o/996/22

TRADE MARKS ACT 1994

IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3468845
YOGA MAN
BY MR AMIT POPAT
(Applicant/Respondent)

AND

IN THE MATTER OF
OPPOSITION NO. 420590
BY LENOVO (BEIJING) LIMITED
(Opponent/Appellant)

AND

IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
AGAINST DECISION NO. O/077/22
OF MS. ROSIE LE BRETON DATED
28 JANUARY 2022

The Applicant/Respondent represented himself.

The Opponent/Appellant was represented by Mr Sean McDonagh of HGF Limited

Hearing date: 10 June 2022.

DECISION

Introduction

1. This is an appeal against decision BL O/077/22 of Ms. Rosie Le Breton, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 28 January 2022. By that decision the Hearing Officer rejected Opposition No. 420590 to the registration of application No. 3468845 YOGA MAN for the following goods and services:

"Class 9: video games [computer games] in the form of computer programs recorded on data carriers; video games on disc [computer software]; video games programs [computer software]; video games software.

Class 38: Transmission of videos, movies, pictures, images, text, photos, games, user-generated content, audio content, and information via the internet"

in its entirety.

2. In the absence of a costs pro-forma from the Applicant, no order was made as to costs.

3. The opposition, which was partial only, was based on section 5 (2) (b) of the Trade Marks Act 1994 ("the Act"). The earlier trade mark relied upon was EU Trade mark ("EUTM") no. 11229085 YOGA registered for "Computers, namely portable computers and tablet computers, including software and peripherals for use therewith" in class 9.

4. The Applicant denied the Opponent's grounds in full. In addition, it requested that the Opponent prove genuine use of the Earlier Mark. Only the Opponent filed evidence in support of its case. The Decision was taken "on the papers".

The Hear i ng Offic er's Dec isi on

Proof of Use and Fair Specification

5. The Hearing Officer determined that the Opponent's evidence showed genuine use of the Earlier Mark for only "laptops and tablet computers" [41]

Section 5 (2) (b)

6. The Hearing Officer referred herself to *Sabel v Puma* and determined as follows:

Comparison of Goods

a) The goods and services of the Contested Mark were found to be similar to those of the Earlier Mark to a low-medium degree [54-55].

Comparison of Marks – Overall Impression

b) The Hearing Officer determined that the overall impression of YOGA was, not surprisingly, just that [59].

c) As for YOGA MAN she held both words *"make a relatively equal contribution to the mark. Whilst YOGA is the first element where the consumer tends to pay more attention, it qualifies the MAN element to create a concept of a man who practices YOGA. The overall impression resides in the mark as a whole"* [60].

Visual Comparison

d) The marks were visually similar to a medium degree [61].

Aural Comparison

e) The first 2-syllable word YOGA coincided. The third syllable in the Contested Mark, MAN, was a point of difference. The marks were determined to be similar to a medium-high degree [62].

Conceptual Comparison

f) The Hearing Officer found that YOGA meant "the practice of stretching the body into a set of positions in the pursuit of fitness and health for the body and spirit ". As for YOGA MAN, YOGA had the same meaning whereas MAN signified an adult male. The Hearing Officer concluded *"Together, and in the context of the goods and services, it is my view these convey the concept of a "yoga man" namely a man that regularly practices yoga and sees yoga as a lifestyle"* [63].

g) The Opponent had argued that the inclusion of MAN in the Contested Mark would indicate goods and services suitable for men. The Hearing Officer dealt with this thus:

"*Whilst I note the submissions from the opponent that these words will be taken separately to indicate YOGA as above, and that the goods and services are suitable for men, it is my view that in the context of the goods and services, this is highly unlikely. It is my view if this does apply, it will be only in a very specific set of circumstances. Particularly I note this may be the case in respect of, for example, an instructional yoga video game which I accept may be tailored for men and women due to their different body types and flexibility. However, for the most part it is my view that the concept of gendered video and computer games software will be viewed as considerably outdated, and so I find it unlikely the meaning will be construed in this way by the consumer. I also find this to be true in respect of the services covered. It is my view therefore that in nearly all circumstances, YOGA MAN will be interpreted as I have set out previously".*

h) The Hearing Officer concluded *"Nonetheless, overall due to the common concept of YOGA, I find the marks to be conceptually similar to a medium degree"* [64].

Average Consumer and the Purchasing Act

i) The Average Consumer would range from a member of the general public paying a medium level of attention to a specialist purchaser exercising an "above medium" level of attention,, mostly acting on visual cues and using a medium-high degree of attention. The goods would generally be purchased visually but there were aural considerations too [67-69].

