitting hair extensions. Asked to explain the LA Weave fitting method, Mr Williams said that he was not a fitting specialist, but he understood that it was effectively a micro ring weft. LA Weave was a nickname the industry used for this fitting method. Asked what he used LA Weave for, Mr Williams' evidence was:

"We use it most days in conversation over the phone, in the salons talking to people about it."

And

"It is part of our training manual, it is part of the promotion of the training, so we use it for the application. We also promote the fact that our products can be applied using the LA Weave method."

37. Mr Williams appeared to be an open and straightforward witness. I accept his evidence that the opponent has been providing training services in an LA Weave method since June 2014 and that he had heard about LA Weave for some time before that. Although he may think that this was as early as 2010, I was not persuaded by his reason for recalling when he first heard of it. He was not able to say where, or from whom, or how it had come up. He did mention Pauls Hair World, but the evidence indicates that Pauls Hair World did not start using the name LA Weave until November 2013. I therefore find that this aspect of his evidence is not reliable. I also accept his evidence that he and others regard LA Weave as a nickname for fitting method also known by another name or names.

¹⁹ See BR24

Kyle Martin

38. Mr Martin's written evidence is that that he has worked in the hairdressing industry providing training services for fitting hair extensions under the name KM Hair Extension Training for around 10 years. He provides training courses independently of any product supplier and covers a variety of different application methods. Due to demand, he started to offer training in the Sew-in-Weft method in 2011. This method had always been popular in the Afro-Caribbean market for hair extensions because it suited those with a hair structure typical of Afro-Caribbean people. Mr Martin explained that a Micro Ring Weft is a process that combines wefts of hair and micro rings. The combination allows hair to be fixed to the head more quickly (compared to attaching individual hairs to the micro rings). Thus it is cheaper and quicker, but does not last as long as the conventional Micro Ring system. Mr Martin said that in 2011 he developed a new method of attaching hair extensions, which also used micro rings and wefts, but lasted longer. He later called this method LA Weave and in "late 2011" started using this as a trade mark. He sold his first training course under the name in January 2012.

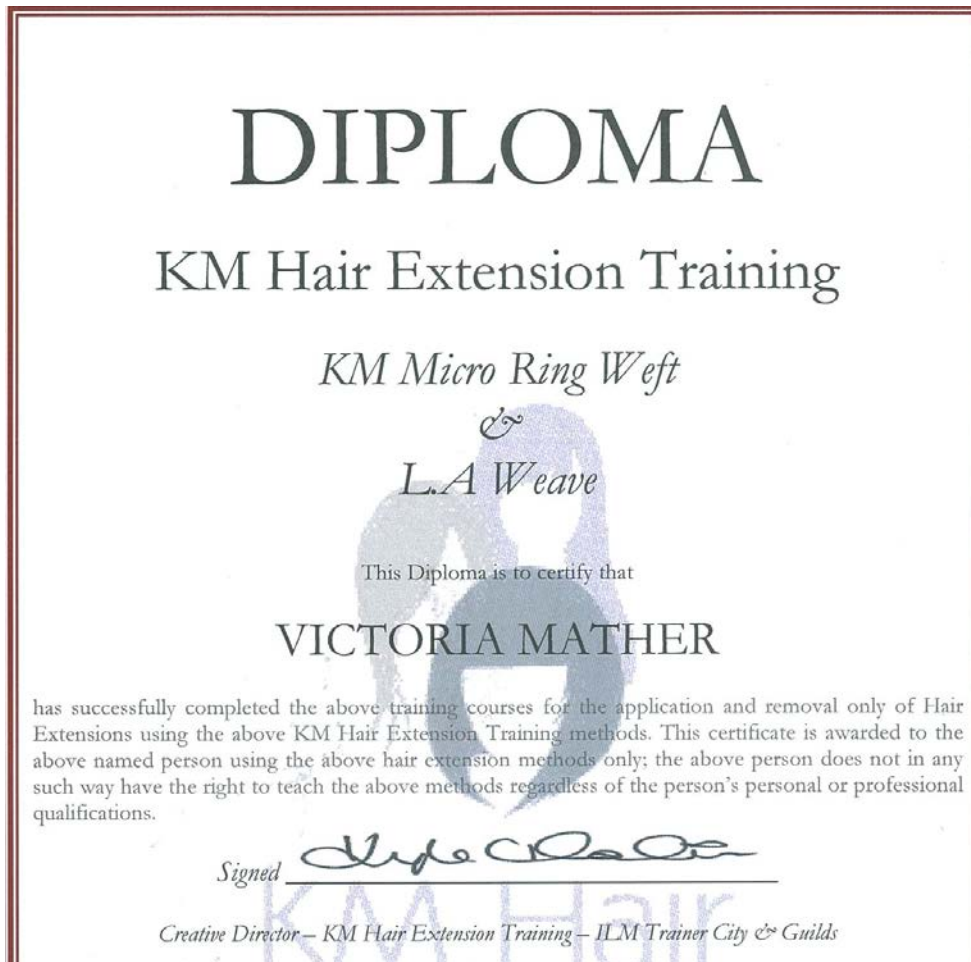
39. Mr Martin said that some of his competitors have since copied "*elements*" of his method, but their versions of the method do not stay in half as long as his. According to him, Micro Sew-In has become the generic name for a method which has "*broad similarities*" to LA Weave.

