O-247-18

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO 3164073: IN THE NAME OF AKEEM FAMUYIWA AND FOOTWEAR SAVAGE LTD

AND IN THE MATTER OF AN APPLICATION FOR INVALIDATION No. 501358 BY KAVAH SAVAGE

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF MS LOUISE WHITE DATED 23 NOVEMBER 2017

DECISION

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1. This is an appeal from a decision of Ms Louise White, the Hearing Officer for the Registrar, in which she found that trade mark No 3164073 was partially invalid in the light of the earlier registered mark No. 2244426 owned by Mr Kavah Savage. Footwear Savage Ltd appeals against that decision.

Background

2. On 11 May 2016, an application was made to register the figurative mark set out below for goods in Classes 9 and 25, and services in Class 35. The full specification is set out in the Annex to this decision. The mark was registered on 19 August 2016. The registered mark is as follows:

3. The application was made in the names of Mr Akeem Famuyiwa and Footwear Savage Ltd. Miss Yewande Akinmokun is the sole director of Footwear Savage Ltd. She explained in her evidence that Mr Famuyiwa was acting on the company's behalf when making the application, and has no proprietary interest in the Footwear Savage trade mark. She has represented the company throughout these proceedings, apparently without the benefit of further legal advice, and it does not seem to me that there is any question as to her capacity to do so, despite doubts raised by Mr Savage on this point. I shall for convenience refer to Footwear Savage Ltd in this decision as "the Proprietor."

4. On 5 October 2016, Mr Savage applied to invalidate the Footwear Savage trade mark on the basis of sub-sections 5(2)(b), 5(3), 5(4)(a) and 3(6) of the 1994 Act. Mr Savage too has acted in person throughout these proceedings. He relied upon his earlier registered UK trade mark No. 2244426, which is for the word SAVAGE, and upon goodwill in the mark. Mr Savage's mark was registered on 5 October 2001 with effect from 4 October 2000 for bags, wallets, purses, briefcases, articles made of leather and artificial leather, and belts in Class 18 and clothing, headgear and footwear in Class 25. The allegation of bad faith was based on a claim that the Proprietor must have known of his mark and therefore the application for the Footwear Savage Mark was made in bad faith.

5. The Proprietor put Mr Savage to proof of use of the Savage mark. He filed a witness statement dated 1 March 2017 claiming to have used the Savage mark for many years in relation to clothing. He also referred to its use in relation to the provision of retail services relating to Class 25 goods, although no such services are included within his trade mark specification. He provided a limited number of documents to support the assertions made in his witness statement.

6. Miss Akinmokun filed a witness statement in answer dated 2 May 2017.

7. Neither side sought a hearing, so the Hearing Officer decided the case on the papers.

8. The Hearing Officer analysed Mr Savage's evidence of use of the earlier mark. At paragraph 15 of her decision, she found that his evidence was insufficient to demonstrate genuine use, reputation or goodwill in the SAVAGE trade mark. However, she noted that Miss Akinmokun accepted in her own witness statement that Mr Savage had used the earlier trade mark in respect of T-shirts. The Hearing Officer considered that the concession by Miss Akinmokun meant that she should accept that genuine use had been established to that extent. She concluded at paragraph 18 that for the purposes of the application a fair specification for the earlier mark would be for “tops and T-shirts” in Class 25.

9. The Hearing Officer proceeded to consider the sub-section 5(2)(b) objection based upon the earlier mark as if limited to that specification. She set out the test which she had to apply in standard terms. She concluded that there was no similarity between the earlier goods and the Proprietor's goods in Class 9. However, she found that there was similarity between the parties’ respective Class 25 goods. At paragraph 24 she said

> "The later goods are (overwhelmingly), footwear. Both the later and earlier goods are used to dress, cover and protect the body (albeit particular areas). They can be selected for similar reasons - season, use, function, fashion. They can employ the same trade channels and indeed the same producers. They are considered to be similar to a high degree. The one contested item that is not footwear are camisoles. Camisoles can be types of tops and so are considered to be identical to the earlier term."

10. She then compared the Class 25 goods to the services in Class 35 saying:

> “25. Retail services, retail store services connected with the sales of footwear mail order retail services, online and Internet retail services connected with the sale of new and used footwear, namely leisure footwear; retail and online retail services in relation to footwear fashion procurement.
>
> 26. The above services aim to provide items to be worn on the body according to use, function fashion. The same applies to the earlier goods. Those supplying

retail services in this area can also manufacture clothing. They are similar, to a low to moderate degree."

11. She found that the rest of the Proprietor’s services were not similar to the earlier Class 25 goods.

12. The Hearing Officer then compared the marks. She considered that the word FOOTWEAR in the Proprietor's mark was descriptive, so that the more distinctive component of that mark was the word SAVAGE. She found that the marks were visually similar to a medium degree, aurally similar to a medium to high degree and highly similar conceptually. She did not accept Mr Savage's claim that the earlier mark had a reputation, but decided that it was fanciful in respect of the earlier goods and so had an above average degree of inherent distinctiveness.