Distinctive Character of the Earlier Mark

j) YOGA was determined to be inherently distinctive to a medium degree and this was not enhanced through use [69-70].

Likelihood of Confusion – Direct Confusion

k) The Hearing Officer ruled out a likelihood of direct confusion, saying at [75]:

"With consideration to all of the factors, it is my view that the differences between the marks are too great for the consumer not to notice or recall these and for them to be directly confused. Whilst there are a very small number of scenarios where the use of MAN may be viewed as a description of the gender at which the applicant's goods are aimed, I find this to be in only in scenarios where YOGA is also used descriptively and as such I do not find this element of the mark would be forgotten or misremembered in these instances. With consideration to all of the factors, I find no likelihood of direct confusion between the marks".

Likelihood of Confusion – Indirect Confusion.

l) Also dismissing a likelihood of indirect confusion, the Hearing Officer held at [76]:
"I therefore consider whether there is a likelihood of indirect confusion between the marks. Again, I consider all of the factors set out above, and I consider whether the use of YOGA in the two marks will lead the consumer to believe that the marks derive from the same undertaking. I note the submissions made by the opponent that MAN will be used to indicate the gender to which the goods are aimed. However, as I have mentioned, I find it very unlikely that this would be the case in respect of the majority of goods and services, and in the only scenario where this may be apparent, YOGA would also be used descriptively in respect of the applicant's goods, meaning in my view the shared element would be put down to coincidence and would not be considered as an indication that the goods derive from the same economic undertaking. In other respects, I find it very unlikely that the consumer would believe the particular goods and services offered would be gendered. I found the consumer would view the mark in the majority of cases as conveying the concept a man that practices yoga as a lifestyle, rather than YOGA

goods or services for men, and that the mark YOGA MAN hangs together as a whole. On this basis, I do not find it would be logical for the consumer to reach the conclusion that YOGA MAN is a sub brand of the YOGA mark in respect of the goods and services, or that the use of YOGA in each indicates an economic connection. Whilst I accept it is a possibility that the earlier mark may be brought to mind, I do not find a likelihood of indirect confusion in this instance".

7. Based on these findings the opposition was dismissed.

The Appeal

8. The Opponent filed an appeal on 25 February 2022.

9. The Grounds of Appeal were helpfully summarised in the Opponent's Skeleton:

    1. The Hearing Officer failed to bear in mind the distinctive and dominant components of the Contested Mark.

    2. There was no evidential basis for the Hearing Officer's view that the average consumer would view the concept of gendered goods and services as outdated.

    3. The Hearing Officer was wrong to find that the words YOGA and MAN make "a relatively equal contribution" to the Contested Mark.

    4. The Hearing Officer failed to consider the independent distinctive role held by the word YOGA in the Contested Mark.

    5. The Hearing Officer was wrong in her approach to likelihood of confusion.

10. The Hearing of the Appeal took place on 10 June 2022. The Opponent filed a skeleton argument and was represented by Mr Sean McDonagh of HGF Limited. At the last minute, the Applicant appeared in person.

Standard of Review

11. The Opponent submitted that the standard of appeal is by way of review, relying on TT *Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 and *esure Insurance Ltd v Direct Line Insurance Plc* [2008] R.P.C. 6. I agree. There have been a number of other cases finessing and formulating the principles in various different ways, but for the most part they all essentially come down to the principles enunciated by Mr Daniel Alexander QC sitting as the Appointed Person in *TT Education* at [52]:

i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

ii) The approach required depends on the nature of decision in question (REEF). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (REEF, DuPont).

iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (Re: B and others).

iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (REEF, BUD, Fine & Country and others).

v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (Re: B).

vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (REEF, Henderson and others)".

12. The Opponent also referred to the observation of Lindsey J in *esure Insurance Ltd v Direct Line Insurance Plc* [2008] R.P.C. 6 on what constituted an error of principle:

    "[12] An error of principle such as to justify or require departure from the decision includes the taking into account of that which should not have been, the omission from the account of that which should have been within it and the case (explicable only as one in which there must have been an error of principle) where it is plain that no tribunal properly instructing itself could, in the circumstances, have reasonably arrived at the conclusion that it reached."

