O/092/20

TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NO 3408139
CRICKET COACHING MAT
FOR SERVICES IN CLASS 41

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE OPPONENT
FROM THE DECISION OF MR MARK JEFFERISS
DATED 19 SEPTEMBER 2019

DECISION

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1. This is an appeal by the Applicant, Mr Andrew Emery, from the decision of Mark Jefferiss on behalf of the Registrar dated 19 September 2019 following an *ex parte* hearing on 17 September 2019.

Background

2. Mr Emery has acted in person throughout the application process. He applied on 20 June 2019 to register the words CRICKET COACHING MAT as a trade mark for the following services in Class 41: sports tuition, coaching and instruction.

3. An initial examination report dated 25 June 2019 refused the application on absolute grounds, on the basis that there was an objection under sub-sections 3(1)(b) and (c) because "the mark consists exclusively of a sign which may serve in trade to designate the kind of services provided e.g. Sports tuition, coaching and instruction, incorporating the use of a cricket coaching mat."

4. Correspondence followed between Mr Emery and the IPO, and the objection was maintained in a letter of 16 July 2019. In that letter, Mr Emery was told of his right to request a hearing. He sent an immediate response, including links to webpages which he explained provided evidence that he had registered a design for his Cricket Coaching Mat in 1996. The Hearing Officer said that he had looked at the links and maintained his refusal. A letter of 17 July maintained the objection, and informed Mr Emery of his right to request a hearing, which he did. That took place by telephone on 17 September 2019.

5. A Hearing Report was sent out to Mr Emery under cover of a letter dated 19 September 2019. This set out the Hearing Officer's reasons for maintaining the refusal under sub-sections 3(1)(b) and (c):

> "I explained that … a trade mark must be distinctive and distinguish the goods/services of one trader from those of another. Whilst I fully accept that the idea may be novel, that does not necessarily equate to distinctiveness. By way of example I referred to the "Oven Chips" case which confirmed this.
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> A trade mark must contain a distinctive element and in my opinion the mark is purely descriptive of a mat used in cricket coaching. …
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> I must consider the mark in the eyes of the average consumer in connection with the services being offered. Whilst I accept that "cricket" for example, can refer to an insect, it is highly unlikely to be viewed as such when an average consumer is considering tuition services in cricket (the game). There is also the "Doublemint" case which confirms that even though a word may have a number of meanings, if one is descriptive then an objection is appropriate.
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> We discussed the possibility of Mr Emery submitting evidence of acquired distinctiveness, but he advised that he would not be in a position to do so."

6. The Hearing Officer also mentioned that Mr Emery had referred him to his website but he had had difficulty accessing it. The Hearing Officer indicated that he had conducted further research following the hearing (the details of which were not set out in the report) but maintained his objections on this basis:

"The mark consists of three words, which, in my opinion, the average consumer would view as merely describing cricket coaching which incorporates the use of a mat."

7. The covering letter of 19 September informed Mr Emery of his right to appeal the decision or to request a statement of grounds. The letter explained that such a request must be made by sending a Form TM5 “Request for a statement of reasons for Registrar's decision.” It seems that Mr Emery did not receive the letter of the 19 September and a further copy was sent to him by email on 29 October. He responded by an email dated 1 November, criticising the decision and saying “This perverse decision should be overturned. I have not received an appropriate written explanation for the refusal of the trade mark application. I wish to complain in this regard. " The Hearing Officer wrote on 4 November extending the time for lodging an appeal or for Mr Emery to request a statement of grounds if he wished to appeal the decision. No Form TM5 was filed seeking a statement of grounds, but Mr Emery filed a Form TM 55 appealing the decision of 19 September. As a result, the only explanation for the Hearing Officer's decision to refuse the trade mark application is that given in the Hearing Report of 19 September. Rather fuller reasoning was set out in the skeleton argument filed on behalf of the UKIPO for the appeal, explaining the basis of the objection, but plainly I must decide the appeal on the basis of what was in the Hearing Report.

8. The appeal was heard by telephone. Mr Emery attended in person and the Registrar was represented by Ms Rees.

Standard of appeal

9. The standard of appeal 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. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC

sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that

> "… 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 (*REEF*, *BUD*, *Fine & Country* and others)."

10. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

> "78. … Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant* , *In re Reef Trade Mark [*2002] EWCA Civ 763; [2003] RPC 5 , paras 25-28 per Robert Walker LJ.
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> …
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> 80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can

> legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible. …
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> 81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge's assessment of obviousness if the appellate court were to reach the view that the judge's conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong …"

I have borne these principles in mind in deciding this appeal.

The appeal

11. The Grounds of Appeal set out in the TM55 are brief. I can summarise Mr Emery's points as follows:

    (a) A mat is an inanimate object like a floor covering, the Cricket Coaching Mat guides through peripheral vision and is not the same as coaching which involves instruction or pedagogy;

    (b) There was no evidence that consumers would understand the meaning of the term in the manner suggested by the Hearing Officer. It is not descriptive.

    (c) The sign has been used as a trade mark since 1995 and belongs to the applicant.

12. Those points were reiterated in a number of documents sent by Mr Emery to the IPO and provided to me in advance of the appeal. Mr Emery pointed out that he had used the expression Cricket Coaching Mat since April 1996 at which point he had registered a design for the mat. He emphasised the numerous different combinations three separate words can make, which he suggested made his mark distinctive. He also suggested that the expression 'Cricket Coaching Mat' might have a whole range of different meanings, depending on context.

