

BL O/1147/23

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,468,845 IN THE NAME OF AMIT POPAT

AND IN THE MATTER OF THE OPPOSITION UNDER NUMBER 420,590 IN THE NAME OF LENOVO (BEIJING) LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF STEPHANIE WILSON (O/446/23) DATED 12 MAY 2023

DECISION

Introduction

1. This is an appeal from the decision of Ms Stephanie Wilson, for the Registrar, dated 12 May 2023 (O/446/23). Lenovo opposed the application of Amit Popat to register a trade mark (No 3,468,845). The opposition by Lenovo was made under section 5(2)(b), but it was unsuccessful. Lenovo appeals.

2. Amit Popat applied to register the word mark YOGA MAN (No 3,468,845) in classes 9, 16, 28, 38 and 41 on 21 February 2020. However, Lenovo’s opposition was confined to the following goods and services in Classes 9 and 38:

Class 9

Video games [computer games] in the form of computer programs recorded on data carriers; Video games on disc [computer software]; Video games programs [computer software]; Video games software

Class 38

Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the Internet.

3. Lenovo opposed this application based on its earlier European Union trade mark YOGA (No 11,229,085) in Class 9. As the mark completed the registration process more than five years ago, there was a requirement to prove use and the Hearing Officer found Lenovo’s mark had been used only in relation to “Portable computers and tablet computers” in Class 9. This finding is not challenged by the Appellant.

4. By way of background, this is an appeal of a remittal. The original decision of the registrar, by Rosie Le Breton, was handed down on 28 January 2022 (O/77/22), but it

was overturned on appeal by Philip Harris sitting as the Appointed Person (O/996/22). He remitted the matter back to the registrar to be heard by a different hearing officer. This is an appeal of that second decision.

Standard of appeal

5. 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 will 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 principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

6. The Appellant challenges the Hearing Officer's decision on four grounds. First, the Hearing Officer failed to compare the Respondent's Class 9 goods with gaming computers. Secondly, the Hearing Officer applied an incorrect factual finding in relation to the similarity of goods when undertaking the assessment of the likelihood of confusion. Thirdly, the Hearing Officer improperly conflated findings of fact with a legal evaluation. Finally, the Hearing Officer failed to consider the Appellant's submission that the mark YOGA would have independent distinctive character in the mark YOGA MAN. I will consider each ground in turn.

Ground 1: Failing to compare the sub-category of gaming computers

7. Mr McDonagh, for the Appellant, submits that the Hearing Officer erred by failing to assess the similarity of the Respondent's Class 9 goods with gaming computers despite mentioning such computers in her Decision, [30]:

The nature of the goods will clearly differ to those covered by the opponent's specification. The method of use of the goods will also differ, as will the purpose. There may be an overlap in trade channels, as businesses specialising in computer goods may sell both games software and the computers on which they are used. The users of the goods will clearly overlap. I accept that there may be some complementarity, as the goods are clearly important or indispensable to each other. However, in my view, the average consumer is only likely to believe that they originate from a common undertaking in certain circumstances (such as where the opponent's goods are specifically targeted at the gaming market). Overall, I consider the goods to be similar to between a low and medium degree.

8. Mr McDonagh refers to *NOSH* (O/224/18) which highlighted that when undertaking the comparison of goods, each different species of goods should be compared separately. In *NOSH*, the Hearing Officer's decision was overturned by Iain Purvis QC, sitting as the Appointed Person, because the Hearing Officer considered the similarity of two different types of tea and coffee products (ready-made bottles and leaves/granules) together rather than separately. The Appellant submits that in this case the Hearing Officer made the same mistake. She identified that computers may be

aimed at the gaming market and so this sort of computer should have been considered separately from other computers.

