

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

**AND IN THE MATTER OF APPLICATION NO. 2538478  
IN THE NAME OF THOMAS PLANT (BIRMINGHAM) LIMITED**

**AND IN THE MATTER OF OPPOSITION NO. 101037 THERETO BY 151 PRODUCTS LIMITED**

**APPEAL TO THE APPOINTED PERSON FROM THE DECISION OF MR C J BOWEN  
DATED 20 MAY 2013**

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**DECISION**

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1. This is an appeal by the Opponent from a decision of Mr C J Bowen on behalf of the Registrar, BL O/213/13, in which he rejected an opposition by 151 Products Ltd ("the Opponent") to the registration of a series of two trade marks by Thomas Plant (Birmingham) Limited ("the Applicant").
2. The Applicant applied on 8 February 2010 to register the following series of two marks for a wide range of goods in Classes 8, 9, 16 and 21:

HOME MADE

*home made*

3. The application was opposed only in relation to goods which can broadly described as culinary equipment and household or kitchen utensils in Classes 8 and 21. The opposition was based on section 5(2)(b) only and the Opponent relied upon its earlier UK trade mark No 2316280, "HOME MAID", also registered for goods in Classes 8 and 21.
4. The earlier mark was subject to proof of use, and the Applicant did put the Opponent to proof. Evidence was produced by the Opponent, claiming that it had made genuine use of the earlier mark on a wide specification of goods, but the Hearing Officer concluded that the

evidence failed as required by s 6A (4) to show use of the mark as registered or “in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered.” As a result he dismissed the opposition without considering whether there was a likelihood of confusion such that the sub-section 5(2)(b) objection succeeded.

5. The essential issue on this appeal is whether the Hearing Officer erred in concluding that the Opponent had failed to prove use of its earlier mark either as registered or in a qualifying alternative form.

### **Standard of review**

6. It was common ground that this appeal is by way of a review; it is not a rehearing. *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) show that neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. Instead, if I am to uphold the appeal, I need to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was clearly wrong (*Reef*). As Robert Walker LJ (as he then was) said:

“...an appellate court should in my view 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” (*Reef*, para. 28).

7. The limits of the appellate jurisdiction in relation to issues of the kind raised in this appeal are well demonstrated by the *Bud* cases reported as to the appeal to the High Court at [2002] R.P.C. 38 and as to the second appeal to the Court of Appeal at [2003] R.P.C. 25. The Court of Appeal held that the Hearing Officer’s decision could not be set aside, as not demonstrating an error of principle; Sir Martin Nourse held that he was unable to hold that the Hearing Officer was not entitled to take the view that he did, even if another hearing officer might have taken a different view, as indeed did the judge. That was so even though the members of the Court of Appeal found the Hearing Officer's decision surprising; the decision could not be described as ‘clearly wrong’.

### **Merits of the appeal as to genuine use**

8. The Opponent's first ground of appeal was based on the premise that the evidence which was put before the Hearing Officer showed use of the earlier mark in the form in which it was registered, as well as in two alternative forms which differed only in elements which did not alter the distinctive character of the mark.
9. It seems to me that the submission that the earlier mark had been used exactly in the form in which it was registered was not made, or at least not made in clear terms, to the Hearing Officer.
10. In their written submissions dated 24 October 2012, the Applicant's attorneys had contended that the Opponent had filed evidence which showed that the distinctive character of the registered mark had been significantly altered, with no use of it exactly or substantially as registered. They suggested that the evidence showed use of the Opponent's mark in three different forms, each of which was distinctively different to the registered mark. The solicitors then acting for the Opponent did not respond in any substantive way to the Applicant's point, save to accept (in their submissions in reply dated 4 January 2013) that the mark had "appeared in different fonts on the packaging" of the Opponent's products. If the Opponent had wished to rely upon examples in its evidence of use of the mark in the form in which it was registered, it did not take the opportunity to point them out to the Hearing Officer.
11. Nevertheless, the Grounds of Appeal included a contention that the evidence showed that the Opponent had used its mark in exactly the form in which it had been registered, and suggested that the Hearing Officer had erred in failing to consider that use. The Grounds of Appeal on this point referred to a single page of Exhibit MJH1, which is a page from the Opponent's 2010 catalogue. According to the Grounds of Appeal this "showed, albeit in small and rather unclear form, the mark HOME MAID appearing in plain text" (that is, as registered) in several lines of printing beside a barcode visible on the label of a package of foam cups. It was submitted that I could infer that the mark would have been used in a similar manner on other packaging shown in the exhibits.
12. I had some difficulty in seeing any form of use of the mark relied upon in this way in the exhibits. The quality of the photocopied exhibits was very poor, both in the copy provided to

