BL O / 338 / 20

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 410888

IN THE NAME OF PUMA S.E.

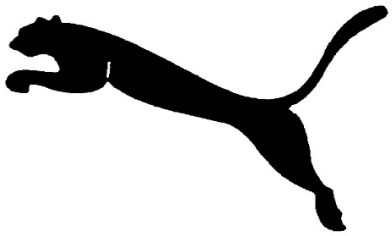
TO TRADE MARK APPLICATION No. 3246172

IN THE NAME OF RONAK HAJIYANI

DECISION

1. On 25 July 2017, Ronak Hajiyani ('the Applicant') applied under number 3246172 to register the following sign as a trade mark for use in relation to *"Footwear [excluding orthopedic footwear]; Footwear for men; Footwear for women; Footwear* " in Class 25:

2. On 27 November 2017, Puma S.E. ('the Opponent') filed a Form TM7 Notice and Statement of Grounds of Opposition under number 410888 contending that the application for registration should be refused under ss. 5(2)(a), 5(3) and 5(4)(a) of the Trade Marks Act 1994 for conflict with the earlier rights to which it was entitled by registration and through use of the following trade mark registered under number 1223225:



3. The earlier trade mark was registered in the United Kingdom with effect from 20 July 1984 in Classes 18, 24, 25 and 28. The goods listed in Class 25 were: *"Articles of clothing; parts and fittings included in Class 25 for footwear"*. The goods listed in Class 28 were: *"Gymnastics and sporting articles (other than clothing)"*.

4. The Opponent's objections to registration under s.5(2)(a) (later corrected to refer to s.5(2)(b) of the Act) and s.5(3) were accompanied by a statement of use for all goods for which the earlier trade mark was registered. The objection to registration under s. 5(4)(a) was accompanied by a statement of use of the earlier trade mark for *"Articles of clothing, headgear and footwear"*.

5. Paragraphs 5 and 6 of the Statement of Grounds of Opposition contained averments directed to the proposition that *"as a result of [the Opponent's] extensive use of its 'Leaping Cat' trade mark the brand, which is one of the most recognised in the United Kingdom and internationally, has established a substantial reputation and goodwill."*

6. Box 7 of the Form TM8 Notice of Defence and Counterstatement filed by the Applicant on 12 February 2018 was headed "**Request for Proof of Use"**. The text beneath the heading stated: **"Please see Tribunal Work Manual Section 3.1.10 Proof of use in opposition proceedings …"** and provided the following information: **"If the person opposing … your trade mark has provided a statement of use on grounds raised under sections 5(1) and 5(2) and 5(3) of the Trade Marks Act, you can request that they provide evidence to show that they are using their trade mark; this is called "proof of use". If you do not request "proof of use" the opponent's statement of use will be accepted with the consequence that the earlier mark(s) may be relied upon for all the goods / services identified in the statement of use."**

7. In response to the question **"Do you want the opponent to provide 'proof of use' ?"** the Applicant answered **"No"**.

8. In his Defence and Counterstatement, the Applicant maintained that the marks in issue were not sufficiently similar to justify refusal of registration on any of the grounds put forward by the Opponent. Although the Applicant did not respond directly to the Opponent's averments of use and reputation, he did so obliquely in paragraph 5 of his pleading, where he referred to *"the fact that … the Opponent is a dominant player in the market and deals in a plethora of goods"* and *"the Opponent's dominance and widespread business presence"* as factors which counted against the existence of a likelihood of confusion ensuing from use of the mark he was seeking to register for the purposes of his new, small scale footwear business.

9. On 16 April 2018, the trade mark attorneys acting for the Opponent filed a Form TM9 requesting an extension of time for filing evidence in support of its Opposition to the application for registration.The Registry responded in an official letter of 19 April 2018 stating *"It is the preliminary view of the registry that the request should be **refused** because … in this instance the registry is not satisfied that the reasons provided allow the registrar to exercise his discretion and allow the extension of time."*

10. The attorneys replied on 23 May 2018 stating (with emphasis added): *"On reviewing the papers submitted on this file we note that as the applicant has not required us to submit proof of use thereby accepting that the marks on which the opponents rely are in use and have been in continuous use since they were registered, as well as accepting the reputation claimed in the Statement of Grounds.* ***We have, following consultation with our clients, decided not to file evidence in respect of this matter****."*