40. Mr Martin claimed that he had advertised his training services via social media and his three websites, kmhairextensiontraining.co.uk, kmhairextensiontraining.com and laweave.co.uk. The latter site was purchased on 3rd October 2013 and is used by people trained by Mr Martin's business in order to purchase products and supplies. Examples of pages from the websites are in evidence²⁰. One is shown below.



²⁰ As KM5 and KM8

41. I note that KM Hair Extension Training is used on the websites to identify Mr Martin's business. LA Weave, or The LA Weave, appears to be used to distinguish one of the methods taught. This is reflected in the diplomas issued to students who have passed the training²¹. An example, is shown below.



42. Mr Martin says that he advertises on Facebook and he provides some examples from 2013/14²².

43. Mr Martin's written evidence is that he spent about £2k promoting his business's services in 2012, around £5k in 2013 and around £7k in 2014. This included the cost of optimising his website. Sales generated by LA Weave amounted to £8k in 2012, £11k in 2013 and £25k in 2014. Mr Martin provided the names of those he has trained in LA Weave²³. There appear to have been 40 trainees in 2012, 55 in 2013 and 129 in 2014. Eight invoices dated between 2012 and 2015 are exhibited in respect of these training services²⁴. These are on KM Training Services notepaper.

²¹ See KM7

²² See KM11

²³ See KM6

²⁴ See KM14

LA Weave is listed under the heading 'description', sometimes alongside other recognised fitting methods, such as 'Pre-bonded'.

44. Mr Martin said that he only permitted people who had completed his training course to use LA Weave by way of a licence. He claimed that such a person is known in the industry as an "*LA WEAVE Authorised Technician*". According to him, the public want to know that their LA Weave hair extensions are fitted by a genuine LA Weave technician. To illustrate this point, he provided a copy of an email sent to the laweave.co.uk website in September 2015 by someone called 'Mags', which asked if there was an official list of stylists in Nottingham. This was because she wanted to avoid 'fakes'. Mr Martin's evidence is that there are more than 20 providers of hair extension training services in the UK. He provided the names of 20 along with copies of pages from their websites²⁵. None advertised training in LA Weave at the time of his search in 2015. I note that many of the providers offered 'micro ring wefts' and some offered 'sew-in wefts'. None are listed as offering 'micro sew-in' extensions (which Mr Martin claims is the generic name for the closest method to his LA Weave method).

45. In cross examination, Mr Martin said that he had never been to California and thought of the name LA Weave in October 2011 whilst in Spain. Asked why he chose the name, he said that it was because it was "*glamorous*" and "*red carpet*". However, he denied that this was because LA was short for Los Angeles.

46. Mr Martin said that when he started training people in LA Weave in 2012 he did most of the training, although a colleague called Kathy Gill did some. By the relevant date in October 2014, three people in his business were training in LA Weave. Mr Martin's said that some of his trainees were hairdressers whilst others were people looking to get into the hairdressing business. He accepted that the number of training courses held in 2012 and 2013 would not have been large given that only 95 people were trained during this period and up to 13 trainees could be trained at one time.

47. Ms Cooper put it to Mr Martin that his written evidence about his trainees being 'licensed' to use his trade mark as 'authorised LA Weave technicians' was not supported by any of the documents he had put in evidence. Ms Cooper pointed out to him that the only restriction shown in any of the documents he had put in was the trainees were not entitled to train others in LA Weave. Mr Martin suggested that the requirement to identify his business as the source of the LA Weave method, and to observe licence-type controls, was expressed in his terms and conditions, which were updated regularly. When challenged as to why he had not provided the relevant document, he asserted that the licence was a matter for him and his students.

