

0/106/20

**IN THE MATTER OF THE TRADE MARKS ACT 1994**

**-and-**

**IN THE MATTER OF TRADE MARK APPLICATION 3259285**

**in the name of ROSEONLY CO. LTD.**

**to register the trade mark**

**GREYBOX**

**As a trade mark in class 35**

**-and-**

**OPPOSITION NO. 411350**

**by GREY GLOBAL GROUP (UK) LTD**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MS AL  
SKILTON, HEARING OFFICER, ACTING ON BEHALF OF THE REGISTRAR OF  
TRADE MARKS DATED 14 FEBRUARY 2019**

**DECISION OF THE APPOINTED PERSON**

Introduction

1. The Applicant seeks to register the trade mark

**GREYBOX**

('the Trade Mark') in respect of a variety of services in class 35 including advertising services. The application is opposed by Grey Global Group (UK) Limited, which is an advertising agency.

2. The Opponent opposes the application under s5(2)(b) and s5(3) of the Trade Marks Act 1994 relying on its own registered mark for the word

## GREY

registered in class 35 for a variety of services including advertising. It also opposes under s5(4)(a) on the grounds that the use of the Trade Mark by the Applicant would be an act of passing off.

3. The Hearing Officer rejected the Opposition under all three heads. The Opponent appeals against that Decision. The Opponent supports the reasoning of the Hearing Officer and has not attended this Appeal.
4. The Opponent was required under s6A of the Act to prove use of its mark GREY in the United Kingdom as a condition of bringing the Opposition. The Hearing Officer, having considered the evidence, held that use had only been established in relation to advertising services, and considered the Opposition on that basis alone. On this Appeal, Ms Blythe seeks to challenge that finding. However, as she accepted, the Opposition based on 'advertising services' represented the Opponent's best case under s5(2) and s5(3), since those services were identical to services covered by the Trade Mark. I shall therefore proceed to deal with the Appeal on the basis of advertising services. Only if that Appeal succeeds may it become necessary to consider (i) whether the Opponent had proved a broader use and (ii) whether that makes any difference to the result.

### The Hearing Officer's Decision

5. In a nutshell the Hearing Officer decided that the average consumer of the services in question (most likely a business) would not assume simply from the fact that the Opponent's mark GREY formed part of the trade mark GREYBOX that the latter had a trade connection with the former. The word GREY is a common English word of the kind which one would expect to find in a variety of trade marks of independent traders. Furthermore, the Trade Mark conveys a quite different concept from the word GREY alone. In the Trade Mark the word GREY is simply an adjective describing the appearance of something else – the BOX.
6. Whilst the Opponent plainly has a significant reputation as an advertising agency, this did not materially increase the risk of confusion. Its customers (those responsible for selecting and dealing with advertising agencies) are relatively sophisticated and will not place business with such an agency without careful consideration. Nor was this a case in which there was an established 'family' of GREY + X marks in which there might be an assumption that GREYBOX was simply another addition to the family.

### The Grounds of Appeal

7. The Grounds of Appeal in this case identify 15 separate errors alleged to have been made by the Hearing Officer. Although Ms Blythe accepted at the hearing that some of the alleged errors were 'minor', she contended that they nonetheless had a 'cumulative effect'. Having heard this appeal and considered the array of points made, I am forced to conclude that the Grounds of Appeal were in fact no more than a list of every point on which the Opponent disagreed with the Hearing Officer.
8. I do not regard it as helpful either for the conduct of appeals generally or for the chances of success of an appellant in an individual case to proceed in this way.
9. Most Opposition proceedings, including this one, involve evaluative, multi-factorial decisions, in which the Hearing Officer applies a

generalized legal test by weighing up the evidence and coming to a nuanced overall impression. It is well-established that a wide latitude is given to Hearing Officers in relation to such decisions and no appeal is likely to succeed unless the appellant demonstrates a distinct and material error of principle. This may involve an actual mistake of law, or it may involve an error in the way the legal test has been applied – for example taking into account irrelevant evidence, or failing to consider relevant evidence. When compiling Grounds of Appeal, it is important for Appellants to have this in mind. The Grounds should identify errors of principle which would provide a proper foundation for the Appointed Person to overturn the Decision.

