

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO 3298871 BY MICHAEL CORRADO JACKSON & SAJID JAVED TO REGISTER A DEVICE MARK



AS A TRADE MARK IN CLASSES 30 & 43 AND OPPOSITION THERETO (UNDER NO. 413107) BY UNILEVER PLC

DECISION

INTRODUCTION

1. This is an appeal by the Applicants from the decision of the hearing officer, Ms Beverley Hedley dated 11 November 2019 in respect of its UK trade mark application no. 3298871 in the name of Michael Corrado Jackson and Sajid Javed. The application was opposed by Unilever Plc (“the Opponent”) on the basis of s.5(2)(b) of the Act relying on two earlier marks, namely:
 - a. UK trade mark no. 2237179 WHIPPY in classes 7, 11 and 30 (the WHIPPY Mark);
 - b. UK trade mark no. 786957 MR. WHIPPY in class 30 (the MR. WHIPPY Mark).

2. The hearing officer held as follows (in summary):
 - a. the Opponent had failed to show any genuine use of the WHIPPY Mark;
 - b. the Opponent had proved genuine use of the MR. WHIPPY Mark in relation to “Ice Cream”;

c. there was a likelihood of confusion between the MR. WHIPPY Mark and the mark applied for in respect of some of the goods and services, namely:

Class 30: confectionery containing milk; bakery and confectionery products; pastries; preparations made from cereals; sauces; ices; edible ices; ice cream; ice cream cones; water ices; frozen confectionery; ice; snacks; preparations for making the aforesaid goods, in so far as not included in other classes.

Class 43: Services for providing food and drink; snack bar services; ice cream parlour services; catering; restaurant services;

d. the Opponent had not established a likelihood of confusion between the MR. WHIPPY Mark and the mark applied for in respect of the following further goods and services:

Class 30: Coffee; tea; cocoa; sugar; rice; tapioca; sago; coffee products; bread; flour; honey; yeast; baking powder; salt and mustard; vinegar; spices; preparations for making the aforesaid goods, in so far as not included in other classes.

Class 43: Temporary accommodation services; bar services; juice bar services.

3. The Applicant contends that the hearing officer was wrong to conclude that there had been genuine use of the MR. WHIPPY Mark in relation to “Ice Cream” and that the opposition should therefore have failed entirely.
4. The Applicant contends that the hearing officer wrongly applied the law on genuine use in relation to the facts presented before her and that, had she applied the approach correctly in relation to the evidence, she would have found that no use had been established. Accordingly, the sole issue on this appeal is whether the hearing officer correctly applied the test for genuine use of a mark to the evidence. There is no challenge to the hearing officer’s summary of the law. Nor is it said that the hearing officer overlooked a critical or determinative fact in the evaluation she conducted. The appeal focusses entirely on the quality and sufficiency of the evidence of use.

LAW

(i) Approach to appeal

5. The approach to an appeal of this kind is well known. In *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) (10 March 2017) Arnold J, as he then was, said:

“11. The principles applicable on an appeal from the Registrar of Trade Mark were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (O/017/17) at [14]-[52]. Neither party took issue with his summary at [52], which is equally applicable in this jurisdiction:

"(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).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is a 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*)."

7. That approach accords with the more recent guidance concerning appeals involving evaluative assessments in *Actavis Group PTC EHF and others v ICOS Corporation and another* [\[2019\] UKSC 15](#) at [78] to [80] (per Lord Hodge JSC, with whom Lady Hale PSC and Lord Kerr, Lord Sumption and Lord Briggs JJSC agreed):

"78. Finally, before addressing directly the question whether the Court of Appeal was entitled to reverse Birss J's finding of non-obviousness, I remind myself of the limits of an appellate court's power to overturn the evaluation of a trial judge in this field. Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v Bessant, In re Reef Trade Mark* [\[2002\] EWCA Civ 763](#); [\[2003\] RPC 5](#), paras 25-28 per Robert Walker LJ.