²⁵ See KM17

48. Asked how he ensured that “*consumers are made aware that my licensees have been trained by me*” (as claimed in his written evidence), Mr Martin accepted that there was not much he could do, other than following what his trainees did and getting them to sign the licence in the first place. He accepted that he did not initially check where the people he had trained were working (so as to be able to monitor unlicensed use by salons). However, he started keeping such records in 2014.

49. Asked about the use of LA Weave in relation to the goods covered by class 26 of his trade mark application, Mr Martin said that he provided a training kit which included hair extensions, clips, and bands, an example of which was shown in a photograph in his evidence²⁶.

50. Mr Martin was plainly passionate in his belief that he created the method he called LA Weave and was entitled to the benefits of its commercialisation under that name. He accepted that he could not object to others using different names for the method, such as Celebrity Weave. Mr Martin was extremely concerned to avoid saying anything which he thought might damage his case. This made him very defensive. I did not find some of his evidence convincing. In particular, I do not believe his evidence that his choice of the name LA Weave had nothing to do with Los Angeles, particularly given his evidence that he wanted a name associated with glamour and ‘red carpet’, which sounds very much like the public image conveyed by Los Angeles with its reputation for celebrity, Hollywood and red carpet film ceremonies, such as the Oscars. He may have denied that this was an intentional association because he feared that it would lend support to the suggestion in the opponent’s evidence that he adopted the name from one already in use in the USA, or he may have been trying to avoid conceding that the name had any sort of geographical meaning because he thought that this alone could potentially affect the validity of his mark. Either way, his denial of the obvious left me with doubts about the truthfulness of the rest of his evidence.

51. Mr Martin’s position on the licences under which his students supposedly operated showed that he was also willing to invent facts. He was relying on the terms of these licences in order to show that the public associated LA weave with him and his business. In these circumstances, denying the relevance of the licence documents to these proceedings was silly. The applicant’s representative, Ms Burchell, later told me that the licences were oral and therefore no such document exists. I had already come to that conclusion after listening to Mr Martin’s evidence. Trying to maintain the fiction of written licences did not help Mr Martin’s case.

²⁶ See exhibit KM2

Other written evidence

52. Gemma Craven is the owner of The Hair Shop in Colwyn Bay, North Wales. She provided a short witness statement in support of the opposition in which these points are made:

- Ms Craven has worked in the hair extensions business since 2004;
- She first heard of an LA Weave method of applying hair extensions in 2008;
- Her business has used the term for a method for applying hair extensions since 2008;
- Ms Craven was not trained by the applicant or by his business;
- She had spoken to “*a number of the clients of The Hair Shop*” who have extensions using the LA Weave application method and none of them had heard of the applicant or his business. These clients all became aware of LA Weave through her business.

53. Ms Robinson did some research in 2015 on the website of The Hair Shop. This showed that the business offers hair extensions, including ‘weaves’ and ‘micro weft’, but that no claim is made to provide LA Weave extensions.

54. I don’t think that Ms Robinson’s evidence *per se* undermines Ms Craven’s evidence. However, given Ms Craven’s failure to attend the hearing for cross examination, I do not intend to attach much weight to her evidence.

55. The same goes for the evidence of Abigail Turner who manages the Liverpool branch of Pauls Hair World. Ms Turner’s written evidence was that “*LA Weave has always been big in Liverpool*” and that Pauls Hair World and two other salons in Liverpool had provided LA weaves “*over time*” and/or “*for years*”. These are vague claims which could have been explored in cross examination, if Ms Turner had attended the hearing.

56. Mr Williams second witness statement included a copy of a signed witness statement by Ms Beau-Bradley. Since 2002, she has run a business called Connect-2-Hair which provides training in hair extensions. According to Ms Beau-Bradley, her business has been training people in LA weave since then. However, apart from providing an example of a backdated diploma²⁷, the only documentary evidence of such use is contained in the results from a search conducted by Mr Williams in 2015

²⁷ In respect of which I have taken account of the points made by Carin Burchell in her witness statement of 25th November 2015

on the website salongeek.com²⁸. Salongeek is a website dedicated to hairdressing professionals. It was registered in 2006. Mr Williams search revealed over 20 examples of posts by Connect-2-Hair on this site offering training in LA Weave. These are mostly dated (before the relevant date) in 2014, but a few are from 2013.

