

BL O/0234/25

TRADE MARKS ACT 1994

IN THE MATTER OF
APPLICATION NO. 3555180
HUMANRACE IN THE NAME OF PW BRANDING, INC.
IN CLASSES 3, 5, 16, 18, 25, 27, 28, 32, 35, 41 & 43

AND

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425084 BY ZABOU GROUP LIMITED

AND

IN THE MATTER OF REGISTRATION NOS.
3424619, 3424638, 918117107 & 918117118
IN THE NAME OF
PW BRANDING, INC. IN CLASSES 25 & 35

AND

APPLICATIONS FOR DECLARATIONS OF INVALIDITY
UNDER NOS. 504187, 504188, 504189 & 504190 BY
ZABOU GROUP LIMITED.

AND

IN THE MATTER OF REGISTRATION NO. 3059824
IN THE NAME OF ZABOU GROUP LIMITED IN CLASSES 18 & 25

AND

AN APPLICATION FOR REVOCATION
UNDER NO. 504005
BY PW BRANDING, INC.

AND

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY PW BRANDING, INC AGAINST DECISION NO. BL O/1108/23
DATED 22 NOVEMBER 2023

PW Branding, Inc was represented by Mr Ian Bartlett of Beck Greener LLP
Zabou Group Limited was represented by Mr Guy Tritton of Counsel instructed by Knights PLC

DECISION

Introduction & Background

1. This is an appeal by PW Branding, Inc (“PWB”) against decision BL O/1108/23 of James Hopkins, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 22 November 2023.
2. There is also Respondent’s Notice from Zabou Group Limited (“Zabou”) contesting aspects of the Decision on additional grounds.
3. PWB filed application No. 3555180 HUMANRACE in *inter alia* classes 18, 25 and 35 on 12 November 2020.
4. Zabou opposed this application (OP425084) under Sections 5 (1), 2 (a) and 2 (b) of the Trade Marks Act 1994 (“the Act”), relying on its registration No. 3059824 HUMAN RACE in classes 18 and 25, directing the opposition to PWB’s application for those classes as well as class 35.
5. Subsequently, PWB filed an application (CA504005) to revoke Zabou’s registration No. 3059824 on the grounds of non-use under sections 46(1)(a) and 46(1)(b) of the Act.
6. Zabou, for its part, applied for declarations of invalidity against four additional registrations of PWB for the trade mark HUMAN RACE, again citing Sections 5 (1), 2 (a) and 2 (b) of the Act and its registration No. 3059824 HUMAN RACE.
7. All of these proceedings were consolidated.
8. Ultimately the lynchpin of the various proceedings proved to be PWB’s application to revoke Zabou’s registration No. 3059824, since all of Zabou’s attacks on PWB’s portfolio were dependent on that mark.
9. Two subsidiary points arose in the course of the proceedings. First, PWB sought to have Zabou’s opposition struck out on the grounds that it was abusive. The basis for this was that the opposition contained a false statement of truth relating to a claim that the mark had been used for all of the goods relied on for the opposition.
10. Secondly, PWB had sought, but was refused, leave to cross-examine two of Zabou’s witnesses.

The Hearing Officer’s Decision

11. In summary, the Hearing Officer decided as follows:

- a) PWB's application to have Zabou's opposition struck out was refused.
- b) As to PWB's application to revoke 3059824 on the grounds of non-use, the Hearing Officer distinguished between a form of use made of the mark in 2016 (which he determined was use of a variant which could not be relied on to support use of the registered mark) and use of a new version from 2017 onwards. The Hearing Officer held that this latter use supported the registration for a fair specification of:

"Men's jeans; men's t-shirts; men's sweatshirts; men's denim jeans; men's casualwear; men's casual trousers"
- c) No. 3059824 was revoked for all other goods in classes 18 and 25 from 27 September 2019.
- d) Zabou's opposition to PWB's application No. 3555180, and its applications to invalidate PWB's registrations Nos. 3424638 and 918117118 succeeded in part (it is not necessary to set out the details for the purpose of this Decision).
- e) Zabou's applications to invalidate PWB's registrations Nos. 3424619 and 918117107 succeeded in full and these registrations were deemed never to have been made.

PWB's Appeals

12. PWB filed two appeals under S. 76 of the Act.

Appeal from Refusal of Cross-Examination

13. This was dated 23 June 2023 and concerned the Hearing Officer's interim Decision to refuse PWB's request for the cross-examination of two of Zabou's witnesses. The sole ground of Appeal was that the Hearing Officer was wrong to have refused the application.

Appeal on Substance

14. The second appeal was dated 20 December 2023 and contested the substantive Decision on the following grounds:

CA504005

Ground 1 – the Hearing Officer was wrong to have held that the evidence showed Zabou's registration No. 3059824 had been put to sufficient use to qualify as genuine use.

Ground 2 – the Hearing Officer was wrong to find that the use of No. 3059824 was genuine. The Hearing Officer should have found that such use as had been made of the mark was for an ulterior purpose, namely, to leverage a sale of the mark to PWB.

OP425084

Ground 3 - The Hearing Officer was wrong to refuse PWB's request to strike out the opposition.

