

O/328/20

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO. 3211021 IN THE NAME OF ABP TECHNOLOGY LIMITED

AND IN APPLICATION FOR DECLARATION OF INVALIDITY THERETO UNDER NO. 502103 BY VOYETRA TURTLE BEACH, INC

AND IN THE MATTER OF UK APPLICATION NO. 3297404 IN THE NAME OF VOYETRA TURTLE BEACH, INC

AND IN THE OPPOSITON THERETO UNDER NO. 423431 BY ABP TECHNOLOGY LIMITED

DECISION

Introduction

1. This is an appeal against a decision of Mr Mark King, acting on behalf of the Registrar of Trade Marks, dated 16 September 2019 (O-544-19). The proceedings related to an opposition against a trade mark application and an application for invalidation against the trade mark registration which formed the basis of the opposition. The Hearing Officer found that: (1) the application for invalidity was dismissed; (2) the opposition was allowed; and ordered Voyetra Turtle Beach, Inc to pay ABP Technology Limited £2,500 as a contribution towards its costs.
2. On 16 March 2018, Voyetra Turtle Beach, Inc ("*Voyetra*") applied for the word mark STEALTH in the UK ("*the Application*") in respect of the following Class 9 goods:

Headsets for use with computers; headsets for use with mobile devices, namely, smartphones, MP3 players, tablets and PDAs; headsets for use with home entertainment systems; headphones; wireless headphones; cases for headphones; Headsets for use with game consoles; headsets for use with controllers for game consoles; headsets for use with hand-held units for playing video games other than those adapted for use with an external display screen or monitor.
3. ABP Technology Limited ("*ABP*") filed an opposition to the application on the basis of section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 ("*the 1994 Act*").
4. For the purposes of section 5(2)(b) ABP relied upon UK Trade Mark No 3211021 ("*the ABP registration*") for:



This mark was filed on 6 February 2017 and registered on 9 June 2017 with respect to ‘*Audio headsets for playing video games; virtual reality headsets*’ in Class 9.

5. The section 5(4)(a) ground of Opposition was based upon earlier rights in the mark STEALTH which it was stated had been used with respect of audio headsets for playing video games and virtual reality headsets since 2014.
6. Voyetra filed a counterstatement denying all the claims made and seeking an award of costs in its favour.
7. On 8 June 2018 Voyetra filed an invalidity action with respect to the ABP registration. It did so pursuant to section 47 of the 1994 Act on the basis of section 5(4)(a) of the 1994 Act. In support of their claim Voyetra claimed to have been selling headphones and headsets under the sign STEALTH since 1 October 2014.
8. ABP filed a counterstatement denying all the claims made and seeking an award of costs in its favour.
9. Both sides filed evidence.
10. A hearing took place at which ABP was represented by Chris Aikens of Counsel, instructed by A.A. Thornton & Co. Voyetra was represented by Benet Brandreth QC of Counsel, instructed by Dolleymores.

The Hearing Officer’s Decision

11. The Hearing Officer first considered the application for invalidity on the grounds of section 5(4)(a) of the 1994 Act.
12. Having set out the legal principles with regard to the law of passing off the Hearing Officer considered the question of the relevant date(s) for the purposes of the assessment that he was required to make. Having referred to paragraphs [39] to [43] of the decision of Daniel Alexander QC sitting as the Appointed Person in Advanced Perimeter Systems Limited v. Multisys Computers Limited (MULTISYS TM) [2012] RPC 14 the Hearing Officer went on to summarise the parties’ respective position as follows (footnotes omitted):

39) As outlined by the above authorities, the date for assessing a passing off claim in invalidation proceedings is typically the date the mark in suit was applied for, in this case 6 February 2017. However, both parties claim to be the senior user. Who

the senior user is and applying the correct legal approach are the central issues to this dispute. I shall begin with the law.