10. It will become apparent that few if any of the Grounds of Appeal in this case identified alleged errors of this kind. Many are little more than restatements of the case argued before the Hearing Officer on a particular point together with an assertion that the Hearing Officer was wrong to make the finding she did. Others raise issues which were simply immaterial to the overall decision. Furthermore, there seems to have been no exercise of discrimination to identify and plead only the points on which the Appellant may have a reasonable chance of success.

11. I shall take the Grounds in the Order in which they were pleaded.

#### Ground 1

12. The first Ground contends that the Hearing Officer was in error by concluding that the services at issue would primarily be selected visually rather than aurally. It is said that the right conclusion was that both visual and aural considerations would play a part but with aural considerations having greater significance, or at least an equally prominent role.

13. This is a paradigm example of a point which raises no issue of principle. The Hearing Officer gave reasons for her decision, namely that the selection process for advertising services would primarily be made from

websites or brochures. She took a properly nuanced view, recognizing that there may also be aural elements, for example where services are purchased on the basis of recommendation.

14. Worse, the point goes nowhere. It plainly made no difference to the Hearing Officer's ultimate determination, since (as she went on to find), the aural and visual similarities between the marks are of the same order (a 'medium degree of similarity'). There was therefore no good reason to include this alleged error in the Grounds of Appeal at all.

## Ground 2

15. This contends that the Hearing Officer erred in concluding that there was no distinctive or dominant component within the Trade Mark and that the overall impression of the mark lies in its totality. It is alleged that this conclusion was so wrong that no tribunal properly instructed could have reasonably arrived at it.
16. The Opponent goes on to suggest that, of the two words which are combined together to make the Trade Mark, the word 'GREY' is inherently distinctive in relation to advertising services, whereas the word 'BOX' is *'descriptive or at least allusive'* of those services, and therefore of a lower degree of distinctive character. The descriptiveness or allusiveness is said to derive from the fact that the word 'box' is associated with televisions ('box' being old-fashioned slang for a television), mail boxes, and email in-boxes. Any of these things could be used for delivering advertising.
17. To my mind it is fanciful to think that the average consumer would, confronted with the mark GREYBOX, understand the BOX element as in any way descriptive or even allusive to advertising, or indeed to televisions, mail or email. Rather, they would understand the concept of the Trade Mark in just the way the Hearing Officer suggested – namely that it relates to a box (ie a container) which is grey. If anything, it is the word 'BOX' which is conceptually more dominant, since the word GREY is merely an adjective describing a feature of the 'BOX'.

18. The contention that the Hearing Officer's evaluation of the nature of the Trade Mark was such that no reasonable tribunal could have reached it is therefore hopeless.

### Ground 3

19. This is presented as a separate Ground of Appeal, but in fact appears to be a conclusion drawn from Ground 2. The Hearing Officer found that the Trade Mark and the earlier mark were similar to a *'medium degree'*. It is said that if the word GREY is taken as the dominant and distinctive component of the Trade Mark, then the similarity should have been found to be at a high level. Given the failure of Ground 2, I need therefore say no more about this Ground.

### Ground 4

20. This Ground again relates to the concept conveyed by the Trade Mark in the mind of the average consumer. The Hearing Officer considered that it would be understood to refer to a *'box coloured grey'*. The Opponent contends that this is not the case. They refer back to the Hearing Officer's findings that their own earlier mark GREY could be seen *'as referring to a colour, as a name, or as a word meaning dull or ill-defined.'* Thus, they say, the same must be true of the word GREY in the context of GREYBOX. They go on to aver that the average consumer would be more likely to see the word GREY in the context of GREYBOX as a surname, thus indicating a box belonging to a Mr or Ms Grey.

21. It is entirely unclear to me why this point is considered to be significant. However, there is in any event an obvious logical flaw in the Opponent's argument. The word GREY on its own does indeed have three different potential meanings: a colour, a name or the metaphorical use to indicate dullness. But when attached to the word BOX, its context is clarified, and

the only obvious meaning is the colour grey. Certainly it could not possibly have the meaning advanced by the Appellant, namely a surname. To indicate a box belonging to a person going by the name GREY, the word would have to be something like GREY'SBOX.