57. Mr Martin challenged the veracity of this evidence in his written evidence. He noted that it was possible to amend details of an event on the salongeek website or create an event for a date already past. In this connection I note that the Ms Burchell provided a witness statement indicating that the opponent had provided it with copies of diplomas supposedly awarded to students in “*Micro Sew-in (aka LA Weave)*” dated in 2007 and 2008. The applicant challenged the veracity of these documents after discovering that the students named in the diplomas appeared to be related to, or share an address with, Ms Beau-Bradley²⁹. These diplomas were not filed in any of the opponent’s evidence. This clearly added to the applicant’s concern that other evidence relating to Ms Beau-Bradley’s supposed use of LA Weave may have been manipulated to show artificially early dates. However, the opponent’s trade mark attorney, Ms Cooper, subsequently re-ran the search on the salongeek site and found 24 relevant entries dated prior to the relevant date, and a further 15 such entries dated after the relevant date³⁰.

58. As I indicated earlier, the opponent opted to have Ms Beau-Bradley’s statement treated as hearsay evidence from Mr Williams. Consequently, the applicant could not cross examine Ms Beau-Bradley on her evidence. I take this into account in deciding what weight to give it. I find that the dates of the posts on salongeek give some support to the claim that Connect-2-Hair was offering training in LA weaves from the latter part of 2013, which fits with Ms Purcell’s evidence that Pauls Hair World used Connect-2-Hair for training in LA weave before it used the opponent’s services. The extent and nature of such use is not clear. In particular, the evidence does not establish that Connect-2-Hair used LA Weave prior to the latter part of 2013.

59. Kathy Gill is one of Mr Martin’s trainers. She filed a witness statement in which she explains that in August 2011 he showed her a new method of fitting hair extensions. Ms Gill had seen other ways of applying micro rings, thread and sewing them together, but not in the same way. Ms Gill says that (by November 2015) she had trained “*hundreds of students*” using the trade mark LA Weave. She says the name catches people’s attention more than ‘micro ring weft hair extensions’ or ‘sew in weft hair extensions’, which I assume she considers to be similar methods. Ms Gill says she is constantly asked “*what is LA Weave?*” by students, including those who have been in the business for years. Therefore she says it is not a generic name.

²⁸ See MW10

²⁹ See footnote 27 above

³⁰ See witness statement of Sally Cooper and exhibit SC6

60. Ms Gill was not cross examined on her evidence, and I therefore accept the evidence set out above.

61. Just before the substantive hearing of the case, Mr Martin filed a third witness statement in which he said that he had discovered a method through which it was possible for third parties to edit Twitter posts. He noted that the result of editing the posts was that the date of post moved back in time by one day. In this connection, he provided³¹ copies of pages he downloaded from Twitter with some of the same posts included³² in Mr Williams' second witness statement. This showed that 6 of the 13 posts at issue (all of which mentioned LA Weave) had a date in 2009 to 2011 that was one day earlier than that shown in Mr Williams' evidence. The clear inference was that Mr Williams' Twitter based evidence had been manipulated.

62. The following day, Ms Cooper filed a second witness statement in which she said that she had conducted the search and obtained the results filed as part of Mr Williams's evidence, and she had no idea how to manipulate data on Twitter. Ms Cooper exhibited the results of a further search on Twitter which revealed some (but not all) of the same hits as her first search. Three of the results that came up in her first search came up again in her later search with the same posting date, i.e. one day later than the dates shown in Mr Martin's search.

63. At the hearing, Ms Burchell did not rely on Mr Martin's evidence as proof that the opponent's evidence from Twitter had been doctored. Rather, she submitted that it was unreliable because it appeared that anyone with the necessary knowledge could manipulate it.

64. I note this concern. However, as none of the posts in question appear to originate from people in the UK (or at least it cannot be seen that they do), I do not think that the accuracy of this Twitter evidence matters. Consequently, I need say no more about it.

Findings of fact

65. I am satisfied on the evidence, particularly that of Ms Harrison and Ms Quayyum, that the term LA Weave was in use in the USA, and known to some hairdressers and hair extension users in the UK, prior to August 2011 when Mr Martin says that he coined the name. For the reasons given below, whether he adopted the name from the USA, or came up with the same name by coincidence is not of decisive importance to the outcome of this case. Therefore, I prefer to leave that matter open. I find that LA Weave was little known in the UK prior to the applicant's adoption and use of that name.

³¹ See exhibit KM2-R1

³² As MW – R2 and MW – R3

66. I find that LA Weave was used by Pauls Hair World from November 2013 onwards as the name of a method of applying hair extensions. The name was used to promote the fitting service and to encourage the sale of appropriate hair extensions. The extent of such use prior to the relevant date is not clear, but it appears to have been local to Manchester and Liverpool and relatively limited in scale.

