

BL0-439-22

TRADE MARKS ACT 1994

IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3481419



BY JAMES ROBBIE DEAR
(Applicant/Appellant)

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421179
BY PEEK & CLOPPENBURG KG
(Opponent/Respondent)

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO. O/596/21
OF Ms B WHEELER-FOWLER DATED
11 AUGUST 2021

The Applicant appeared in person.

The Opponent/ was represented by Mr Thomas Hooper of Bird & Bird LLP

Hearing date: 26 January 2022.

DECISION

Introduction

1. This is an appeal against decision BL O/596/21 of Ms B Wheeler-Fowler, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 11 August 2021. By that decision the Hearing Officer upheld Opposition No. 421179 in its entirety and rejected Application No.

3481419 (the “Contested Mark”) in its entirety. She ordered the Applicant to pay the Opponent £700 as a contribution towards its costs.

The Application and the Opposition

2. The Contested Mark was filed on 14 April 2020. As can be seen above, it consists of a graphic device and the word McNeill. The application covered a very long list of goods in class 25 as set out in the Annex to the Hearing Officer’s Decision. The Contested Mark was published for Opposition purposes on 14 May 2020.
3. The Opponent filed opposition on 13 August 2020. Objection to registration was taken under sections 5 (2) (b) and 5 (3) of the Trade Marks Act 1994 (“the Act”). However, absent evidence to support the S. 5 (3) ground of opposition, that ground was deemed withdrawn and the Decision was based solely on the section 5 (2) (b) ground.
4. The opposition was based on the following registered trade mark (the “Earlier Mark”):

EUTM Registration No. 14557631 Mc Neal dated 15 September 2015 and registered for:

Class 3: Bleaching preparations and other substances for laundry use; Cleaning, polishing and abrasive preparations; Soap; Perfumery, essential oils, cosmetics, hair lotions; Dentifrices

Class 25: Clothing, footwear, headgear

Class 35: Advertising; Business management; Business administration; Office functions; Retail services, also via a website and Teleshopping, in relation the following goods: Ready-made clothing, footwear, headgear, Bleaching preparations and other substances for laundry use, Cleaning, polishing, scouring and abrasive preparations, Soaps, Perfumery, Essential oils, Cosmetics, Hair lotions, Dentifrices, Sunglasses, precious metals and alloys thereof, jeweler goods, Jewellery, Precious stones, Horological and chronometric instruments, Luggage, Trunks and travelling bags, Bags, Handbags, Wallets, Purses, Key cases, Rucksacks, Bags, Shoulder belts and straps, leather and imitation leather, Furs; animal skins, Goods of leather, Imitation leather articles, Articles made from fur, goods made of animal skins, namely Luggage, Trunks and travelling bags, Bags, Handbags, Wallets, Purses, Key cases, Rucksacks, Bags, Shoulder belts and straps, Leather straps, leather laces, Bandoliers, Sheets of imitation leather for use in manufacture; Arranging and conducting of advertising events and customer loyalty programmes; Except retailing, in relation the following goods, School satchels, Satchels.

5. The Earlier Mark's registration process was completed on 13 January 2016.
6. Notwithstanding registration of the Earlier Mark occurred less than 5 years before the Contested Mark's application date, the Applicant requested proof of use for EUTM No. 14557631. The Applicant also filed various materials in non-evidential form. Only the Opponent filed submissions. No hearing was requested, however, and the Decision was taken "on the papers".

The Hearing Officer's Decision

Non-evidential materials submitted by the Applicant

7. It is apparent from the Decision and the UK IPO file that the Applicant had sent, uninvited and prior to filing a counterstatement, "*various letters with attachments to the Tribunal*" (approximately 20 in all, including "Exhibits") (the "Emails") and that the Office had explained to Mr Dear that these would be disregarded but that properly formatted evidence could be submitted at the appropriate time. In the event no such evidence was filed. The Hearing Officer noted at [10] that "*For the avoidance of doubt, I have not had sight of any of the aforementioned 'exhibits'/attachments. No evidence was filed nor, therefore, admitted in these Proceedings*".

Application of the Common Practice Rules

8. The Applicant had expressly requested that the Common Practice ("CP") Rules be taken into account, in particular CP3 and CP4. The Hearing Officer confirmed she would be guided by the Common Practice Rules where relevant but determined [13-14] that CP3 and CP4 were irrelevant to the matter before her.

No Need for Proof of Use of the Earlier Mark

9. Following the Applicant's request that the Opponent file proof of use of the Earlier Mark, the Office had previously clarified to him that pursuant to S. 6A of the Act, the Opponent was not required to prove that its mark had been used. The Hearing Officer confirmed this was correct at [16].