40) Mr Aikens, on behalf of the proprietor, argues that the senior user is the party who first makes external use of the mark and not the person who first generates a protectable goodwill. He argues that from the case law this can be the only interpretation of the phrase. In support of his Mr Aikens referred me to *Wadlow* whereby it is stated at 9-85 that: “It is self-evident that the senior user is entitled to continue with conduct which was innocent in its inception notwithstanding that it might later be said to convey a misrepresentation to the majority of the public”.

41) Mr Brandreth disagrees. He argues that the relevant date is not the date that the mark was first “used”, i.e. presented to the public, it is the date when whichever party established the first right. In other words, “goodwill is required”¹² and whoever establishes it first is the senior user. In support of his claim, Mr Brandreth prays in aid of *Multisys* and *Crooms*, and tested Mr Aikens’ argument by saying that if the “teaser advertisement” is the basis to establish ABP as the senior user, then any party may tell others that it intends to launch a mark but then sit on it for a period of time and then tell a subsequent user of the mark that they can no longer use it. He described this approach as “nonsense”. Further, Mr Brandreth argues that Voyetra was not aware of the “teaser advertisement” and could not have been in a position to challenge such “use”.

42) To summarise, on the one hand, Mr Brandreth argues that the senior user is established by the first who could have enforced its right, i.e. the first to have established goodwill and, on the other, Mr Aikens claims it to be the first date of external use.

13. Having referred to the judgment of the Court of Appeal in Roger Maier and Assos of Switzerland SA v. ASOS plc and ASOS.com Limited [2015] EWCA Civ 220 and the decision of Thomas Mitcheson QC sitting at the Appointed Person in CASABLANCA TM (O-349-16) at paragraphs [35] to [37] the Hearing Officer concluded as follows (emphasis as in the original, footnotes omitted):

45) The guidance set out in *Assos* and *Casablanca* is clear. I must firstly establish the date the proprietor’s actionable **use** began. It is not the date that ABP acquired goodwill of its own¹³. In other words, the relevance of ABP’s use is limited to establishing the date that the actionable use began. Once this date has been established, it is for Voyetra to show that it had protectable goodwill.

14. The Hearing Officer then proceeded to consider when ABP's actionable use began and concluded as follows:

48) Taking all of the evidence into account, it builds a clear and consistent picture that the mark was conceptualised in around January 2014 and subsequent "Mock Ups" for inclusion in an Argos catalogue produced in February 2014. This led to discussions and sales being agreed in August 2014 and then sales took place in December, as evidenced by the invoice dated 17 December 2014 to Argos for 600 units. Further, the evidence shows that there were various price lists produced for the STEALTH products which were due to be released in GAME in September.

49) The evidence is not without fault and could be clearer. However, the action taken by ABP could have been the subject off a *quia timet* injunction and therefore considered to be actionable use of the mark STEALTH. Mr Brandreth argues that it could not have been aware of such use in order to have acted but this argument appears to go against him since it indicates that the use was actionable.

50) In view of the above, I find that the first use by ABP to be early to mid-2014. I should also point out that I do not consider ABP to have acquired goodwill at this point but it is clear from *Assos* and Mr Mitcheson's guidance in *Casablanca* that this is not required. In fact, I find the present circumstances to be entirely consistent with the scenario illustrated in the aforementioned cases.

15. The Hearing Officer then went on to consider whether Voyetra was the 'senior user' and found that '*In order to be the senior user, Voyetra must demonstrate that it had a protectable goodwill prior to the date that the actionable use began.*' (paragraph [51] of the Decision). Having referred to the case law with regard to what is required to establish goodwill at paragraphs [52] to [56] of his Decision the Hearing Officer concluded as follows (footnotes excluded):

57) Voyetra claims to have first presented its headset under the sign STEALTH in June 2014 at the E3 exhibition in LA. Presenting a product at an exhibition is not in-itself evidence of goodwill, not least because it is established law that customers in the UK are necessary for a finding of goodwill. Voyetra also states that the first listing of its STEALTH headset in the UK was on Amazon on 15 August 2015. I do not consider the Amazon Keepa report to be sufficient evidence to demonstrate goodwill. It does not show the mark on sale to UK customers. Instead I find that the date on which Voyetra has demonstrated that it had acquired a protectable goodwill to be 13 October 2014 which is the date of the invoice from Voyetra to GAME

for £65,988 (Vat inc.). The invoice is for 1000 “Ear Force Stealth 500p”. This is after ABP’s date of actionable use and therefore it is not the senior user.

