BL O/0495/25

O/0870/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3678886
BY RASHID RAY
TO REGISTER

Pizzology

AS A TRADE MARK IN CLASS 43

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 429267 BY
THE LITTLE BROWN BOX PIZZA, LLC

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE LITTLE BROWN BOX PIZZA, LLC
AGAINST A DECISION OF CLARE BOUCHER
DATED 9 SEPTEMBER 2024

DECISION

Introduction

1. This is an appeal from a decision of Clare Boucher acting for the Registrar, dated 9 September 2024, in relation to an opposition by The Little Brown Box Pizza, LLC ("**the Appellant**") to an application by Rashid Ray to register **Pizzology** as a trade mark in the United Kingdom in respect of the following services:

   Class 43

   Fast food restaurants; Fast-food restaurant services; Catering in fast-food cafeterias; Take-away fast food services; Restaurant services for the provision of fast food; Food preparation; Food sculpting; Contract food

   ("the Respondent's Mark").

2. The opposition was based on s.5(2)(b) of the Trade Marks Act 1994 (**"the Act"**) targeted at all of the services of the Respondent's Mark (reliance on an additional ground under s.5(3) of the Act was withdrawn prior to the hearing before the Hearing Officer). The Appellant relied on its UK trade mark number 913112479 for **PIEOLOGY**, a UK comparable mark with an application date of 24 July 2014 and a registration date of 16 December 2014 **("the Appellant's Mark")**. The Appellant's Mark was registered for the following goods and services, all of which were relied on:

   Class 29

   Preserved, frozen, dried and cooked fruits and vegetables; salads.

   Class 30

   Flour and preparations made from cereals, bread, pastry and confectionery; pizza and sticks flavoured with butter, herbs or spices.

   Class 43

   Restaurant services.

3. As the Appellant's Mark was an earlier mark within the meaning of s.6(1) of the Act which completed its registration process more than five years before the application date of the Respondent's Mark, it was subject to the proof of use provisions under s.6A of the Act. The

Appellant was put to proof of use of the Appellant's Mark in respect of just the class 43 services. The Appellant relied on a witness statement by the Appellant's Chief Financial Officer, and two witness statements by a trade mark attorney with the Appellant's legal representative, Reddie & Grose LLP, together with supporting exhibits.

4. At the hearing before the Hearing Officer, the Appellant was represented by Reddie & Grose LLP, and Mr Ray represented himself.

The Hearing Officer's Decision

5. The Hearing Officer found that the evidence of use relied on by the Appellant was insufficient to establish proof of use of the Appellant's Mark for the class 43 services. The Hearing Officer therefore had to decide the opposition on the basis of just the class 29 and 30 services, and concluded that there was a likelihood of indirect confusion in respect of "*food preparation*" services covered by the Respondent's Mark, but not for any of the other services, so that, subject to any appeal, the Respondent's Mark would proceed to registration in respect of:

> Class 43
>
> *Fast food restaurants; Fast-food restaurant services; Catering in fast-food cafeterias; Take-away fast food services; Restaurant services for the provision of fast food; Food sculpting; Contract food*

The Appeal

6. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was represented by Mr Jamie Muir Wood instructed by Reddie & Grose LLP. Mr Ray attended the hearing, purporting to represent the current owner of the Respondent's Mark, which had been transferred by Mr Ray to a company called Pizza Bites Ltd (**"the Respondent"**) in February 2025. The secretariat had been notified shortly before the hearing before me that the Respondent would be represented at the hearing by Ms Kusuma Medasani. However, as Ms Medasani did not in fact attend the hearing, and as no notification had been received from the Respondent authorising Mr Ray to represent the Respondent at the hearing before me, I declined to hear any submissions from Mr Ray.