79. An experienced patent judge faced with a challenge to a patent on the ground of obviousness, and who has heard oral evidence including cross-examination, carries out an evaluation of all the relevant factors, none of which alone is decisive but each of which must be weighed in the balance in reaching a conclusion. In *Biogen Inc v Medeva plc* [\[1997\] RPC 1](#), 45, Lord Hoffmann emphasised the need for appellate caution in reversing the judge's evaluation of the facts where the application of a legal standard involved no question of principle but was simply a matter of degree. He held that it would be wrong to interfere with the judge's assessment if no question of principle were involved.

80. What is a question of principle in this context? 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. What is the nature of such an evaluative error? In this case we are not concerned with

any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This 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: *Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.”

8. I apply this approach to the present appeal.

(ii) Proof of use

9. The hearing officer set out the law at [23], following the summary in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at [15]:

“(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43][51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an

outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].”

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

10. The Applicant also refers to the *Awareness Limited v Plymouth City Council* (Case BL O/236/13) (“*Awareness*”) at [22]-[28] where the Appointed Person said:

"22. The burden lies on the registered proprietor to prove use... However, it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

and further at paragraph 28:

"28. ... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as "tuition services", is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to "tuition services" even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted."

11. In *Awareness* those observations were made in the context of a case in which the hearing officer had rejected as insufficient evidence provided by the undertaking seeking to prove use. In a situation such as the present case where the hearing officer has concluded, after a nuanced evaluation, that despite being open to certain criticisms, use has been sufficiently proved for some goods but not for others, an appellate tribunal should be cautious before overturning that decision on the basis that there was insufficient evidence to reach that conclusion. A question of whether evidence is sufficient to establish use itself involves a global evaluation and is subject to the same constraints of appellate modesty as other such evaluations.

ARGUMENTS ON APPEAL

12. The Applicant submits that the hearing officer erred in four main respects which I address in turn and which were amplified in oral submissions.

13. First, it is said that at [28] the hearing officer incorrectly summarised the key factors to be taken into account in determining a finding of genuine use and that this was not consistent with the approach taken in *Awareness*.

14. I am unable to accept that submission. At [28], the hearing officer set out the key passages of *Awareness* to which I have referred above and said correctly that it was not essential to provide particular types of evidence. She said, and I agree, that the evidence must "when considered as a whole, show that the mark at issue has been put to genuine

use within the UK”. As she acknowledged, each case must turn on its own facts and that there was no unique way of satisfying the evidential requirements (see Decision at [31]).

15. Second, it is said that at [30]-[31] the hearing officer wrongly interpreted the facts by concluding that

1. the evidence indicated that stockists must sell ice cream under the MR. WHIPPY Mark and
2. the exhibited photographs illustrated use of the MR. WHIPPY Mark with consent;

16. Again, I do not believe that the hearing officer fell into error in these respects. She was entitled to conclude that, on the balance of probabilities, the Opponent had sufficiently proven sufficient use of the MR. WHIPPY Mark during the relevant period and to base that finding largely on the solid (and unquestioned) evidence of sales of ice cream mix to multiple undertakings operating ice cream vans for making up into ice creams pursuant to agreements with the Opponents.

17. The Opponent submitted evidence, primarily that of Mr Michael Rorai of the Opponent, including several supporting exhibits describing the Opponent’s business particularly in ice creams and ice cream mixes. The evidence directed attention to various websites from which MR. WHIPPY ice cream mixes could be purchased and the statements exhibited or referred to sample agreements with undertakings operating ice creams vans relating to the sale of MR WHIPPY ice cream (of which a list of van registrations was provided) and a photograph of such a van in operation (albeit not with a date within the period) with a prominent sign advertising “MR WHIPPY 99” singles and doubles for sale alongside several other brands.

18. The Opponent’s evidence referred to the significant sales volume of ice cream mix packs (which was to be made up into ice cream by the undertaking selling it pursuant to those agreements) in ice cream vans. In the years 2015-2018, the sales volume was never less than 100,000 and in 2018 alone, approaching half a million packs (each of which would make up approximately 20 MR. WHIPPY ice creams). In consequence,

taken at face value, as a whole, this evidence demonstrated that it was overwhelmingly likely that very significant numbers of MR. WHIPPY branded ice creams would be sold in the United Kingdom in the relevant period (assuming, as is again highly likely that a significant proportion of the ice cream mixes sold were made up into ice creams).

