BLO/915/21

TRADE MARKS ACT 1994

IN THE MATTER OF

APPLICATIONS Nos 3347382 & 3347331 in the name of Andrew Hart

OPPOSITIONS THERETO Nos 415433 & 415498 in the name of David Michaels

AND IN THE MATTER OF

AN APPEAL TO THE APPOINTED PERSON BY David Michaels.

DECISION

INTRODUCTION

1. This is an appeal by Mr David Michaels from a decision of the Hearing Officer, Heather Harrison, dated 3 February 2021. It concerns UK trade mark applications Nos. 3347331 ('331) and 3347382 ('382), both made in the name of Mr Andrew Hart (the "Applications"). The Applications were opposed by Mr Michaels under ss 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 ("the Act") and cover all the services to which the Applications relate. Mr Michaels's opposition relied upon European trade marks Nos. 8458846 and 8458812 (the "Earlier Marks"). Pursuant to Section 6A(3)(1) of the Act, Mr Hart put Mr Michaels to proof of genuine use in the UK of both the Earlier Trade Marks ("Genuine Use").

2. The Hearing Officer dismissed the Opposition on the basis that Mr Michaels had failed to establish Genuine Use. In the light of this finding the Hearing Officer did not need to, and did not, address the substantive grounds of opposition made under ss 5(1), 5(2)a and 5(2)b.

REPRESENTATION

3. Both Mr Michaels and Mr Hart appeared before me in person by video link.

STANDARD OF REVIEW

4. This appeal is a review of the hearing officer's decision, not a rehearing of matters before him. It is well established that before I can interfere with the decision of the Hearing Officer it is necessary for me to find that there was either (a) a distinct and material error of principle in that decision or (b) that the Hearing Officer's decision was wrong (i.e. not merely a decision which I might have taken differently had I been deciding the matter). The relevant principles are set out in *TT Education*

Ltd v Pie Corbett Consultancy [2017] RPC17 by Daniel Alexander QC and by the Supreme Court in *Actavis Group PTC EHF v ICOS Corporation* [2019] UKSC 15.

THE GROUNDS OF APPEAL

5. Mr Michaels advanced his appeal on three basic grounds. These are, in summary, as follows:
    a. the Hearing Officer was wrong, based on the evidence before her, to find that there had been no Genuine Use of the Earlier Marks **("Ground 1")**.
    b. the Hearing Officer was wrong to refuse the admission of additional evidence of use of the Earlier Marks. If she had done, she should have gone on to find there had been Genuine Use of the Earlier Marks **("Ground 2")**.
    c. I should admit further evidence of use of the Earlier Marks. That evidence, if admitted, demonstrates Genuine Use of the Earlier Marks **("Ground 3")**.

GROUND 1

6. The burden of proving Genuine Use lies with Mr Michaels. The nature and standard of proof required are well known. The Hearing Officer's analysis of the law applicable to these issues was set out in paragraphs 31 – 36 of her decision. In my view the Hearing Officer's analysis was both an accurate and a sufficiently complete statement of the law relevant to the matters she had to decide (nor did Mr Michaels urge me otherwise).

7. I gratefully adopt the summary of Mr Michael's evidence set out by the Hearing Officer in paragraphs 18 – 19 of her decision:

> 18. [Mr Michaels] says that he has been using the earlier marks, including by licensing them to others, since 2009. He admits that he entered into a licence agreement with Bite Me Burger Co Ltd, a company run by Mr Hart, in June 2017. He states that he agreed to assign the trade marks to Mr Hart's company but that this agreement was contingent on certain other events which never occurred. He also states that he terminated the agreement for various breaches on 18 October 2017.
>
> 19. A second agreement, with another of Mr Hart's companies, was entered into on 9 November 2018. This concerned joint ownership of the earlier trade marks. Mr Michaels makes various submissions about the ownership of these marks and the potential for confusion if the contested trade marks are registered. However, I do not need to address this further, as Mr Michaels remains recorded as a joint owner of the earlier trade marks

8. In addition, Mr Hart submitted evidence which also pertained to the use of the Earlier Marks. Again, I set out the Hearing Officer's findings in her own words:

> 38. The evidence filed by Mr Hart includes evidence of payments due and invoices from August 2017, which is within the relevant period. The payments which appear to be accepted as genuine total £5,576.80 (or, if the 24 August invoice to We Work is included, £5,928.80). As Mr Michaels has admitted that he had a licence agreement with Mr Hart between June 2017 and October 2017, it can be inferred that the use was with Mr Michaels' consent. The mark which has been used on the invoices is UK382.

9. Mr Michaels did not materially criticise either the Hearing Officer's the summary of (a) his evidence or (b) the relevant evidence of Mr Hart. Instead, he urged me to reach a different conclusion from the one she had reached. I note in particular that Mr Michaels did not suggest that the Hearing Officer had either a) had taken into account matters she should not have done or b) failed to take into account matters she should have done.

