

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,295,804 BY JUICE CABIN LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF TERESA PERKS (O/635/19) DATED 21 OCTOBER 2019.

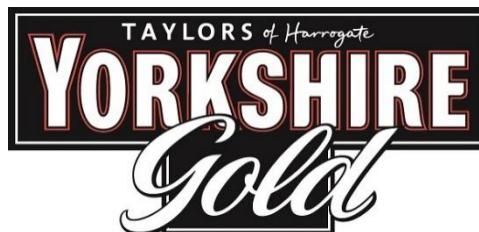
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DECISION

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### Introduction

1. This is an appeal from the decision of Mrs Teresa Perks, for the Registrar, dated 21 October 2019 (O/635/19) where she upheld the opposition of Bettys & Taylors Group Limited to Juice Cabin Limited's trade mark application (No. 3,295,804) under section 5(3) of the Trade Marks Act 1994, but rejected the opposition under sections 5(2)(a) and (b) and 5(4)(a). Juice Cabin appeals that decision in relation to section 5(3) and Bettys & Taylors cross-appeal the decision in relation to section 5(2)(b) and 5(4)(a).
2. Juice Cabin applied to register the word mark YORKSHIRE GOLD in Class 34 for the following goods:  
Electronic cigarette liquid [e-liquid] comprised of propylene glycol; Electronic cigarette liquid [e-liquid] comprised of vegetable glycerin; Flavourings, other than essential oils, for use in electronic cigarettes.
3. Bettys & Taylors opposed the application relying on two earlier marks. The first the word mark YORKSHIRE GOLD (No 1,570,389) which is registered in respect of tea in Class 30. The second earlier mark (No 3,118,901) is the following figurative mark:



4. This mark is registered in Class 30 for the following goods:  
Infusion products, teabags, leaves, plant extracts, fruit extracts and herbal extracts for making hot beverages; coffee; coffee beans; ground coffee; flavoured coffee; artificial coffee; coffee capsules; coffee pods; caffeine free coffee; coffee-based beverages; coffee substitutes; tea; herbal teas; fruit teas; tea substitutes; tea pods; iced tea; cocoa; hot chocolate; flavourings for beverages.

5. As the opposition was entirely successful before the Hearing Officer, the cross-appeal needs to be considered only if the appeal is successful. This was accepted by Mr Wylie who appeared for Bettys & Taylors.

### **Standard of review**

6. 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 relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC and more recently by the Supreme Court in *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15. What is meant by a material error was explained by Lord Carnworth in the Supreme Court in *R (R) v Chief Constable of Greater Manchester* [2018] UKSC 47, [2018] 1 WLR 4079 at paragraph 64:

In conclusion, the references cited above show clearly in my view that to limit intervention to a "significant error of principle" is too narrow an approach, at least if it is taken as implying that the appellate court has to point to a specific principle—whether of law, policy or practice—which has been infringed by the judgment of the court below. The decision may be wrong, not because of some specific error of principle in that narrow sense, but because of an identifiable flaw in the judge's reasoning, such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion. However, it is equally clear that, for the decision to be "wrong" under CPR r 52.11(3), it is not enough that the appellate court might have arrived at a different evaluation...

7. And, in *Z, R (On the Application Of) v London Borough of Hackney* [2019] EWCA Civ 1099 Lewison LJ at paragraph 66 highlighted that:

It is not enough simply to demonstrate an error or flaw in reasoning. It must be such as to undermine the cogency of the conclusion. Accordingly, if there is no such error or flaw, the appeal court should not make its own assessment.

8. When considering this appeal, and applying the principles I have outlined above, it is important to remember the high bar set.

### **The Appeal**

9. The Appellant's appeal had two limbs. The first was that "the final decision is based on a fiction" in that Juice Cabin has never and would never make a tea flavoured e-cigarette liquid (which I will call "e-juice"). The second was that Juice Cabin would be willing to give a guarantee that it would never produce a tea flavoured e-juice in the future.

### *Notional use*

10. It is well established that the Hearing Officer should make assessments for the purposes of section 5 of the Trade Marks Act 1994 based on a notional and fair use of the respective marks. This means in relation to a trade mark application the notional and fair use of all the goods and services in respect of which the application has been made, and in relation to the earlier mark used as the basis of the opposition a notional and fair

use of all the goods and services in respect of which it is registered (see *Maier v Asos plc* [2015] EWCA Civ 220, [78]).

11. Therefore, it is irrelevant for the purposes of section 5 whether an applicant has used, or intends to use, the mark on a particular good or service included in its specification (although an absence of intent to use may constitute a ground to oppose under s 3(6)). What is important, therefore, is that the applicant's specification covered tea flavoured e-juice, as the Hearing Officer correctly explained in the first part of paragraph 71 of her Decision:

Turning to the facts of the case, there is no evidence that the applicant wanted to use the name YORKSHIRE GOLD to send a message to its potential customers that its e-liquids and flavourings for use in electronic cigarettes taste like the opponent's well-known tea. However, the applicant's goods are not restricted in any way and, as the opponent correctly argued, cover tea-flavoured products...

12. For this reason, the fact that Juice Cabin does not sell tea flavoured e-juice does not assist its case. In the hearing, I allowed Mr Pickin to argue the matter slightly more widely. The wider argument was that the relevant public would not consider tea to be a viable e-juice flavour.

13. However, the evidence is entirely contrary to this proposition. Exhibit KLG4 provides the results of a search on Google for "tea e-juice uk". The exhibit extends to thirty-nine results relating to tea flavoured e-juice, including tea varieties such as English Breakfast or Earl Grey. Furthermore, Exhibit RJW6 includes two photographs of e-juice bottles which use branding very similar to famous soft drinks and products (such as Coca Cola, Mars and so forth); albeit these bottles use mild variations to the trade marks (one assumes in the hope of avoiding infringing). Thus, there is clear evidence that tea might be used as an e-juice flavour and further that this could extend to branded tea. Accordingly, even on the broader basis I allowed the case to be put, the first ground of appeal must be dismissed.

*The offer of a guarantee*

14. The second limb of Juice Cabin's appeal was that it would "guarantee" not to sell tea flavoured e-juice.
15. A promise by an applicant not to sell a particular product covered by its trade mark specification might be acceptable to an opponent (for example, in the form of a co-existence agreement) and this might be sufficient for the opponent to consent to registration (see s 5(5)). However, the determination of an opposition must be based on the specification before the Hearing Officer (or the Appointed Person) and therefore an undertaking not to use a mark on a good or service (or in a particular way) cannot in itself assist an applicant. I therefore dismiss the second limb of Juice Cabin's appeal.
16. I should add that if Juice Cabin had wished to exclude tea flavoured e-juice from its specification an application should have been made to restrict its list of goods or services in accordance with section 39(1). Whether such a restriction would have been

enough to overcome the opposition under section 5(3) was not before the Hearing Officer or me and I will say no more about it.

### **Conclusion**

17. I dismiss the appeal in its entirety and uphold the decision of the Hearing Officer. I therefore do not need to consider the cross-appeal. As the Respondent was entirely successful in its appeal, it is entitled to a contribution to its costs. I therefore order that the Appellant must pay a £1,000 contribution to the Respondent's cost (along with the £1,900 award of costs made in favour of the Respondent by the Hearing Officer).

PHILLIP JOHNSON  
21 April 2020

For the Appellant: Les Pickin (in person)

For the Respondent: Richard Wylie of HGF Limited.