

**TRADE MARKS ACT 1994  
IN THE MATTER OF TRADE MARK REGISTRATION NO. UK00003567801 IN  
THE NAME OF ADFIL LIMITED  
AND IN THE APPLIATION FOR INVALIDITY THRETO UNDER NO. 504260 BY  
FIBRE CONCRETE SOLUTIONS**

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**DECISION**

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**Introduction**

1. This is an appeal against the decision of Arran Cooper, acting on behalf of the Registrar of Trade Marks, dated 3 November 2022 (O-959-22)(“*the Decision*”) in which the application for invalidity brought by Fibre Concrete Solutions (“*the applicant*”) against the above registration in the name of Adfil Limited (“*the proprietor*”) was rejected.

**Background**

2. The proprietor is the registered proprietor of the Trade Mark No. UK00003567801 for the word mark ZENITH registered with respect to a variety of different goods in classes 9, 17, and 19 (“*the contested mark*”). The contested mark was filed on 20 December 2020, was registered in 7 May 2021 and has a priority date of 7 August 2020.
3. On 1 October 2021 the application filed an application for invalidity under section 47 of the Trade Marks Act 1994 (“*the 1994 Act*”) in respect of all the goods for which the contested mark was registered. The single ground of invalidity was section 5(4)(a) of the 1994 on the basis of the use of the unregistered sign ‘Zenith’ which the applicant claimed to have used throughout the UK since 14 April 2020 for ‘*steel fibre reinforced concrete products*’.
4. The proprietor filed a counterstatement denying all the claims made.
5. Both parties filed evidence.
6. A hearing took place via video conference at which Mr Rupert Beloff of Kings Chambers instructed by BRM Law Limited represented the applicant; and Ms Jacqueline Reid instructed by Haseltine Lake Kempner LLP represented the Proprietor.
7. In the Decision the Hearing Officer rejected the application for invalidity on the basis that the applicant had ‘*failed to demonstrate that its sign enjoyed a protectable goodwill across the UK as at the relevant date*’ (paragraph [39] of the Decision).

## **The appeal**

8. On 30 November 2022 a Notice of Appeal to the Appointed Person on Form TM55P was filed on behalf of the applicant in accordance with the 1994 Act.
9. There is no suggestion in the Grounds of Appeal filed by the applicant that the Hearing Officer misidentified the legal principles that were applicable to the application for invalidity or that he had failed to identify the correct date for the determination of whether it had a protectable goodwill.
10. The Grounds of Appeal were instead directed to the suggestion that the Hearing Officer had '*not properly and fully considered the evidence that was before [him]*'. A number of respects in which it was said that this was the case were given.
11. On 23 December 2022 a Respondent's Notice was filed on behalf of the proprietor. In the Respondent's Notice the proprietor maintained that the Decision should be upheld for the reasons given by the Hearing Officer below. Six additional reasons why the Decision should be upheld were also put forward.
12. At the hearing of the appeal which took place via video conference Mr J R Gale instructed by BRM Law Limited represented the applicant; and Mr Michael Conway of Haseltine Lake Kempner LLP represented the Proprietor. Both representatives filed written arguments in advance of the hearing.

## **The standard of review**

13. An appeal against decisions taken by the Registrar 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. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].
14. Sir Anthony Mann in Stitch Editing Limited v. TikTok Information Technologies Ltd [2023] EWHC 1167 (Ch) conveniently summarised the approach in cases such as the present 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."*

15. I shall keep these principles firmly in mind when considering the present appeal.

### **Decision**

16. The gravamen of the applicant's position on this appeal was contained in paragraph 11 of the skeleton argument filed on its behalf which stated '*. . . the Hearing Officer's decision was wrong in that it did not properly and fully consider the evidence before it, placing too much emphasis on the need to evidence actual sales under its name, and failed to take into account marketing in circumstances where the product was directed to a limited number of trade customers.*'
17. In support of this submission particular reliance was placed on the fact that the Hearing Officer had disregarded or not given appropriate weight to a certificate issued in Bratislava (Slovakia<sup>1</sup>) which was said to be a pre-requisite to obtaining *inter alia* the relevant certification in the UK; and certain online articles and materials which it was said demonstrated '*evidence of actual goodwill in the UK which the applicant had accrued*'.
18. As was suggested in paragraph 11 of the skeleton argument referred to above and which was expressly confirmed in the course of the hearing before me **no** relevant sales of the product under the name ZENITH had occurred in the UK prior to the relevant date.
19. In this connection, it is necessary to keep in mind that, as the Hearing Officer himself correctly observed in paragraph [28] of his Decision, the goods relied upon by the applicant in these proceedings are '*steel fibre reinforced concrete products*'.
20. Further, I note that before the Hearing Officer went on to address the evidence filed in support of a claim to goodwill in the UK the Hearing Officer made clear his approach stating in paragraph [27] of his Decision that:

At the hearing, the applicant's representative argued that while each piece of evidence on its own may not point to a protectable level of goodwill, the evidential picture as a whole is clear in that it does satisfy the requirements of there being goodwill in the applicant's sign. To confirm, I agree that it is necessary to look at the evidential picture as a whole rather than focus on individual pieces of evidence. However, in order to make such an assessment of the whole, I must consider each item of evidence individually. During the hearing, both parties

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<sup>1</sup> The Hearing Officer refers in his Decision to Slovenia rather than Slovakia. I understand that this is an error that neither side regarded this as a material error.

presented arguments as to their position in respect of the evidence provided. I do not intend to reproduce those submissions in full but will, if necessary, refer to specific points below. For the avoidance of doubt, I confirm that I have given the evidence and submissions full consideration in making my decision.

