

## BLO/265/22

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,453,688 IN THE NAME OF ARLA FOODS AMBA

AND IN THE MATTER OF AN OPPOSITION UNDER 420,897 BY LACTALIS McLELLAND LIMITED

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF OLIVER MORRIS (O/583/21) DATED 4 AUGUST 2021

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### DECISION

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#### **Introduction**

1. This is an appeal from the decision of Mr Oliver Morris, for the Registrar, dated 4 August 2021 (O/583/21). Lactalis McLelland opposed the application of Arla Foods Amba to register SKYRIOUSLY as a trade mark (No 3,453,688). The application was opposed under section 5(2)(b) and 5(3) of the Trade Marks Act 1994.
2. The Opposition was based on two earlier marks. The first is a figurative mark (the SERIOUSLY STRONG mark) (No 2,317,123), which was registered in Class 29 for Cheese and Cheese products and is as follows:



3. The second mark (the SERIOUSLY TASTY mark) (No 2,398,648) is a series mark, which was registered in Class 29 for Cheese; cheese products; milk; milk products; dairy products; yoghurt; cream; edible fats; butter; margarine; milk beverages; prepared meals; snack foods products, and is as follows:



4. As both marks completed the registration procedure more than five years ago, Arla Foods therefore required that Lactalis McLelland prove use of its marks.

#### **Standard of review**

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 recently summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]:

...I was referred to numerous cases on the subject (including *English v Emery Demibold & Struck Ltd* [2002] 1 WLR 2409, *REEF Trade Mark* [2003] RPC 5, *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11, *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5, *Shanks v Unilever Plc* [2014] RPC 29, *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17, *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch), *Actavis Group PTC v ICOS Corporation* [2019] UKSC 1671 and *NINEPLUS O/039/21*), the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

i) The appeal is by way of a review, not a rehearing (see *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [52(i)]);

ii) The appeal court will allow an appeal where the decision of the lower court was “wrong” (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference (*NINEPLUS O/039/21* at [14]);

iii) The decision of the lower court will be “wrong” if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was “outside the bounds within which reasonable disagreement is possible” (*Actavis Group* at [81]);

iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question (*REEF Trade Mark* [2003] RPC per at [26]). There is a “spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision” (*TT Education* at [52(ii)]), with decisions of primary fact at one end of the spectrum and multi-factorial decisions ... being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court 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 (*TT Education* at [52(iv)], *REEF* at [28] and *Fine & Country* at [50]-[51]).

vi) An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. The evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible (*Actavis Group* at [80]).

vii) Another variable to be taken into account will be “the standing and experience of the fact-finding judge or tribunal” (*REEF* at [26], *Actavis Group* at [78]). Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts (*Shanks* at [28] citing the warning given by *Baroness Hale in AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49).

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; “The duty to give reasons must not be turned into an intolerable burden” (see *REEF* at [29]). The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted (*English* at [17], *Fage* at [115]). The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained (*English* at [19]).

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account (*TT Education* at [52(vi)]).

6. When considering this appeal, and applying these principles, it is important to remember the high bar set.

### **Scope of appeal**

7. The Hearing Officer found that neither of the two earlier marks satisfied the proof of use requirements. Accordingly, the opposition failed at that point. The Appellant had used the following two marks during the five-year period ending on 23 December 2019:

2014-2017	2017 onwards
	

8. In short, it was accepted by the Hearing Officer that there had been substantial use of both these marks, but the question before him was whether one or both of these marks were an acceptable “variant form” the use of which counts as use of the earlier marks as registered: see Trade Marks Act 1994, s 6A(4)(a).

#### Law on variant forms

9. The purpose of allowing a trade mark proprietor to use a variant mark was explained by the General Court in T-146/15 *Hypen v EUIPO*, EU:T:2016:469 at [27]:

The purpose of that provision, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in insignificant respects, and the two signs can therefore be regarded as broadly equivalent, the abovementioned provision envisages that the obligation to use the trade mark which was registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.

10. The Appellant’s argument in a nutshell is that the word SERIOUSLY which is in all the marks (both as registered, and the 2014 and the 2017 forms) is the distinctive part of the mark and that has been retained (or as a fall-back position a similar submission in relation to SERIOUSLY STRONG in the 2014 form).
11. The Hearing Officer began his assessment by adopting the approach set out by Richard Arnold QC, sitting as an Appointed Person, in *Nirvana TM* (O/262/06) and the questions he set out in [34] namely:

(a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.

12. The Hearing Officer therefore particularised the differences between both marks as registered and the 2014 form of use and the 2017 form of use (Decision, [26] to [28] and [34]). Mr Wood, for the Appellant, suggests that this approach is wrong. The correct approach, he submits, is to assess whether the distinctive elements were the same. What I take him to mean by this is that what is material is whether the distinctive elements in the mark as registered were used during the relevant period, rather than simply comparing the mark as registered with what is used. In effect, he was saying that the use of SERIOUSLY (or SERIOUSLY STRONG) was enough because that was all that was distinctive in the mark as registered.
13. I reject the suggestion that the marks should not be compared. While the law has developed since *Nirvana*, the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).
14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will *usually* be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).
17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.