67. I find that Connect-2-Hair used LA Weave in relation to training services as the name, or as an alternative name, of a method of fitting hair extensions. This use appears to have started in the latter part of 2013. The extent and nature of such use is not clear. However, it seems likely that there was limited promotion of such services under the name LA Weave.

68. I find that the opponent also provided hair extension training services from June 2014 during which the name LA Weave was used as the name of one of the methods being taught. There is no persuasive evidence that the training services were publicly promoted under the name LA Weave. The extent of these training services prior to the relevant date was also limited. On the basis of the discrepancies in Ms Qayyum's evidence, I find that the opponent trained fewer than the 102 trainees it claims.

69. I find that Mr Martin created a variation of the micro ring weft method in 2011, which he later called LA Weave.

70. I find that, from 2012 to the relevant date in 2014, Mr Martin used LA Weave as the name of a method for fitting hair extensions. There is nothing in the evidence which indicates that he used it as a trade mark.

71. I find any use of LA Weave by the hairdressers trained by Mr Martin or his business, prior to the relevant date, in the course of providing hair extension fitting services, was not licensed or controlled by him or his business. I further find that the people who received hair extensions fitted from Mr Martin's trainees using the LA Weave method, had no reason to believe that the service, or the hair product, had anything to do with Mr Martin or his business.

72. I find that, apart from a small number of posts on Instagram, there is no persuasive evidence of the use of LA Weave by UK based hairdressers, or UK based users of hair extensions, prior to the relevant date.

The Law

73. Section 3(1) of the Act is as follows:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

Section 3(1)(c)

74. It is convenient to start with the s.3(1)(c) ground of opposition. The opponent pleaded case is that LA Weave is a sign that may serve, in trade, to designate the geographical origin of the goods and services listed in the application.

75. In its judgment in *Windurfing Chiemsee*³³ the European Court of Justice (“CJEU”) stated that:

“25. Article 3(1)(c) of the Directive pursues an aim which is in the public interest, namely that descriptive signs or indications relating to the categories of goods or services in respect of which registration is applied for may be freely used by all, including as collective marks or as part of complex or graphic marks. Article 3(1)(c) therefore prevents such signs and indications from being reserved to one undertaking alone because they have been registered as trade marks.

26. As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

³³ Joined cases C-108 & 109/97

27 –

28 -

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to ‘...indications which may serve ... to designate ... geographical origin’, that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location — or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.”

76. Although there is evidence of LA being used in trade marks for hairdressing and hair extension services, there is no evidence that LA (or Los Angeles) is used as a designation of the geographical origin of such services, or of hair pieces.

77. As to whether such an association may become established in the future, I note the following points:

- LA is commonly used, and widely understood by the UK public, as a shortened form of the place name 'Los Angeles';
- Los Angeles is very familiar to the UK public as the name of a large US city with a particular reputation for films, celebrities, show business, beaches and theme parks;
- Although the opponent's witnesses suggested that LA Weave is associated with California, or the USA generally, none of them gave evidence of hair extensions, or hair extension fitting services, being offered in the UK which originated from the geographical location of Los Angeles;
- On the evidence, 'weave' is a method of fitting hair extensions (or perhaps a group of such methods), but not a type of hair extension.

78. As to the services covered by the application, I see no reason to believe that Los Angeles will become associated in the future with hair extension fitting services in a way that LA could come to designate the geographical origin of such services. In particular, it seems farfetched to imagine service providers travelling from LA to the UK to provide such services, or the UK public travelling to LA for the service.

79. As to the goods in class 26, I see no reason to believe that Los Angeles will become associated with hair, hair pieces, hair extensions, hair ornaments, articles for the hair, elasticated hair bands, hair-bands, hair curlers, hair clips, or rollers in a way that LA could come to designate the geographical origin of such goods. 'Weave' is obviously not descriptive of the geographical origin of hair ornaments, bands, curlers etc. Further, although 'weave' appears to designate a method of fitting hair extensions, it is not a name for the goods themselves. On the contrary, hair and hair extensions would be called 'hair pieces' or 'wefts'. Therefore, even if I am wrong about LA being capable of designating the geographical origin of such goods, 'LA Weave' (as a whole) would still not be a suitable designation of the geographical origin of the goods.

80. I acknowledge Mr Williams' evidence that LA Weave could be used to designate a type of hair piece suitable for application by the LA Weave method³⁴. However, whether this is correct or not is irrelevant for current purposes because this is not the opponent's pleaded case under s.3(1)(c).

