<u>BL O/0870/23</u>

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3651209
PUMA
IN THE NAME OF DN SOLUTIONS CO., LTD
(FORMERLY DOOSAN MACHINE TOOLS CO., LTD)

AND IN THE MATTER OF OPPOSITION No. 428006 IN THE NAME OF PUMA SE

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF
MR MATTHEW WILLIAMS DATED 25 JANUARY 2023

DECISION

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1. This is an appeal from the decision of Matthew Williams (the "Hearing Officer"), BL O/0077/23, dated 25 January 2023, in which he rejected in its entirety an opposition by Puma SE ("the Opponent") against an application to register a slightly stylised mark PUMA. The application was filed in the name of Doosan Machine Tools Co., Ltd, which has changed its name to DN Solutions Co., Ltd ("the Applicant"). The Opponent appeals to the Appointed Person.

2. The application was filed pursuant to the Withdrawal Agreement on 4 June 2021 and claimed a priority date of 27 November 2012 from an EUTM. The Applicant sought to register the mark set out below for the following goods in class 7: "Lathes; CNC (computer numerical control) lathes; machining centers; turning center; electric discharge machine."

PUMA

3. The Opponent filed its opposition based upon three grounds and three earlier marks, all of which were subject to proof of use. It filed evidence of use, which it later decided to withdraw, and restricted its opposition to reliance upon only s 5(2)(b) and its earlier mark, IR 582886, which consists of the following combination mark:

4. The earlier mark is registered for a broad range of goods in Class 9. Mr Edenborough KC, who appeared for the Applicant on the appeal, pointed out that the Hearing Office referred in paragraph 7 of his Decision to the earlier mark being registered for “safety and protective clothing” and “measuring devices, apparatus and instruments,” but the wording of the Opponent’s specification was a little different (see Annex A below), and the goods relied upon by the Opponent were more precisely “measuring, signaling, monitoring, emergency and teaching apparatus and instruments” and “clothing for protection against accidents.” I do not consider that this wording makes any real difference to the points I must resolve on this appeal, especially as the introductory phrase of the specification refers in broad terms to “physical, optical and photographic … devices”.

5. An oral hearing was held on 9 November 2022. As I have said, there was no evidence before the Hearing Officer. Both sides were professionally represented before the Hearing Officer, the Applicant by Mr Edenborough KC, who also appeared on the appeal, and the Opponent by Mr Daniel Bailey of Appleyard Lees. On the appeal, the Opponent was represented by Mr Chris Hoole, also of Appleyard Lees.

6. The Hearing Officer found:

6.1 the marks were highly similar overall,

6.2 it was not self-evident that the parties' goods were similar and although the Opponent had been put on notice that the Applicant denied the claimed similarity of goods, it had filed no evidence to prove similarity,

6.3 there were differences between the physical nature, intended purposes and methods of use of the goods, and they were not in competition with each other,

6.4 he concluded that the goods were not similar,

6.5 for completeness, he considered the position had he found a degree of similarity between the goods, but even doing so, he found no likelihood of confusion.

7. The Opponent appealed, and it was common ground that there was really just a single point in the appeal, which Mr Hoole described as a point of both law and fact, namely: did the Hearing Officer fail to make a proper assessment of the similarity between the Applicant's goods in Class 7 and the Opponent's measuring devices in Class 9? The Opponent said that he had so erred, that the goods are self-evidently similar, and that the Hearing Officer ought to have found a likelihood of confusion. The Applicant said that he was entitled to reach the conclusions he did, but also filed a Respondent's Notice, suggesting additional reasons why the Hearing Officer's conclusions were correct. Although the Grounds of Appeal included references to the Opponent's "safety and protective clothing," the Opponent made no arguments on the appeal based upon those goods.

Standard of appeal

8. It was common ground that this appeal is by way of review, it is not a rehearing. The relevant principles were not in dispute. 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 the appellate tribunal 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].