me and in the copy on the Registry's original file, which I have inspected. In both, the small print beside the barcode is visible but completely illegible. Indeed, the Hearing Officer commented upon the poor quality of the pages provided to him in paragraph 13 of his decision, and said at paragraph 28 that as far as he could tell the evidence provided by the Opponent did not contain any examples of its mark being used in the form in which it stood registered.

13. Where the Opponent had failed to draw the Hearing Officer's attention to the particular use of the mark now relied upon and had failed to provide legible copies of its exhibits to the Hearing Officer, it does not seem right to me to suggest that the Hearing Officer erred in failing to conclude that there had been use of the mark in the form in which it is registered. I was also invited to find that the Hearing Officer should have inferred that use would have been made of the mark aurally, when goods were ordered from the Opponent; that point was not raised directly in the Grounds of Appeal, but in any event I would reject that submission in the absence of any evidence to that effect which the Hearing Officer should have considered. I therefore reject the first Ground of Appeal.
14. The Opponent next sought to persuade me that the Hearing Officer had erred in his assessment of the impact of the differences between the mark as registered and the 'versions' in which the mark had been used (paragraphs 5-13 of the Grounds of Appeal). No criticism was made of the Hearing Officer's analysis of the appropriate legal test which he set out at paragraphs 29 to 32 of his decision. However, the Opponent submits that the Hearing Officer erred in his approach to the assessment of the impact of the differences between the mark as registered and as used, and in particular failed sufficiently to analyse the various qualities of the mark and the two different versions of it used by the Opponent.
15. The Opponent's evidence showed that use had been made over a number of years of two different 'versions' of the mark. First, the mark was used in the form shown below:



("the First Version").

16. Secondly, possibly only in 2010, it was used in this form:



("the Second Version").

17. The Hearing Officer first considered the distinctive character of the mark, and concluded at paragraph 34 that the two words together evoked the concept of a female servant working in one's home; he concluded that the distinctiveness of the mark lay in the totality of the mark, not in the individual words of which it is made up. It does not seem to me that any criticism can be made of that conclusion, which the Hearing Officer was obviously entitled to reach.
18. The real criticism of his decision relates to his consideration of whether either of the two versions of the mark shown above differed only in elements which did not alter the distinctive character of the mark. He dealt with this at paragraphs 35 and 36 of his decision.
19. Considering the First Version, the Hearing Officer held in paragraph 35 that the addition of the black background to the mark, and the presentation of the words 'home' and 'made' in different cases and on different lines was unlikely to affect the distinctive character of the mark. By contrast, he added in the same paragraph:
- "However, the presentation of the word "Home" in significantly larger letters than the word MAID changes not only the visual appearance of the trade mark as registered (to one in which the word Home is clearly the dominant visual element), but it also, in my view, is likely to alter the average consumer's perception of the trade mark from one which sends the conceptual message I have mentioned above to one that does not. In those circumstances, the distinctive character of [the Opponent's] registered trade mark will, in my view, be altered."
20. It is perhaps a little surprising that the Hearing Officer considered the impact of the way the words were presented separately from the impact of the First Version as a whole. However, he went on at paragraph 36:
- "However, even if such confusion is considered arguable, the differences I have already identified, even if considered insufficient on their own, will, when

considered in combination with the inclusion of a stylised device of a spoon (which would, arguably, be distinctive for anything other than spoons) in circumstances in which the stylised device of a spoon forms an integrated part of the trade mark as used, also, in my view, alters the distinctive character of [the] registered trade mark.”