22. I have no hesitation in agreeing with the Hearing Officer's view of the conceptual meaning of the Trade Mark.

#### Ground 5

23. This takes issue with the Hearing Officer's view that the conceptual similarities between the marks were at a *'fairly low level'*. It is said that the conceptual similarity should have been found to be at least at a *'medium'* level. I do not consider there is any great value in debating differences between *'fairly low'* and *'medium'* degrees of similarity in the context of the overall assessment of likelihood of confusion. Certainly, I do not consider that such fine distinctions can properly be characterized as errors of principle. They are at best simply disagreements about the precise 'weight' to be given to a factor in the overall assessment, something which the Courts have consistently rejected as a proper ground of Appeal. Furthermore, given the lack of clarity and subjectivity of the terms in question, it is impossible to have any sensible debate on Appeal about whether the Hearing Officer was right.

24. However, in any event, Ground 5 appears to be another Ground which depends on the success of Ground 2. The argument that the conceptual similarities are higher than was found by the Hearing Officer is founded on the allegation that the word GREY is the dominant and distinctive element of the Trade Mark (which of course I have already rejected).

#### Ground 6

25. This is another disagreement about 'weight' based on the precise words used by the Hearing Officer. She found that the distinctive character of the

mark GREY had been enhanced to a *'fairly high degree'*. The Opponent contends that this should have been a *'very high degree'*. The Opponent takes the same point on the Hearing Officer's finding about the reputation of the mark GREY for the purpose of the s5(4)(a) case, suggesting that it has a *'very strong'* not simply a *'fairly strong'* reputation.

26. For the same reasons given above under Ground 5 in relation to the extent of the similarities between the marks, I do not consider that points like this can amount to an error of principle, even if it was considered sensible to debate them on Appeal. Nor do I see anything to suggest that the Hearing Officer's assessment of distinctive character or reputation was in any way flawed. The use of hyperbolic descriptions such as *'very high'* and *'very strong'* is to my mind not justified on the basis of the limited evidence filed by the Opponent.

#### Ground 7

27. This alleges that the Hearing Officer was wrong to discount the evidence from the Opponent of its use of the term GREY in conjunction with other words (specifically GREY SHOPPER, GREY X, and GREYWORKS). The Hearing Officer was not impressed with this evidence, which is very thin in terms of the extent of the usage of such sub-brands. She noted that the Opponent did not allege that it could claim an enhanced reputation on the basis of a *'family of marks'* (see Il Ponte Finanziaria v OHIM C-234/06 at 63-66).

28. I cannot see any error of principle in the approach taken here, or the conclusion reached. Indeed, I struggle to understand what the relevance of these subsidiary marks is said to be when it was accepted by the Opponent at the hearing that the average consumer would not be expected to have heard of them at all.

## Ground 8

29. This is a lengthy ground of appeal, essentially challenging the Hearing Officer's overall evaluation of the likelihood of 'indirect confusion' in paragraph 75 of her Decision. The Hearing Officer had previously given an accurate summary of the law on the subject of marks containing a common element, quoting in particular the decision of Arnold J in Whyte and Mackay Limited v Origin [2015] EWHC 1271 at [18]-[21]. In particular, in that passage, Arnold J discussed the approach to the likelihood of confusion in the case of composite mark containing an earlier mark within it. In those circumstances, he stressed the need to consider whether the earlier mark has an independent distinctive significance within the composite mark. He emphasized at [20] that this is not the case '*where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (eg BECKER and BARBARA BECKER)*'.
30. In paragraph 75, the Hearing Officer concluded that GREY did not have an independent significance in the GREYBOX MARK. '*Rather it simply describes the following noun, BOX*'. She went on to note that BOX was not the kind of word which one would expect to be added to another word to make a sub-brand. Furthermore the average consumer would not be surprised to see the common word and name GREY being used in more than one trade mark by independent traders. In all the circumstances, she dismissed the likelihood of indirect confusion.
31. The Appeal attacks the finding of lack of independent significance. It is said that the word GREY has the same linguistic meaning in both marks. That is not entirely correct, since in the Opponent's mark it could have a variety of meanings, as the Hearing Officer pointed out. But in any event it misses the point. The word 'Origin' in Whyte & Mackay had the same

linguistic meaning in both 'Jura Origin' and 'Origin'. The word 'BECKER' had the same meaning (a surname) whether attached to the first name BARBARA or not. The issue being raised by Arnold J was a more subtle one, namely whether the earlier mark has lost its independent distinctive significance when subsumed into the 'unit' which is the composite mark. In such a case its meaning is *'qualified'* by the unit as a whole. Here that is plainly the case. Rather than the abstract concept 'GREY' with its potential multiplicity of applications, the word is now simply indicating a particular characteristic of something else – a BOX.