13. I bear these principles in mind in reaching this decision.

<u>Merits of the Appeal</u>

14. Simply because it can be disposed of briefly I shall deal with Ground 5 first. This was that the Hearing Officer failed to consider the independent distinctive role supposedly held by the word YOGA in the Contested Mark. This not surprising since no argument or submission (other than by way of the standard reference to it in the general principles to be adopted) was put forward. If the Opponent had wanted to run this point at first instance it should have been brought specifically to the attention of the Hearing Officer and the Applicant. It is too late to try to run it for the first time on Appeal. Ground 5 fails.

15. That leaves Grounds 1-4. As I explain below, however, Grounds 1, 3 and 4 are impacted by Ground 2, so that is the Ground I shall deal with next.

16. The complaint in Ground 2 is that the Hearing Officer had no evidential basis for concluding that the average consumer would view the concept of gendered goods and services as outdated.

17. In its written submissions to the Hearing Officer, the Opponent argued:

"The word 'MAN' merely provides a descriptive indication of the target consumer of the Applicant's Goods and Services. This element does not add to the distinctive character of the Contested Mark and is likely to go unnoticed by the average consumer".

18. The Hearing Officer dealt with this in relative detail at [64] (emphasis added):

"Whilst I note the submissions from the opponent that these words will be taken separately to indicate YOGA as above, and that the goods and services are suitable for men, it is my view that in the context of the goods and services, this is highly unlikely. It is my view if this does apply, it will be only in a very specific set of circumstances. Particularly I note this may be the case in respect of, for example, an instructional yoga video game which I accept may be tailored for men and women due to their different body types and flexibility. ***<u>However, for the most part it is my view that the concept of gendered video and computer games software will be viewed as considerably outdated, and so I find it unlikely the meaning will be construed in this way by the consumer.</u>*** *I also find this to be true in respect of the services covered. It is my view therefore that in nearly all circumstances, YOGA MAN will be interpreted as I have set out previously. Nonetheless, overall due to the common concept of YOGA, I find the marks to be conceptually similar to a medium degree".*

19. This conclusion appears to feed into:
    a) the Hearing Officer's assessment of the dominant/distinctive components and overall impression of the Contested Mark, at [60]:

    "The contested mark comprises the two words YOGA and MAN. Both words make a relatively equal contribution to the mark. Whilst YOGA is the first element where the consumer tends to pay more attention, it qualifies the MAN element to create the concept of a man who practices yoga. The overall impression resides in the mark as a whole".

    b) Her assessment of the likelihood of confusion at [75-76]:

    "*75. With consideration to all of the factors, it is my view that the differences between the marks are too great for the consumer not to notice or recall these and for them to be directly confused. Whilst there are a very small number of scenarios where the use of MAN may be viewed as a description of the gender at which the applicant's goods are aimed, I find this to be in only in scenarios where YOGA is also used descriptively and as such I do not find this element of the mark would be forgotten or misremembered in these instances. With consideration to all of the factors, I find no likelihood of direct confusion between the marks*.

76. I therefore consider whether there is a likelihood of indirect confusion between the marks. Again, I consider all of the factors set out above, and I consider whether the use of YOGA in the two marks will lead the consumer to believe that the marks derive from the same undertaking. I note the submissions made by the opponent that MAN will be used to indicate the gender to which the goods are aimed. However, as I have mentioned, I find it very unlikely that this would be the case in respect of the majority of goods and services, and in the only scenario where this may be apparent, YOGA would also be used descriptively in respect of the applicant's goods, meaning in my view the shared element would be put down to coincidence and would not be considered as an indication that the goods derive from the same economic undertaking. In other respects, I find it very unlikely that the consumer would believe the particular goods and services offered would be gendered. I found the consumer would view the mark in the majority of cases as conveying the concept a man that practices yoga as a lifestyle, rather than YOGA goods or services for men, and that the mark YOGA MAN hangs together as a whole. On this basis, I do not find it would be logical for the consumer to reach the conclusion that YOGA MAN is a sub brand of the YOGA mark in respect of the goods and services, or that the use of YOGA in each indicates an economic connection. Whilst I accept it is a possibility that the earlier mark may be brought to mind, I do not find a likelihood of indirect confusion in this instance.

20. It is clear from these paragraphs that the Hearing Officer did not consider the likelihood of confusion, direct or indirect, from the perspective of a notional consumer who might believe the particular goods and services offered would be gendered were the Contested Mark to be used non-descriptively for the Applicant's goods or services, and that her reason for doing so was rooted in her view that "*the concept of gendered video and computer games software will be viewed as considerably outdated".*

21. As the Opponent submitted, the Hearing Officer's view that *"the concept of gendered video and computer games software will be viewed as considerably outdated"* is unsupported by reference to any evidence. Furthermore, no explanation for her view was set out, nor is there anything to indicate whether this was something the Hearing Officer was taking as a matter of judicial notice or was basing it on her personal knowledge, perception, or supposition.