Opponent's Behaviour

10. In its counterstatement the Applicant had, in effect, called the Opponent's *bona fides* into question. This was not pursued further by Mr Dear and, as the Hearing Officer noted, was a matter for invalidation proceedings against the Earlier Mark in any event. The Hearing Officer therefore declined to "*delve into this any further*".

Likelihood of Confusion

11. The Hearing Officer determined that:

- The class 25 goods of the Contested Mark were identical or highly similar to the Opponent's class 25 goods, and of medium similarity to the Opponent's class 35 retail services.
- The Opponent's class 3 goods were not similar to any of the Applicant's goods.
- The Average Consumer of class 25 goods was either a member of the general public or, in the case of some specific goods, might be a professional consumer. Visual purchasing conditions mostly applied, without ignoring aural considerations. The level of attention would be medium to high.
- As regards class 35 retail services, the selection process would be mostly visual and the level of attention, medium.
- The overall impression of the Contested Mark was balanced between the word McNEILL and the shield/silhouette device. The overall impression of the Earlier Mark was simply the words Mc Neal.
- There was a medium degree of visual similarity of marks.
- Phonetically, they were identical.
- Conceptually, the Hearing Officer held *"Overall, I consider there is a medium degree of conceptual similarity based on the inclusion of a similar surname."*
- The Earlier Mark had a medium level of inherent distinctive character.
- There was no likelihood of direct confusion.
- However, there was a likelihood of indirect confusion.
- The opposition therefore succeeded in full.

The Appeal

Notice of Appeal

12. The Opponent filed an appeal on 19th August 2021. The grounds of appeal as filed were originally incomplete. As fully filed and with the benefit of the focus provided by Mr. Dear's Skeleton Argument they can be summarised as follows:

Ground 1

The Hearing Officer erred by wrongly relying on the Emails. Had the Applicant known this material was to be relied on, he would have resubmitted it in proper evidential form.

Ground 2

The Applicant was not aware of and given no opportunity to comment on the Opponent's submissions as to costs. Further, the Applicant questioned "*what other undocumented contact occurred between the IPO and Bird & Bird LLP?*"

Ground 3

The Hearing Officer was said to have erred by failing to consider, in line with CP3 (*Figurative Marks containing descriptive/non-distinctive words*), the significance of the term McNeill as a descriptive term within a figurative mark.

Ground 4

The Earlier Mark should itself have been assessed for registrability against current rules before being compared to the Contested Mark.

Ground 5

The Applicant contended that the Earlier Mark had been registered for more than 5 years and that his request for proof of use was therefore wrongly denied.

Ground 6

Further, the Applicant contended there is no 5-year minimum period in the proof-of-use provisions.

Respondent's Notice

13. The Opponent filed a Respondent's Notice on 4 October 2021. In essence it asserted the appeal was unfounded on all grounds. Alternatively, if I upheld any ground of appeal, the Respondent asserted that on a re-assessment of the likelihood of confusion the outcome would be the same as the original Decision.

The Appeal Hearing

14. The Appeal was heard on 26 January 2022. Mr Dear appeared on his own account. The Opponent was represented, as it was before the Office, by Bird & Bird LLP in the person of Mr Thomas Hooper. Both sides filed skeleton arguments.

Standard of Review

15. At the outset of the Hearing, principally for the benefit of Mr Dear as a party-in-person, I explained that the appeal was by way of review, not an opportunity to re-hear the original case, and that to uphold the Appeal I had to be satisfied that there was an error of principle by the Hearing Officer in the way the law was applied and the case was decided, or that the Decision was otherwise wrong. I understood both parties to agree that this was indeed the case.
16. *Abanka DD v Abanca Corporation* [2018] Bus LR 612 endorses the principles set out in *TT Education v Pie Corbett* [2017] ETMR 26 as the appropriate standard. 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. As regards matters of factual evaluation, appellate tribunals should not interfere unless the disputed conclusion is outside the bounds within which reasonable disagreement is possible. In order to intervene I must be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong - *Reef Trade Mark* [2003] RPC 5; and *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 at [78] to [81].
17. As to whether a decision is "wrong", I remind myself of the following passage from *Abanka* at [24] (by Mr Daniel Alexander QC sitting as a Deputy Judge of the Chancery Division that "*the real question, as all the cases say, is whether the decision in question was wrong in principle or was outside the range of views which could reasonably be taken on the facts...*").
18. I bear these principles in mind.

