

O/0709/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3654493 BY SMASH PATTIES LTD FOR THE TRADE MARK



IN CLASS 43

AND THE OPPOSITION THERETO UNDER NO. 430847 BY SMASHBURGER IP HOLDER LLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF CLARE BOUCHER (O/419/23) DATED 5 MAY 2023

DECISION

Introduction

1. This is an appeal by Smash Patties Limited ("**Appellant**") from decision O/419/23 of Ms C. Boucher ("**Decision**") concerning the opposition by Smashburger IP Holder LLC ("**Respondent**") to application number 3654493 ("**Application**") for the mark shown below, filed by the Appellant on 11 June 2021 in respect of "Take-away fast food services" in class 43.



2. The Respondent relied upon a number of marks, but for the purposes of this appeal the only relevant mark is UKTM No. 3518954 ("**the 954 mark**"), filed on 4 August 2020 and registered on 20 November 2020 for SMASH in relation to "Carry-out restaurants; catering; restaurant and bar services; self service restaurants" in class 43.

3. In the Decision, C. Boucher for the Registrar held that the opposition was successful, and the Application was accordingly refused.
4. On 29 May 2023 the Appellant filed a Notice to Appeal to the Appointed Person against the Decision under Section 76 of the Trade Marks Act 1994.

The Hearing Officer's decision

5. The Hearing Officer held as follows (in summary, and insofar as is relevant to this appeal):
 - a. The Appellant's "Take-away fast food services" are highly similar to the Respondent's services;
 - b. The average consumer would be a member of the general public who would be paying a low to medium degree of attention;
 - c. The purchasing process would largely be visual;
 - d. The 954 mark has a medium degree of inherent distinctive character, which has not been shown to have been enhanced through use;
 - e. The Application is visually, aurally and conceptually similar to the 954 mark to a low degree;
 - f. The differences between the marks are too great for there to be a likelihood of direct confusion;
 - g. The word "SMASH" has a distinctive significance independent of the Application as a whole.
 - h. The average consumer is likely to believe that the Application is another mark of the Respondent's, such that there is a likelihood of indirect confusion.

Grounds of Appeal

6. In the Statement of Grounds of Appeal and its skeleton argument, the Appellant made a single criticism of the Decision, namely that contrary to the Hearing Officer's finding at paragraph 32, the word SMASH would be recognised by the average consumer as referring, or alluding, to a method of cooking burgers. Accordingly, the Hearing Officer should have found that the 954 mark is descriptive of the Respondent's services and therefore has a very low level of distinctiveness. Accordingly, there is no likelihood of confusion.
7. The Appellant's director, Mr Husain, expanded upon the above at the hearing. Mr Pescador, Trade Mark Attorney for the Respondent, sought in his skeleton argument to uphold the Hearing Officer's decision, and again expanded upon this in the hearing. I set out below further details of the parties' arguments as are necessary to understand my overall conclusions.

Standard of review

8. The approach to be adopted in an appeal hearing has been laid down a number of times in case law, both in general terms (e.g. by the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671) and specifically in relation to appeals before the Appointed Person (Daniel Alexander Q.C. sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17), approved by Arnold J in *Apple Inc. v Arcadia Trading Limited* [2017] EWHC 440 (Ch)). These cases establish the following principles:

- Appeals to the appointed person are by way of review, not re-hearing;
 - It is necessary for the appellant to satisfy the appeal tribunal that there was a distinct and material error of principle in the Hearing Officer’s decision, or that the Hearing Officer was wrong;
 - In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it;
 - 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;
 - Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice;
 - The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account.
9. In addition to the above, Mr Iain Purvis KC sitting as the Appointed Person in *ROCHESTER Trade Mark*, BL O/049/17, made the following observations at paragraph 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.”

10. I shall bear all the above in mind when reviewing the Decision.

Discussion

11. The Appellant contends that “smash” is the name of a type of burger which is cooked using a particular method in which a ball of mince-meat is smashed on a flat griddle.

12. In order to persuade a Hearing Officer that a term such as “smash” is descriptive, a party has in general two options. First, it can contend that the term is so well-known to the general public that the Hearing Officer can take judicial notice of the meaning, without the need for the party to file evidence. Secondly and alternatively, it can file evidence to support its contention that the average consumer would understand the word to be descriptive.

13. The Appellant did not contend, either before the Hearing Officer or in this Appeal, that judicial notice should be taken of the fact that “smash” refers to a type of burger. I consider he was right not to do so. The issue of when a Hearing Officer may take judicial notice of a fact has been reviewed by the Appointed Person a number of times, including by Daniel Alexander KC in *O2 Holdings Plc* [2011] RPC 22, paragraphs 39-52, Phillip Johnson in *Elvis Juice* O-048-18 paragraphs 12-18, and most recently by Iain Purvis KC in *Harley* O/168/22 paragraphs 8-25. The underlying requirement, as referred to by the Court of Appeal in *Perfetto SpA’s TM* [1999] EWCA Civ 1766, is that the fact must be “notorious” before judicial notice can be taken of it. The cases mentioned above give a flavour of the type of fact of which judicial notice may properly be taken:

- *O2 Holdings* – SIM cards are ubiquitous in mobile telephones and are often sold separately from the phones themselves;
- *Elvis Juice* - Elvis Presley was a very famous singer;
- *HARLEY* – Harley Street is famous for medical services.

