

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3250126 BY CABLE LOGIC
EUROPE LTD TO REGISTER A TRADE MARK IN CLASS 29**

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO.
410891 BY WAGAMAMA LIMITED**

**IN THE MATTER OF THE APPEAL AGAINST THE DECISION OF
MS HEATHER HARRISON DATED 19 DECEMBER 2018**

DECISION

1. This is an appeal from a decision of Ms Heather Harrison on behalf of the Registrar, BL O/810/18, in which she rejected a trade mark application in the name of Cable Logic Europe Ltd ("the Applicant") in the light of an opposition filed by Wagamama Ltd ("the Opponent"). The Applicant appeals.

Background

2. On 14 August 2017, the Applicant applied to register the device shown below as a trade mark for the following goods in Class 29: "Prepared meals; instant meals; snack foods; preparations and ingredients therefor; soups; prepared, preserved, dried, cooked and/or frozen fruits and vegetables; reduced fat content dairy products; potato crisps and potato chips; all consisting wholly or principally of noodles. Made out of rice and wheat."



3. The application was published on 25 August 2017 and opposed by the Opponent on the basis of sub-sections 5(2)(b), (3), (4)(a) and 56 (1) of the Trade Marks Act 1994 ("the Act"). The Opponent relied upon its earlier rights:
 - a. EUTM 810010 **WAGAMAMA**. The mark is registered for goods and services in Classes 29 to 33 and 42, but the Opponent relied only upon "Providing of food and drink; cafes and cafeteria services; canteen services; catering services; restaurant and self-service restaurant services; snack bars" registered in Class 42 (although now proper to Class 43).
 - b. EUTM 3102233 **WAGAMAMA**. This mark is registered for services in Classes 35, 38 and 43 and reliance was placed for the purposes of the Opposition upon certain services in Classes 35 and 43, namely in Class 35: "The bringing together, for the benefit of others, a variety of goods, enabling customers to conveniently view and purchase those goods from an Internet website specialising in marketing of food, drinks, general merchandise and restaurant services; retail services; providing information about the provision of food and drink via electronic networks and the Internet, and through publication of print media," and in Class 43: "Providing information about the sale of merchandise via electronic networks and the Internet, and through publication of print media."
 - c. EUTM 4718334 This mark is a stylised form of the name WAGAMAMA (shown below) and registered for services in Class 43: Providing food and drink; providing of food and drink by means of on-line ordering; food and drink takeaway services; cafes and cafeteria services; canteen services; catering services, restaurants and self-service restaurant services, snack bars; services for providing food and drink; providing information about the provision of food and drink.

wagamama^{*}

4. The Opponent claimed that
 - a. the respective marks and goods/services were similar for the purposes of subsection 5(2)(b);
 - b. all of its marks had a reputation in the UK for the purposes of section 5(3);

- c. it had goodwill in the name WAGAMAMA, which been used in the UK since 1992, for the purposes of sub-section 5(4)(a); and
- d. the marks were entitled to protection as well-known marks under article 6bis of the Paris Convention.

Although its earlier marks had been registered for more than five years as at the date of publication of the Applicant's application, the Opponent was not put to proof of use.

- 5. In its counter-statement, the Applicant (which has not been professionally represented at any point) stated *inter alia* that its trade mark "was formed after Wakayama, a physical geographical location found within Kansei prefecture, Japan, noted for ramen noodles where our products are sourced."
- 6. Evidence was filed on behalf of the Opponent, to make good its claims under sub-sections 5(3), 5(4)(a) and 56(1). No evidence was filed on behalf of the Applicant. Neither party sought a hearing and submissions were filed only on behalf of the Opponent.
- 7. The Hearing Officer in the decision under appeal
 - a. analysed the evidence filed on behalf of the Opponent,
 - b. set out the usual principles in relation to sub-section 5(2)(b),
 - c. considered in particular the question of the potential similarity of goods to services, and grouped the goods and services together in order to carry out the comparison, concluding that
 - i. all of the goods were similar to a medium degree to the retail services in Class 35, but
 - ii. only some of the goods (prepared meals; instant meals; snack food; soups; prepared, cooked and/or frozen fruits and vegetables; potato chips; all consisting wholly or principally of noodles. Made out of rice and wheat) were similar (to a medium degree) to the services relating to the provision of food and drink in Class 43,
 - d. identified the average consumer as a member of the general public,