9. The principles have been summarised in a number of recent trade mark appeals, such as by Sir Anthony Mann in Stitch *Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch) 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.
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> > "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.
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> > 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.
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> > 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.
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> > 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.
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> > 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.""

10. I have kept these principles in mind when considering the present appeal.

Merits of the appeal

11. It is necessary to set out some of the central parts of the decision. At paragraphs 26 to 27, the Hearing Officer set out his understanding of the nature of the Applicant's goods:

"26. On a quick search of the internet for a description of what is a *lathe*, I note that it is a powered machine tool that rotates a workpiece about an axis of rotation to perform various operations such as spraying or cutting, sanding, drilling, and turning, with tools that are applied to the workpiece to create an

object with symmetry about that axis. Lathes are used for instance in woodturning, metalworking and glass-working. This matches both my own understanding of those goods and the submission by the Opponent in its skeleton argument that the Applicant's Goods "are tools for cutting, shaping and machining wood, metal and other materials."

27. Although not addressed in the papers or at the hearing, I understand – again from consulting Google - that a *machining center* is a computer-controlled machine tool that can perform different operations like milling, boring, and drilling, quickly and accurately. It consists of an automatic tool-changing mechanism that enables it to use multiple cutting tools during the machining process. Google also informs me that *turning centers* and lathe machinery look much the same, but the terms usually refer to slightly different machine tools. Lathes can usually only turn on two axes, while turning centers can be more advanced. I learn (from Wikipedia) that *electrical discharge machining* is also known as spark machining, spark eroding, wire burning or wire erosion. It is a metal fabrication process whereby a desired shape is obtained by using electrical discharges (sparks) to remove material from the work piece by a series of rapidly recurring current discharges between two electrodes.

28. All of this aligns with the Opponent's general description of the Applicant's Goods and with Mr Edenborough's references at the oral hearing to the Applicant's Goods being central to a fabrication technique that removes layers of material to create the desired shape - a subtractive manufacturing process."

12. At paragraph 29, the Hearing Officer set out the Opponent's arguments as to the similarity of the parties' respective goods. Those arguments were substantially the same as those made on the appeal. The Opponent argued that there is self-evidently a close connection between the goods, because the users of the Opponent's goods would need to use measuring devices and both parties' goods would be sold through the same trade channels and have the same users. The Hearing Officer went on at paragraph 30 to cite from the decision of Mr Hobbs KC in *Raleigh International Trade Mark* [2001] RPC 11 at paragraph 20, where he said (inter alia) "If the goods or services

specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered, the objection should be supported by evidence as to their "similarity" ….”

13. The Hearing Officer went on:

> “31. Mr Edenborough described as “hollow assertion” the Opponent’s claimed similarity of goods, and noted that the Opponent adduced no evidence to support its allegations that the respective goods are sold through the same trade channels, have the same customer base, are complementary and originate from the same undertakings. It ought to have been straightforward for the Opponent to file evidence to substantiate its claims. I agree. This is significant not only because the goods are not self-evidentially similar, but also because the Opponent had been put on notice that the Applicant denied the claimed similarity (for instance in the submissions filed during the evidence rounds).
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> 32. At the hearing Mr Bailey invited me to consider, for instance, a consumer visiting a store such as *B&Q* or *Homebase* in order to buy a lathe, perhaps as a hobbyist wood-worker. Conscious of the risk of injury in operating machinery, the consumer might, Mr Bailey submitted, seek also to buy protective clothing and may also purchase calipers to assist with accurate measuring and that such goods would “be sold in close proximity to” the lathes. Firstly, I am not satisfied that the respective goods are sold on shelves alongside one another (as the case law anticipates). If that were so, then it would have been straightforward to show that in evidence. Secondly, a hardware store might sell a wide range of goods – from drill bits to ladders and even bird seed to padlocks. It is not, in my view, a sufficient premise for finding of similarity that the goods may be sold in a hardware store. There is, anyway, no evidence on the point.
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> 33. … There is no evidence on trade channels at all – whether as to origin or market outlets. I do not accept therefore that the goods are complementary as described in case law, since even if protective clothing or measuring instruments were considered to be important for the use of the Applicant’s Goods, I do not find that the connection between the goods is close such that customers would think that the responsibility for those goods lies with the same undertaking.