11. That was followed by an official letter from the Registry dated 5 June 2018 stating (with emphasis added): *"I refer to your letter dated 23 May 2018 in which you confirmed that the opponent does not intend to file evidence in support of the opposition. As Rule 20(3) of the Trade Marks Rules 2008 is not relevant the opposition will hereby proceed.* ***As the opponent has not filed evidence the claims in the notice of opposition under Sections 5(3) and 5(4)(a) have been struck out****."*

12. The Applicant filed a short witness statement on 2 August 2018 maintaining his position that the Opposition should be rejected. The Opponent then proceeded to file a witness statement with 4 exhibits dated 2 October 2018. This was made on its behalf by Mr Alan Fiddes (the trade mark attorney representing it in the Opposition).

13. In paragraph 4 of his witness statement, Mr Fiddes observed: *"As there has been no request in these proceedings to file evidence of use it is clear that the Opponent (sic) accepts that the marks on which the Opponent relies have been used on or in relation to all of the goods covered by those registrations."* He provided evidence of use of the earlier trade mark by reference to several exhibited documents: 2 pages (one being a 'Consolidated Statement of Financial Position' the other being a 'Consolidated Income Statement') extracted from the Opponent's Annual Report for 2017 (Exhibit 1); a database extract showing that a trade mark featuring a "leaping cat" was one of the first trade marks registered by the Opponent in Germany in 1948 (Exhibit 2); 3 pages extracted from the Opponent's website showing *"some of the goods to which the mark is applied"* and a copy of an 8-page article headed *" 10 Best Shoe Brands in The World"* in which PUMA was referenced in position 4 on pp 5 and 6 (Exhibit 3); and copies of 8 *"decisions of the EUIPO and the Court of Justice in which the Opponent's 'leaping cat' logo has been in issue"* as showing *"... the extent to which the Opponent has a reputation under the 'leaping cat' logo"* (Exhibit 4).

14. The Opposition proceeded to a hearing before Mr Mark King acting for the Registrar of Trade Marks. The Opponent was represented by Mr Fiddes. The Applicant's representatives sought an adjournment on the basis that they had been unable to contact the Applicant and were without instructions. The request for an adjournment was refused and the hearing took place in the absence of the Applicant.

15. In his Skeleton Argument for the hearing, Mr Fiddes pursued objections to the application for registration under ss. 5(2)(b), 5(3) and 5(4)(a) of the Act notwithstanding that the Opposition was supposed to be proceeding solely on the basis of s.5(2)(b) as a result of the events I have described in paragraphs 9 to 11 above.

16. The Hearing Officer sought and obtained clarification at the hearing as to the basis on which the Opposition was proceeding:

THE HEARING OFFICER: Okay, then. It is opposition 410888 and it is against the mark that has the words "NICO LONDON" in it. I think the first place to start is that I got your skeleton, thanks for that. There seems to be a little bit of confusion. There seems to be confusion on the earlier marks you are relying on and the grounds that you are relying on. The reason I say that is in your skeleton you refer to 5(3) and 5(4) (a) and in your TM7 you did oppose the mark on 5(3) and 5(4)(a), but you did not file any evidence so on 5th June, and tell me if I am going too quick

MR. FIDDES: No, I think you are probably right.

THE HEARING OFFICER: On 5th June we wrote out to you to say that because no evidence has been filed and, as you know, they are heavily evidential based grounds, 5(3) and 5(4)(a) have been struck out.

MR. FIDDES: You are absolutely right, sir. That was me being slightly over enthusiastic in my skeleton.

THE HEARING OFFICER: Okay, no problem.

MR. FIDDES: That is fine, sir. It is just a straightforward 5(2)(b) case.

THE HEARING OFFICER: …. to summarise we have the application, NICO LONDON, with a device. You are relying on your earlier UK registration for the cats leaping to the left and there is no proof of use, the other side did not put you to proof of use, and it is a straight 5(2)(b) case.

MR. FIDDES: Yes, sir.

THE HEARING OFFICER: Brilliant. Okay. With that in mind, then let's begin with your submissions on why you think there is going to be a likelihood of confusion.