- e. considered the principles requisite to the comparison of the trade marks and held that there was a medium degree of visual similarity, a high degree of aural similarity, and conceptual neutrality between them,
 - f. decided that the earlier marks were inherently highly distinctive and had enhanced distinctiveness for restaurant services, and
 - g. concluded that the Applicant's mark would be seen as a variant mark being used by the Opponent and so there was a likelihood of confusion with the earlier marks.
8. In the circumstances, the opposition based upon s 5(2)(b) succeeded across the board, and the Hearing Officer did not deal with the remaining grounds of opposition.
 9. The Grounds of Appeal filed by the Applicant were signed and (I presume) drafted by Mr Sanjay Dattani who also appeared at the appeal. He does not appear to be a current director of the Applicant company, but has previously been a director of it and told me that he was the "appointed officer" representing the company. I saw no reason to doubt his capacity to represent the company on the appeal.
 10. The Grounds of Appeal were brief. The main points made were that:
 - a. The Hearing Officer had been confused by the volume of "insignificant" evidence filed on behalf of the Opponent;
 - b. The Hearing Officer had ignored the Applicant's factual evidence which was more significant and meritorious;
 - c. The Applicant's "trade mark, Wakayama is an actual location in Japan, famous for its ramen noodles which we are planning to manufacture and sell into the retail and wholesale market"; and
 - d. Wagamama is a restaurant chain serving oriental food which is not authentic but generic.

The Applicant therefore asked for the Hearing Officer's decision to be "re-assessed."

11. A Respondent's Notice was filed by the Opponent. However, it did not identify any different or additional grounds upon which the decision should be upheld, as required

by Rule 71(5), although some such points crept into Mr Alkin's skeleton argument for the appeal. In the circumstances, I consider that the Respondent's Notice adds nothing to the appeal, and I shall not consider it further.

Basis of the appeal

12. As I explained to Mr Dattani at the hearing of the appeal, an appeal against a decision 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]. My role is not simply to "re-assess" a Hearing Officer's decision.

13. 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 recently *Actavis* (above):

"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."

14. That is in particular the position where a Hearing Officer has assessed the likelihood of confusion for an opposition based upon sub-section 5(2)(b) of the Act. For instance,

Mr Iain Purvis QC sitting as the Appointed Person in *Rochester* BL O/049/17, said at [33]:

“... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

- (i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case
- (ii) The legal test ‘likely to cause confusion amongst the average consumer’ is inherently imprecise, not least because the average consumer is not a real person.
- (iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.
- (iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case.”

15. I have borne these principles in mind on this appeal.

16. In addition, Mr Alkin, for the Opponent, submitted that the Grounds of Appeal failed to identify any relevant error on the part of the Hearing Officer in this case. He referred me to *Coffeemix trade mark* [1998] RPC 717, a decision of Mr Simon Thorley QC sitting as the Appointed Person. In that case, the appellant had filed very brief Grounds of Appeal, and Mr Thorley refused to allow its counsel to raise a new point of law foreshadowed only in its skeleton argument. He said at p 721:

“It will thus be seen that the Statement of Grounds of Appeal and Statement of Case form an important part in the appeal procedure. The provisions of the Act providing for a right of appeal to the Appointed Person are significant in that they provide for a quick and cheap method of testing any decision of the registrar. The fact that no appeal lies from the decision of the Appointed Person enables finality at an early date. In the case of a trade mark application, this is important not only to the applicant but also in the wider public interest, so that the interested public may know at an early date the extent to which a monopoly by way of trade mark rights are to be granted to rival traders. ...