81. I do not accept that LA Weave could be used to designate the French origin of the goods and services. Firstly, I do not accept that the letters LA will be seen as the

³⁴ This could, in principle, permit honest descriptive use of the term by third parties under s.11(2)(c) of the Act.

French word 'La' in the context of the applicant's mark. Secondly, even if they were, the proposition that 'La' is a designation of geographical origin is manifestly absurd.

82. For these reasons, I reject the ground of opposition under s.3(1)(c).

Section 3(1)(d)

83. This ground is at the heart of the opponent's case.

84. In *Telefon & Buch Verlagsgesellschaft GmbH v OHIM*³⁵ the General Court summarised the case law of the Court of Justice under the equivalent of s.3(1)(d) of the Act as follows:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959, paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma (BSS)* [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public's perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).

51. Furthermore, although there is a clear overlap between the scope of Article 7(1)(c) and Article 7(1)(d) of Regulation No 40/94, marks covered by Article 7(1)(d) are excluded from registration not on the basis that they are descriptive, but on the basis of current usage in trade sectors covering trade in the goods or services for which the marks are sought to be registered (see, by analogy, *Merz & Krell*, paragraph 35, and *BSS*, paragraph 39).

52. Finally, signs or indications constituting a trade mark which have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services covered by that mark are not capable of distinguishing the goods or services of one undertaking from those of other undertakings and do not therefore fulfil the essential function of a trade mark (see, by analogy, *Merz & Krell*, paragraph 37, and *BSS*, paragraph 40).”

³⁵ Case T-322/03

85. The relevant question is therefore whether the mark had ‘become customary in the current language or in the *bona fide* and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought’. That question must be answered taking account of the expectations of average consumers of the goods/services at issue.

86. Pausing here, I note that the origin or authorship of the term at issue is not of decisive importance to the answer to the relevant question, although conceivably it could have some effect on the expectations of relevant average consumers (assuming that they would know where or from whom the term originated).

87. The ‘target public’ for the goods covered by class 26 of the application plainly includes both hairdressers and members of the public being the end users of the goods. Therefore, the perception of average consumers in both groups counts.

88. I asked Ms Burchell who is the target public for the training services covered by the application. She initially submitted that the target public for these services were hairdressers and others in the market for training on fitting hair extensions. However, after I pointed out to her that Mr Martin appeared to rely on his reputation amongst those consumers receiving hair extensions, I think Ms Burchell was disposed to accept that they might also be included within the relevant (“target”) public.

89. In this connection, I note that in *Stash Ltd v Samurai Sportswear Ltd*³⁶, Professor Annand, as the Appointed Person, accepted that it was sufficient if a mark offended either limb of s.3(1)(d). That is to say that (at the relevant date) the mark had become customary (a) “*in the current language*”, or b) “*in the bona fide and established practices of the trade*”. In the current case, the first limb appears to include consumers of hair extension fitting services, whilst the second limb seems more limited to those giving and receiving training in such services. I am therefore inclined to the view that the perception of both groups counts for this purpose.

90. The opponent’s case is based on a) the use of LA Weave by consumers of hair extension fitting services and those offering those and/or related training services, and b) use of LA Weave by itself or third parties, which predates, or is concurrent with, the applicant’s use of LA Weave.

91. I earlier found that LA Weave was known to some hairdressers and hair extension users in the UK, prior to August 2011 when Mr Martin says that he coined the name. However, there is nothing to suggest that this was a widely known term in the UK at that time, or at the later date of January 2012 when the applicant started to use the name in trade. In this connection, I note that Mr Williams’ evidence was that the hair extension business in the UK grew substantially over the preceding 5 years,

³⁶ BL O-281-04

prior to which it was smaller and more of a 'backstreet' enterprise. This suggests that average consumers of hair extension services in 2014 were unlikely to have had much of an historical perspective on the terms used in the trade. Further, although many industries are international in nature, with the result that terms used in one place quickly spread to other places, the evidence in this case, particularly that of Ms Qayyum, points to users and providers of hair extension fitting services in the UK having a relatively regional (i.e. less than national) perspective on fitting methods. Again, this makes it less likely that average consumers in either section of the target public would have an appreciation of terms used to designate fitting methods elsewhere in the world.