MR. FIDDES: Sir, do you need me to address you on the goods issue? I think they are either identical or similar.

THE HEARING OFFICER: That was going to be another one of my questions because in the TM7 you say you are relying on all of the goods because it covers classes 18, 24, 25, and 28. Presumably, you are jut relying on Class 25?

MR. FIDDES, Yes, sir. If they are identical, then they have to be similar.

MR. FIDDES: Obviously, given that the application is not restricted to any particular type of footwear, it is effectively footwear per se, then obviously sporting goods, sports footwear, running shoes, training shoes, football boots, all of those sorts of things, the sporting articles, they would quite easily be associated with those goods. Obviously, from my perspective, I would say that you do not need to get past Class 25 because that is either near identical or highly similar. The rest of it just goes to the – there is an overall similarity between them.

THE HEARING OFFICER: You would agree, though, that if you do not succeed in the Class 25 you are not going to succeed for the remaining goods.

MR. FIDDES: I was sort of working on that basis, sir.

THE HEARING OFFICER: I think that is a fair statement.

MR. FIDDES: I do not see how if you do not find in my favour on the basis that the goods are similar in Class 25, then I would be quite surprised if you turned round to me and said, "Well, they are similar in Class 24." I think that would be somewhat surprising.

THE HEARING OFFICER: Okay. Thank you.

17. The Opposition under s.5(2)(b) was in due course rejected for the reasons given by the Hearing Officer in a Decision issued under reference BL O/059/19 on 28 January 2019. He ordered the Opponent to pay £300 to the Applicant in respect of his costs of the proceedings in the Registry.

18. In summary, the Hearing Officer decided:

(1) that the contested application for registration covered goods that were similar to a medium degree to those for which the Opponent's earlier trade mark was registered in Class 25 (paragraphs [13] to [20]);

(2) that the marks in issue were visually and conceptually similar to a low degree, with no aural similarity between them (paragraphs [21] to [28];

(3) that the relevant average consumer would engage with a normal level of attention in the largely visual process of selecting and purchasing Class 25 goods of the kind in issue (paragraphs [29] to [33];

(4) that the earlier trade mark was possessed of an above average degree of distinctive character as a result of the use which had been made of it (paragraphs [34] to [36];

(5) that there was no likelihood of direct or indirect confusion: *"The presence of the words 'Nico London' in the application and the differences between the respective 'big cats' are sufficient for me to conclude that the average consumer would not assume that [the] goods came from the same economic undertakings"* (paragraphs [37] to [41]).

19. The Opponent instructed new attorneys to act for it on appeal to an Appointed Person under s.76 of the 1994 Act. The appeal was based on the following grounds set out in paragraph 6 of its Statement of Grounds of Appeal:

(a) that the Decision is materially wrong because the learned hearing officer failed to properly apply the law to the facts when considering the Opposition under s. 5(2)(b);

(b) that the Decision is materially wrong because the trade mark registry made a material error and struck out the Opposition in relation to sections 5(3) and 5(4)(a), without providing the Opponent with an opportunity to be heard, as required by rule 63(1) of the Trade Marks Rules 2008 as amended …;

(c) that the Decision is materially wrong because the learned hearing officer failed to consider the Opposition at all under section 5(3);

(d) that the Decision is materially wrong because the learned hearing officer failed to consider the Opposition at all under section 5(4)(a).

20. Permission was sought to file voluminous additional evidence, ostensibly in support of the Opponent's case under ss. 5(3) and 5(4)(a). It was contended that *"If no permission is granted for the evidence to be introduced then this will lead to a miscarriage of justice"*.

21. The Opponent's case was further developed in its Skeleton Argument for the appeal and orally in argument at the hearing before me.

22. Application to file fresh evidence. The discretionary power to permit fresh evidence to be filed on appeal from the Registrar is exercisable in accordance with the principles identified by Henry Carr J in the **TIN PAN ALLEY** case: Consolidated Developments Ltd. v Cooper [2018] EWHC 1727 (Ch) at paragraphs [18] to [33]. These have since been affirmed and re-affirmed in the **HALLOUMI** case: Permanent Secretary v John & Pascalis Ltd [2018] EWHC 3226 (Ch) at paragraph [44] (Arnold J); and the **TRUMP TV** case: Trump International Ltd v DTTM Operations LLC [2019] EWHC 769 (Ch) at paragraphs [65] to [67] (Henry Carr J).