58) Even if I were to accept that the Keepa report is the date that its goodwill had been established (August 2014), it would be after ABP’s first actionable use and it is not the senior user. Voyetra’s could not have prevented ABP’s use at the date when ABP applied for its mark because Voyetra had no right to prevent ABP’s use at the date it commenced.

16. In the light of those findings the Hearing Officer found that the application for invalidity failed (paragraph [59] of his Decision).
17. The Hearing Officer then considered the Opposition. He only did so briefly on the basis that during the hearing before him it was agreed with Counsel that ‘*the invalidity and opposition proceedings stand and fall together*’. That that is correct was also the position adopted by the parties in the context of the present appeal.
18. Against this background the Hearing Officer considered the section 5(2)(b) ground of Opposition which he found had been made out on the basis that there was a likelihood of indirect confusion (see paragraph [61] to [65] of the Decision). No finding was made with regard to the section 5(4)(a) ground of Opposition.

The appeal

19. On the 10 October 2019, Voyetra filed an appeal against the Hearing Officer’s Decision pursuant to section 76 of the 1994 Act.
20. In broad summary the Grounds of Appeal identified two errors:
 - (1) That the Hearing Officer had erred in law in his approach to section 5(4)(a) of the 1994 Act in the context of the application for invalidity of the ABP registration. In particular it is submitted that he fell into error by substituting the correct test under section 5(4)(a) of the 1994 Act with a short hand algorithmic approach and therefore only considered the question of what constituted the ‘senior user’; and
 - (2) That the Hearing Officer erred in his assessment of the evidence of use by treating certain of the evidence of ABP as ‘*uncontested*’ when in fact it was contested.
21. A Respondent’s Notice was filed on behalf of ABP. The primary position of ABP was that the Hearing Officer’s decision should be upheld. In the event that it was held on appeal that the determinative question in the invalidity was ‘*whether there was an actionable misrepresentation to end consumers at the filing date of the [ABP registration]*’ then ‘*the answer is no*’.

22. The hearing of the appeal took place on 17 April 2020. At the hearing of the appeal Voyetra was represented by Benet Brandreth QC instructed by Dolleymores and ABP by Chris Aikens instructed by AA Thornton & Co.

Standard of review

23. An appeal against decisions taken by the Registrar 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 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. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].
24. Moreover, where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

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.

25. In Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115] Lewison LJ said:

114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva plc* [1977] RPC 1;

Piglowska v Piglowski [1999] 1 WLR 1360 ; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 ; *Re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33 [2013] 1 WLR 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58 [2013] 1 WLR 2477 . . .

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: *see Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

26. That this is the correct approach was not disputed by the parties to the present appeal.

Decision

The first error

27. As noted above the first error identified by Voyetra is that the Hearing Officer fell into error by substituting the correct test under section 5(4)(a) of the 1994 Act with a short hand algorithmic approach and therefore considered only the question of what constituted the ‘senior user’ in reaching his conclusion.
28. The first question that arises in the context of the first error is what the relevant date for the assessment under section 5(4)(a) of the 1994 Act is. Voyetra contends that this is not a controversial issue but that the Hearing Officer considered that it was which led him into error on the basis that ‘*he understood [this issue] to be related to the question of who the “senior user” was*’.
29. It was accepted before me on behalf of Voyetra that before the Hearing Officer both parties had run their arguments by reference to who was said to be the ‘senior user’ as recorded in paragraphs [40], [41] and [42] of the Decision and that this may have led to ‘*confusion*’ on the part of the Hearing Officer. I also note in this connection that on

the basis of the submissions before him that the Hearing Officer considered ‘*Who the senior user is and applying the correct legal approach are the central issues in dispute*’ (see paragraph [39] of the Decision).