21. With respect to the individual pieces of evidence that were before the Hearing Officer, including in particular the specific pieces of evidence relied upon for the purposes of the appeal, it is not suggested by the applicant that the Hearing Officer did not refer to the evidence in his Decision. That must be correct. It is clear that the Hearing Officer carefully went through the evidence in paragraphs [28] to [38] of his Decision.
22. Instead, what is said is that the Hearing Officer '*focussed too strongly on finding direct evidence of trading activities under the name [ZENITH]*' rather than considering '*whether the Applicant had a business in the UK and then considering whether the reputation in the name ZENITH had attached to that business*'. In this connection the applicant relied upon the judgment in Plenty of Fish Media v. Plenty More LLP [2011] EWHC 2568; [2012] RPC 5 which was referred to by the Hearing Officer in footnote 16 of the Decision.
23. I do not consider, even if the distinction which the applicant seeks to draw is a valid, that on the basis of the findings in the present case that this is a criticism that can properly be made given the way in which the Hearing Officer set out his conclusions in paragraphs [39] and [40] of the Decision (emphasis added):

39. I have set out above that it is necessary to look at the evidential picture as a whole. In doing so, **I am not satisfied that the applicant has provided anything sufficiently solid that demonstrates any level of trading activities in the UK for the goods it claims to have used its sign for.** I have set out above my issues with each specific piece of evidence and even taking them all together, I am unable to conclude that, collectively, they are sufficient to satisfy the requirements in determining the existence of a protectable level of goodwill. I accept that the evidence points to the existence of a brand called 'Zenith' under the applicant's umbrella of operations. **However, it is my view that there is simply nothing further provided to demonstrate that the applicant has undertaken any trading activities under its 'Zenith' sign whatsoever, let alone to a point that would attract a protectable level goodwill in the business, regardless of whether the applicant's sign would be distinctive of or associated with that goodwill or not.** Lastly, I refer to the case law cited above which sets out that evidence of goodwill comes primarily from the trade and the public, will be supported by evidence of the extent of use and, to be useful, must be directed to the relevant date. In the present case, these requirements have simply not

been met. None of the evidence is focused on the trade undertaken by the applicant, neither does it address the public targeted or the extent of the use and, finally, it is not directed at the relevant date, with much of the evidence coming after or lacking specificity in that it makes vague references of figures 'to date'. As a result, the applicant has failed to demonstrate that its sign enjoyed a protectable level of goodwill across the UK as at the relevant date. Therefore, the applicant's reliance upon section 5(4)(a) of the Act fails in its entirety.

40. For the sake of completeness, I wish to address the issue raised by the proprietor's representative at the hearing regarding the specific goods relied upon and the goods that the evidence points to. In short, the proprietor's position is that the goods shown in the evidence are not the goods relied upon in these proceedings. While these submissions are noted, **I am of the view that regardless of what specific goods have been demonstrated in the evidence, the evidence is not sufficient to demonstrate a protectable level of goodwill** and, therefore, it is not necessary for me to consider the nature of the goods relied on against the goods discussed by the applicant in its evidence.

24. Further it seems to me that against this background that, if the points raised by the applicant were to be considered afresh by me, then as stated by Geoffrey Hobbs QC sitting as the Appointed Person in NICO LONDON Trade Mark (O-338-20) at paragraph [36]:

. . . the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.

25. Nonetheless, I have reviewed the Decision in the light of the alternatives put forward by the applicant with respect to the pieces of evidence upon which it places significance. Having done so I am satisfied that none of the points relied upon reveal any errors on the part of the Hearing Officer which taken either individually or together establish that the conclusion he reached is one that is vitiated by error. Rather it is one that it seems to me that it was open to the Hearing Officer to reach for the reasons that he gave.
26. In the circumstances the appeal against the finding that there was a protectable goodwill for the purposes of a section 5(4)(a) ground of invalidity is rejected.

27. Given my view on the above it is not necessary to comment specifically on the additional grounds for upholding the Hearing Officer's decision set out in the Respondent's Notice

**Conclusion**

28. For the reasons set out above it does not seem to me that the applicant has identified any error of principle or material error in the Hearing Officer's Decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the decision that he did. In the result the appeal fails and is dismissed.
29. Since the appeal has been dismissed the proprietor is entitled to a contribution towards its costs. I will therefore make an order that the applicant pay to the proprietor a contribution of £1,000 towards its costs of the appeal. These are additional to the order made by the Hearing Officer below in which he ordered the applicant to pay to the proprietor a contribution of £1,200 with respect to its costs.
30. In those circumstances I order Fibre Concrete Solutions to pay to Adfil Limited the sum of £2,200 on or before 4 pm on 22 September 2023.

Emma Himsworth KC

Appointed Person

25 August 2023