23. As emphasised by Henry Carr J in his Judgment in the **TIN PAN ALLEY** case at paragraphs [10(ii)], [30] to [32], [33(v)] and [33(vi)], the admission of fresh evidence on appeal is the exception not the rule and there is no broad remedial discretion to admit fresh evidence for the purpose of enabling an appellant to re-open proceedings in the Registry.

24. All of the evidence which the Opponent now seeks to introduce is evidence which it could with reasonable diligence have put forward for consideration by the Registrar in the first instance. Its failure to file such evidence in the Registry proceedings appears to have been intentional. On 23 May 2018, its attorneys informed the Registry that "***We have, following consultation with our clients, decided not to file evidence in respect of this matter***" (see paragraph 10 above). I have no reason to believe that this was anything other than a true and accurate statement of the Opponent's position. I also have no reason to suppose that the limited evidence which the Opponent subsequently chose to file in October 2018 (see paragraphs 12 and 13 above) was anything less than the totality of the evidence which it then wished and intended to file for the purpose of advancing its own case and refuting the case raised against it. Moreover, the fresh evidence I am presently considering is sought to be adduced in support of objections to registration under ss. 5(3) and 5(4)(a) of the Act which were disavowed by the Opponent's attorney at the hearing of the Opposition (see paragraph 16 above).

25. The Opponent wishes to undo the effects of its omission to file evidence at first instance of the kind which it now seeks permission to file on appeal. Its position in that regard is summarised in paragraphs 20 and 21 of its Statement of Grounds of Appeal:

> 20. The Appellant recognises there have been some procedural shortcomings in its previous management of this case. No disrespect was meant by its failure to file evidence in chief but this was merely a simple misunderstanding as outlined above.The Appellant understands that this has severely, potentially fatally, prejudiced its position.
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> 21. The Appellant recognises that it must meet a high threshold if permission is to be granted to introduce evidence for the first time on appeal. It also understands that its actions have led to the unnecessary use of resources by the parties, the Registrar and the appointed person. Nevertheless, the Appellant has new professional representation and is taking steps to remedy the position, demonstrate contrition and furnish appropriate evidence to support its case. In short, it wishes to mitigate the loss and damage it will potentially suffer by reason of the Decision and ensure a legally sound decision is reached which is fair in all the circumstances.

26. I do not accept that the change in professional representation between first instance and appeal adds anything of significance to the Opponent's application. I consider that the result of notifying the Registry that the Opponent had "***decided not to file evidence in respect of this matter***" was too predictable to be treated as if it was the unintended consequence of "*merely a simple misunderstanding*" of what the effect of the notification would be. If there had been any such misunderstanding, I would have expected the Opponent to question the decision recorded in the official letter from the Registry dated 5 June 2018 to the effect that: "***As the opponent has not filed evidence the claims in the notice of opposition under Sections 5(3) and 5(4)(a) have been struck out.****"* That did not happen. And far from questioning the decision, the Opponent's attorney expressly accepted it at the hearing of the Opposition. I consider that this was more than sufficient to eliminate any doubts or concerns there might otherwise have been as to the status and effect of the Registry decision.

27. I note that the Opponent has not sought to say or show that the trade mark attorneys then representing it acted without instructions or beyond the scope of their authority at any point in their conduct of the Registry proceedings.

28. If I acceded to the present application, the effect of doing so would in practical terms be: (i) to belatedly grant the request for an extension of time for filing evidence made in the Form TM9 filed by the Opponent on 16 April 2018; (ii) to put the Opponent (but not the Applicant) in the position it would have been in if the evidence now sought to be filed had been filed as evidence in chief in support of the Opposition; and (iii) to re-open the basis on which the Opposition was conducted from April 2018 down to the date of the Decision issued by the Hearing Officer on 28 January 2019, so as to allow the Opponent to proceed with a plainly contestable claim for the opposed application to be refused under ss. 5(3) and 5(4)(a) of the Act whether or not it is found to be acceptable under s. 5(2)(b).