10. I have carefully read the evidence and the Hearing Officer's analysis of that evidence. Having done so, it seems clear to me that the Hearing Officer reached a conclusion in relation to Genuine Use that she was fully entitled to given the evidence before her. The first ground of appeal must therefore fail.

GROUND 2

11. Before the Hearing Officer, Mr Michaels sought the right to rely on additional evidence of use of the Earlier Marks. This evidence was said to date from 2017 and be in respect of franchises operated in Marlborough and Southampton. It was said to consist of documents such as franchise agreements, contracts between parties and social media accounts. At the time the request was made, Mr Michaels had produced neither additional witness evidence nor the documents he referred to.

12. The Hearing Officer directed herself to the principles set out in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch). In my view the Hearing Officer's analysis of the relevant law was entirely correct (nor did Mr Michaels seek to say otherwise).

13. The Hearing Officer refused the admission of the additional evidence for the following reasons:

    a) "The opponent bears the burden of proof. Whilst allowances may be made for a litigant in person's unfamiliarity with rules and procedures, unfamiliarity itself does not absolve a party from all responsibility to make their case within normal procedures, particularly when that party is the complainant. Proof of use was clearly requested and Mr Michaels has had ample opportunity to file evidence to support his case;

b) Whilst evidence of the type which Mr Michaels sought to file may have had an important effect on the case, there was no evidence before me: only a general description was provided and there was, therefore, no way for me to make a proper assessment of the effect on the case of the evidence which may eventually be forthcoming;

c) The request was filed at a very late stage of proceedings and would, in effect, take them back to the beginning. Since no evidence had been provided with the request, it was unclear whether Mr Hart would wish to file evidence in response but he would at least have to be offered the opportunity. The delay would be significant.

d) Although a refusal to allow late evidence was likely to have a material impact on the outcome of these oppositions and was considerably to Mr Michaels' disadvantage, I considered this outweighed by the other factors outlined above. I would add that, although a multiplicity of proceedings is to be avoided, opposition proceedings do not create an issue estoppel, so even if the oppositions were to fail and my refusal to allow Mr Michaels a further opportunity to file evidence were upheld on appeal, nothing would prevent Mr Michaels from seeking to invalidate the trade marks once they have become registered"

14. I find no error of principle in the Hearing Officer's reasoning (nor was Mr Michaels able to identify one to me). In my view, the Hearing Officer was fully entitled to refuse to admit the additional evidence. Therefore, Ground 2 also fails.

GROUND 3

15. The principles to be applied when admitting fresh evidence on appeal were set out by Henry Carr J in *Consolidated Developments Limited v Cooper* [2018] EWHC 1727 (Ch) at [33]:

"The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:

i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;

ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;

iii) it is useful to have regard to the *Hunt-Wesson* factors;

iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;

v) the admission of fresh evidence on appeal is the exception and not the rule;

vi) the *Gucci* decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and

vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence".

16. The well-known *Ladd v Marshall* factors referred to by Henry Carr J are:
    i) it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;
    ii) the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and
    iii) the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.

17. Likewise, the *Hunt-Wesson* factors are:
    i) whether the evidence could have been filed earlier and, if so, how much earlier;
    ii) if it could have been, what explanation for the late filing had been offered to explain the delay;
    iii) the nature of the mark;
    iv) the nature of the objections to it;
    v) the potential significance of the new evidence;
    vi) whether or not the other side would be significantly prejudiced by the admission of the evidence in a way which could not be compensated, e.g. by an order for costs;
    vii) the desirability of avoiding multiplicity of proceedings; and
    viii) the public interest in not admitting onto the register invalid marks.

18. The additional material Mr Michaels seeks to introduce on appeal is contained in, or appended to, a document entitled "Appellant's Submissions". Mr Michaels accepted before me that this material a) could have been filed in time to be considered by the Hearing Officer and b) there was no explanation (save for Mr Michaels' failure to be properly organised) why this had not happened.

19. I have considered the additional evidence Mr Michaels wishes to adduce carefully and in the light of the principles identified in *Consolidated Developments Limited v Cooper*. In my view the key parts of that evidence can be summarized as follows:

A Statement by Simon Wetton

20. This consists of a short email which states as follows:

    "Savernake Ventures Ltd, trading as Biteme Burger Co (Marlborough) has licensed the rights to the above mentioned brand names along with other licensed names and trademarks granted to us in relation to the License Agreement agreed with David Michaels to operate a franchise for the abovementioned brand since November 2019. Throughout this time the business has been operating both with instore dining and a full delivery/takeaway business with the exclusive use of these brand

names in the United Kingdom since 31 November 2019 and operating continuously throughout the period through to today's date. The License Agreement remains in force for a further ongoing period of years."

Pages from the www.bitemeburger.com website

21. Pages are exhibited which are said to a) confirm that the website has been running since 2006 and b) to show where "Bite Me Burger" marks have been used. The pages are undated and there is, in my view, no satisfactory evidence to date them.