14. In my view, the Appellant’s contention that the word “smash” is descriptive of a type of burger is simply not “notorious”, or well-known enough, for judicial notice to be taken of it. The Appellant states, in the Grounds of Appeal:

“I can understand why the technique of cooking called ‘Smash’ may not be known to a person deciding on the outcome of this dispute, as it is a relatively new method in terms of popularity, despite this type of burger having been invented over 60 years ago. Nevertheless, the term ‘Smash’ is widely used within the food industry describe the method and type of burger being cooked”.

15. That statement, it seems to me, would be fatal to any contention that judicial notice should be taken of the meaning of “smash”, as understood by the general public, in relation to burgers.

16. Accordingly, the only option open to the Appellant was to file evidence in support of his contention. I shall review that evidence, and the Hearing Officer's analysis of it, but first make a general observation. The 954 mark is validly registered, and its validity is not in contention in this dispute. Accordingly, there is a presumption of validity, and the 954 mark must be considered to have at least a minimum degree of inherent distinctiveness. The Hearing Officer held that it has a medium degree of inherent distinctive character. At best, therefore, the Appellant might hope to establish that it only has a low degree of inherent distinctiveness. The Appellant's contention that SMASH is not distinctive because it is wholly descriptive is not therefore an available outcome in this action.
17. The Appellant filed a witness statement including the following exhibits (the descriptions are taken from paragraph 31 of the Decision):
- An undated screenshot from amazon.co.uk showing a product described variously as a "grill press", a "smash burger press" and a "burger smasher for griddle and grill" (Exhibit 1);
 - An undated print-out from an unknown website that Mr Husain says belongs to a wholesale food supplier showing a product described as the "original smash burger" (Exhibit 2);
 - An article dated 28 May 2018 entitled "The art of the smash burger – of our best burger recipes" from the ourmodernkitchen.com website (Exhibit 3a); and
 - An undated print-out from the Tesco website containing a recipe for smash burgers (Exhibit 3b).
18. As the Hearing Officer rightly said at paragraph 32, the relevant date for assessment of the average consumer's understanding of the word "smash" is the filing date, 11 June 2021. The fact that three of the four exhibits were undated means that they cannot be taken into account in this regard, as the Appellant cannot establish a likelihood of them having come to the attention of the consumer in the UK by 11 June 2021. The Appellant, in his Grounds of Appeal, apologised for the failure to date the exhibits, stating that this was a consequence of him acting in person, having been unable to afford legal fees. Whereas that is perfectly understandable, it cannot obviate the need to file evidence capable of proving the facts in dispute. The Hearing Officer made no error of principle in deciding to take no account of the undated documents, and was not wrong to do so.
19. With regard to the single dated document, the Hearing Officer said at paragraph 32 "*as only the text has been provided I am not able to make any inferences about the likelihood of this having come to the attention of the consumer in the UK by the relevant date of 11 June 2021*". Again, I believe the Hearing Officer made no error of principle here – without information as to the ourmodernkitchen.com website and its traffic levels, the Hearing Officer had no way of knowing whether it is an obscure website with few visitors, or a mass-market website.
20. I would further add that even had Exhibit 2 been dated, it would have been unlikely to assist the Appellant, because it is said to be a website of a wholesale food supplier. Such a website is not aimed at the general public, and therefore cannot provide evidence of the general public's understanding of the word "smash".
21. The Appellant drew the Hearing Officer's attention to a number of other trade marks containing the word "SMASH" that are registered for services in Class 43. The Hearing Officer cited, at

paragraph 55, the following passage from the General Court's decision in *Zero Industry Srl v OHIM*, Case T-400/06:

"As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned".

22. The Hearing Officer concluded, at paragraph 56, that *"This "state of the register" evidence has no bearing on the decision I must make"*. The Hearing Officer made no error of principle here, because, as explained by the General Court above the mere fact of words being incorporated in registered marks gives no indication as to the actual usage of those marks in the market.
23. Finally, the Appellant submitted details of three other companies using the word "SMASH", being Smash Burger London, Super Smash – Leicester, and Smash Bros Burgers. However, all three print-outs are undated, and the Hearing Officer again dismissed the argument on the grounds that so there is no evidence that these names were being used on the market at the relevant date. Once again, the Hearing Officer made no error of principle in this regard.
24. In summary, therefore, the Appellant did not discharge the burden of proof, which lay on it, to show that the word "smash" is descriptive of a type of burger. The Hearing Officer was entitled to conclude that the word "smash" has a medium degree of inherent distinctive character. The remainder of her reasoning is not challenged, and accordingly her overall conclusion that there is a likelihood of indirect confusion must stand.

Conclusion

25. The appeal is dismissed, and the Application is therefore refused.

Costs

26. Clearly, the Respondent has been the successful party in this appeal. I order that the Appellant should pay the Respondent £1,200 by way of costs of this appeal, comprising:
 - Preparation of skeleton argument: £600
 - Attendance at hearing: £600.
27. That is in addition to the £1,850 costs awarded to the Respondent by the Hearing Officer. The total costs award to the Respondent is accordingly £3,050.

Dr. Brian Whitehead

22 July 2023

Representation

Imran Husain, director, for the Applicant / Appellant

Mr Roberto Pescador, Trade Mark Attorney with Bird & Bird LLP for the Opponent / Respondent