

TRADE MARKS ACT 1994

**IN THE MATTER OF UK TRADE MARK APPLICATION NO. 3247404
IN THE NAME OF GOLDEN CALA TRADING EST.**



**AND IN THE MATTER OF OPPOSITION NO. 411195 THERETO
BY FLORIAN MACK**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST A DECISION OF MR MARK KING
DATED 31 MAY 2019**

DECISION

1. This is an appeal from a decision of Mr Mark King, on behalf of the Registrar, BL O/300/19, in which he upheld in part the opposition by Mr Florian Mack (“the Opponent”) to a trade mark application in the name of Golden Cala Trading Est (“the Applicant”). The Applicant appeals his decision.

Background

2. On 1 August 2017, the Applicant applied to register this device as a trade mark:



The specification covered the following goods in Class 9:

Scientific, nautical, surveying, photographic, cinematographic, optical, weighing, measuring, signalling, checking (supervision), life-saving and

teaching apparatus and instruments; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers, recording discs; compact discs, DVDs and other digital recording media; mechanisms for coin-operated apparatus; cash registers, calculating machines, data processing equipment, computers; computer software; fire-extinguishing apparatus; optical lenses; ophthalmic lenses; correcting lenses (optics); contact lenses and cases for contact lenses; glasses and sunglasses; optical goods.

3. The Opponent's opposition was based upon two earlier marks, EUTM No 16547267 and an International registration designating the UK, No 1371582. The marks consist of the device:



The earlier marks are both registered for Class 9: Contact lenses; glasses, sunglasses and contact lenses; optical goods, Class 35: Online retail store services relating to cosmetic and beauty products, and Class 44: Optical services.

4. The opposition was based upon sub-sections 5(2)(b), 5(3) and 5(4)(a). It succeeded only on the basis of the sub-section 5(2)(b) objection and in relation only to some of the goods applied for ("the Goods"), which the Hearing Officer found were similar or identical to the Opponent's Class 9 goods, namely

Scientific, nautical, surveying, photographic, cinematographic, optical, measuring, signalling, teaching apparatus and instruments; apparatus for recording, transmission or reproduction of images; optical lenses; ophthalmic lenses; correcting lenses (optics); contact lenses and cases for contact lenses; glasses and sunglasses; optical goods.

5. The Hearing Officer held, in summary:
- a. There was identity and/or a high degree of similarity between the Opponent's goods (including "optical goods") in Class 9 and the Goods.
 - b. There was no similarity between the Opponent's earlier goods and services and the Applicant's remaining goods.
 - c. The marks were visually highly similar and aurally identical. In some circumstances, the marks would be seen as conceptually identical, in others, as conceptually neutral.
 - d. The average consumer could be either a member of the general public or a business customer. A reasonable degree of care would go into the selection of the Goods by members of the public; the level of attention for businesses was higher.
 - e. The earlier marks had below medium but not low inherent distinctiveness.
 - f. There was a likelihood of direct confusion under sub-section 5(2)(b) in respect of the Goods.
 - g. Considering the opposition pursuant to sub-sections 5(3) and 5(4)(a) only in respect of the remaining goods:
 - i. The opposition under 5(3) failed as the Opponent had not proved the requisite reputation;
 - ii. The Opponent had proved that it had goodwill in the earlier marks for contact lenses and optical goods but for the remaining goods use of the mark applied for would not lead to a misrepresentation, so that the opposition based upon sub-section 5(4)(a) also failed in relation to those goods.

Standard of appeal

6. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in

question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).”

7. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant, In re Reef Trade Mark* [2002] EWCA Civ 763; [2003] RPC 5, paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge’s conclusions of primary fact but with the correctness of the judge’s evaluation of the facts which he has found, in which

he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge's assessment of obviousness if the appellate court were to reach the view that the judge's conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ..."