22. In O-048-18 *BREWDOG ELVIS JUICE* Mr Phillip Johnson, sitting as the Appointed Person, summarised the approach of the tribunal in such matters as follows:

"12. Judicial notice is a mechanism of proof whereby a court or tribunal can find a fact proven without having evidence led to support it. While there are different types of judicial notice, what is relevant for these purposes is where a judge can take judicial notice of a fact because it is notorious.

13. Hearing Officers routinely rely on their own experience when making findings of fact. Indeed, as the quality of evidence filed by parties is sometimes so poor (or there is none at all), Hearing Officers are often compelled to make findings of fact without evidence at all as otherwise the outcome of oppositions might be arbitrary or capricious. For instance, in the instant case, a finding was made as to the usual places where the relevant goods are sold without any evidence being led (see paragraph 31 for instance).

14. The basis for this aspect of tribunal practice was considered at length by Daniel Alexander QC, sitting as the Appointed Person, in O2 Holdings Ltd's Trade Mark Application [2011] RPC 22. Where, after setting out the authorities, he summarised the position at paragraphs 49 and 50:

"While none of these cases is conclusive, they do reflect a discernable trend in cases of diverse kinds, involving the assessment of the meaning and significance of representations made in trade, to be fairly generous in the latitude given to tribunals of fact to determine such issues for themselves, while at the same time suggesting caution where the determination involves issues far from the tribunals' day to day experience.

The cases also underline the need to proportionality in this regard and reflect degree of underlying unease as to whether the quality of decision-making is improved by over-egging of the evidential pudding. If the approach to exactly what is required by way of evidence in this area was more pernickety and if the courts had shown themselves to be systematically mistrustful of tribunals' abilities to make the relevant determinations for themselves, one would expect actual evidence from real people of this kind to be treated with greater reverence. Instead, quite often it is viewed as a costly distraction, sometimes doing no more than teaching an otherwise competent tribunal to suck eggs".

15. Indeed, one of the markers of when a judge or tribunal is straying away from taking notice of everyday things is the inclination to actually state that judicial notice is being taken of something. Thus, a Hearing Officer would probably not say that he or she is taking judicial notice of the fact that cheese is sold in supermarkets. As a matter of proof, however, the Hearing Officer is taking notice of this notorious fact. Yet the fact is far too well-known or indisputable for it to be marked as an instance of a proof by notice.

16. As O2 Holding indicates, the further away the fact is from the tribunal's day-to-day experience the less appropriate it is for it be found without evidence. Importantly, in this sense it is not the particular Hearing Officer's day-to-day experience which is relevant, but that of the notional tribunal. In other words, it is a fact so well-known that all Hearing Officers are likely to be aware of it and nobody could reasonably dispute it.

17. Before moving on, it is important to remember that Hearing Officers all lead very different lives and some will have hobbies and interests meaning that in fact they do have day-to-day knowledge of something of which other Hearing Officers have no knowledge. In such an instance it may be that the Hearing Officer's particular expertise can assist with making the decision, but before this occurs other considerations apply in the same way as they would when a justice uses his or her local knowledge: see Bowman v DPP [1991] RTR 263; Clift v Long [1961] Crim LR 121. In any event, as Bowman (at p 269) makes clear, this practice is not part of judicial notice and so it needs not be considered here.

18. Finally, the decision to take judicial notice of a fact is an exercise of discretion by the Hearing Officer and it should only be interfered with on appeal where it is manifestly wrong: see K T&G v BAT (O/165/16) paragraph 18 adopting Phipson on Evidence (18th Ed, Sweet and Maxwell 2013), par 3-03.

23. For the Opponent Mr McDonagh, quite properly, acknowledged that there is pressure on brands across a range of industries to "shun stereotypes and embrace gender neutrality", as he put it. However, he submitted, it is a "significant assumption" to make that "all brands, including that of the Respondent, would align themselves with this gender-fluid approach". He submitted, albeit without evidence that "…gender marketing remains a common practice across a host of different industries. For instance, such gender targeting can be seen in publications (e.g. magazines), personal care products (such as razors and tissues), dating apps, food products etc." He argued that "to disregard the possibility of particular goods being gendered or targeting a specific gender without a single piece of evidence, on the basis that it is outdated, is simply not sufficient or reasonable".