Late "Evidence"

19. Mr Dear's Notice of Appeal was accompanied by documents "*to show the true use of MCNEAL*", in other words as proof of the non-use of the Earlier Mark. These documents were not exhibited to a witness statement.
20. It is convenient to deal with this issue here at the outset, even though it actually arose later in the course of the Hearing. I took the view that the inclusion of this material, coupled with the grounds of appeal, was in effect, an application to admit late evidence. I declined to admit the "evidence", and these are my reasons.
21. The admission of such evidence is discretionary. The basic principles for deciding such applications on appeal are set out in *Ladd v Marshall* (1954) 1 WLR 1489, [1954] 3 All ER 745, [1954] EWCA Civ 1. There are three considerations:

(a) the evidence could not have been obtained with reasonable diligence for use at the hearing below.

(b) the further evidence is such that, if given, it would probably have an important influence on the result of the case.

and

(c) the evidence is such as is presumably to be believed.

22. After hearing the parties, and bearing in mind the principles outlined above, I declined to admit the material because, as shall be covered in more detail below, the use of the Earlier Mark was not in issue in these proceedings. The materials were therefore irrelevant and would have no influence on the outcome of the case. In any event the “evidence” was not in the proper form. Furthermore, it clearly could have been brought before the Hearing Officer filed at first instance.

23. Whilst there are additional and/or overlapping considerations in trade mark appeals (see, for example, *Du Pont De Nemours & Company v S.T. Dupont* [2003] EWCA Civ 1368, [2004] FSR 15, [2006] 1 WLR 2793 per May LJ) I had no need to consider these specifically since the materials did not even make it past the basic hurdles of *Ladd*.

24. Mr Dear’s Appeal was also accompanied by copies of extracts from IPO documents, the Act and the Common Practice Rules. No point was taken as to the admissibility of that material.

Merits of the Appeal

Ground 1

25. Ground 1 was, in effect, a complaint that the Hearing Officer erred in principle by taking into account “evidence” (the Emails) that was irrelevant because it should not have been before her.

26. As developed by Mr Dear in his submissions, the complaint seemed to have several entangled strands. On the one hand, Mr Dear accepted he had wanted the Emails to be taken into account – that was why they were sent in the first place. On the other, he was concerned that they *were* taken into account despite his having been told that they would be disregarded and that this had influenced on the outcome. Alternatively, he argued that some of the content of the Emails was selectively ignored. Furthermore, that had Mr Dear known the Emails were to be considered by the Hearing Officer, he would have re-submitted the material in admissible form.

27. In particular, Mr Dear submitted:

“I think it would have been only decent and fair for the IPO to inform me that these e-mails were

being used in a hearing and to have given me the opportunity to resubmit them in a proper and professional format...

... (the Hearing Officer) constantly refers to the e-mails right throughout the document. There are excerpts from my e-mails in there. I can give you umpteen pages. Mr Dear also submitted that "Clearly, the Hearing Officer reading these has an influence".

28. The Hearing Officer dealt with this issue at [9-10] of her Decision.

"9. Prior to the filing of the applicant's counterstatement, I am aware that the applicant sent various letters with attachments to the Tribunal. I provide an excerpt of a letter (dated 7 October 2020) sent from the Tribunal to the applicant below: (She embedded a copy of the Tribunal's letter which stated, amongst other things, that the correspondence would be disregarded).

29. At [10] the Hearing Officer, having set out the Applicant's Counterstatement and noting it referred to *"filing various evidence"* said:

"For the avoidance of doubt, I have not had sight of any of the aforementioned 'exhibits'/attachments. No evidence was filed nor, therefore, admitted in these Proceedings"

30. Mr Dear submitted that, despite that clear statement by the Hearing Officer, the Emails were referred to in the Decision. He said *"(S)He constantly refers to the e-mails right throughout the document. There are excerpts from my e-mails in there. I can give you umpteen pages."*

31. I asked Mr Dear to identify examples where the Emails had been taken into account for me. He replied:

"Just one example is on page 6. He cites: "'I will also be defending on the basis of the limited target market of my McNeil application ...'". This was in the e-mails. How would he know I was targeting a limited market? This was in the e-mails".

32. I pointed out to Mr Dear that this quote was taken from his own Counterstatement. He replied:

"But there was a lot more in the e-mails. There was detail about it in the e-mails, which (s)he (the Hearing Officer) ignored."