19. The Applicant questions the absence of evidence of actual sale of ice creams as opposed to ice cream mix and criticises the evidence for its thinness as to specifically whether a significant proportion of sales were under the MR. WHIPPY Mark. I am unpersuaded by that point. First, it is not suggested that purchasers of ice cream mix would have any other significant use for it other than to make up into ice cream for onward sale. Second, it is overwhelmingly likely that, even if a very significant proportion of the ice cream made up from mix was not sold under the MR. WHIPPY Mark (which is itself not very likely given the agreement and a van operator's reasons to use the brand), very substantial absolute volumes of such ice cream were sold under that brand during the relevant period. There is no evidence (including none from the Applicant) suggesting that operators of ice cream vans would be likely to have done anything else and some (albeit limited) photographic evidence that at least some operators were selling such ice cream in that way. The volumes of sales of ice cream mix are so large that even if a relatively small fraction was sold under the MR. WHIPPY Mark, that would still amount to a significant number of ice creams sufficient to satisfy the relatively modest quantitative requirements for genuine use of a trade mark, having regard to the substantial size of the ice cream market (see the summary of the law in para. 9 above).

20. The Notice of Opposition says that the hearing officer "reached a wrongful and dangerous assumption that in selling MR. WHIPPY branded ice cream mix to third parties, that such third parties sell ice cream under the mark MR. WHIPPY with consent of the Opponent, without any collaborating or conclusive evidence that this is the case." However, I do not regard that as a wrongful assumption, still less dangerous. Apart from the inherent implausibility of purchasers not doing so, at least in significant quantities, there is actual evidence (albeit limited) that this happened. It seems to me to be beside the point whether or not the stockists were contractually obliged to sell ice cream under the MR. WHIPPY Mark. The question was whether it was shown on the evidence on the balance of probabilities that (a) they had in fact done so and (b) such was with the Opponent's consent pursuant to the agreements referred to.

21. I was not persuaded that there was substance in the argument that these sales might have been without consent of the Opponent. The whole purpose of buying ice cream mix was to sell it on in finished form.
22. Moreover, in the absence of any challenge to the evidence submitted by the Opponent by way of cross-examination, or its own evidence relating to the market, there is nothing to set against the clear, even if limited, evidence of the Opponent that it sells ice cream under the MR WHIPPY Mark through ice cream vans throughout the UK and the further evidence as to the periods during which (and the scale on which) it has sold ice cream mix for the purpose of that being done.

The hearing officer's conclusions on use

23. The hearing officer summarised her conclusions on the evidence and as to use at [30]-[31] as follows:

“30) Mr Hoole has made valid criticisms of the opponent's evidence of use, insofar as it purports to demonstrate genuine use in relation to ice cream per se, as referred to in the bullet points above. I am particularly mindful of the lack of any sales figures for ice cream (as opposed to sales of packs of ice cream mix) and that the size of the relevant market is significant. I also agree that it cannot be assumed that all the ice cream mix was subsequently sold as ice cream under the mark MR. WHIPPY, as contended by Mr Moss. However, I also bear in mind that it is not strictly necessary to exhibit any particular kind of documentation. Therefore, the absence of sales figures for ice cream per se, is not, of itself, fatal if, when considered overall, the evidence nevertheless paints a picture of the opponent having used the mark such as to create or preserve a share of the market. Further, while I note the various cases referred to by Mr Hoole in his evidence and at the hearing, every case must be determined on its own particular facts and circumstances.