30. The reference to the expression ‘senior user’ came originally from the Decision of Geoffrey Hobbs QC sitting as the Appointed Person in CROOM’s TM [2005] RPC 2 at paragraphs [45] and [46] where the underlying principles with regard to rival claims raised with regard to the right to use a trade mark in the context of an objection under section 5(4)(a) of the 1994 Act were identified. It is however important to note that in the decision in CROOM’s TM the reference to ‘senior user’ was not a reference to the first to use a trade mark but the first to acquire a protectable goodwill under the common law (as is confirmed by paragraph [49] of the decision in CROOM’s TM).
31. The principles set out in CROOM’s TM were referred to by the Hearing Officer in his Decision at paragraph [38] in which he set out the analysis of the case law from the decision of Daniel Alexander QC sitting as the Appointed Person in MULTISYS TM [2012] RPC 14 which included a quote from paragraph [46] of the decision in CROOM’s TM which contained the reference to the analysis by reference to the term ‘senior user’.
32. However, the Hearing Officer did not set out the approach that he had to take in deciding the issue under section 5(4)(a) of the 1994 Act by reference to the analysis (or algorithm as Voyetra puts it) in CROOM’s TM.
33. Instead, on the basis of MULTISYS TM the Hearing Officer clearly and correctly set out in paragraph [39] of his Decision that in the normal course the date for assessing a passing off claim in invalidation proceedings was the date the mark in suit was applied for. In the present case that date was 6 February 2017.
34. However, the Hearing Officer clearly appreciated that in order to determine the position as of 6 February 2017, in circumstances where there was a dispute between the parties with regard to their respective use *prior to* the application date, it was relevant (and indeed both parties submitted it was appropriate) for him to assess the passing off claim at a date prior to the application date. That relevant date was identified by the Hearing Officer as the date of first actionable use. The Hearing Officer came to this view by reference to the law set out in the judgment of the Court of Appeal in Roger Maier and Assos of Switzerland SA v. ASOS plc and AOS.com Limited [2015] EWCA Civ 220 and the decision of Thomas Mitcheson QC sitting as the Appointed Person in CASABLANCA TM (O-349-16). It seems to me that there is no error in the Hearing Officer’s statement of the legal approach.
35. The Hearing Officer then proceeded to set out the legal approach he was going to take, without any reference to the term ‘senior user’, to the case that was before him.

He concluded at paragraph [45] of his Decision that in order to consider the position prior to the application date he first had to decide the date when *ABP's actionable use* began and noted that this date was not dependent upon the generation of goodwill by ABP; and second that once that date had been identified it was for *Voyetra to show that it had a protectable goodwill* as of that date. It seems to me that this was the correct.

36. In the circumstances, I reject the submission that (1) the net effect of the Hearing Officer's approach was to give undue weight to the single question who first made external use of the sign in question; (2) the Hearing Officer was '*confused*' with regards to the legal issues that had to be decided as a result of the parties submissions by reference to the term 'senior user'; or (3) the *only* question in the present case was whether there was passing off as at the filing date rather than considering what the position was at the time when the first actionable use began and to then go on to assess whether the position would be any different at the later filing date.
37. Having identified the correct legal approach, the Hearing Officer then went on to make his findings by reference to the facts as he found them. Some of these findings are also the subject of the present appeal and which are dealt with below.
38. First the Hearing Officer considered the date upon which ABP's first actionable use began. In making this assessment the Hearing Officer clearly had in mind the case law summarised in paragraph [42] of MULTISYS TM (above) which he had set out in paragraph [38] of his Decision which states as follows:

42. . . . it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

39. In summary, Voyetra seeks to challenge the Hearing Officer's finding of the date of the first actionable use on the basis that¹:
 - (1) The Hearing Officer did not give careful consideration to the nature and extent of the antecedent use relied upon by ABP; and

¹ There is a further point taken on the evidence that is dealt with in the context of the second error below.