34. Likewise, it has not been shown in evidence that the goods have the same users. What is clear is that the goods are different in their physical nature, intended purposes and methods of use and do not compete with one another as alternative goods. These clear points strongly weigh against a finding of similarity. Coupled with the lack of evidence to substantiate the claimed similarity - despite there being no obvious or self-evident similarity, and despite that point having specifically been contested by the Applicant - **my primary conclusion is that the goods are not similar**."

14. Having made that primary finding, the Hearing Officer said at paragraph 36 that there was no likelihood of confusion. Nevertheless, for the sake of completeness, he went on to consider the alternative position on the basis that there is a degree of similarity between the goods. He described this further in paragraph 52 "any such similarity is in my view very low given the significant factors against similarity (nature, purpose, the method of use, non-competitive, and not shown to be complementary nor to be sold alongside each other, nor to share manufacturers or channels of trade)."

15. His central findings on that alternative basis were:

a) that the strongest factor contributing to similarity would be the potential for shared users;

b) but the "most generous construction" would afford the goods only a very low degree of similarity;

c) the level of attention for purchasing the Applicant's goods would be relatively high, whilst the level of attention for the Opponent's goods might be vary, factoring in that some of them would be relatively mundane purchases;

d) the earlier mark was inherently highly distinctive and the marks were strongly similar;

e) the similarity of the marks was not sufficient in a multifactorial assessment to offset a very low degree of similarity in goods; and

f) there was no likelihood of confusion, direct or indirect.

16. As I have said, the major point taken on the appeal was that the Hearing Officer was wrong not to find the goods self-evidently similar, whether because they would have shared users or trade channels, or because they were complementary. Mr Hoole submitted that it is self-evidently the case that anyone using a lathe would need some form of measuring device, perhaps in the form of calipers, in order to ensure that the end product was the right size and shape, *or, if necessary*, symmetrical. In making that argument, the Opponent criticised not just the reasoning in [31]-[34], but also some of the Hearing Officer's findings which I have summarised in paragraph 15 above.

17. The Opponent's central argument before me was that the average user would be bound to use a form of measuring device with a lathe, meaning that the measuring devices and lathes are complementary goods. Mr Hoole went further and told me that more sophisticated lathes and the machining centers in the Applicant's specification may well have a measuring device built into them. He submitted that those facts are self-evident, so that the Opponent did not need to provide evidence substantiating what he told me (and what Mr Bailey had told the Hearing Officer) on this point so as to prove complementarity. The Hearing Officer dismissed this argument for the reasons he gave in [33] Decision.

18. The difficulty the Opponent faces, it seems to me, is that the Hearing Officer did *not* think it self-evident that the goods are indispensable and so complementary. That submission sounds perfectly reasonable, but that is not the same as being self-evident to the extent that no evidence is needed to support it, and the position is in any event more complicated, given that the Applicant's specification includes what appear to be more sophisticated machines than just lathes. The Hearing Officer had mentioned the proper test for complementarity at [25] Decision, that is to say, that the goods must be indispensable or important for the use of the other. He carried that through into his reasoning at [33]. In the absence of any evidence as to how measuring device are indispensable/important to the use of such machinery, I do not think that he can be said to have erred in that conclusion.

19. The Opponent also suggested that it was self-evident that the parties' respective goods were similar because they would be sold through the same trade channels. The Hearing Officer dealt with that point in the second part of [32] Decision. He dismissed the submission that the fact that both parties' goods might be sold in a hardware store was sufficient to demonstrate similarity, given the very wide range of goods such stores may carry. In the absence of any other evidence as to how such goods might be sold, I do not think that he can be said to have erred in that conclusion.