33. To me, the absence of any reference to this “detail” is entirely consistent with the Hearing Officer’s confirmation she had not seen the Emails at all, contrary to Mr Dear’s complaint.
34. Mr Dear did not take me to any other examples. Nevertheless, I have been through the Decision. All of the references to matters put forward by Mr Dear are taken from directly his Counterstatement. Despite Mr Dear’s contentions and sincerely held belief, there is nothing to indicate the Emails were seen or taken into account by the Hearing Officer and she expressly states she did not have sight of them.
35. I find that the Hearing Officer did not see or in any way take into account the Emails. The Hearing Officer reached her Decision perfectly correctly on the materials properly before her and nothing more. **Ground 1 fails.**

Ground 2

36. Ground 2, properly analysed, is an allegation of a serious procedural irregularity. It is that the Applicant was not given the opportunity to comment on the Opponent’s submissions as to costs, in other words, a violation of the right to be heard. Further, the Applicant questioned “*what other undocumented contact occurred between the IPO and Bird & Bird LLP?*”.
37. This Ground was not supported by any evidence of any kind.
38. I note that the Applicant was served (albeit belatedly) with the Opponent’s Written Submissions in lieu of evidence and that these contain the following:
- 36. The Opposition requests an award of costs be made in the Opponent's favour.*
- 37. Due to the large volume of evidence previously submitted by the Applicant, which had to be reviewed by the Opponent (despite not being accepted by the Office), together with the conduct of the Applicant (including the very large volume of emails to the Office and us as representatives for the Opponent), we kindly request that the Office considers making an award of costs above the normal scale in favour of the Opponent.*
39. It was not disputed by Mr Dear that he received these submissions under cover of a Tribunal letter dated 1 April 2021.
40. That letter also informed Mr Dear that the S. 5(3) ground of opposition had been withdrawn, that the case was proceeding under the S. 5 (2) (b) ground only and that the Opponent would not be filing evidence of its own. It also set out the deadline for Mr Dear to file his own

responsive evidence/submissions (1 June 2021) and stated, *“Upon the conclusion of the evidence rounds the parties will be asked if they wish to be heard on this matter”*.

41. Mr Dear accepted that he received the Tribunal’s 1 April letter and that he was aware of the deadline of 1 June to file evidence/submissions.
42. Mr Hooper, for his part, submitted that since Mr Dear had been served with the Opponent’s submissions, which contained its request on costs and to which Mr Dear could have responded, that was effectively an answer to this ground of appeal.
43. That is correct as far as it goes, and in my view, it also disposes of Mr Dear’s speculation as to *“undocumented communications between the UKIPO and Peek & Cloppenburg KG”*.
44. However, that is not a complete end to the matter. In the normal run of things, after the evidence periods closed the parties would be given notice of the opportunity to be heard or, at their option, to file further written submissions, and advised how to claim costs.
45. The Tribunal file contains just such a letter dated 18 June 2021 addressed to Mr Dear, setting out this information and addressed to his address for service.
46. At the Hearing, it became apparent that Mr Dear’s position was that he *“was never offered a Hearing”* and that he had been surprised to have received the Hearing Officer’s Decision. When it was drawn to his attention, he said he had not had the 18 June letter.
47. The difficulty is that Mr Dear had filed no evidence to prove as a matter of fact that he was not offered a Hearing (and, by extension, offered an opportunity to be heard or make submissions on costs). Had he done so, his evidence might have been unchallenged and accepted, or alternatively challenged. Either way, his claim could have been fully assessed and explored.
48. The upshot is, that all I have to go on is the letter of 18 June 2021 on the Tribunal file which, on the face of it was properly addressed to Mr Dear at his address for service. I have no evidence to show whether it was or was not sent to Mr Dear at that address and so on balance I find it was indeed sent, whether by post or electronically. Given the Tribunal file appears to include email communication between it and Mr Dear, I consider, without deciding, that method of service is the most likely.
49. I cannot tell whether or not Mr Dear had the letter, but in the event that does not matter, for the following reasons.

50. Rule 63 of the Trade Mark Rules 2008 reads as follows:

Decisions of registrar to be taken after hearing

63.—(1) *Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, 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.*

51. S. 7 of the Interpretation Act 1978 reads as follows:

References to service by post.

Where an Act authorises or requires any document to be served by post (whether the expression “serve” or the expression “give” or “send” or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of post.

52. Thus, if the letter was sent by post to Mr Dear’s address for service, unless the contrary is proved it is deemed to have been effectively served on Mr Dear in the ordinary course of post.

53. If, alternatively, the letter was sent by email or other electronic means it is covered by Rule 79 of the Trade Mark Rules 2008, which reads as follows:

Electronic communications

79.—(1) *The delivery using electronic communications to any person by the registrar of any document is deemed to be effected, unless the registrar has otherwise specified, by transmitting an electronic communication containing the document to an address provided or made available to the registrar by that person as an address for the receipt of electronic communications; and unless the contrary is proved such delivery is deemed to be effected immediately upon the transmission of the communication.*

(2) In this rule “electronic communication” has the same meaning as in the Electronic Communications Act 2000.