It is plain from section 76(3) and from rules 57 and 58 that, if a matter is one which either the registrar or the Appointed Person believes might properly be transferred to the Court, observations by the other parties should be made at an early date so that no unnecessary delays occur.

The above considerations highlight the importance of a full Statement of Grounds of Appeal and Statement of Case being served pursuant to rule 57. When I say full, I do not mean that the document should be prolix or, indeed, drafted with any degree of formality, such as might be the case as with a Notice of Appeal to the Court of Appeal. It must be full in the sense that it must outline each of the grounds of appeal relied upon and state the case relied upon in support of those grounds. It should be as succinct as possible but it must be complete.”

Mr Thorley QC went on at page 723 to consider the power to permit amendments to the Grounds of Appeal:

“I am satisfied that I do have power to allow an amendment to the Statement of Case although I believe it must be an inherent power since it is not expressly conferred by the Act or the Rules. In my judgment it would be correct for this Tribunal to act in the same way as any other appellate tribunal and to allow amendments to the Notice of Appeal and supporting documents in appropriate circumstances so as to ensure that the matter before the Tribunal is fully determined. There is, for example, often no objection to a new point of law being taken on an appeal. It would make no sense for an excusable omission in the Statement of Case not to be rectifiable.

However, as with any question of the exercise of discretion on amendment, regard must be had to the conduct of the party proposing the amendment and to the public interest. In particular, it must be done without delay.

In the present case, it is quite apparent from paragraph 5 of the Statement of Case as filed that the draftsman (who, I am told, was not Mr Edenborough) had not turned his mind fully to the matters which might be raised on the appeal. ...

The structure of the Act and the rules is such that a full Statement of Case (full in the sense I have referred to above) should be served within one month of the decision appealed against. Any notion that pleadings before this Tribunal should be skeletal rather than full, as apparently is the view held by Mr Edenborough, should be dispelled at once. The Tribunal cannot function in the manner intended if wholly new arguments are to be raised on the day fixed for the hearing merely because the appellant's representatives have not turned their mind to the matter in good time. If it appears to those representatives that the Statement of Case is not full, then an application to amend should be made at that earliest possible moment. It is not sufficient for representatives to file an inadequate Statement of Case and then sit back and do nothing until a few days before the hearing. ...”

It is therefore well-established that parties to proceedings in the IPO are obliged to set out their position in their statements of case in sufficient detail to enable the opposing party to know the case they have to meet, and whilst amendment is possible,

the discretion to permit amendment must be exercised with care so as not to be unfair to the respondent.

17. Mr Alkin relied upon *Coffeemix* because, he said, the Grounds of Appeal as drafted completely failed to identify any error on the part of the Hearing Officer in this case which could properly form the basis of an appeal by way of review. I accept that the Grounds of Appeal were skeletal rather than full, and it is also true that Mr Dattani (perhaps unsurprisingly) did not make an application to amend the Grounds and was unable to expand upon them at the hearing in any very meaningful way. However, I think that it was possible to discern a few criticisms of the decision, and I think it appropriate to deal with their merits.

Merits of the appeal

18. The first point which it is possible to identify in the Grounds of Appeal is that the Hearing Officer was confused by the volume of “insignificant” evidence filed on behalf of the Opponent. The Applicant failed to identify any particular aspect of the decision which suffered from any such confusion.
19. In my judgment, the volume of evidence filed by the Opponent in this case was not excessive for a case in which reliance was placed upon sub-sections 5(3) and 5(4)(a). There is no reason to think that the Hearing Officer would have had any difficulty whatsoever in dealing with the evidence before her. None is evident from her summary of the evidence at paragraphs 11-18. Furthermore, the evidence was also relevant to the opposition based upon the sub-section 5(2)(b), as it went to the enhanced distinctiveness of the Opponent's marks which the Hearing Officer dealt with at paragraph 58 of the decision. There is no merit at all in this Ground of Appeal.
20. Next, the Grounds of Appeal claimed that the Hearing Officer had ignored the Applicant's “significant and meritorious” factual evidence. Presumably, the Applicant was referring to its point (identified in its counter-statement, as I have said) that Wakayama is a location in Japan, famous for its ramen noodles. This was not disputed by the Opponent, but there are nevertheless a number of problems for the Applicant