13. The Hearing Officer carried out a global appreciation of the likelihood of confusion and concluded that it was inevitable that confusion would occur in relation to the Proprietor’s goods in Class 25 and the services in Class 35 which she had found to be similar to tops and T-shirts. The objection under sub-section 5(2)(b) succeeded to that extent.

14. In the light of her finding that there was no evidence of reputation or goodwill, the Hearing Officer rejected the objections raised on the basis of sub-sections 5(3) and 5(4)(a) and sub-section 3 (6). The application for invalidity therefore succeeded in part, but in particular succeeded for the goods in Class 25 which were of particular interest to the Proprietor.

15. The Proprietor appealed. The main point raised by the Grounds of Appeal was that the Hearing Officer was wrong to invalidate the Footwear Savage mark in relation to footwear. Two reasons were given for that contention. First, Mr Savage had not shown any use of his own mark in relation to footwear and secondly, there was no evidence of similarity between footwear and clothing. Miss Akinmokun contended

> "There has also not been any solid supporting evidence to show how confusion could arise in the eyes of the consumer in regards to mistaking footwear for T-shirt designs, as I will be selling footwear and Mr [Savage] sells T-shirts we are not even in direct competition. Mr [Savage] has marketed himself as a T-shirt brand so visually and conceptually in the consumer's eyes there is a distinct difference … which allows consumers to identify goods provided."

Miss Akinmokun suggested that the marks could co-exist. It was not at all clear whether the appeal was also intended to relate to the Hearing Officer's findings in relation to the Class 35 services.

16. Miss Akinmokun also complained that the decision was not clear and was based on hearsay rather than concrete evidence. A number of other matters were raised by Miss Akinmokun in the Grounds of Appeal, relating in particular to whether there was a finding in relation to the copying of designs. I do not consider that these points need to be considered on the appeal, as in my judgment they do not reflect any part of the decision below.

Nature of the appeal

17. This appeal is by way of review. The principles applicable on an appeal of this kind were considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (BL O/017/17) at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc V Arcadia Trading Limited* [2017] EWHC 440 (Ch):

> "(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).
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> (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral

evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF*, *DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) 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).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached

a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF*, *Henderson* and others)."

18. Further comments on the nature of an appeal to the Appointed Person were made by Mr Iain Purvis QC in *Rochester* BL O/049/17, and he said at [33]:

> "… the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:
>
> (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
>
> (ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person.
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> (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.
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> (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. … Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

19. I will apply these principles to this appeal.

Merits of the appeal

20. The main complaint made by the Proprietor on the appeal was to challenge the Hearing Officer's finding of similarity between tops and T-shirts in Class 25 and the Proprietor's own Class 25 goods, consisting mainly of footwear. First, the Proprietor complained that the finding of similarity was not based on any evidence. In my view,

there is no error in the decision below in that respect. A Hearing Officer does not need to have evidence before him to take account of facts which are likely to be known by anyone or which could be learnt from generally accessible sources. Such facts include those relating to the similarity of one kind of everyday consumer goods to other such goods, where the manner in which both are generally sold/purchased is within the tribunal's knowledge as a notional average consumer (see e.g. *esure Insurance Ltd v Direct Line Insurance Plc* [2008] RPC 34 at [56]). The decision here does not disclose any error just because the Hearing Officer reached her conclusion in the absence of evidence as to such similarity.

21. The next issue is whether the Hearing Officer erred in her analysis of the similarity of the goods and services. Where this requires the analysis of the similarity between lists of goods the Hearing Officer much consider each of the different types or "species" of goods/services listed in the opposed application. Goods/services which can be assessed in essentially the same way for essentially the same reasons, whether or not within a single class, may be addressed collectively (or in categories) by the Hearing Officer. See Case C-239/05, *BVBA* [2007] E.C.R. I-1455; [2007] E.T.M.R. 35 12.

22. The Hearing Officer described the Proprietor's Class 25 goods as being overwhelmingly footwear. The only item which she distinguished from that category was camisoles. She was plainly right to describe the Class 25 goods as being overwhelmingly footwear, however, in addition to footwear in general terms (e.g. footwear, sandals, slippers; boots), the specification includes some more specific kinds of footwear (e.g. football boots, cycling shoes) and, in addition, footwear accessories or parts (e.g. inner soles, uppers and non-slipping devices for footwear). It also included camisoles (which the Hearing Officer considered) and socks (which she did not).