92. I accept that the use of LA Weave by Pauls Hair World between November 2013 and the relevant date in 2014 is likely to have educated some members of the target public for hair extension services to the perception that LA Weave designates a method of fitting hair extensions. However, the unclear extent of such use, the local nature of the use and the very limited promotion of LA Weave is likely to have affected the perception and expectations of only a tiny proportion of the relevant UK public.

93. I accept that use of LA Weave by the Connect-2-Hair from the latter part of 2013, and by the opponent between June 2014 and the relevant date in October 2014, in relation to hair extension training services is likely to have affected the perception and expectations of some providers of hair extension fitting services. The people who received this training were, as a result, more likely to believe that LA Weave designated a method of fitting hair extensions. However, the extent of the training services provided by Connect-2-Hair under LA Weave is very unclear and appears to be limited. The extent of the training services provided by the opponent in LA Weave is also unclear, but is likely to have amounted to fewer than 100 people. The promotion of training services by either of these parties, by reference to the name LA Weave, appears to have been almost non-existent. Consequently, the use of LA Weave by Connect-2-Hair and the opponent is only likely to have affected the perception of a tiny proportion of providers of hair extension fitting services in the UK.

94. Therefore, based on the use specifically relied on by the opponent, and taking account of the expectations of relevant average consumers, my answer to the question posed in paragraph 85 above would be that the opponent has not shown that LA Weave was in 'customary use' at the relevant date "*in the current language*", or "*in the bona fide and established practices of the trade*".

95. The applicant says that he used LA Weave as more than the name of fitting method. He points to the restriction in some of the diplomas he gave to his students which states that they were not entitled to train others in LA Weave. The applicant

submits that this was, in effect, an assertion that LA Weave was a proprietary name. I do not accept this. Firstly, the restriction was expressed as relating to the fitting method the student was taught, not the name LA Weave. Secondly, it was not made clear what the reason for the restriction was. It was not therefore clear that the applicant asserted that LA Weave was a trade mark. I therefore find that the nature of the applicant's use of LA Weave was (only) as the name of a method for fitting hair extensions. It follows that the mark had not acquired any distinctive character it otherwise lacked as a result of the applicant's use of LA Weave prior to the relevant date.

96. This finding is only material if the mark was *prima facie* excluded from registration under s.3(1) at the relevant date.

97. There is one further matter I should consider before rejecting the opponent's opposition under s.3(1)(d); namely, whether LA Weave was in customary use by hairdressers, other providers of hair extension training services and end users of hair extensions, partly as a result of the applicant's own use of LA Weave in the delivery of his business's training services. Words are malleable as to their meaning. It is therefore possible, in certain circumstances, for words to acquire a generic meaning even though they have been used mainly, or even entirely, in relation to the goods or services of a particular undertaking³⁷. A trade mark owner may be responsible for his mark becoming generic. And the process through this occurs can start before or after the registration of the mark.

98. In this connection, I note that the opponent was keen to demonstrate that the applicant's use of LA Weave was relatively trivial³⁸. By contrast, the applicant relied on the extent of his use of LA Weave to support his claim that it distinguishes the training services provided by his business. I prefer the opponent's submissions on this matter to those made on behalf of the applicant. Considered in the context of the potential UK market for training in hair extension fitting services, which Mr Williams estimated as 100,000 businesses, the 200 or so people that Mr Martin trained in LA Weave prior to the relevant date is too few to have caused LA Weave to have become 'customary in the current language or in the *bona fide* and established practices of the hairdressing trade'. It is, of course, also necessary to consider the effect of the applicant's promotional activity, which might have affected the perception of a greater number of hairdressers. However, I agree with the opponent that the amount the applicant spent on promotion was relatively trivial. It was not much more than maintaining his websites. Consequently, even if I take account of the use of LA Weave by the applicant, as well as by others, prior to the relevant date, the overall level of use of LA Weave in the UK as the name of a fitting method for

³⁷ See, for example, *Jeryl Lynn* [1991] FSR 491

³⁸ This was no doubt intended to undermine the applicant's claim that his use of LA Weave had resulted in the mark acquiring a distinctive character as a trade mark.

hair extensions does not appear to have been such that it could reasonably be said that it had become “*customary*” in the *bona fide* and established practices of the hairdressing trade.