#### **Was it use of the SERIOUSLY STRONG mark?**

18. The Hearing Officer set out his findings as to the distinctiveness of the various elements of the SERIOUSLY STRONG mark (#123) as registered: Decision, [25]:

... the distinctive character of the mark as registered resides less in the inclusion of the words SERIOUSLY STRONG CHEDDAR but more in the overall get up of those words and its roundel device, together with the presence of the word McLelland and the accompanying device of a cheese press. I take this view because, notwithstanding their visual prominence within the mark, the words will likely be perceived as an indication of the strength and nature of the cheddar, it being seriously strong. As I come on to say later, I consider this phrase to be weak in inherent distinctive character....

19. Thus, the Hearing Officer was concluding that the distinctiveness of the mark resides not in the words, but in the get-up (also see Decision, [34]). This is a factual determination he was fully entitled to make (notwithstanding, in the usual case it is the words and not the get up that are distinctive: see *M & K*).
20. Furthermore, I entirely agree with the Hearing Officer that “Seriously Strong” would be seen as an adjectival phrase relating to the noun “Cheddar”. In simple terms, the words are descriptive (or very suggestive) in their use in the mark as registered. Indeed, even Mr Wood accepted in the hearing before me that “Strong” and “Cheddar” were non-distinctive in relation to cheese. However, he argues that “Seriously” had become the distinctive part of the mark through use. As a starting point, it has long been established that an element of a composite mark can become distinctive through use: *C-353/03 Nestlé v Mars* [2005] ECR I-6135, [32].
21. I also broadly accept that whether the variant form differs in elements which alter the distinctive character of the mark as registered should be assessed through the eyes of the relevant public.
22. Accordingly, the relevant public in 2014 would assess whether the 2014 form of the mark was a variant of the registered mark; likewise, when the new form of variant mark was introduced in 2017 it would be assessed by that later relevant public. This seems to be in accord with the approach in *C-252/12 Specsavers v ASDA*, EU:C:2013:497. I also accept that (in theory) whether something is a variant form might change over the five-year period, and furthermore, that this sort of approach may work against the proprietor as well as in its favour. This is because a difference in a variant mark which, when introduced, was not distinctive could become so and move the variant from counting as a use of the mark as registered to become a use which is not.
23. The difficulty for Mr Wood is that even if he is right and the word SERIOUSLY is now a distinctive mark for cheese, it does not mean that the phrase “SERIOUSLY STRONG CHEDDAR” would not be seen as a unit in the mark as registered (see Decision, [42]). And when this phrase is seen as a unit, it will (as the Hearing Officer stated) indicate to the relevant public the strength and nature of the cheddar.
24. Furthermore, as is clear from *Fashioneast*, assuming the word SERIOUSLY were individually distinctive, its use would not be sufficient if other distinctive elements of the mark as registered were not also used at the same time. The Hearing Officer found that the overall get-up was the distinctive element of the registered mark, and this get-up was not used in the relevant period. Thus, neither the 2014 nor the 2017 form of the

mark can amount to use of the SERIOUSLY STRONG mark (that is mark No 2,317,123) as registered.

### **Was it use of the SERIOUSLY TASTY mark?**

25. The Hearing Officer concluded that whether the SERIOUSLY TASTY mark (#648) had been used was also based on the same uses of the 2014 and 2017 forms of the mark (he discounted a single use of the mark on Facebook on 24 December 2015: Decision, [31]). The Hearing Officer's conclusions were set out at [34]:

I accept that the decision here is a closer one than in relation to the assessment of the first earlier mark. This is because the get-up of the mark as registered at least includes the rosette form of use. That said there are still the other differences as I have described with my first assessment. There is a further difference though, on account of the main verbal element in the mark as registered being SERIOUSY TASTY CHEDDAR (as opposed to STRONG), although I need to keep in mind my earlier comment that the distinctiveness lies less in the verbal elements and more in the get-up. Having carefully considered the matter, I still consider the differences between the marks as registered, and the forms of use, alters the distinctive character

26. In the hearing before me, Mr Wood suggested that a rosette is a non-distinctive border for a food product. While I accept that a rosette is not very distinctive, I think the Hearing Officer is right to suggest that the get-up of the SERIOUSLY TASTY (#648) mark is closer to the 2017 form (and probably the 2014 form as well) than the SERIOUSLY STRONG (#123) mark. Nevertheless, I agree with the Hearing Officer's conclusion in relation to the SERIOUSLY TASTY mark and his reasoning set out above. This means that the Appellant has failed to establish use of the SERIOUSLY TASTY mark as well.

27. Accordingly, I do not need to consider the Appellant's challenge to the Hearing Officer's contingent finding on likelihood of confusion.

### **Conclusion**

28. Overall, I uphold the Hearing Officer's decision and dismiss the appeal.

29. As the Respondent did not take any part in these appeal proceedings (other than attending in the virtual public gallery), I make no order as to costs.

PHILLIP JOHNSON  
THE APPOINTED PERSON  
28 March 2022

### **Representation:**

For the Appellant: Mr Aaron Wood of Brandsmiths

The Respondent did not take part in the appeal.