54. Thus, if the letter of 18 June was sent to Mr Dear by email, unless the contrary is proven it is deemed to have been served on Mr Dear immediately upon transmission of the email.

55. I have determined that the letter of 18 June 2021 was sent to Mr Dear. Since I have no evidence from Mr. Dear to prove the contrary in either case, he is deemed to have been served with the letter of 18 June 2021 giving him notice of the right to be heard or to make submissions as to costs.

56. Since Mr Dear is deemed to have been served, absent evidence to the contrary I do not need to decide further whether he was actually served or was even aware of the letter.

57. It follows from this that Mr Dear has not proved his case on this issue, and **I dismiss Ground 2 of the Appeal.**

Ground 3

58. The Hearing Officer was said to have erred by failing to consider, in line with CP3 (*Figurative Marks containing descriptive/non-distinctive words*), the significance of the term "McNeill" as a descriptive term within a figurative mark.

59. In his Skeleton Argument Mr Dear stated:

"I referred the Hearing Officer to the Common Practice rules. These could have only been the Figurative and LOC Common Practice rules. Having directed the Hearing Officer to these rules at no point in the Hearing Officer's findings did the Officer consider the word McNeill as a descriptive word (a Proper Adjective). The Officer should have at least considered the possibility of the word McNeill as a descriptive word to had either agreed or disagreed with this point. Having not given my figurative trademark full consideration of all aspects of the Common Practice rules there was no full assessment by the Officer. I had discovered an in-built bias by the IPO against the Common Practice rules which I will talk to, for the Appointed Person have a look at the the UKIPO Trademark Manual and type in the search for Common Practice, there is no reference to the Common Practice rules in the UKIPO's reference manual even though the Common Practice rules have been in place since 2014. I have recently talked to 2 Examiners and 1 senior Examiner and 1 Hearing Officer about other trademarks. I have been involved in 22 trademarks, the response I received from these IPO employees was, "the Common what?"

60. At the Hearing Mr Dear submitted that:

"Also within (her) ruling, (s)he gave what I regard as selective comments from the common practice rules. I believe that my "McNeill" is descriptive. I know that (s)he looked at descriptive,

but (s)he looked at "McNeill" versus "McNeal", and not the global "McNeill". I believe (her) global assessment to be false".

61. The Hearing Officer dealt with this at [13-14]:

"13. With regards to "CP3", this common practice is in relation to "the Common Practice of Distinctiveness – Figurative Marks containing descriptive/non-distinctive words". This rule specifically relates to composite marks with non-distinctive/descriptive components. Neither the earlier mark nor contested mark contain descriptive/non-distinctive words; thus, this common practice rule is not applicable. In any event, it is worth highlighting that whilst the protection of each mark is as a whole, that does not stop the mark being similar (and confusable) to something else which might comprise part of a composite mark.

14. Where the applicant refers to "B&W marks", I understand they are referring to "CP4. Scope of protection of B&W marks". This rule largely relates to the circumstances where a black and white mark is considered identical to the same mark in colour and whether use of a mark in colour (or black and white) is considered use of the same mark registered in black and white (or colour), and vice versa. The current opposition is on the basis of section 5(2)(b), within which, inter alia, requires that a contested mark is similar to an earlier mark. As we are considering the similarity, not identity, between the marks, CP4 is not relevant to the matter before me."

62. I understand Mr Dear to be arguing, in effect, that the surname McNeill is a descriptive term and therefore "weak" so is covered by CP3 for the purpose of assessing the likelihood of confusion.

63. However, the fact a word is a surname does not, of itself make it descriptive of goods or services. Without more, the Hearing Officer was perfectly entitled to form her own view. I cannot fault her analysis and I detect no error of principle. Mr Dear's argument is, in effect, a mere disagreement with the Hearing Officer's conclusion. That is not something justifying my intervention.

64. Ground 3 of the Appeal therefore fails.

Ground 4

65. Because it is quite complex in formulation, I set out this Ground as pleaded in full (any errors are imported from the original)

"The Officer's Decision was highly dependent on the inclusions of old, out of date court and or judge rulings. The officer cited 20 rulings, 18 of which were prior to the introduction of the April

2014 Common Practice rules, 1 prior to the October Likelihood of Confusion (LOC) Common Practice rules introduction. And the case cited from 2015 Whyte & Mackay is an extremely tenuous link as this was about an existing trademark holder adding a word to their trademark in the protected whisky industry in Class 33. Not the same issue at all involved with the MCNEILL trademark.