31) The evidence before me shows a number of agreements within the relevant period with various third parties. They indicate that those third parties must stock and sell (exclusively) MR. WHIPPY ice cream in the soft serve category. While it is true that there is no evidence from those third parties attesting to sales of MR. WHIPPY branded ice cream, I am prepared to accept that those parties purchased mix from the opponent (or from the opponent's chosen wholesaler, which appears to be a condition stipulated in at least one of the agreements) to sell as ice cream under the mark MR. WHIPPY with the opponent's consent. The

photographic evidence, whilst minimal (and some of which falls outside the relevant period or is undated), does show examples of use of MR. WHIPPY within the relevant period on menu boards for ice cream and the front of an ice cream van. Further, the photograph of the ice cream stall, although outside the relevant period, is under three months after the end of that period and therefore I consider it more probable than not that it was in operation within the relevant time. There is also the evidence of brochures which the opponent has circulated in the years within the relevant period to wholesalers, leisure parks, zoos etc. showing promotion of MR. WHIPPY ice cream and related point of sale materials (of the kind shown in use on the ice cream stall). Taking the evidence in round, and whilst recognising that it is not without deficiencies, I find that the mark MR. WHIPPY has, on the balance of probabilities, been put to genuine use by the opponent, or at least with its consent, in relation to ice cream within the relevant period.”

24. In my view, the hearing officer analysed the issue correctly, applied reasonably exacting standards of evaluation as required by the case law, made appropriate criticisms of the evidence but nonetheless reached a conclusion that use had been sufficiently proved which was clearly open to her on the material provided and which accords with common sense.

Other points

25. I can deal with the other two points relatively briefly in the light of the above.
26. It is said by the Applicant that insufficient account was taken by the hearing officer of the economic sector concerned, the nature of the goods, and the characteristics of the market (being low cost, high volume) in reaching her conclusion that there was sufficient proof of genuine use of the mark in relation to ice cream, having regard to the potential evidence available to the Opponent. It is also said that the evidence submitted by the Opponent was not sufficiently solid and specific to establish genuine use of the mark MR. WHIPPY Mark in relation to ice cream or to demonstrate sufficient use (or intention) to carve out, create or preserve a market share in the MR. WHIPPY Mark in relation to the sale of ice creams.
27. In my view they are answered by the same material to which I have referred under the second point. In this case there was sufficient evidence showing that on the balance of probabilities there had been use of the MR. WHIPPY Mark in relation to a substantial number of ice creams in the United Kingdom over an extended period. In my view

this case is far removed from the *Awareness* case which did not involve a situation where there was significant and unchallenged evidence of very large sales (in the millions) of an unfinished product under the mark (the ice cream mix) and no convincing reason why that should not have been carried through to very significant sales of the finished product with at a least a significant proportion of that also being done under the mark.

28. For these reasons, I do not consider that any of the grounds of appeal have been made out. The remaining points in the Notice of Appeal are ways of reformulating the arguments I have not accepted above or are addressed by the discussion.
29. The appeal must therefore be dismissed. There being no other ground upon which it is said that the Applicant's mark should proceed to registration to a greater extent than permitted by the hearing officer, it must be limited in the manner indicated by her.

COSTS

30. The Opponent seeks an award of off scale costs to reflect what it contends to be the lack of merit of the arguments and the unnecessary cost and time to which it has been put. The Opponent contends that appeals which involve a re-hearing of the facts should be discouraged. While that is true, and although I have rejected the points made by the Applicants, it does not appear to me to have been procedurally improper to advance this appeal, unmeritorious as it is, given that the hearing officer accepted that valid criticisms had been made of aspects of the Opponent's evidence.
31. The mistake (if it can be so described) that the Applicants appear to have made in pursuing this appeal is to say that because it was open to the Opponent to have produced better evidence of use and they had not done so, it should be treated as having failed to discharge its evidential burden. That does not seem to be the kind of unreasonable conduct where off-scale costs would be justified. Moreover, this is not a case where advancing such a case has forced a respondent to run up large costs in defending the decision below. To the contrary, the Opponent's skeleton argument is justifiably and commendably brief. The Opponent's counsel realistically recognised that the application for off-scale costs was ambitious and I reject it.

32. The Applicants should therefore pay the Opponents **£500** in total by way of costs made up of:

Considering Notice of Appeal: £200

Preparing skeleton argument and attending hearing: £300

DANIEL ALEXANDER QC

APPOINTED PERSON

1 June 2020

Representation

Mr Christopher Hoole, Appleyard Lees IP LLP for the Applicant/Appellant

Mr Jonathan Moss instructed by Baker & Mckenzie LLP for the Opponent/Respondent