(2) The Hearing Officer erred in his identification of ‘actionable use’ on the basis of his findings with regard to whether the use could have been the subject of a *quia timet* action by Voyetra.

40. With regard to the first point this was raised by reference to paragraphs [30] to [33] of the Decision in CASABLANCA TM which state as follows:

31. Whilst accepting that it was settled English Law that the relevant date for assessing passing off was the date of date of the commencement of the conduct complained of (*Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429), the Opponent emphasized that the nature of the antecedent use had to be examined carefully. In particular the Opponent relied on examples of a number of types of use that it was submitted would not be sufficient to establish a senior user, suggesting the following conditions must apply:

(a) The use in question must be *distinctive* use. Thus use of the phrase “*Our tea is from Casablanca*” would not give rise to relevant antecedent use of the mark in the Application.

(b) *Internal* use would not be relevant - an inter-office memo referring to “Casablanca” tea would be insufficient to constitute antecedent use for the purposes of defeating a passing off claim.

(c) Use for goods/services different to those against which the opposition is directed would not be relevant use. Thus use of “Casablanca” for perfumes would be insufficient to constitute antecedent use for this purpose.

(d) Use which did not involve UK marketing or sales would not be relevant even if it generated knowledge of the mark in the UK.

(e) One-off or sporadic use would be insufficient. A business which makes a one-off sale under a given sign does not thereby immunize itself against a passing off claim aimed at the use of that sign, for all time. It was also suggested that small sporadic sales, for instance every year, of an ordinary consumer product, would be insufficient to give rise to relevant antecedent use.

32. The Opponent submitted that the Hearing Officer had not assessed the issue of antecedent use with these factors in mind, and accordingly had fallen into error.

33. I accept that the type of use which is alleged to amount to antecedent use must be assessed carefully. Some of the factors referred to are clearly relevant – non-distinctive use, use on

different goods and use outside the UK would rarely give rise to antecedent rights. Internal use and sporadic use are more difficult and must turn on the particular facts of the case. For example the suggestion that it would be wrong if a user could “inoculate” itself against a later trade mark application with a single use of a particular mark clearly has weight – although those are not the facts of the present case. Further, the boundaries for precisely what sort of intermittent use can amount to antecedent use are not well defined by the authorities and must be a matter of fact and degree. The question for me is whether this uncertainty has any bearing on the conclusions reached by the Hearing Officer and whether it can be shown that she fell into error.

41. I agree with the observations made by Thomas Mitcheson QC in paragraph [33] of his Decision in CASABLANCA TM. The type of use that is alleged to mount to antecedent use must be assessed carefully and is a matter of fact and degree. It is true that the Hearing Officer did not refer to the particular paragraphs in CASABLANCA TM upon which Voyetra seek to rely however (1) he was clearly familiar with the decision in that case as he referred to it in his Decision; and (2) his review of the evidence in paragraphs [46] to [50] of the Decision demonstrate that he was aware of the exercise that he was required to engage in.
42. Further in this connection it is to be noted that firstly Voyetra does not appear to say that the antecedent use fell within any of the categories identified in paragraph [33] of CASABLANCA TM; and secondly it seems clear from the evidence that such actionable use did not at any relevant stage cease but rather continued.
43. In the circumstances, whilst I agree with the Hearing Officer’s observation that ‘*The evidence is not without fault and could be clearer*’ it seems to me that it was open to him to reach the conclusions that he did that the date of the first actual or threatened act of passing off by ABP was early to mid-2014 on the basis of the materials that were before him.
44. With regard to the reference to a ‘*quia timet injunction*’ it seems to me that the Hearing Officer was using this wording in paragraph [49] of the Decision as a way of expressing his view that the various examples of use of the mark STEALTH by ABP was of a type or class that would have been actionable by way of proceedings for passing off; and not that Voyetra could or should as a matter of fact have brought such proceedings. That this is the correct view to take of the finding is confirmed by the last sentence of that paragraph where the Hearing Officer states ‘*[Voyetra] argues that it could not have been aware of such use in order to have acted but this argument appears to go against [it] since it indicates that the use was actionable*’.