The UKIPO is there to enforce its rules as they stand today, I have no issue with UKIPO citing previous cases where ALL the conditions are exactly the same but citing cases where rulings were made when the conditions are not in line with the UKIPO's current rules is unfair and uneven-handed on new applications. It is not the role of the UKIPO to assume that a court and or judge ruling, for example, from 1998 would be exactly the same in today's sets of rules and regulations. It is not for the UKIPO to second guess how a court and or judge would rule today in very different circumstances, it is not for the UKIPO to assume the role of a Court and or Judge.

I would remind the Appointed Person at this point the onus is on Existing Trademark Holders to keep their trademark up to date and in line with current rules and regulations. There is no onus for new applicants to have their application, where they have read, understood and complied with the current UKIPO publications on trademark rules, regulations and procedures to be in compliance with old, out of date, say 1998, rules, regulations and procedures. I will repeat the UKIPO are there to enforce their rules as they stand today. At no point, no point whatsoever, did the Officer in their Decision assess the Existing trademark against the UKIPO's current rules, regulations and procedures. Had the Officer bothered to do so they would have found that the Existing trademark is out of line with a lot of the current rules, regulations and procedures. In opposition the Existing trademark holder is putting forward their trademark against my application an application compliant to today's UKIPO rules, regulations and procedures.

It is a very odd situation where the Officer in the Decision was eager to look back in time as far back as 1998 with my application but was unprepared to look at the Existing trademark: against today's rules etc. Peek & Cloppenburg KG having put their trademark forward in opposition should have had their trademark assessed against ALL of today's rules, regulations and procedures. It never was. The onus is on Existing trademarks to keep their trademark up to date with current regulations and therefore should have been assessed against ALL of the Common Practice Rules whether it be for Absolute or Relative grounds. A trademark holder does not get to decide which rules applies to its trademark and which do not. Having put their trademark forward in opposition the Peek & Cloppenburg KG trademark: should have been assessed for its

compliance with the UKIPO's current rules. Something which never happened. (and incidently is true of the current UKIPO Examination process)". (sic)

66. There was no elaboration of this in Mr Dear's Skeleton Argument nor in his submissions before me.
67. Concerning Mr Dear's points about previous cases, rules and regulations, and his assertion that the UKIPO is not to assume the role of a court or judge, I am afraid he is simply wrong on both counts. It is part of the normal legal process to consider relevant precedent cases and rules/regulations which have not been overruled or repealed, and UK IPO is a properly constituted tribunal which does indeed apply the law and decide facts in the role of a court or judge.
68. As to the remainder, the best view I can take of this is that it amounts to a claim that the Hearing Officer should have assessed the validity of the Earlier Mark as part of the S. 5 (2) (b) assessment.
69. It is well established that the validity of an Earlier Mark cannot be challenged in opposition proceedings - see, for example, Case C-196/11 P, *Formula One Licensing BV v OHIM, Global Sports Media Ltd*. If the Applicant had wished to challenge the validity of the Earlier Mark the proper course of action would have been to make a separate application for a declaration that it was invalid. There was no such challenge.
- 70. Ground 4 of the Appeal fails accordingly.**

Grounds 5 and 6

71. Both of these Grounds relate to the proof of use of the Earlier Mark, and it is convenient to take them together.
72. By Ground 5 the Applicant contended that the Earlier Mark had been registered for more than 5 years and that his request for proof of use was therefore wrongly denied.
73. Before me, I understood Mr Dear to submit that the Earlier Mark was more than five years' old because it was, in effect, a continuation of another registration (I believe he had in mind No. 900306324) dating from 1996.
74. Each registration is entirely independent of any other registration. The proof of use requirements are assessed solely by reference to the completion date of the registration process

for that registration and whether 5 years have elapsed between that time and any contested mark's filing date. UK TM Registration No. 900306324 was not relied on by the Opponent in this case. The Earlier Mark is an entirely separate and independent registration, and it is against that mark only that the proof of use requirements fall to be assessed.

75. Both the Registry and the Hearing Officer in her Decision confirmed, entirely correctly, that the Earlier Mark, having been registered for less than 5 years at the date the Contested Mark was filed, was *not* subject to the "proof of use" provisions and that the opponent was not required to prove that its mark had been used. That disposes of Ground 5.