8. As to the position where a Hearing Officer has assessed the likelihood of confusion for an opposition based upon sub-section 5(2)(b) of the Act, Mr Iain Purvis QC sitting as the Appointed Person in *Rochester* BL O/049/17, said at [33]:

"... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal

will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

9. I have borne those principles in mind on this appeal.

Grounds of appeal

10. The Grounds of Appeal raised three points which remained live by the time of hearing the appeal:

- a. The Hearing Officer erred in his comparison of the parties’ Class 9 goods, because he failed to consider whether the phrase “optical goods” is so unclear and imprecise that it could not properly be relied upon for the purposes of the opposition. Had he carried out the appropriate comparison, he would have found a narrower range of the Applicant’s goods to be identical/similar to the Opponent’s goods, namely contact lenses, glasses and sunglasses, optical goods, optical lenses, ophthalmic lenses, correcting lenses (optics) and cases for contact lenses.
- b. The Hearing Officer erred in his analysis of the level of attention liable to be shown by the average consumer.
- c. All of this indicated that the global assessment of the likelihood of confusion was wrong, and he should have found no likelihood of confusion.

The Grounds also raised a point about the impact of the visual differences between the marks, which was not pursued at the hearing of the appeal.

11. The Opponent filed a Respondent’s Notice, in which it submitted that if the decision was overturned on appeal in respect of any of the Goods, the opposition should be upheld in respect thereof under section 5(4)(a), which was not considered by the Hearing Officer. Alternatively, the matter should be remitted to the Registry for consideration of the 5(4)(a) grounds.

Optical goods

12. The main point argued on the appeal was the issue about the term “optical goods.” The Hearing Officer dealt with the point as follows:

“33) Applying the principle set out in *Meric*, the applied for *optical lenses; ophthalmic lenses; correcting lenses (optics)* to be included in the broader earlier term optical goods. Therefore, they are identical.

34) Also applying the *Meric* principle I find that the applied for “*photographic, cinematographic, optical, and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of images*” to be sufficiently broad to include the earlier *optical goods*. This is because they would all include goods such as lenses, for example photographic and cinematographic goods would include cameras which have lenses, etc. Further, teaching apparatus would include items such as microscopes which are used in teaching environments such as biology classes, etc. Therefore, they are identical.

35) Turning to the applied for “*Scientific, nautical, measuring, surveying, signalling apparatus and instruments*” they are all broad terms which would include specific 14 items such as microscopes (within scientific and teaching), telescopes (within nautical), apparatus used to measure distance (within surveying and measuring) and lenses used for signals (within signalling). Therefore, applying the principle set out in *Meric*, I find the goods to be identical.

36) The applied for *cases for contact lenses* are not optical goods *per se*. They differ in nature since contact lenses are used to improve one’s sight and the cases are used to carry and store them. They will be purchased by the same end user, sold in close proximity to one another and sold via the same distribution channels. The respective goods are not in competition with one another, though they are complementary since cases are important for the use of the other. They are highly similar.”

13. Two points were raised about these paragraphs in the Grounds of Appeal. First, the Opponent submitted that as the Hearing Officer's view was that optical lenses, ophthalmic lenses and correcting lenses all fell within the term “optical goods,” so that was in effect his definition of the term, which could not be extended to cover the further goods identified in paragraph 34 and 35 of the decision. This point was not pursued at the hearing, realistically in my view, because it does not seem to me that the Applicant was right to say that the contents of paragraph 33 of the decision

amounted to a definition of the term "optical goods" which prevented the Hearing Officer from considering whether that term overlapped with the broader categories of scientific, nautical, photographic, etc goods.