9. For the Appellant's submission to succeed, it must be established that a gaming computer is an independent sub-category of computers. For something to be a sub-category of goods it must be something which can be delimited with sufficient precision: see C-31/14P *OHIM v Kessel*, EU:C:2014:2436, [37] and C-714/18 *ACTC v EUIPO*, EU:C:2020:573, [40]. In other words, it must be clear whether something falls within the sub-category or not.
10. I accept that the term gaming computer is used as a marketing device, but that is not enough to make it a sub-category. Mr McDonagh did not make any submissions as to what delimits a gaming computer and there was no evidence on the matter either. It is therefore difficult to identify with any precision what is meant by gaming computers. Indeed, it appears to me that "gaming computer" is both an uncertain and ambulatory term.
11. A gaming computer might be said to be a computer "good" for gaming or possibly a computer with better graphics or sound cards. But these very terms raise a problem. Good compared to what? Better than what? Many computers sold today can play even the most advanced games (maybe with a lesser gaming experience) without being badged as a gaming computer. Likewise, many gamers will use their "gaming" computer for emails, word processing, spreadsheets, searching the internet, and so on. In the absence of evidence, it seems to me that a computer with a particular specification might be sold as a "computer" by some retailers and as a "gaming computer" by others (or maybe the same retailer badges the specification differently to attract different types of customers).
12. Furthermore, the term is ambulatory; the hardware specification needed to be sold as a "gaming computer" when the earlier mark was filed in 2012 would not be sufficient for it to be so described today. This is because computer hardware has improved so much over the last decade that a ten-year-old computer would no longer provide something described as a 'good' gaming experience.
13. I do not therefore believe that gaming computer can be seen as a separate sub-category of goods. I also do not believe that gamers are a distinct relevant public as they will have the same characteristics as other consumers purchasing computers.
14. In any event, I do not believe the statement by the Hearing Officer regarding computers being targeted at gamers is identifying a sub-category of goods at all. Instead, when she refers to gaming, it is in the context of addressing the 'usual' origin of goods as a factor in her assessment of the similarity of the goods; in other words, that computers and games may come from the same manufacturer. While this factor is not mentioned in C-39/97 *Canon* [1998] ECR I-5507, it has been accepted that commonality of origin can be relevant to assessing the similarity of goods and services (see T-388/00 *Institut für Lernsysteme* [2002] ECR II-4301, [55]), provided the commonality exists between a

large number of producers of the goods in question (T-150/04 *Tosca Blu* [2007] ECR II-2353, [37]).

15. Accordingly, the Hearing Officer was entitled to reach the conclusion that she did as to the similarity of the goods in class 9. I therefore dismiss the first ground of appeal.

Ground 2: Applying the wrong finding of fact as to similarity of goods

16. I can deal with the second ground of appeal quite quickly. Mr McDonagh submits that the Hearing Officer applied the wrong facts regarding the similarity of the goods to her assessment of the likelihood of confusion. He makes this submission on the basis that the Hearing Officer refers to there being a “relatively low degree of similarity” rather than the similarity being “between a low and medium degree” in Decision, [48]. I reject this submission entirely. In the immediately preceding paragraph (Decision, [47(a)]), the Hearing Officer reminds herself of the similarity correctly and it is inconceivable that this had been forgotten when she was writing the next paragraph. The use of the word “relatively low” is, in my view, just another way of expressing “between a low and medium degree”. Accordingly, I reject this ground of appeal.

Ground 3: Conflating findings of fact with legal evaluation

17. In relation to the third ground of appeal, Mr McDonagh submits that the Hearing Officer conflated findings of fact with the legal evaluation of those facts in Decision, [38]:

I recognise that there are some goods which are often broken down into gendered categories (such as cosmetics or clothing). However, I have no evidence before me to suggest that the goods in issue are sold as such and, in the absence of any such evidence or any basis for taking judicial notice of the same, I am unable to find that the word MAN would be seen as indicating a particular category of the goods by reference to the target consumer. In my view, the overall impression lies in the combination of these words, which form a unit, with neither word dominating.

18. This submission is based on Mr Iain Purvis QC’s decision in *HARLEY* (O/168/22), [15] to [21]. In summary, Mr Purvis draws a distinction between findings of fact (either by evidence or judicial notice) and the evaluative decisions based on those findings of fact. Mr Purvis calls such an evaluative decision a ‘legal’ evaluation, but I think this is even more confusing than the more traditional moniker of a ‘mixed question of fact or law’ as a legal evaluation suggests a question of ‘pure’ law. But nothing turns on the nomenclature as his analysis is clear.

19. There are numerous questions in civil proceedings which are entirely artificial and hypothetical but are answered by real people — judges or in former times juries — making evaluative decisions about what a notional person might think or do whether that notional person is an average consumer, a reasonable person, an officious bystander, a person skilled in the art, an informed user, an ordinary reader, or one of the many other legal constructs.