45. In any event, it does not seem to me that the mere fact that the Hearing Officer expressed his view the way that he did in paragraph [49] of the Decision detracts from his conclusion that the relevant i.e. actionable first use took place in early to mid-2014 in paragraph [50] of the Decision. Given that is my view it is not necessary for me to consider any other dates prior to the date of application that seem to be being put forward on behalf of Voyetra as being the date of first actionable use for the for the purposes of the relevant assessment and I do not do so.
46. The Hearing Officer then turned to consider the second issue that was before him namely had Voyetra established '*that it has a protectable goodwill prior to the date that the actionable use began*' (Decision paragraph [51] emphasis in the original). That is to say was Voyetra entitled to a '*right to protection conferred upon senior users at common law*' (see CROOM TM at paragraphs [45] and [46]).
47. It seems to me that the Hearing Officer correctly identified the issue that he had to decide on the basis of the evidence that was before him. It also seems to me that given the way that the case had been presented to him it was open to him (and indeed unsurprising) to refer to the term 'senior user' in the context of his assessment of Voyetra's position.
48. In considering the question of protectable goodwill, the decision taker must take into account his or her findings in relation to the relevant date being the date of the first actionable use. This requires the party seeking to rely upon its right to protection at common law to establish that it can satisfy the requirements to bring an action for passing off i.e. has a protectable goodwill as of that date and not any other date or dates as suggested by Voyetra on this appeal.
49. There is no suggestion on this appeal that the Hearing Officer did not identify the correct legal approach to the issue of whether or not a party has established that it has a protectable goodwill in paragraphs [52] to [56] of the Decision. Nor is it suggested that the Hearing Officer made any errors with regard to his findings of fact that he made in paragraphs [57] and [58] with regard to the use made of the sign STEALTH by Voyetra in those paragraphs. Further in this connection it is to be noted that as set out in paragraph [7] above, in support of Voyetra's application for invalidity it sought to rely upon sales of headphones and headsets under the sign STEALTH since October 2014.
50. In the circumstances where *all* Voyetra's use of the sign STEALTH *post-dated* the first actionable use by ABP it follows that such use could not support a claim for common law protection by way of an action for passing off as of that date.
51. In the premises, it seems to me that it was open to the Hearing Officer to go on to find as he did at paragraph [58] of his Decision (and in line with the approach set out in paragraph [42] in MULTISYS TM (above)) that '*Voyetra's (sic) could not have*

prevented ABP's use at the date when ABP applied for its mark because Voyetra had no right to prevent ABP's use at the date it commenced'.

52. Further, to the extent that it may have been suggested otherwise by Voyetra on this appeal (1) the question of whether or not ABP did or did not have any goodwill in the mark as of the date of first actionable use or indeed at any other point in time was, for the reasons set out above, not relevant to the assessment that the Hearing Officer was required to make; and (2) the assessment under section 5(4)(a) of the 1994 Act must be made by reference to the normal and fair use of ABP's mark with respect to the goods for which it is registered (see MULTISYS TM (above) at paragraph [36]).
53. In addition, in circumstances where all of Voyetra's use of the sign STEALTH post-dated the first actionable use by ABP and where as noted above such use continued the points that Voyetra sought to raise on this appeal with regard to the Hearing Officer's failure to consider '*all possible classes of people with whom Voyetra had goodwill*' do not arise and I therefore do not consider them.
54. In the premises, it is my view that it was open to the Hearing Officer to reach the conclusion that he did and I do not accept that he made the first error relied upon by Voyetra.
55. Given my findings on the appeal above it is not necessary for me to separately deal with the contents of the Respondent's Notice and therefore I do not do so.