Standard of review

7. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer's conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be *"wrong"* if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of 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"* (*Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court 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 (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

8. In *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

> *"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.*
>
> > *"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.*
> >
> > *ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.*
> >
> > *iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not*

mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

> *"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion"." (Re Sprintroom Ltd [2019] EWCA Civ 932)*

8. And last, as Richards J observed in Instagram, proper respect should be paid to the decision of an expert tribunal in the field in question:

> *"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right.""*

9. In *Lidl Great Britain Ltd and another v Tesco Stores Ltd and another* [2024] EWCA Civ 262, Lord Justice Arnold stated:

> *"16. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: Volpi v Volpi [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2](v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare Magmatic Ltd v PMS International Group plc [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and Actavis Group PTC EHF v ICOS Corp [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see Re Sprintroom Ltd [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ), which was cited with approval by the Supreme Court in Lifestyle Equities CV v Amazon UK Services Ltd [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin)."*

10. I have borne those principles firmly in mind.

The Appeal

11. The Appellant had a single ground of appeal in its Form TM55P, namely that "*the Hearing Officer erred in concluding that, despite the Appellant having used the [Appellant's Mark] for a restaurant in Madrid over a period of two years, that did not amount to genuine use*". Had the Hearing Officer found genuine use of the Appellant's Mark in respect of "*restaurant services*", the Appellant submitted that she would have gone on to find at least a likelihood of indirect confusion between "*restaurant services*" and all of the services covered by the Respondent's Mark. This would have resulted in the Respondent's Mark being refused in its entirety.

12. The relevant period was between 9 September 2016 and 8 September 2021, which meant that the Appellant could rely on use within the EU for the period up to 31 December 2020.

13. The Hearing Officer set out the relevant law regarding genuine use in paragraphs 24 to 28 and paragraph 30 of her Decision, and no criticism was made of this summary by the Appellant. The Appellant's appeal was based on an incorrect application of that law to the facts.

14. I set out below the Hearing Officer's summary of the evidence relating to the Madrid restaurant, followed by her conclusions on that evidence:

> *"21. The European presence is accounted for by a restaurant in Madrid that was opened on 30 October 2018 and was closed as of 1 January 2021. Mr Ostaszewicz states that the opponent is looking to open further outlets and there is some evidence of plans to open a restaurant in the UK. These did not come to fruition and Mr Sullivan confirmed that the opponent was not relying on these plans to prove use of the earlier mark.*
>
> *22. No turnover figures have been provided for the Madrid restaurant. The evidence consists of the following:*
>
> - *An extract from TripAdvisor, showing that the restaurant has received 13 reviews;*
> - *An article from QRS Magazine website dated 22 March 2018 entitled "Pieology Pizzeria to expand into Spain, accelerate franchise growth";*
> - *The company's master order guide for Spain. This is undated;*
> - *An extract from the website www.esmadrid.com, described as the "Official website of Tourism of the city of Madrid", showing a listing for the*

opponent's Madrid restaurant. The website says that it was last updated on 19 December 2018;

- *An extract from the Restaurant Guru website, including photographs of, and information about, the restaurant;*
- *An extract from the website madridfree.org, containing an article about the Madrid restaurant dated 16 January 2019;*
- *Undated photographs of the restaurant in Madrid. They show price information in euros and the mark can be seen on signage, and T-shirts and caps worn by staff; and*
- *A press release issued by the opponent concerning the opening of the Madrid restaurant.*

...

29. The use of the mark is geographically confined to a single pizza restaurant in Madrid between 30 October 2018 and 1 January 2021. ***I am satisfied that the mark was used on the premises and that the restaurant was referred to by the mark on listings and review websites.*** *I also note that there are 13 reviews on TripAdvisor. This does not seem to be a large number, although I accept Mr Sullivan's caution about treating this figure as indicative of the number of customers. I have nothing to enable me to make any reasonable inferences about the proportion of restaurant customers likely to leave reviews. The reviews are dated February 2019 (2 reviews), April 2019 (2 reviews), May 2019, June 2019, July 2019 (2 reviews), August 2019, February 2020 (3 reviews) and November 2020.* (emphasis added).

...