in seeking to rely upon this point. First, it had not filed any substantive evidence about Wakayama other than the short point made in its counter-statement supported by the statement of truth signed by Mr Dattani. There was no evidence to suggest that the average consumer in the UK would have any idea that Wakayama is a place name, let alone the name of a place famous for its noodles; indeed, Mr Dattani accepted at the hearing before me that the average consumer would not recognise the name as such. The Hearing Officer referred to this point at paragraph 52 of her decision:

“Conceptually, and notwithstanding the applicant's submissions regarding the meaning of WAKAYAMA as a geographical location, I do not consider that the average consumer will attribute any concept to the word in the contested mark: there is no evidence to support such a view.”

21. In the circumstances, it does not seem to me that the Hearing Officer erred in any way in failing to consider the relevance of the Applicant's claim about the meaning of Wakayama. She did consider it, so far as necessary and appropriate, and in the absence of proper evidence about the meaning of the term, and in particular its meaning to the average consumer in the UK, there is no error in her decision.
22. The Applicant's next point in the Grounds of Appeal related to the Opponent's business. It claimed that Wagamama is a restaurant chain serving oriental food which is not authentic but generic. That point had not been foreshadowed in the counter-statement, so there was no evidence from the Applicant about it, although plainly there was the Opponent's own evidence as to its use of the earlier marks, including some evidence that it serves noodles at its restaurants.
23. Again, it was unclear how this point was said to indicate any error on the part of the Hearing Officer. I presume that it reflects Mr Dattani's submissions about the differences between the parties' respective business models. The difficulty (ignoring the lack of evidence) is that the Hearing Officer quite rightly was comparing the parties' respective trade mark specification rather than their actual/intended business models/activities. There is no error in the decision on this point.

24. At the hearing of the appeal, Mr Dattani made a number of additional submissions, which were not, in my view, foreshadowed at all in the Grounds of Appeal. I will, however, deal with these points in brief for completeness. First, Mr Dattani submitted that the Hearing Officer had erred in finding that the parties' respective marks were similar, especially bearing in mind the visual element of the Applicant's mark (although he accepted that it was reasonable for her to find that the words "premium quality noodles" were not likely to be spoken). Quite apart from the fact that no such error was pleaded in the Grounds of Appeal, it seems to me that the Hearing Officer carried out a proper analysis of the similarities/differences between the marks, and did take the visual element of the Applicant's mark into account. At paragraph 47, she decided that the device played an important role in the Applicant's mark and was sufficiently stylised to be a distinctive element of it. Secondly, Mr Dattani sought to challenge the finding that there was any likelihood of confusion, pointing to the difference between the parties' goods/services, and the manner in which he said the Applicant intends to run its business. As I have already said, that is not a relevant consideration, as the Hearing Officer had to look at the likelihood of confusion given normal and fair use of the specification sought. I do not consider that there was any error in this regard.
25. For these reasons, the appeal is dismissed. The costs must follow the event. I explained to Mr Dattani about the scale of costs used by the UKIPO, and bearing in mind that scale I will order the Applicant to pay the Opponent the sum of £750 in relation to its costs of the appeal, to be paid together with the costs ordered by the Hearing Officer (£1000) by 5 pm on 27 August 2019.

Amanda Michaels
The Appointed Person
6 August 2019

Mr Sanjay Dattani appeared in person for the Appellant
Mr Tom Alkin (instructed by Charles Russell Speechlys LLP) appeared for the Respondent