14. The second pleaded point was that the Hearing Officer had not taken into account the need for terms in specifications to be construed with precision, and his finding that "optical goods" overlapped with the goods identified in paragraph 34 and 35 showed that the term did not satisfy the requirement of clarity and precision and so should have been ignored in the assessment of the relative ground objections.
15. Following Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) ("IP Translator")* [2012] E.T.M.R. 42 at [40] to [49], and in accordance with the principle of legal certainty, trade mark specifications are required to satisfy the requirements of clarity and precision. If wording within a trade mark specification does not satisfy the requirement of clarity and precision it "can play no part in the assessment of relative grounds objections" (see *Gap (ITM) Inc v Gap 360 Ltd* [2019] EWHC 1161 (Ch) at [39]-[44]). On the other hand, as Henry Carr J pointed out in *Gap* at [41], citing *Total Limited v YouView TV Limited* [2014] EWHC 1963 at [57], this does not mean that *any* degree of uncertainty will have such an effect. Such an exclusion would only apply where there is such a "lack of clarity and precision in the specification as to create an unacceptable or unreasonable level of uncertainty regarding the scope of protection given by the trade mark, having regard to the context in which it is to operate."
16. The Applicant's position was that the term "optical goods" lacks clarity because it covers a range of categories. It is too general and covers goods which are too variable to be compatible with the trade mark's function as an indication of origin.
17. A serious preliminary difficulty with that point is that it was not raised below. Indeed, although the Applicant's trade mark attorneys filed two sets of written submissions, no issue was raised at all as to the parties' respective goods, whether in terms of the comparison of the goods, their similarity or identity, or the possibility that the term "optical goods" is objectionable. Perhaps that is not surprising, as the Applicant's own

specification contained the term "optical goods" (disclaimed on the appeal). Be that as it may, there was nothing to indicate that the Applicant took any point about the Opponent's reliance on the optical goods in its specification. No evidence or submissions were filed on the point by the Opponent, nor was it a matter otherwise drawn to the Hearing Officer's attention.

18. It is well established that it is only in exceptional circumstances that an appeal tribunal will allow a party to advance on appeal a new case on a different basis. An exception may be made where the new point is a pure point of law. Even in those circumstances, permission will not be given where there is a possibility of an injustice occurring. This principle was stated by Rix LJ in *Lowe v W Machell Joinery Ltd* [2011] EWCA Civ 794, at [81] (although a dissenting judgment, there was agreement between the members of the Court as to this principle):

"It is a long-standing and fundamental principle of this court that a new point of law which was not presented to the court of trial may be raised on appeal, but normally only where there is no possibility of any injustice occurring by reason of the fact that, if it had been raised at trial, it might have affected the conduct and in particular the evidence or its evaluation in those proceedings..."

See also *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, [2014] FSR 29 per Kitchen LJ at [78].

19. I drew the parties' attention to *Lowe v Machell* prior to the hearing. Counsel for the Applicant of course accepted the principle, but sought to persuade me that this was a pure point of law which could be raised on the appeal because it would not have changed the evidence before the Hearing Officer. Counsel for the Opponent, by contrast, submitted that permitting the Applicant to raise the point on appeal would be unjust, because if the point had been raised below, the Opponent could have sought to deal with it by providing evidence as to the proper meaning of the term "optical goods."

20. It seems to me that it would not be appropriate or just to permit the Applicant to raise this point on appeal, when it was not raised before the Hearing Officer. The Applicant had ample opportunity to raise the point below, and whilst perhaps the point about the need for clarity in trade mark specifications has been highlighted by recent legal developments, the principle was established well before the hearing below in light of *IP Translator* and *YouView*. I do not accept the Applicant's suggestion that the Opponent could or would not, if alerted to the point, have run the case differently below, and filed some relevant evidence as to the meaning of the phrase "optical goods." I would reject this Ground of Appeal on that basis alone.
21. In any event, I am not persuaded by the Applicant's argument that "optical goods" is a term which is too broad and vague to be acceptable. It seems to me that the real thrust of the Applicant's argument (although this point was disclaimed by counsel when I put it to him) is that the wider terms in its own specification, such as scientific or nautical apparatus or instruments, are too broad and vague to be acceptable, because they may contain certain goods which are also properly described as optical goods (hence the Hearing Officer's finding that the specifications overlapped). Alternatively, the Applicant was seeking to draw an unrealistic distinction between those goods and optical goods, and especially between the "optical apparatus and instruments" in its own specification and optical goods in the Opponent's specification.
22. I do not need to decide whether any of those terms is too broad to satisfy the requirements set out above, as the question for me is whether the Hearing Officer made any error in the analysis which he carried out in paragraphs 33 to 36 of the decision. It does not seem to me that the Applicant has identified any error in the reasoning of the Hearing Officer in these paragraphs. He identified optical goods which he considered could be found within the broader categories in the Applicant's specification, and applied *Merix* in the usual way. None of those specific findings was challenged.
23. For those reasons also, I would have rejected the first Ground of Appeal