21. The Opponent criticised the Hearing Officer's approach to the analysis of the differences between the First Version and the mark. The first point taken by the Opponent was that the Hearing Officer was wrong to find that changing the relative size of two words which together make up a plain word mark affects the mark's distinctiveness, as such a finding would be contrary to the principle that the registration of such a mark covers its use in any form or font. The Opponent drew my attention to a decision of Professor Annand, *Appetite trade mark*, BL O/275/11, in which the Hearing Officer had failed to consider the central question of whether the use of the mark upon which the Opponent relied was in a form differing in elements which did not alter the distinctive character of the mark in the form in which it was registered. Professor Annand commented that the particular font chosen by the Opponent was irrelevant, relying upon cases such as Case T-346/04, *Sadas SA v OHIM* [2005] ECR II-4891 in which the General Court said at [47] that where a registration is of a word mark “nothing prevents its use in different scripts.” The Opponent here said, therefore, that the Hearing Officer had been wrong to take the view that increasing the size of the word Home in comparison to the word Maid fell outside the registration of the word mark, as this was no different to using the different parts of the mark in different scripts.
22. There is some force in the Opponent's point, and, as I have said above, it also seems to me that there was no reason for the Hearing Officer to consider the impact of the way the words were set out separately from the impact of the First Version as a whole. Nevertheless, it seems to me that the Hearing Officer considered that in this version of the mark even the way the words alone were presented added a figurative element to the mark. It was his view that the presentation of the mark in this form changed its character by giving greater emphasis to the word Home and less to the word Maid, for this increased not just the size but also the dominance of the word Home. The principle that a word mark covers use of the mark in all fonts etc does not seem to me necessarily to stand in the way of that finding, because the Hearing Officer considered that it affected the distinctive character of the mark.

In my view that assessment was one which it was open to the Hearing Officer to make and his decision discloses no error of principle.

23. In any event, the Hearing Officer also considered the impact of the combination of the presentation of the words with the spoon device, which he found was an integrated part of the First Version of the mark. Adding a device element to a plain word mark may, it is clear, make all the difference to the inherent distinctiveness of a mark (see the comments of Mr Justice Arnold at first instance in *Starbucks (HK) Ltd v British Sky Broadcasting Group plc* [2013] FSR 29) and may equally amount to a material variant of the mark for the purpose of proof of use, whether for s 6A or s 46(2).
24. However, this is, as ever, a matter of degree and cases turn on their particular facts. Sir Martin Nourse held in *Bud* [2003] RPC 25 at [12]:
- “A mark may have recognisable elements other than the words themselves which are nevertheless not significant enough to be part of its distinctive character; or, to put it the other way round, the words have a dominance which reduces to insignificance the other recognisable elements.”
25. More recently, in *Catwalk trade mark*, BL O/404/13, Mr Geoffrey Hobbs QC sitting as the Appointed Person heard an appeal in which it was submitted that the Hearing Officer had erred in finding that presenting the plain word mark ‘Catwalk’ in the stylised form shown below was not an immaterial variant of the mark as registered for the purposes of section 46(2) of the Act.



Mr Hobbs QC held at paragraph 18 of his decision:

“The stylised form of the word **CATWALK** is indeed a variant of the word **CATWALK** as registered. The way in which the former individualises the latter may perhaps be analogised to the way in which a signature individualises the name it represents. It appears to me that in terms of its visual impact, there is visual individualisation to a degree which causes the stylised form of the word **CATWALK** to differ distinctively from the word **CATWALK** in ordinary letterpress.”