76. Ground 6 is allied to this. Mr. Dear contended the 5-year period was only applicable to invalidation procedures. He had arrived at this conclusion from looking at Form TM8 about which he said, for example:

"All I would say to you is that on the TM8 form it is quite clear there is no reference to five years. There is a reference to the invalidation process. I was not invalidating...I had no need to go and look at that process because I was not invalidating. The TM8 form does not stipulate five years anywhere on it."

77. I am afraid Mr Dear has misunderstood the law and the form TM8. Taking the form first, the TM8 filed by Mr Dear himself contains, at Section 7, the standard note as to the proof of use requirement (emphasis added for ease of reference):

"7. Request for "proof of use"

Please see [Tribunal Work Manual Section 3.1.10 Proof of use in opposition proceedings](#) or Section 3.4.6 Proof of use in invalidation proceedings.

If the person opposing or applying to cancel 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".

78. It is correct that there is no express reference on the form to the 5-year period, but the notes clearly refer to both opposition and invalidation proceedings. Reference to the Tribunal Work Manual as directed would have confirmed the position. Furthermore, the Tribunal appears to have explained the position in at least 3 separate letters to Mr Dear, and the Hearing Officer confirmed it correctly at [15-16] of her Decision.

79. For the avoidance of any doubt, the relevant law is contained in S. 6A of the Act (with emphasis added):

6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

80. Mr Dear’s grounds of appeal include the statement about the Act:

“... in 6A it talks to the Relevant Period it does state the Relevant Period is 5 years but again there is no stipulation it Must be five years or more”.

However, as can be seen from the quoted section above, S. 6A (1A) does indeed state *“the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a)”*.

81. Taken along with S. 6A (1) (c) the effect is that for the Applicant to request proof of use, the Earlier Mark *must* have completed its registration process before the start of relevant period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a). In this case the Earlier Mark had not completed its registration process before the start of the relevant period.

82. Thus, the Hearing Officer confirmed the law correctly and there was no error of principle in her finding that the opponent was not required to provide “proof of use”.

83. Grounds 5 and 6 of the appeal both fail.

Other Matters

84. In the course of his submissions, Mr Dear touched on matters such as the actual target market for the goods covered by his application and the impact of the parties’ respective “real world”

activities on the general public. I explained that in an opposition under S. 5 (2) (b) of the Act, the comparison was limited to “mark for mark” and that the “average consumer” was a legal construct, not a reference to the factual public. Since no evidence on these issues had been put to the Hearing Officer and the specification of goods of the Contested Mark was not limited by reference to customer/market type, Mr Dear’s submissions as to his actual consumers/market on appeal were of no relevance to the case under S. 5 (2) (b).

85. Mr Dear also disputed the Hearing Officer’s findings as to phonetic and conceptual issues, saying:

“His (sic) assessment about the marks being phonetically and conceptually identical is just plain wrong”.

Quite apart from the fact the finding related to similarity, not identity, this is no more than a disagreement with the Hearing Officer’s views.

86. Neither of these issues were included in the Grounds of Appeal so I do not need to consider them, but if it had fallen to me to determine them, I would have dismissed the objections.

Outcome of the Appeal

87. None of the grounds of appeal having succeeded, the Appeal stands dismissed in full.

Afternote - Cancellation Action No. CA000504070 against UKTM No. 914557631 Mc Neal

88. A while after the Appeal Hearing, Mr Dear asked the Appointed Person Secretariat to draw my attention to Cancellation Action (Non-use Revocation) No. CA000504070 brought by Global Trademark Services Limited (a company of which Mr Dear is apparently a Director) against the Opponent’s UK registration No. 914557631 Mc Neal. This registration (the Comparable Mark) is the comparable UK trade mark derived from the Earlier Mark after Brexit as a result of the operation of S. 52A and Schedule 2A of the Act (as amended).

89. In particular, Mr Dear asked, *“Given the very unusual amount of time the IPO has taken, (I have filed 2 previous TM26(N) forms), to deal with this matter and it’s(sic) significance to this case I would request the details of the revocation be forwarded to the Appointed Person.”* No further information was given as to the “significance” of the proceedings (which it seemed had only just

been accepted by the Office) nor was any specific request made for me to take any action or make any order in this Appeal based upon it.

90. From the papers forwarded to me I can see that the Cancellation was the subject of considerable correspondence between Mr Dear and the Tribunal in order to get the action into an admissible state. The upshot of this was a decision by the Tribunal admitting the Cancellation's TM26 (N) dated 4 November 2021 seeking non-use revocation of the Comparable Mark under S. 46 (1) (a) of the Act with effect from 14 January 2021. I have not been informed of any further progress in, nor any determination of, that action at this time.