Various Pages of Social Media

22. These all are said to relate to Bite Me Burger, Marlborough. They consist of a) a Facebook page dated 6 February 2021 b) a further Facebook page whose date cannot be seen c) an Instagram page whose date cannot be seen and d) a Twitter page. The date of this Twitter page is not clearly shown, although it appears to date from some time during or after May 2017.

Menus and Leaflets

23. Mr Michaels produced a menu, and two types of delivery leaflets. The leaflets appear again to relate to Bite Me Burger in Marlborough. None are dated.

Bite Me Burger Presentation

24. This is an undated presentation, which refers amongst other things to Bite Me Burger branded restaurants in Marlborough and in Dubai. The presentation also shows extracts of what appear to be twitter pages dated in April and March 2020. The precise status of these twitter pages is unclear. Not least because they are also not consistent with the assertion in the presentation that Bite Me Burger restaurants are only open in Marlborough and Dubai (as they purport to record thanks sent by Police operating in Camden).

25. I decline to admit the additional evidence, and in so doing note the following:

26. First, it is evidence (as Mr Michaels' readily conceded) that could have been adduced much earlier.

27. Second, there is no satisfactory reason why the evidence was not adduced earlier.

28. Third, whilst the evidence to some extent addresses the issue of Genuine Use, it is in my view of comparatively limited significance. First, it predominantly relates to a single location. Second, and more importantly, it is very far from complete. Many factors, and in particular the scale of use, are left unaddressed. In this regard, I pay particular attention to the following discussion by Daniel Alexander QC in PLYMOUTH LIFE CENTRE Trade Mark BL O/236/13 at [22]:

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

In my view Mr Michaels' additional evidence fails to be sufficiently solid and specific in relation to the issue of Genuine Use. Furthermore, nothing that Mr Michaels has submitted to me (or that I can derive from the material before me) identifies a proper excuse for why Mr Michaels did not, if it existed, submit evidence that was sufficiently solid and specific.

29. Third, Mr Michaels application is, at least to some extent, an attempt to adduce evidence which I have already concluded the Hearing Officer was right to exclude. However, there is one very material difference: unlike the Hearing Officer I have seen the evidence. For this reasons, I believe that the correct way to address this matter is as a factor relevant to the lateness with which the evidence is produced (and which have already noted above).

30. Fourth, it is clear to me that if the evidence were to be admitted, then Mr Hart would have to be given a proper opportunity to address the evidence, the consequence of which would be further delay and, almost certainly remittance to the UKIPO.

31. Having weighed each of these considerations in the light of the factors set out in *Consolidated Developments Limited v Cooper* I have formed the clear view that the additional evidence should not be admitted. The Third Ground of Appeal therefore fails.

OTHER MATTERS

32. Mr Hart argued that Mr Michaels had fraudulently registered the Earlier Marks under a false name (i.e. Mr David Michaels) as his correct name was, Mr Hart asserted, Mr Simon Levy. Mr Hart argued this precluded Mr Michaels, regardless of any other reason, from succeeding in his opposition.

33. The issue of Mr Michaels name was raised before the Hearing Officer. However, she did not reach a conclusion on the issue as she did not need to (having dismissed Mr Michaels' opposition on the non-use grounds I have as discussed above). Furthermore, although Mr Hart raised the issue before

me, he did not do so in the context of a Respondent's Notice. Furthermore, Mr Hart advanced no cogent reasons as to why such I should grant retrospective permission to him serve a Respondent's Notice.

34. It was also clear in my view that the complaint raised about Mr Michaels' use of his name was collateral to the trade mark questions before both the Hearing Officer and I. That is to say, it was being advanced primarily for reasons other than to defend the Opposition.

35. Mr Hart advanced no cogent reasons why such I should grant retrospective permission to him serve a Respondent's Notice and I refuse to do so. The matter of Mr Michaels' name was therefore not before me on appeal. Consideration of the matter was, in any event, unnecessary as I have found as set out above, that the Appeal must fail in any event. In such circumstances it would be wrong for me to express any view whatsoever as to the cogency of the matters raised by Mr Hart on this issue, and I decline to do so.

CONCLUSION

36. For the reasons I have set out above, I find there to be no basis to interfere with the Hearing Officer's decision. The appeal therefore fails and is dismissed.

37. Mr Hart having succeeded is entitled to his costs. Neither party submitted to me that I should depart from the award of costs on the normal contributory rather than compensatory basis. Mr Hart submitted he spent 10 hrs in preparation for the Appeal. That seems to be to be an entirely proportionate and reasonable time. The Litigants in Person (Costs and Expenses) Act 1975, the Civil Procedure Rules Part 46 and the associated Practice Direction set the amount payable to litigants in person at £19 per hour. Therefore, I order Mr Michaels to pay Mr Hart the sum of £190. This sum is to be paid with twenty-one days of the date of this decision.

GEOFFREY PRITCHARD
THE APPOINTED PERSON
10 December 2021