31. The question I must decide is whether use of the mark for a single pizza restaurant in Madrid between 30 October 2018 and 31 December 2020 (IP completion day) is sufficient to constitute genuine use of the mark in the EU. The absence of turnover figures makes it harder to assess that the use is such as is warranted in the economic sector to maintain or create a share in the market for pizza restaurant services. I agree with Mr Sullivan that turnover figures are not the only evidence that can support a finding of genuine use. However, the remaining evidence is fairly thin. The photographs show what appear to be customers in the restaurant, but these are undated. There is limited evidence from third parties: a listing on the Madrid tourism website that was last updated on 19 December 2018, 13 reviews from TripAdvisor spread throughout the period, an article dated January 2019 on the website madridfree.org, and an extract from the Restaurant Guru website showing that the restaurant is permanently closed. I consider that the article from QSR magazine is aimed at business readers, rather than potential customers, as its focus is on the opponent's business strategy. Even so, it is not clear how many people in the EU are likely to have seen this article. There is also little evidence of promotional activity, such as advertisements or social media posts. Taking the evidence as a whole, I find that it does not show sufficient use to be warranted in the economic sector to create or maintain a share in the EU market for restaurant services, even if these were to be limited to pizza restaurant services."

15. It can be seen from the wording shown in bold text above that the Hearing Officer accepted that the restaurant did trade under the Appellant's Mark during the relevant

period. The issue for her to decide was essentially therefore whether a single restaurant operating in Madrid for approximately 2 years, but with no evidence of its turnover figures before her, was sufficient evidence such that she would be wrong to conclude that that evidence did not demonstrate genuine use in the EU.

16. Mr Muir Wood reminded me at the hearing that one of the eight principles summarised by Lord Justice Arnold in *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247 is that there is no *de minimis* rule. It is worth setting out the principle in full as it appears in that judgment (and as set out by the Hearing Officer in paragraph 18 of her Decision):

> *"(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: Ansul at [39]; La Mer at [21], [24] and [25]; Sunrider at [72] and [72]; Leno at [55]"*

17. It is therefore not simply the case that any use within the relevant period which can be shown not to be merely token use means that a finding of genuine use must follow. That is confirmed by Lord Justice Arnold's eighth principle:

> *"(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: Reber at [32]."*

18. The Hearing Officer had to consider all of the factors set out in Lord Justice Arnold's sixth principle:

> *"(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: Ansul at [38] and [39]; La Mer at [22]-[23]; Sunrider at [70]-[71], [76]; Centrotherm at [72]-[76]; Reber at [29], [32]-[34]; Leno at [29]-[30], [56]; Ferrari at [33]."*

19. In terms of *"the territorial extent of the use"*, the Hearing Officer was alive to the fact that use in just one Member State of the EU may be sufficient *"in certain circumstances"* where *"the market for the goods and services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State"*, citing the

relevant passage from the CJEU's judgment in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11. She also expressly recognised the statement by Arnold J (as he then was) in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited* [2016] EWHC 52 that *"the assessment is a multi-factorial one which includes the geographical extent of the use."*. She then went on to refer to the General Court's judgment in Case T-398/13, *TVR Automotive Ltd v OHIM*, and continued (at paragraph 27 of her Decision):

> *"Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making this assessment I am required to consider all relevant factors, including (i) the scale and frequency of the use shown; (ii) the nature of the use shown; (iii) the services for which use has been shown; (iv) the nature of those services and the market for them; and (v) the geographical extent of the use shown. It does not necessarily follow from a finding of proven commercial use that such use is deemed genuine for the purposes of section 6A of the Act."*

20. Finally she referred to the decision of Mr Daniel Alexander QC (as he then was), sitting as the Appointed Person in *JUMPMAN Trade Mark*, BL O-222, in which he reviewed the relevant EU and UK case law and reiterated the need for a multi-factorial assessment referred to in the extract from *The London Taxi Corporation* judgment referred to above. In that case, while stressing that each case will depend on its own facts, Mr Alexander KC concluded:

> *"I do not think that a hearing officer can be criticised for concluding that in the context of the specification in question there is no sufficient use "in the Community" as required by the CTMR, if (as here) there has been both a low volume of sales (by reasonable standards) which has been confined in effect to a single shop in a single town in a single member state of the Community over a relatively short part of the relevant period (with some exiguous trade sales elsewhere of uncertain ultimate destination)."*

21. It is therefore clear to me that the Hearing Officer was fully aware of the relevant factors that she was required to take into account when reviewing the evidence, and that it was a multi-factorial assessment. Mr Muir Wood sought to criticise the Hearing Officer for failing to repeat the no *de minimis* rule in her summary in paragraph 27 of her Decision set out above, but I do not accept that as a fair criticism. She had previously referred to it

in paragraph 18 of her Decision, and I do not see anything in the subsequent paragraphs of her Decision to suggest that she had forgotten to take that into account in her assessment of the evidence and her final conclusion.