20. In my judgment, it was open to the Hearing Officer to find that the Opponent needed to prove its case on complementarity, and could not simply assert it. Equally, the Hearing Officer was entitled to find that the trade channels point (whether in terms of origin of the goods or outlets) needed to be supported with evidence. No appealable error has been identified and the appeal on this point must fail.

21. At the hearing of the appeal, Mr Hoole argued that the Hearing Officer had also erred in having carried out his own internet searches (as described in [26]-[27] of the Decision), pointing out that it was not clear exactly what searches had been carried out nor clear why, if the Hearing Officer was in doubt about the complementary nature of the goods, he had not carried out further searches. It seems to me that the Hearing Officer was essentially using the internet searches which he describes in those paragraphs to find a dictionary definition of a lathe and a machining center, to confirm his own understanding of those terms. In my view, had he gone any further in his internet research, he would have fallen into the trap of providing evidence of similarity on the Opponent's behalf which it had failed to provide despite knowing that the Applicant disputed the similarity of the goods. Furthermore, it does not seem to me that the Opponent is in a position to complain on this appeal about the Hearing Officer's internet searches, as this is a point which is not, in my view, raised even tangentially in the Grounds of Appeal.

22. It seems to me that in the circumstances the Hearing Officer's findings on the alternative notional basis are of no relevance, because the appeal would in any event fail. I am satisfied that in assessing the Hearing Officer's primary findings, it is not

appropriate to take into account any of the points the second part of the Decision which the Opponent says were wrong. The Hearing Officer's reasoning in [37] onwards of the Decision was predicated on the notional basis that the goods had some level of similarity. I do not see how the views he expressed in that part of his decision may be taken as demonstrating that he erred in his primary finding that there was no similarity at all between the goods, which was fully set out in the passages I have identified above.

23. In the circumstances, it is not necessary for me to consider the points raised in the Respondent's Notice.

24. The appeal will be dismissed, and the Opponent must pay a contribution to the Applicant's costs. I will order the Opponent to pay costs of the appeal in the sum of £1500 to be paid together with the costs awarded by the Hearing Officer by 4 pm on 5 October 2023.

Amanda Michaels
The Appointed Person

14 September 2023

ANNEX A: the specification of the earlier mark 582886

Class 9 Physical, chemical, optical, photographic apparatus, devices and instruments (included in this class); **measuring**, signaling, monitoring, emergency and teaching **apparatus and instruments**, apparatus and instruments for recording, transmitting and reproducing sound and images; media with sound and/or image recording; magnetic recording media; sound recording disks; automatic vending machines and mechanisms for coin-operated apparatus; cash registers, calculating machines, pocket calculators, data processing equipment and computers; fire extinguishers; measuring, signaling and regulating apparatus and devices used for measurements taken in sports medicine as well as for measurements taken during sports events; teaching apparatus and instruments used in the field of sports medicine; spectacles,

spectacle lenses and spectacle frames, contact lenses, ergometric devices in the form stationary bicycles, stationary rowing machines, wrist ergometers, ergometers for use in weightlifting and ergometers for running tracks or belts, also with calculators or computers, contact and signaling devices in the form of indications and signs fashioned by means of a needle or by digital electronic indications, with input signal generators and memories, also with connections to different signal generators used in human medicine; calculators and ergometers used for processing signals from the aforesaid instruments and devices, with electronic chronometers, also with daily performance meters; pedometers particularly for verification and determination of runner performance, altimeters, odometers, measuring devices for geographical maps, anemometers, directional compasses, binoculars, telescopes;, including footwear, special clothing used for rescue, workmen's protective faceshields, protective eyewear and masks for workers; helmets, including protective helmets for motorcyclists and cyclists; special containers (covers, sheaths, cases) adapted to the apparatus and instruments included in this class; signaling whistles, including dog whistles; vehicle breakdown warning triangles; breathing apparatus for underwater swimming, swimming belts and floats for swimming; angle meters and protractors (measuring instruments); timers (time switches); entertainment apparatus as complementary apparatus for television receivers; bags used for storing photographic equipment and bags for photographic reporters (included in this class).