23. The specific kinds of footwear listed in the specification fall mainly into the broad categories of fashion footwear and sports footwear. In my view, the Hearing Officer's overall analysis of the similarity of tops and T-shirts to footwear applies to fashion footwear, which may be produced by the same operators and sold through the same channels as fashionable T-shirts. I note that in, for example, Case T-115/02 *AVEX Inc.*

v OHIM, the General Court upheld a similar finding that there was some level of similarity between clothing and footwear, because they might be produced by the same operators or sold through the same channels. The same could be said for sports footwear and tops or T-shirts designed as sportswear. I do not discern any error in the Hearing Officer's approach to the footwear items in the specification just because she did not break those items down into different categories of footwear. In my view there is no error in the decision in so far as it relates to footwear.

24. However, the Hearing Officer did not deal separately or expressly with the footwear accessories in the specification, and it is not apparent from the decision why, presumably, she did not consider it necessary to do so. On the other hand, no express point relating to footwear accessories was made in the Grounds of Appeal or by Ms Akinmokun at the hearing. In the absence of any clear appeal in relation to such goods, it does not seem to me that it would be appropriate for me to consider further whether the Hearing Officer ought to have reached any different conclusion about them. Similarly, the Hearing Officer failed to deal specifically with socks, which also appear in the specification, although she dealt with the only other clothing item in the specification, camisoles, but again there is no reference to socks in the Grounds of Appeal.

25. As I have said, it was not clear to me whether the Proprietor also wished to appeal the Hearing Officer's findings in relation to the invalidated Class 35 services. However, I do not consider that there is any error in her reasoning in paragraphs 25 and 26, which would vitiate her conclusion in paragraph 46 that there is a likelihood of confusion in relation to such services.

26. I therefore dismiss the appeal.

27. In those circumstances, it seems right to me to order the Proprietor to make a contribution towards Mr Savage's costs of the appeal. The Civil Procedure Rules limit the amount of costs which may be awarded to a litigant in person. CPR 46.5(4) provides that where the litigant can prove financial loss, the amount awarded may be that amount, alternatively where the litigant cannot prove financial loss, he may be

awarded an amount for the time reasonably spent on doing the work at the rate set out in Practice Direction 46. That rate is currently £19 per hour. It has long been accepted that (i) an award of costs to a litigant in person should not exceed the costs incurred and (ii) a litigant in person should not be in any more favourable position in proceedings in the Registry than he would be in High Court proceedings under CPR r. 48.6. See *Air Parts* O/160/08 at [34] *per* Mr Richard Arnold QC (as he then was).

28. At the hearing I invited the parties to make submissions to me as to costs and any expenses which they had incurred. Mr Savage did not provide me with a breakdown of any expenses or of time spent in relation to the appeal, but invited me to award him the sum of £500. That sum seems excessive, given the low hourly rate which is applicable here and the very brief Grounds of Appeal filed. I consider that Mr Savage could reasonably have spent up to 3 hours in preparation for the hearing, and around three hours in travelling to and attending the hearing. I will therefore order the Proprietor to pay him the sum of £115 as a contribution towards his costs of the appeal. That sum is to be paid by 5 PM on 11 May 2018.

Amanda Michaels
The Appointed Person
20 April 2018

Annex A

The Footwear Savage specification:

Class 09: Software (Computer -), recorded; Software drivers; Software; Software for processing images, graphics and text; Software for the operational management of portable electronic devices and electronic cards; Software for tablet computers; Software development kit [SDK];Software and applications for mobile devices; Software for mobile phones; Software for customising footwear; safety footwear; interactive computer software; Computer software; computer software platforms; software and software applications to enable transmission, access, uploading, posting, displaying, sharing or otherwise providing electronic media or information, text, web links and images over the internet or other communications networks; software downloadable via the internet and wireless devices; downloadable software in the field of custom made prototyping; downloadable software in the form of a mobile application.

Class 25: Footwear; sandals; slippers; boots; boot uppers; boots for sports; beach shoes; camisoles; football boots; football shoes; footmuffs; footwear uppers; non-slipping devices for footwear; ski boots; socks; inner soles; soles for footwear; wooden shoes; high heels namely wedges; loafers;

moccasin; sneakers; trainer; rainboots; riding boots; rollerblades; rollerskates; running shoes; saddle shoes; sandals; shoes; skates; skate shoes; slides; slingbacks; slippers; sneakers; steel-toe boots; stiletto heels; cleats; climbing shoes; clogs; court shoes; cowboy boots; cycling shoes.

Class 35: Retail services, retail store services connected with the sales of footwear mail order retail services, online and internet retail services connected with the sale of new and used footwear, namely leisure footwear; advertising; business management; business administration; office functions; marketing, advertising and promotional services; online advertising and marketing services; market research and information services; publication of advertising texts; promoting the goods and services of others via computer and communication networks; online business networking services; dissemination of advertising for others via an on-line electronic communications network; business data analysis; providing statistical business information; business networking; business information services, all provided via an online electronic database on a global computer network; business monitoring and consulting services, namely, providing strategy, insight and marketing guidance; computerised database management services; retail and online retail services in relation to footwear and fashion procurement.