32. I therefore see nothing to criticize in paragraph 75 of the Hearing Officer's decision.

#### Grounds 9-11

33. These Grounds concern the determination by the Hearing Officer of the case under s5(3). This is another multifactorial question, where an error of law or principle sufficiently serious to undermine the decision would have to be shown in order to give rise to a proper ground of appeal. No such errors are identified.

34. The ninth ground suggests that the Hearing Officer took no account of the identity of the relevant services in her assessment of the existence of a link. Although the Hearing Officer did not explicitly mention this, it seems to me inconceivable that she was approaching the case in any other way than on the assumption that the services were identical, given that she had made this explicit when considering likelihood of confusion under s5(2).

35. The tenth ground is that the Hearing Officer took the wrong approach to considering whether any relevant damage would flow from any link made by a consumer between the marks. In particular it is said that it was necessary for the Hearing Officer to consider the likelihood of damage separately with regard to each head pleaded, that is to say damage to

reputation, detriment to distinctive character and unfair advantage. I do not regard this as a proper criticism of the Decision. The Hearing Officer was very clear that any link which might be created in the sense of the earlier mark being 'brought to mind' by the Trade Mark would be so 'fleeting' that no damage or unfair advantage would be caused. That is a perfectly reasonable determination on the facts which does not require a laborious analysis under each head of damage/unfair advantage.

36. The eleventh ground is a root and branch attack on the decision under s5(3) on the basis that it was '*preposterous*' in circumstances where the earlier mark had a very strong reputation and a very high degree of enhanced distinctiveness, and where there was use of GREY in conjunction with sub-brands. It will be recalled that I have rejected the appeal grounds based on '*very strong*' reputation and the '*sub-brands*' point. For completeness, I disagree that the Hearing Officer's decision was '*preposterous*' and would suggest that such extreme language should be avoided when drafting Grounds of Appeal.

#### Grounds 12-14

37. These grounds concern the Opposition under s5(4)(a) on the basis that the use of the Trade Mark in relation to advertising services would amount to passing off.

38. The twelfth ground points out an error in the Decision where the Hearing Officer states that it is the '*applicant's*' customers or potential customers who must be deceived. Plainly this is incorrect, the customers are those of the opponent. However, given that the Hearing Officer specifically quotes the relevant passage of Neutrogena v Golden [1996] 473 where the Vice-Chancellor makes this point (by reference to the claimant in a passing off action), I do not believe that this is anything other than a typographical error and did not affect the overall decision.

39. The thirteenth ground complains that the reasoning as to the absence of a misrepresentation is '*extremely brief*'. This is hardly surprising, given that

there is little or no difference in the present case between assessing the likelihood of confusion under s5(2) and for the purpose of passing off under s5(4). The Hearing Officer had done the entire analysis under s5(2) at some length. I would only have expected a more lengthy analysis under s5(4) if there had been a realistic prospect that the result might be different.

40. The fourteenth ground simply sets out the Opponent's case under s5(4), making many of the same points discussed above under ss5(2) and (3) including the 'sub-brands' point and the 'very strong' reputation point, concluding that no reasonable tribunal could have reached the decision of the Hearing Officer. I disagree. It seems to me that the decision of the Hearing Officer was well within the bounds of what a reasonable tribunal could have decided.

#### Ground 15

41. This is a challenge to the Hearing Officer's findings under s6A. In the light of my findings above I do not need to address this for the reasons given earlier.

#### Conclusion

42. The Appeal is dismissed and the Trade Mark may proceed to grant.

**IAIN PURVIS QC**  
**THE APPOINTED PERSON**  
**19 February 2020**