The second error

56. The second error identified by Voyetra is the reference to the evidence of Mr Shephard's evidence on behalf of ABP being '*uncontested*' (paragraph [46] of the Decision). It is submitted that Mr Shephard's evidence was '*hotly contested*'. It was also suggested that the Hearing Officer was proceeding in the way that he did on the basis that Mr Shephard was not the subject of cross-examination and that it was not open to him to do so.
57. In Pan World Brands v. Tripp (EXTREME TM) [2008] RPC 2 a decision of Richard Arnold QC (as he then was) sitting as the Appointed Person set out a summary of the law in relation to unchallenged evidence at paragraphs [33] to [37] of that decision and in particular paragraph [36] which states as follows:

Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in

Brown v Dunn applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

58. That is not to say, however, that Richard Arnold QC did not regard a tribunal evaluating the evidence as bound to accept everything said by a witness without analysing what it amounts to (see paragraph [37] of the Decision). See further the decision in MULTISYS TM (above) at paragraphs [17] to [22] in which Daniel Alexander QC analysed the position and concluded at paragraph [22]:

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield's aphorism from *Blatch v Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v Glenhaven Funeral Services Ltd* [2002] UKHL 22 [2003] 1 AC 32 and in *CLUB SAIL*:

“...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted.”

59. Turning to the position in the present case it is in my view not correct to say that the evidence of Mr Shephard was ‘*hotly contested*’ but rather the case is closer to that envisaged in EXTREME TM.
60. First, Voyetra despite being provided with an opportunity to file evidence in reply to Mr Shephard’s evidence chose not to do so. Indeed, by letter dated 28 January 2019 it was specifically confirmed on behalf of Voyetra that they would not be filing evidence in reply. Second, Voyetra did not make any application to cross-examine Mr Shephard. It does not seem to me that in such circumstances that the Hearing Officer can be criticised for saying as he did in his Decision that Mr Shephard’s witness statement was uncontested (see paragraph [46] of his Decision).
61. Against that background, it is correct that submissions were made before the Hearing Officer on behalf of Voyetra as to why Mr Shephard’s evidence should not be believed or given weight. In particular it was said that the evidence in his first witness statement was not, or not sufficiently supported, by the exhibits to his first witness statement. Those submissions were responded to on behalf of ABP at the hearing below. In particular it was stressed at the hearing on behalf of ABP that (1) Mr Shephard was a director of ABP’s predecessor in title at the relevant time; and (2) that there was nothing inherently inconsistent or incredible about his evidence.
62. It is apparent to me, as it was to the Hearing Officer, that the evidence was ‘*not without fault and could be clearer*’. It is clear from this statement in paragraph [49] of the Decision that the Hearing Officer had come to this view after reviewing the evidence and having heard the submissions of both parties. However, bearing in mind the approach to be taken to evidence in the context of proceedings in the UKIPO set out in the case law, it seems to me that it was open to the Hearing Officer to proceed in the way that he did with regard to his findings on the basis of Mr Shephard’s

evidence whether or not such evidence should or should not have been properly described as '*uncontested*'.

Conclusion

63. For the reasons set out above, it does not seem to me that there is any error of principle or material error in the Hearing Officer's decision. It was in my view open to the Hearing Officer to make the decision that he did for the reasons that he gave. In the result the appeal fails.
64. Therefore, the appeal is dismissed.
65. With respect to the costs of the appeal there is no dispute but that as is the usual course the successful party is entitled to a contribution towards its costs. I will therefore make an order that Voyetra pay to ABP a contribution of £2,500 towards its costs of the appeal. This sum should be paid in addition to the costs of £2,500 ordered by the Hearing Officer below. I therefore order Voyetra Turtle Beach, Inc to pay to ABP Technology Limited £5,000 within 21 days of this decision.

Emma Himsworth QC
Appointed Person
17 June 2020