BL O/0383/26

APPEAL TO THE APPOINTED PERSON

TRADE MARKS ACT 1994

IN THE MATTER OF
Trade Mark No UK3635437 in the name of ShareP AG

and

Application for Invalidity no 506340 thereto by PARK AGILITY PTY LTD

DECISION

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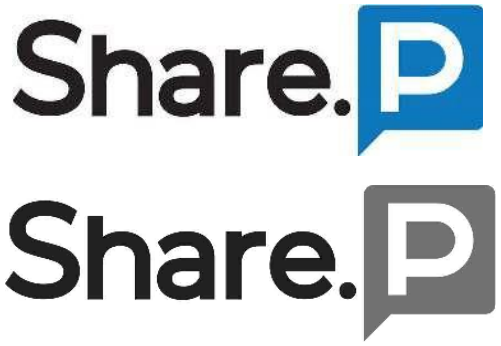
1. This is an appeal from the decision of the Hearing Officer, Ms. L Nicholas dated 15 August 2025 (the "**Decision**"). The Decision concerns an application for invalidity of Trade Mark No UK3635437 (the "**Trade Mark**"), registered for:



(Series of 2)

2. The application was partially successful. This appeal challenges the Hearing Officer's decision that the following services were not to be the subject of invalidation:

> Class 42: providing a website with information about and for booking temporary vehicle parking spaces (the "**Excluded Services**").

3. The primary reason for that decision, and for that reason the primary reason on appeal, was a finding that they were dissimilar to the services of the mark relied upon for invalidation. Namely, UK917960088, **SHAREPARK** (the "**Earlier Mark**").

The Issues on Appeal

4. The Appellant's case on appeal was that whilst the Hearing Officer had understood the legal tests she had to apply when comparing the services in issue, she failed to apply those tests properly in relation to the Excluded Services. The Appellant helpfully summarized that position in its oral submissions as follows:

> *"The [Hearing Officer's reasoning that] led to a finding of dissimilar for class 42… does not demonstrate that the governing treat [..] criteria were applied to the service in the same manner that they were applied to the other goods and services, particularly in relation to cross-class comparisons. Those comparisons were central to the pleaded trade mark conflicts that were analyzed elsewhere in the decision".*

5. The Respondent's answer was simple: the matters now relied upon by the Appellant were not pleaded or canvassed before the Hearing Officer. It follows, it submitted, they were points that could not be run on appeal.

The Law

Standard of Appeal

6. There was no dispute about how I should approach this appeal. The principles are well understood and are discussed in detail in *Axogen v Aviv Scientific* [2022] EWHC 95 (Ch)*, Lifestyle Equities v Amazon* [2024] UKSC 8 and *Iconix v Dream Pairs* [2025] UKSC 25. For present purposes it is sufficient for me to remind myself of the summary of the approach given by Mr. Thomas Mitcheson KC, sitting as the Appointed Person, in SOCIAL WORK NEWS (O/00/50/24) at [13]:

> *To paraphrase, an appeal should only be allowed where the decision of the lower court was "wrong". Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible". In the case of a multifactorial assessment and in the absence of a distinct error of principle, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere.*

Pleadings

7. The requirement for adequately particularized pleadings is a matter of central importance in ensuring procedural fairness. The question in this case is how detailed pleadings should be where there are a very large number of services to be compared. This was an issue addressed (in very similar circumstances) by Mr. Iain Purvis KC, sitting as the appointed person, in *Abus August Bremicket KG v Muhammad Ali, Case BL O/0911/24.* At paragraphs 27, 28 and 31 of that decision Mr. Purvis found as follows:

> *27. On behalf of the Opponent, Mr Wood of Brandsmiths fairly accepted that the point had not been made. However, he submitted that the TM7 pleading was wide enough to cover the point (since it relied on 'all' the goods of the earlier marks and alleged 'similarity' in respect of all of them). In the circumstances, he contended, the Hearing Officer was obliged to compare each category of goods in the earlier marks and each category of goods in the Application, and to consider any points of similarity which might exist between them whether or not those points had been actually identified or relied on by the Opponent.*
>
> *28. I do not accept this. As I have said, it is for the Opponent to put forward the combinations of goods on which it relies for similarity (or identicality). If it fails to identify a particular combination, it cannot expect the Hearing Officer to do the job for it. The approach for which Mr Wood contends would place an intolerable burden on Hearing Officers in cases of this nature in which there will be thousands of potential combinations of goods which could be relied on, and for each combination a slightly different argument for similarity could be made. Furthermore, such an approach would be unfair on the Applicant for the mark, since they will have had no opportunity to address points on similarity taken by the Hearing Officer if those points are not first raised by the Opponent.*
>
> …….
>
> *31. There are a number of points to be made about this:*
>
> *(i) Clearly this was a case where further particularisation was required. The TM7 was manifestly inadequate in identifying any case of 11(ii) (iii) (iv) (v) identicality or similarity, and it was unfair on the Applicant and indeed on the Registry to expect it to deal with the Opposition on the basis of such a pleading.*
>
> *(ii) The failure of the casework examiner to demand further particularisation is unfortunate but not something which excuses the Opponent from the burden of pleading its case, nor gives it the right to raise unpleaded points on appeal. This is particularly the case where the Opponent is professionally represented.*
>
> *(iii) The case was in fact further particularised in the written submissions. The Hearing Officer must have considered that these gave her (and the Applicant) enough information about the Opponent's claim for her to be able to determine the Opposition without a hearing. That was a*

matter for her, although I have to say I find the written submissions extremely confused and unhelpful.

(iv) The Hearing Officer should have considered the Opposition on the basis of the case put forward in the written submissions. This was the case which the Applicant would have understood was being put forward by the Opponent, and it can be assumed that he relied on this when decided that he was happy for the matter to be decided by the Hearing Officer without making further submissions of his own.

(v) In fact (as I have pointed out) the Hearing Officer went beyond the written submissions in making findings of similarity in respect of a number of groups of goods on the basis of arguments which had not been raised by the Opponent. If the Applicant had complained about this by way of an Appeal, there would probably have been a good argument that he had been the victim of procedural unfairness. But this has of course not happened and to this extent the Opponent has benefited from the Hearing Officer's generosity. However, it would obviously be perverse to say that the Hearing Officer ought therefore to have taken every other unpleaded and unargued point in the Opponent's favour.

(vi) In the circumstances, there is no basis on which the Opponent is entitled to complain on Appeal that this unpleaded, unargued point was not taken in its favour by the Hearing Officer

The Appellant's Criticisms of the Decision

8. Mr. Steinhausen, who appeared for the Appellant, submitted that the Hearing Officer's very brief finding in relation to class 42 (in paragraph 46 as set out above) demonstrated that she had not carried out the comparison task she was required to in relation to, inter alia, the Excluded Services. In support of this contention, he contrasted the brevity of the analysis in paragraph 46 with the much more detailed analysis made in relation to other services in paragraph 49 of the Decision.

9. In addition, Mr. Steinhausen drew attention to a comparison between the Excluded Services and certain service in class 39 of the Earlier Mark:

Excluded Services	**Earlier Mark**
Providing a website with information about and for booking temporary vehicle parking spaces	Class 39: Provision of vehicle parking facilities; vehicle parking services

The thrust of his submission was that if the Hearing Officer had turned her mind

to this comparison properly, she could not have reached a finding of dissimilarity.

10. I agree that if the Hearing Officer was required to turn her mind to the comparison shown in the table, then there is considerable force in the Appellant's submissions. That brings me to the question of whether she was required to do so.

11. Before considering that question I should however note here as well that Mr. Steinhausen also drew attention to a comparison between the Excluded Services and services in class 9 for which the Earlier Mark was registered. For reasons that will be apparent below it is unnecessary for me to consider that comparison separately and, because it seems to me to be the stronger of the Appellant's cases, I will deal with this appeal by reference to the class 39 comparison.