20. In each case, the evaluative decision must be based on established facts. These facts can be established by direct evidence, circumstantial evidence (or inferences from

either), or can be proved by way of judicial notice. I am not suggesting here that evidence can be led to prove what the average consumer (a legal construct) actually thought, that would be absurd. But there needs to be a factual basis upon which the evaluation is built.

21. Indeed, it is because an evaluative decision is based on factual findings that appellate courts and tribunals are cautious about reversing a decision where it involved no error of principle but was simply a matter of degree (*Biogen Inc v Medeva plc* [1997] RPC 1 at 45 per Lord Hoffmann). On the other hand, it should go without saying that where there was no (or an insufficient) factual basis upon which a tribunal could properly come to the evaluative decision it did, then appellate courts and tribunals do not hesitate to substitute their own evaluative decision for that of the court or tribunal below.
22. Opposition proceedings before the registry are unusual in that the facts used to support the evaluative decisions made by Hearing Officers are often established entirely by judicial notice. This in turn means that it is common for a party to ask the tribunal to find a particular fact, such as baked beans are sold in supermarkets, without leading any evidence in support. While in practice the two are often conflated, this is really a party asking the Hearing Officer to take notice of the fact that baked beans are sold in supermarkets (in real life) and then the submission that from this fact the Hearing Officer should conclude that this is where beans would be found by the (hypothetical) average consumer when making the purchase (and imperfectly recalling the earlier mark).
23. This sort of request by a party is acceptable to the extent that it is asking the tribunal to find that a fact is something which can be properly judicially noticed. But critically, if the Hearing Officer does not believe it is proper to take judicial notice of that fact, then (absent evidence) the fact is not established. And in the absence of one or more facts being established it may be that certain conclusions (evaluative decisions) are no longer open to a Hearing Officer.
24. Of course, even where judicial notice might be taken of a fact it is open to parties to submit evidence as well. So, for instance, a dictionary might provide evidence as to the conceptual meaning of a word, but a Hearing Officer may also properly consult a dictionary under the doctrine of judicial notice following enquiry. It may of course be that in some cases the average consumer – as a legal construct – conceives the word differently from how it is described in a dictionary. But a dictionary definition is evidence upon which the evaluative decision as to how the average consumer conceives the word can properly be based.
25. In this case, the Hearing Officer did not think she could take judicial notice of the fact that in the real marketplace computers and tablets are currently sold, or in the future they are likely to be sold, in gendered categories. Accordingly, in the absence of evidence, this fact could not be established. In the absence of this fact being established the Hearing Officer was perfectly entitled (and in my view right) to make the evaluative decision that the average consumer would not see the word MAN in the trade mark

YOGA MAN as indicating the target customer for the goods. Therefore, this ground of appeal is dismissed.

Ground 4: Failure to consider the argument YOGA had independent distinctive character

26. Mr McDonagh submits that the Hearing Officer failed to consider his submission that the mark YOGA has independent distinctive character in the mark YOGA MAN. While it is true the Hearing Officer did not expressly refer to whether YOGA had independent distinctive character in her decision, she concluded that “the overall impression” of the mark “lies in the combination of these words, which form a unit, with neither word dominating” (see Decision, [38]). In light of this finding, it would not have been open to her to also find YOGA had independent distinctive character. It is therefore not surprising that the matter was not expressly considered. I therefore dismiss this ground of appeal as well.

Conclusion

27. I have dismissed the appeal in its entirety and uphold the Hearing Officer’s decision to dismiss the opposition.

28. The Respondent, Amit Popat, was a litigant-in-person. He indicated during the Hearing that he spent about 10-15 hours preparing for the case. Litigants in person are usually awarded costs before the Appointed Person on the same basis as before the High Court, namely at a rate of £19 per hour. Accordingly, in light of the range of time indicated by the Respondent, I will work on the basis he spent a little over ten hours preparing for the Hearing and award him £200 in costs. This is to be paid by the Appellant to the Respondent within 14 days of the date of this decision.

PHILLIP JOHNSON
2 December 2023

Representation

Sean McDonagh (of HGF Limited) for the Appellant

Amit Popat (litigant-in-person) for the Respondent