26. The differences were not, perhaps, very great, but were material. Mr Hobbs QC therefore upheld the decision below. By contrast, in Professor Annand's decision mentioned above, the Opponent's earlier mark was the word 'apetito.' Professor Annand did not consider that replacing the dot of the 'i' with a little heart device was sufficient to alter the distinctive character of the mark; she held that it would be seen as a mere 'flourish.' The distinctive character of the mark would still be perceived by the relevant public as residing in the verbal element of the mark.
27. Those cases serve to demonstrate that what must be considered is whether the form in which the mark has been used differs in elements which alter the distinctive character of the mark and in particular whether the words in the mark reduce "to insignificance" the other elements of the version of the mark which has been used. If the mark's distinctive character is altered, because elements other than the words are of significance, use is not deemed use of the registered mark.
28. The Hearing Officer was entitled to find in this case that the First Version changed the distinctive character of the mark, and contained elements which were not insignificant, even if the manner in which the words were displayed alone might not have had such an impact. He acknowledged that he should consider the position on the basis that his view of the impact of the manner of use of the words alone was wrong and there is nothing in paragraph 36 to suggest that he did not do so. In the circumstances, I do not accept the Opponent's argument that if he was wrong about the text alone his assessment of the impact of all of the elements making up the First Version was also necessarily wrong. In my judgment, it cannot be said that he was wrong in finding that the words were not the sole significant elements of the mark.
29. The Opponent relied heavily upon the Hearing Officer's failure to acknowledge that the First Version was aurally identical to the mark as registered, but it seems to me that in the light of his findings that there were both visual and conceptual changes of distinctive significance, that omission does not indicate that he erred in a material way.
30. In my judgment, the Hearing Officer here approached the question he had to decide in the right way in the light of the authorities: he first looked at the distinctive character of the

mark as registered, then the different form in which the mark had been used, and then asked himself whether it altered the distinctive character of the mark. Having done so, he reached a conclusion which was open to him. His decision cannot properly be overturned on appeal.

31. The Hearing Officer then turned to consider the Second Version of the mark. He found that there were “even more significant differences” between that version and the registered mark. The Opponent criticised the way in which the Hearing Officer put this point in paragraph 36 of his decision, as he did not set out the elements of the Second Version which he considered amounted to significant differences. However, he referred back to the differences which had been identified by the Applicant and which he had set out at paragraph 25 of the decision; these included two device elements, the human figure to the left of the composite word ‘Homemaid’ and a spoon in place of the ‘i’ and, less significantly, the additional word ‘kitchenware’ beneath it. I accept that the Hearing Officer might have expressed fuller reasons for his findings on this point, but given the basis expressed for his findings in relation to the First Version, it does not seem to me that one can identify any material error or error of principle in his findings.
32. The Opponent also submitted that the device elements of the Second Version were mere stylistic flourishes, and the Hearing Officer had plainly had regard to irrelevant matters if he had relied upon them. I do not accept that submission. The addition of the human figure device is plainly of some significance, and the Hearing Officer was entitled to regard it as of distinctive significance. Whether or not I agree with his conclusion (which in fact I do), the Opponent has not identified any proper basis for appealing his conclusions. I would therefore reject the appeal in so far as it relates to the Second Version.
33. In the circumstances, it is not necessary for me to consider the issue which the Applicant sought to raise in a very late Respondent’s notice, as to whether the 2010 catalogue (which was the only one to feature use of the Second Version) proved use in the relevant period.
34. I reject the appeal and as a result the opposition fails.
35. In the circumstances, I do not believe that it is necessary for me to consider a further question as to the amendment of the scope of the opposition and of the specification of the

Applicant's mark which may proceed to registration, which was argued before me and might have arisen had I allowed the appeal and remitted the section 5(2)(b) issues to the Registry. This was considered by the Hearing Officer at paragraph 39 of his decision. He concluded that:

“Although [the Applicant] may have reacted differently had the scope of [the] opposition been made clear to it from the outset, the fact remains that [the Applicant] filed a form TM21 to amend its specification and there is nothing before me to suggest that it is not content with its amended specifications.”

No appeal was filed by the Applicant against the Hearing Officer's decision to hold it to its TM21 amendment. For the avoidance of doubt, the application may proceed to registration in respect of the specification as amended by that Form.

36. I will order the Opponent to pay a contribution towards the Applicant's costs of the appeal of £1000, to be paid in addition to the costs awarded by the Hearing Officer. Both sums are to be paid by 5 pm on 4 April 2014.

Amanda Michaels  
The Appointed Person  
21 March 2014

Ms Alaina Newnes, instructed by BBS Zatman, appeared for the Opponent/Appellant

Mr Christopher Hall, instructed by Forresters LLP, appeared for the Applicant/Respondent.