The Pleading Issue

12. The comparison that appears in the table above was not set out in the Appellant's TM7. Nor, it appears, was it a comparison which was urged on the Hearing Officer at the oral hearing, as the following passage from the Decision strongly suggests:

> *22. In the hearing I noted before I passed to the parties for submissions that there had been limited comment so far on the goods and services comparison. I mentioned that the list of goods and services to be compared was not insignificant and stated I would be grateful if the parties could make sure they addressed this within their submissions to me.*
>
> *23 Mr Steinhausen gave initial submissions that the Cancellation Applicant had every class registered that the Registered Proprietor's mark had as well, being classes 9, 39 and 42. He said that class 9 has software and electrical apparatus, class 39 he summarised as transportation and car parking or parking services and class 42 was a service class for technology.*
>
> *24 I asked Mr Steinhausen if his submissions meant that there was no real need for the Cancellation Applicant to rely upon their class 11, 35 and 37 goods and services as he had made no mention of them. He replied that this was not the case and those classes should also be taken into consideration and that he had been, in the first instance, addressing the goods and services in the identical classes.*
>
> *23. Mr Wood in his response stated that the above submissions lacked detail and did not make reference to the Treat criteria.*
>
> *24. After some discussion around the goods and services, Mr Steinhausen*

said he would stick to grouping the goods and services as he had set out above (paragraph 22).

25. I remind myself of what was said by Iain Purvis KC as the Appointed Person in Abus August Bremicket Sohne KG v Muhammad Ali, Case BL O/0911/24 at paragraph 9 that:

> *"9. In a case like this where the marks cover a multitude of different goods, it is obviously necessary for the Opponent to identify with precision, both in its pleaded case and in any submissions made to the Registry, which goods of its own registrations are alleged to be similar to which goods of the Application. If this is not done, it is unfair to the Applicant and it is extremely difficult if not impossible for the Hearing Officer to decide the case."*

26. I note that this decision came out after the hearing, however, it is not a new concept that the parties, in particular those bringing proceedings, should clearly outline their case. I have noted Mr Steinhausen's submissions that were given in the hearing. I will therefore proceed on the basis of those submissions and I will only consider similarities where it is obvious to do so; otherwise, the goods and services will be found to be dissimilar.

25 I was not provided with a transcript of the hearing before the Hearing Officer. However, neither party (when I asked) suggested that the comparison shown in the table above (or the class 9 comparison I have referred to above) was urged on the Hearing Officer. I will therefore proceed on the basis that it was not.

26 It follows that the Appellant failed to plead the point now relied upon (i.e. the comparison in the table above). Nor did it identify it to the Hearing Officer at the oral hearing. For the reasons explained in *Abus August Bremicket* it was in my view required to do so. This is particularly so as the list of services before the Hearing Officer was substantial. Both she and the Respondent were entitled to know on what basis upon which the Appellant made its case. That included identifying with precision which services were to be compared. Having not raised the point properly in its pleadings and submissions it is not entitled to raise the point now. On this basis I therefore dismiss this appeal.

27 It is apparent from paragraphs 22-27 of the Decision (see above) that the Hearing Officer decided to push ahead with her analysis in circumstances where the pleaded case appears have fallen far below that which is required. As there is no cross-appeal I cannot, and should not be taken as commenting on, the correctness of her decision to push ahead with the analysis. However, I do note that it seems to me that as a general matter great care should be exercised, for the reasons expressed by Mr. Purvis KC, before pushing on with a hearing in circumstances where the

pleadings setting out the comparison of goods and services are manifestly inadequate.

46. I direct that the Appellant shall pay to the Respondent the following sums in costs within 21 days of the date of this decision:

    a. £1350, being the sum awarded by the Hearing Officer, and
    b. £1500, as a contribution to the Respondent's costs of this appeal.

GEOFFREY PRITCHARD KC
THE APPOINTED PERSON
29 April 2026