99. Turning to the perception of consumers of hair extension fitting services, I accept that the hairdressers trained by the applicant, the opponent, and possibly by Connect-2-Hair would have used LA Weave to more members of the relevant target public as the name of a method to fit hair extensions. However, there is very little evidence of hairdressers publicly promoting LA Weave prior to the relevant date, or at all. The opponent’s witnesses suggested that there was a good deal of word of mouth use of LA Weave by, and to, the public. However, the evidence of use of LA Weave by UK consumers on social media sites is extremely thin. Further, although it appears to be standard practice to record the fitting methods offered to consumers in consultation reports, not one such report has been filed by any of the opponent’s witnesses showing that they discussed fitting hair extensions using the LA Weave method. As Lord Bingham of Cornhill said in *Fairchild v. Glenhaven Funeral Services Ltd*³⁹:

“... I think it is salutary to bear in mind Lord Mansfield’s aphorism in *Blatch v. Archer* (1774) 1 Cowp 63 at 65, 98 ER 969 at 970 quoted with approval by the Supreme Court of Canada in *Snell v. Farrell*:

‘It is certainly a maxim that all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.’ ”

Taking all these matters into account, I find that the opponent has not shown that LA Weave was in customary use at the relevant date ‘in the current language’ of trainers of methods for fitting hair extensions, hairdressers, or consumers of hair extension fitting services.

100. The position regarding the goods in class 26 is clear. There is no evidence that LA Weave was in customary use in relation to hair extensions, or any of the other goods in class 26.

101. I therefore reject the ground of opposition under s.3(1)(d).

Section 3(1)(b)

102. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act)

³⁹ [2002] UKHL 22; [2003] 1 AC 32 (HL) at paragraph 13

were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG*⁴⁰ as follows:

“29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67).”

103. It is possible for a trade mark to be devoid of any distinctive character even if the mark is free from objection under s.3(1)(c) (descriptive) or under s.3(1)(d) (in customary use). The relevant question under s.3(1)(b) is whether the mark is incapable of distinguishing the goods and services listed in the application.

104. In this case the opponent’s pleaded case under s.3(1)(b) has three limbs. Firstly, that the word ‘weave’ is descriptive of a method of fitting hair extensions, and LA brings only two additional letters to ‘weave’. Secondly, that LA Weave is a term used in trade to describe hair extensions adapted for fitting by micro rings. Thirdly, that the mark had not acquired a distinctive character through use prior to the relevant date.

105. I have already accepted the third point, but that does not mean that the mark did not have the necessary inherent qualities to be able to distinguish the goods/services at the relevant date. In contested proceedings I am required to consider the pleaded matters afresh. Therefore, I am no more bound by the Office’s initial assessment that the mark is excluded from *prima facie* registration, than I am by the Office’s initial assessment that it had acquired a distinctive character through use.

⁴⁰ Case C-265/09 P

106. I accept the facts asserted in the first point in paragraph 104, but I do not accept that this means that the mark as a whole lacked the necessary capacity to distinguish the goods/services listed in the application. Letters must be assessed for distinctive character in relation to the goods/services in question, as with other types of marks. See *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co. KG*⁴¹. I see nothing about the letters 'LA' which means that, when combined with 'Weave', they are incapable of distinguishing the goods/services at issue

107. I have already rejected the second point in paragraph 104 as part of my examination of the s.3(1)(d) ground of opposition.

108. I conclude that, in this case, the opponent's s.3(1)(b) ground adds nothing to its other grounds. Consequently, I reject the s.3(1)(b) ground too.

Outcome

109. The opposition has failed. Subject to appeal, the mark will proceed to registration.

Final comments

110. Although the opposition has failed, the applicant would be well advised to consider how he uses LA Weave in future. I note that he currently uses the name with a trade mark symbol. This alone may not be sufficient to prevent LA Weave becoming the common name for the services listed in the application, if it becomes established in the language of hairdressers and end users of hair extensions as the name of a method for fitting hair extensions⁴². If this situation comes about because of acts or omissions on the part of the proprietor of the mark, the registration will be liable to revocation under s.46(1)(c) of the Act.

Costs

111. The opposition has failed and so the applicant would normally be entitled to a contribution towards his costs. Neither side suggested that I should depart from the usual approach of determining costs from the published scale.

112. I will therefore award the applicant the sum of £2800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

£300 for considering the notice of opposition and filing a counterstatement
£1500 for filing written evidence and considering the opponent's evidence

⁴¹ Case C-265/09 P, CJEU

⁴² See the judgment of the CJEU in Case C-409/12, *The Kornspitz Company GmbH v Pfahnl Backmittel GmbH*

£1000 for attending a hearing and filing skeleton arguments

113. I therefore order Ecotrade Europe Ltd to pay Mr Kyle Martin the sum of £2800. The above sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of those proceedings.

Dated this 8th day of June 2016

**Allan James
For the Registrar**