29. I do not accept that the Opponent has established any sufficient or proper justification for allowing it to proceed with an appeal on the basis of such a large departure from the way in which it chose to conduct the Opposition in the tribunal below. I therefore refuse its application for permission to file fresh evidence on appeal.

30. Ground (a). Shortly stated, the question for determination by this Tribunal is whether it was open to the Hearing Officer, on the evidence and materials before him, to come to the conclusion he did for the reasons he gave in relation to the Opponent's objection to registration under s.5(2)(b).

31. The Hearing Officer directed himself correctly as to the applicable legal principles in paragraphs [11] and [12] of his Decision. He went on to assess the objection on the following basis: *"During the hearing Mr Fiddes agreed that the opponent's best case lay with its earlier class 25 goods. I shall proceed by making the comparison based on the earlier class 25 goods. It follows that if the opponent is unsuccessful on these goods it is in no better position relying upon the other goods and services and further analysis would not be necessary."* (paragraph [16]).

32. It was contended before me that the Hearing Officer should also have evaluated the degree of similarity between the goods in issue on the basis that the earlier trade mark was registered in Class 28 for *"Gymnastic and sporting articles (other than clothing)"*, the suggestion being that this wording covered goods which either included sports footwear or came closer to *"footwear"* than the *"Articles of clothing; parts and fittings ... for footwear"* for which the earlier trade mark was registered in Class 25: Transcript p.33, line 17 to p. 34, line 14.

33. Would it have improved the Opponent's position if the Hearing Officer had additionally or alternatively focused on a comparison between *"Gymnastic and sporting articles (other than clothing)"* in Class 28 and *"footwear"* in Class 25 ? I do not think so. In successive editions of the Nice Classification from the First (published in 1963) to the Tenth – 2015, the Class Heading to Class 28 referred to sporting articles *"pas compris dans d'autres classes" / "not included in other classes"*. These words were omitted

from the Class Heading in the Tenth – 2016 edition and have not since re-appeared. However, this change in wording does not detract from the basic proposition that there has at all relevant times been a formal administrative requirement in place for trade marks for clothing and footwear in general (and sports clothing and footwear in particular) to be allocated to Class 25 within the framework of the Nice Classification.

34. Against that background, I am unable to see how the earlier registration for *"Gymnastic and sporting articles (other than clothing)"* in Class 28 could correctly be taken to cover goods which come closer to *"footwear"* than the *"Articles of clothing; parts and fittings … for footwear"* covered by the earlier registration in Class 25. The Opponent has provided me with no substantiation for its suggestion that this was a real possibility. I do not, as matters stand, accept that the Hearing Officer erred or acted disadvantageously to the Opponent by concentrating as he did (consistently with the position which the Opponent's representative had adopted at the hearing) on the comparison between *"Articles of clothing; parts and fittings included in Class 25 for footwear"* and *"footwear"* for the purposes of his assessment of the objection to registration under s.5(2)(b).

35. It is contended that the Hearing Officer "*failed to properly apply the law to the facts*" when assessing the Opponent's objection to registration under s. 5(2)(b). In its Statement of Grounds of Appeal, the Opponent singles out the passages in the Hearing Officer's Decision with which it disagrees and criticises them for being under or over stated evaluations of the factual matters to which they relate. Having done so, it maintains that "*in the present case any tribunal properly instructing itself would not reasonably have come to the same conclusions as did this hearing officer*." I understand this to mean that the rejection of the Opposition under s. 5(2)(b) should be regarded as perverse.

36. If the points raised by the Opponent's criticisms were all to be considered afresh, the Decision would end up being re-taken by this Tribunal under the guise of reviewing it for error. However, it is necessary in order to maintain the required distance between the role of decision taker at first instance and the role of decision taker on appeal for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Opponent relies are by force of what they reveal sufficient to establish that the Decision is vitiated by error.

37. I have reviewed the Decision in the light of the Opponent's criticisms of the Hearing Officer's evaluations. Having done so, I am satisfied that none of the points relied on reveal any mistakes on his part and therefore cannot be taken, individually or together, to establish that the Decision under s. 5(2)(b) is vitiated by error.