24. Mr Popat, for his part, contested the Opponent's submissions but only in brief general terms.

25. I agree with the Opponent on this issue, for the following reasons:

    a) Whilst in my view it is a notorious fact of which judicial notice can be taken that, in the broad sense, gender issues are undoubtedly the subject of current cultural debate and ongoing change, that does not tell the tribunal anything about whether gendered marketing is viewed by the average consumer as outdated.

    b) It is implicit in the Hearing Officer's findings she accepted that, in principle, in the Contested Mark *MAN* could be used to indicate the gender to which the goods are aimed. It is also clear that she treated this possibility as "highly unlikely" because of her view on consumer attitudes to gendered marketing.

    c) It may well be that the Hearing Officer's particular experience or perception is that gendered marketing is an outdated concept, but as noted by Mr. Johnson, *" … in this sense it is not the particular Hearing Officer's day-to-day experience which is relevant, but that of the notional tribunal".* Given that gender is a still a matter of intense societal debate at this time, it is not yet possible to conclude without evidence or reasoning that the proposition gendered marketing is viewed by consumers as outdated "*is a fact so well-known that all Hearing Officers are likely to be aware of it and nobody could reasonably dispute it".* Even if it is an outdated concept, without further evidence or reasoning that does not mean it is so obsolete that consumers would discount it in situations of non-descriptive use of the Contested Mark.

    d) In so far as the Hearing Officer was not on relying judicial notice, but on her own personal knowledge or perception, she should have drawn this knowledge or perception to the attention of the parties and given them the opportunity to make submissions and/or file evidence on the point either way.

e) Thus, in my view, Mr McDonagh is correct in saying that the Hearing Officer's supposition in this regard is one which no reasonable judge could have reached

26. It follows that the Hearing Officer's conclusion of primary fact that "gendered marketing" is outdated amounts to that "rare case" for which there was no evidence in support and which no reasonable judge could have reached. It is therefore "wrong" within the meaning of *Re: B* and others. Notwithstanding the caution I must exercise in approaching such matters, I am satisfied that the Hearing Officer fell into error and that it is appropriate for me to intervene.

27. This ground of appeal is therefore upheld.

28. The next matter to be considered is whether the error "taints" the remainder of the decision and, if so, what action I should take.

29. Given that the Hearing Officer's findings on overall impression and direct/indirect confusion are informed by her view on the average consumer's perception of gendered marketing it is possible (although not in any way certain, of course) that if she hadn't taken that view she would have reached different conclusions.

30. I am therefore of the view that the error justifies setting the Decision aside.

31. As to what action I should take, the parties were content that I if I upheld the appeal to any extent I could re-determine the matter myself. However, I note that:

    a) Neither party was given the opportunity to respond to the Hearing Officer's view on gendered marketing and its relevance, either by way of evidence or submissions.

    b) Before me, the submissions were for the most part limited to whether the finding was an error, rather than to its substance (which might well have required further evidence in any event), so I am no better placed to consider the matter.

    c) The point is one which to a reasonable tribunal at first instance might be nothing or something, and on which in the latter case it might issue appropriate directions.

    d) The Hearing Officer's view, either expressly or by implication, permeates a number of the disputed aspects of her Decision, namely Ground 1 (dominant/distinctive components of the Contested Mark), Ground 3 (Overall Impression) (Grounds 1 and 3 are essentially the same point) and Ground 4 (likelihood of confusion).

32. Taking the best view I can of it, in my judgment, this is a case which should be remitted to the Registry for reconsideration by another Hearing Officer in respect of the comparison of marks and likelihood of confusion under Section 5 (2) (b), specifically as regards:

    a) The overall impression of the Contested Mark.
    b) Conceptual comparison.
    c) The likelihood of confusion, direct or indirect, taking into account the reconsideration of the aforesaid matters.

33. I therefore order the application to be remitted to the Registry for these issues to be re-determined.

34. I should stress that I have not reached any conclusion as to any of these matters and in particular as to the likelihood of confusion. I do not seek to point to any future decision by the Hearing Officer tasked with deciding the remitted case.

35. I should also emphasise that remitting the case is not an opportunity for the Opponent to run a fresh line of argument based on the supposed independent distinctive character of YOGA in the Contested Mark, (or any other new line, for that matter). That ship has sailed and is well out of sight of land.

36. As to costs, these are reserved to be dealt with by the Registrar in all respects.

Philip Harris

Appointed Person

11 November 2022