91. In view of Mr Dear's request that this be brought to my attention but without any further indication as to his aim in doing so, I directed that the Parties should file any brief written submissions they wished to make regarding the relevance of CA000504070 and its ultimate outcome to the conduct of and my determination of this Appeal, including as to whether the appeal should be stayed, or any decision made on a provisional basis. Both parties duly filed submissions.

92. For his part, Mr Dear criticised the Office's general conduct of these matters in trenchant and, I may say, unjustified terms. In so far as his submissions addressed the matter in issue, he said:

"I want to apologise to Mr Harris because in the normal run of procedure I would have notified Mr Harris that the TM26(N) was in play but I could not. I filed the TM26(N) in October/November 2021 and it was not only until recently the TM26(N) was accepted by the IPO, after a very and overly lengthy spirited process & debates. At the time of our Hearing in London the IPO had not yet accepted and I could not raise the matter for fear of being seen to try and exert undue influence on Mr Harris. I couldn't raise the matter of the TM26(N) until it had been accepted by the IPO.

With the Mc Neal case I have been absolutely consistent in claiming that Peek & Cloppenburg KG do not use the trademark as registered and even within my submission pointed out in the USA Peek & Cloppenburg KG registered their trademarks as used. All the way through Examination and the Hearing I pointed out the reason for the different filing in the UK & EU is because there is much more use of the name McNeal and all of it's (sic) many iterations and the Mc Neal is an attempt to be a catch all for any of the iterations for McNeal and that Peek & Cloppenburg KG had no intention of using the trademark as registered in the UK & EU knowing they were going to use the trademarks as registered in the USA.

I cannot answer for the IPO's actions but during the Examination and Hearing process I was very clear that Peek & Cloppenburg KG were not using the trademark as registered. Both the Examiner and Hearing Officer chose to turn a blind eye to this matter."

93. From this it is tolerably clear that Mr Dear was seeking in some way to bring the "use" issue as it relates to the Earlier Mark back in to play by virtue of his company's attack on the Comparable Mark, although he made no application or submission as to what, if anything, I should do with this information.

94. Mr Hooper of Bird & Bird filed submissions for the Respondent, saying:

"These opposition proceedings (OP000421179) should not be suspended pending the resolution of the non-use action (CA000504070).

The EUTM registration relied upon by the opponent in the opposition was registered on 13 January 2016. The contested application (being UKTM application number 3481419) was filed on 14 April 2020. At that date, the opponent's mark could not be challenged on use grounds or subjected to proof of use and so use requirements have no relevance whatsoever in these opposition proceedings. This was confirmed in paragraph 16 of the appealed opposition decision. The EUTM registration relied upon became vulnerable to such actions from 14 January 2021 which is of course after the filing/relevant date of the contested application".

95. That submission is correct as far as it goes but it seems to me there is a further point here. The non-use Cancellation is directed to the *Comparable* Mark (which is on the UK register, not the *Earlier* Mark (which is on the European Trade Mark Office register), and it is the latter which is relied on in these proceedings. Whatever the result of the Cancellation as it affects the *Comparable* Mark, of itself it has no bearing on the *Earlier* Mark, which is separate, independent and continues to have effect in these proceedings, as noted in footnote (1) to the Decision under appeal.

96. For the avoidance of any doubt, I am aware of the changes to Schedule 5 of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 brought about by The Trade Marks and International Trade Marks (Amendment) (EU Exit) Regulations 2021, in particular as regards the options open to the Tribunal in proceedings based on an EUTM where the corresponding comparable mark is subject to certain kinds of revocation proceedings. However, those changes

do not extend to non-use cancellation proceedings under S. 46 (1) (a) of the Act, which is the situation here.

97. Thus, I conclude that I need take no account of Cancellation Action (Non-use Revocation) No. CA000504070.

Conclusion

98. The Appeal has failed in full. The Applicant's application No. 3481419 is refused.

Costs

99. As the successful party the Opponent is entitled to an award of a contribution to its costs. Both parties agreed that I should make the award based on the usual scale of costs.

100. The Hearing Officer made an award of £700 against the Applicant as a contribution towards the costs of the Opponent. I order that James Robbie Dear should pay Peek & Cloppenburg KG a further sum of £1,300 by way of costs, made up of:

- Reviewing the Notice of Appeal and preparing a Respondent's Notice: £600
- Preparing a skeleton argument: £200
- Preparing for and attendance at the hearing: £500
- Total £1300

101. **Therefore, I order James Robbie Dear to pay to Peek & Cloppenburg KG the total sum of £2,000 within 21 days of the date of this decision.**

Philip Harris
Appointed Person
23 May 2022