Average consumer

24. In paragraphs 52 and 53 of the decision, the Hearing Officer held
- “52) The average consumer is a member of the general public and businesses. In respect of the general public, the goods found to be identical or similar are not everyday items and a reasonable degree of care will go into their selection, although not of the highest possible degree. The goods are likely to be purchased via self-selection in shops such as opticians or from perusal of websites, brochures and catalogues. This suggests a visual process, but I do not ignore aural recommendations.
- 53) With regard to the goods which are more likely to be purchased by businesses, the level of attention is typically higher. However, the goods will still be selected following a visual inspection of the goods on websites, brochures, etc. but I do not disregard aural recommendations.”
25. In the Grounds of Appeal, the Applicant submitted that the Hearing Officer had gone wrong in that analysis. It is submitted that all of the Goods were "very far from everyday items" and included highly technical goods, such as the scientific, nautical, etc goods, and “medically important” goods such as the optical lenses, contact lenses, etc. It submitted, therefore, that the average consumer of those goods would exercise a high to very high degree of attention when choosing the goods.
26. The argument put forward in the Applicant's skeleton for the appeal was somewhat broader. It complained that the Hearing Officer had erred in failing to explain which goods would be purchased by members of the general public, and which goods would be more likely to be purchased by businesses. The Opponent objected that this point was not to be found in the Grounds of Appeal and therefore could not be run on the appeal. I agree. I do not consider that this is a point which can be raised at this stage.
27. However, the Applicant also argued on the appeal that the Hearing Officer had gone wrong not to find that the level of attention with which all of the Goods would be purchased was very high, because all of them are very technical and would be purchased only after careful consideration. It does not seem to me that the Applicant

has identified an error of principle on the part of the Hearing Officer in this regard. He had found that the Goods were not everyday items and that a reasonable degree of care would go into their selection. That seems to me a judgment which it was plainly open to him to make, just as it was open to him to find that Goods purchased by businesses would be purchased with a higher level of attention.

28. In any event, when assessing the likelihood of confusion, the impact of the mark applied for upon members of public with the lowest level of attention must be taken into account (see e.g. Case T-700/18, *Kalypso Media Group GmbH v EUIPO* EU:T:2019:739 at [34]).
29. In the circumstances, I do not consider that there is any error in the Hearing Officer's analysis in respect of the level of attention which would be paid to purchase of the Goods, and there is no merit in this Ground of Appeal.

Global assessment of the likelihood of confusion

30. The Applicant submitted that the Hearing Officer had erred in his global assessment of the likelihood of confusion of the marks. That argument depended upon a combination of narrowing down the list of similar Goods, criticism of the Hearing Officer's assessment of the similarity of the marks, and the average consumer point. As I have rejected the first and third of those points and the second was not pursued on the appeal, it does not seem to me that the Applicant has identified any error in the overall assessment of the likelihood of confusion.

Conclusions

31. For these reasons the appeal is dismissed. There is, therefore, no need to consider the Respondent's notice or the question of remission of the case to the Registry.

32. As the successful party, the Opponent is entitled to a contribution towards its costs from the Applicant. I will order the Applicant to pay the Opponent the sum of £1000 in respect of its costs of the appeal, to be paid by 5 PM on Friday 31 January 2020.

Amanda Michaels
The Appointed Person
15 January 2020

Mr Daniele Selmi (instructed by **Nucleus IP Ltd**) appeared the Applicant/Appellant

Mr Jamie Muir Wood (instructed by **Albright IP Ltd**) appeared for the Opponent/Respondent