22. Mr Muir Wood acknowledged that the lack of any sales figures was unfortunate (the Appellant's representative at the hearing before the Hearing Officer had described it as *"regrettable"*). The Hearing Officer accepted that turnover figures were not the only evidence that can support a finding of genuine use, but did say that *"the absence of turnover figures makes it harder to assess that the use is such as is warranted in the economic sector to maintain or create a share in the market for pizza restaurant services"*, and that *"the remaining evidence is fairly thin"*. I consider that to be a fair summary of the evidence and the position that the Appellant had put the Hearing Officer in.

23. The burden of proof was on the Appellant to prove genuine use, which required it to provide solid and objective evidence of effective and sufficient use of the trade mark on the market concerned. Given the nature of the evidence filed by the Appellant in this case, it is worth setting out here the same extract from Lord Justice Arnold's judgment in the *easyGroup* case referred to above that the Hearing Officer set out in paragraph 30 of her decision:

> *"107. The trade mark proprietor bears the burden of proving genuine use of its trade mark: see section 100 of the 1994 Act and Ferrari at [73]-[83]. The General Court of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. Lidl at [33]. In Awareness Ltd v Plymouth City Council [2013] RPC 24 Daniel Alexander QC sitting as the Appointed Person said:*
>
> > *'19. For the tribunal to determine in relation to what goods or services there has been genuine use of a mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. ...*
> >
> > *22. ... it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of*

> *use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said the public.'"*

24. No explanation was provided for the lack of turnover figures, which should have been easy for the Appellant to produce. Mr Muir Wood suggested at the hearing before me that opening a single restaurant in the capital city of Spain was a reasonable strategy for a restaurant franchise looking to test the market for a possible expansion into the EU, rather than opening a whole series of restaurants across the EU at the same time. However, again there was no evidence before the Hearing Officer to support that assertion. Mr Muir Wood suggested that it was something I could take judicial notice of, but I note from a review of the transcript of the hearing before the Hearing Officer that that assertion was not put to her. I also note that the Appellant's Chief Financial Officer said in his statement *"My company's premises in Spain closed as of 1 January 2021, but my company is looking to open* ***further establishments in Spain shortly****"* (emphasis added). This did not necessary suggest a strategy of only opening one restaurant to test the market when the first restaurant had closed after about two years 18 months prior to the statement being signed. The Hearing Officer therefore cannot be criticized for not taking into account whether or not testing the market with one restaurant in Madrid reflected standard industry practice for restaurant franchises.

25. I therefore consider that the Hearing Officer's criticisms of the Appellant's evidence were fair, and that her conclusion that, taking the evidence as a whole, the Appellant had failed to show sufficient use to be warranted in the economic sector to create or maintain a share in the EU market for restaurant services, or for pizza restaurant services, was a conclusion that she was entitled to reach.

Conclusion

26. The Appellant has not identified any error of law or principle made by the Hearing Officer, nor was the Hearing Officer's consideration of the evidence rationally insupportable. Accordingly, the appeal fails and the Respondent's Mark may proceed to registration for the services set out in paragraph 5 above.

Costs

27. As the Appellant has been unsuccessful in its appeal, but the Respondent was not represented at the hearing before me and had not submitted a costs pro forma in respect of a claim for costs of considering the Appellant's Form TM55P, I make no order for costs in respect of the appeal. The Hearing Officer ordered the Appellant to pay the sum of £550 to Mr Ray in respect of the proceedings before her. I therefore order that the Appellant pay to the Respondent the sum of £550 within 21 days of the date of this decision.

Simon Clark
The Appointed Person
30 May 2025

Representation:

Appellant: Jamie Muir Wood instructed by Reddie & Grose LLP

Respondent: Not represented.