38. In Butler v Bankside Commercial Ltd [2020] EWCA Civ 203 Lewison LJ (with whom David Richards and Asplin L.JJ agreed) repeated at paragraph [19] what Mummery LJ (with whom Rimer and Underhill L.JJ agreed) had said in Neumans LLP v Andronikou [2013] EWCA Civ 916 at paragraph [38] (in the context of paragraphs [36] to [40] under the heading "Lord Wilberforce and appeals from impeccable judgments"): "*If the judgment in the court below is correct, this court can legitimately adopt and affirm it without any obligation to say the same things over again in different words. The losing*

party will be told exactly why the appeal was dismissed: there was nothing wrong with the decision appealed or the reasons for it."

39. Adopting that approach, I dismiss the Opponent's appeal against the Hearing Officer's Decision under s. 5(2)(b) on the basis that the Decision was right for the reasons he gave.

40. Ground (b). The Applicant contested the Opponent's objections to registration under ss. 5(3) and 5(4)(a) of the Act. These were by their very nature objections which could only succeed with evidence sufficient to substantiate the Opponent's right to claim protection under those provisions and the existence of a real risk of transgression by the Applicant of the Opponent's rights in that regard. By not requesting "proof of use", the Applicant agreed to the Opposition proceeding on the premise that the Opponent was not prevented by lack of use from seeking protection for its trade mark in respect of goods and services of the kind referred to in its statements of use. Nothing in the body of the Applicant's Defence and Counterstatement removed the need for the Opponent to prove its case in relation to the objections in question.

41. When the Opponent notified the Registry of its decision "***not to file evidence in respect of this matter***" it was entirely predictable that the Registry would respond as it did on 5 June 2018 saying "***As the Opponent has not filed evidence the claims in the notice of opposition under Sections 5(3) and 5(4)(a) have been struck out***." In effect, the Opponent had discontinued those objections by notifying the Registry that it would be filing no evidence in support of them and the Registry had formalised the discontinuance by striking them out of the case.

42. I shall assume that the act of formalising the discontinuance in that way amounted to or involved the taking of a decision within the scope of r. 63 of the Trade Marks Rules 2008. On that assumption, there will have been a failure to comply with the requirements of r. 63(1) (" *...the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings, give that party an opportunity to be heard.*") and r. 63(2) ("*The registrar shall give that party at least fourteen days' notice, beginning on the day on which notice is sent, of the time when the party may be heard unless the party consents to shorter notice*"). There will then have been an "*irregularity in procedure*" amenable to rectification by the Registrar under r. 74 " *... after giving the parties such notice ... and ... subject to such conditions ... as the registrar may direct.*"

43. Consistently with the strike out of its objections under ss. 5(3) and 5(4)(a) being a matter of no surprise to the Opponent, it raised no concerns under r. 63 and took no steps to invoke the procedure for rectification of irregularities under r. 74. Its attorney expressly accepted the strike out decision at the hearing of the Opposition. As I have said, I consider that to have been more than sufficient to eliminate any doubts or concerns there might otherwise have been as to the status and effect of the Registry decision. I dismiss Ground (b) of the appeal on the basis that the Opponent has waived any right it may have had to complain of procedural irregularity under r. 63 in relation to the strike out decision recorded in the Registry letter of 5 June 2018.

44. Grounds (c) and (d). I dismiss Grounds (c) and (d) of the appeal on the basis that the Opponent's objections to registration under ss. 5(3) and 5(4)(a) were and remain struck out in accordance with decision recorded in the Registry letter of 5 June 2018.

45. Overall conclusion. For the reasons I have given, the appeal is dismissed. I have no reason to believe that the Applicant has incurred any or any significant costs in connection with the appeal. I therefore make no order for costs in respect of the proceedings before me. The Hearing Officer's order as to costs in respect of the proceedings in the Registry remains in place.

Geoffrey Hobbs QC

25 June 2020

Ms Olivia Gregory of Appleyard Lees IP LLP appeared for the Opponent (they having been instructed by the Opponent on change of professional representation for the purposes of the appeal).

The Applicant did not appear and was not represented at the hearing of the appeal.

The Registrar took no part in the appeal.