13. Sub-section 3(1) of the 1994 Act provides that the following shall not be registered –

"(a) …

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or any other characteristic of goods or services,

…

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b),(c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it."

14. Mr Emery told me on the appeal that he had registered a design under the name 'Cricket Coaching Mat' for a pattern on a floor covering, and it was that which he wished to register as his trade mark. In an email of 16 January he pointed out that "It is not possible for a simple pattern on a floor covering to deliver coaching, thus rendering this word both random and pseudo in relation to this trade mark application."

15. One of the main points made by Mr Emery in his written submissions and orally at the appeal was to the effect that "the trade mark applies only to the pattern on the floor covering." That point unfortunately reflects a lack of understanding on Mr Emery's part of the nature of the trade mark application which he made. The question of whether the mark is descriptive or has sufficient distinctive character to qualify for registration as a trade mark must be tested in relation to the goods or services for which registration is sought. In this case, the application is for a word mark and the specification is for the particular services in Class 41. The application has nothing to do with either the pattern of Mr Emery's mat design, or with mats (as goods) or sporting goods of any kind. If Mr Emery is suggesting that the Hearing Officer erred in his assessment of the distinctive character of the trade mark because he should have considered this in the context of a pattern on a floor covering, I cannot accept that argument. On the contrary, the Hearing Officer was right to consider the application

in the way that he did, that is to say in relation only to the sports tuition, coaching and instruction services in Class 41.

16. That last point also deals, in my judgment, with the point Mr Emery made about the phrase 'Cricket Coaching Mat' potentially having a range of different meanings, depending on context. He argued that the Hearing Officer had erred because the phrase 'Cricket Coaching Mat' could have a variety of meanings to the average consumer, so it was not descriptive or lacking distinctiveness. What he said to me was that "the words are certainly distinctive because there are three of them. The combinations for three separate words are infinite but they have also been interpreted as being descriptive. Like I say, that is a false interpretation because a coaching mat cannot coach."

17. The difficulty with that submission is again that the application has to be assessed for distinctiveness etc in context, and the context here requires consideration of the potential normal and fair use of the mark in relation only to sports tuition, coaching and instruction services in Class 41. That was the approach taken by the Hearing Officer, following the guidance of the CJEU in Case 421/04, *Matratzen Concord AG v Hukla Germany SA* [2006] ETMR 48 at [24]:

> " … to assess whether a national trade mark is devoid of distinctive character or is descriptive of the goods or services in respect of which its registration is sought, it is necessary to take into account the perception of the relevant parties, that is to say in trade and or amongst average consumers of the said goods or services, reasonably well-informed and reasonably observant and circumspect, in the territory in respect of which registration is applied for …"

18. I can therefore discern no error in the approach taken by the Hearing Officer in considering the impact of the mark upon the average consumer of those services, namely to say that the sign designates a characteristic of the services, and would be perceived as describing cricket coaching which incorporates the use of a coaching mat as a coaching aid.

19. As to Mr Emery's third line of argument, a sub-section 3(1) objection applies whether the mark is being used, or is capable of being used, descriptively. See Case C-191/01 P *OHIM v WM Wrigley JR Company* '*Doublemint*' [2004] R.P.C. 18 at [32]:

> " …it is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provisions itself indicates, that such signs and indications could be used for such purposes. A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned."

In my view it was open to the Hearing Officer to conclude that the mark was descriptive and/or not inherently distinctive. Whether or not Mr Emery was the first person to use that phrase, and whether or not the phrase had been or is now used by others, was irrelevant.

20. Mr Emery also argued that the Hearing Officer ought to have taken into account the fact that he had registered his design in 1996 and used it since 1995. Mr Emery is of course right that the proviso to sub-sections 3(1)(b) and (c) may permit the registration of marks which are inherently descriptive or non-distinctive where distinctiveness has been acquired through use. However, Mr Emery had not provided any evidence of acquired distinctiveness. Mr Emery had provided some links to webpages which he said would be of help, but it was plain throughout that the Hearing Officer had not found that to be sufficient. The hearing report records that the Hearing Officer discussed with Mr Emery on 17 September the possibility that he might submit evidence of acquired distinctiveness, but Mr Emery said that he would not be able to do that. It must therefore have been plain from the discussion at the hearing that further evidence would be required to overcome the Hearing Officer's objections, but no such evidence had been filed and no application was made to file any. As a result, whatever use had been made of the trade mark by Mr Emery - and from a number of comments which he made at the hearing of the appeal, it seems to me that he was

talking about its use in relation to the sale of goods, rather than the supply of sports coaching services - the fact that he came up with the term in the mid-1990s when he registered his design does not help to overcome the objection to registration of this mark upon absolute grounds.

21. In the circumstances, I do not consider that Mr Emery has identified any error in the Hearing Officer's approach to the assessment of the trade mark application, and the appeal must fail.

22. As is usual in these appeals, no application was made by the IPO for costs and there will be no
order as to costs.

Amanda Michaels
The Appointed Person
12 February 2020

Mr Andrew Emery, the Applicant, appeared in person (by telephone)

Ms Bridget Rees appeared for the Registrar (by telephone)