Zabou's Respondent's Notice

15. Zabou filed a Respondent's Notice on 12 January 2024. It pleaded the following additional Grounds for supporting the Hearing Officer's Decision:

Ground 1 – the Hearing Officer was wrong to find that the form of Zabou's mark used in 2016 ("the 2016 Variant") did not amount to the use of No. 3059824.

Ground 2 – even if the Hearing Officer was right to exclude that use as such, he should still have taken account of the 2016 Variant to determine whether, overall, the mark HUMAN RACE had been used for token purposes or for a real commercial use.

Ground 3 – The Hearing Officer should have given additional express reasons for dismissing PWB's claim that 3059824 had only been put to token use.

Ground 4 – As regards the refusal of PWB's application to strike out Zabou's opposition, the Hearing Officer should have given additional reasons namely:

- a) Zabou's cancellation applications and its evidence were consistent with the actual use made of 3059824.
- b) Inferentially, the false statement of truth in OP425084 was made by Zabou's previous representatives without properly consulting the Respondent and as a precautionary preliminary designation.
- c) There was no prejudice to PWB.
- d) Alternative sanctions such as an adverse costs order would have been more appropriate.

Standard of Review

16. An appeal is by way of review, not re-hearing. The Court of Appeal has recently summarised the test to be applied to appeals of this kind in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, where Arnold LJ stated the position to be as follows at [110]:

110. It is common ground that, in so far as the appeals challenge findings of fact made by the judge, this Court is only entitled to intervene if those findings are rationally insupportable: *Volpi v Volpi* [2022] EWCA Civ 464, [2022] 4 WLR 48 at [2] (v) (Lewison LJ). Equally, it is common ground that, in so far as the appeals challenge multi-factorial evaluations by the judge, this Court is only entitled to intervene if the judge erred in law or principle: compare *Magmatic Ltd v PMS International Group plc* [2016] UKSC 12, [2016] Bus LR 371 at [24] (Lord Neuberger of Abbotsbury) and *Actavis Group PTC EHF v ICOS Corp* [2019] UKSC 15, [2019] Bus LR 1318 at [78]- [81] (Lord Hodge), and see *Re Sprintroom Ltd* [2019] EWCA Civ 932, [2019] BCC 1031 at [72]-[78] (McCombe, Leggatt and Rose LJJ) which was cited with approval by the Supreme Court in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at [49] (Lord Briggs and Lord Kitchin).

17. The judgment of Joanna Smith J. in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24] is an appropriate summation of the detail of the approach to be followed:

24. Although I was referred to numerous cases on the subject the approach of the appeal court to a statutory appeal under section 76(1) of the TMA is uncontroversial. I bear the following principles, relevant to the issues before me, firmly in mind:

- i) The appeal is by way of a review, not a rehearing;
- ii) The appeal court will allow an appeal where the decision of the lower court was "wrong" (see CPR 52.11). Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffices to justify interference;
- iii) The decision of the lower court will be "wrong" if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. Absent an error of law, the appellate court would be justified in concluding that the decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible";
- iv) The approach required by the appeal court depends on a number of variables including the nature of the evaluation in question. There is a "spectrum of appropriate respect for

the Registrar's determination depending on the nature of the decision", with decisions of primary fact at one end of the spectrum and multi-factorial decisions (of the type which the parties agree were made in this case by the Hearing Officer) being further along the spectrum.

v) In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court 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.

vi) 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. The 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;

vii) Another variable to be taken into account will be "the standing and experience of the fact-finding judge or tribunal". Expert tribunals are charged with applying the law in the specialised fields and their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts.

viii) The appellate court should not treat a judgment as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed; "The duty to give reasons must not be turned into an intolerable burden". The reasons need not be elaborate. There is no duty on a judge, in giving her reasons, to deal with every argument presented by counsel in support of his case. It is sufficient if what she says shows the basis on which she has acted. The issues the resolution of which were vital to the judge's conclusions should be identified and the manner in which she resolved them explained.

ix) In evaluating the evidence, the appellate court is entitled to assume, absent good reason to the contrary, that the first instance judge has taken all of the evidence into account.

Merits

18. I shall deal with PWB's appeal against the refusal of its request for cross examination first because if it is granted, the entire proceedings will need to be remitted back for a re-hearing.

PWB's Request for Cross Examination

19. Before considering this further it will be helpful to set out the background by way of context.
20. The Intellectual Property Office Manual of Trade Mark Practice has this to say about cross-examination:

4.8.9 Challenging evidence

It is normally unacceptable for parties to invite a Hearing Officer to disbelieve the factual evidence of a witness without that witness having had the opportunity to respond to the challenge either by filing further written evidence or, by answering the challenge that his or her evidence is untrue in cross-examination (EXTREME Trade Mark BL O/161/07).

Normally, this will mean the opposing party making written observations within the period allowed for filing its evidence in response to the witness's evidence explaining why the witness should not be believed. Alternatively, the opposing party can file factual evidence in reply of its own which shows why the evidence in question should not be believed. In the further alternative, the opposing party can ask to cross-examine the witness in question at a hearing.

However, requesting cross-examination may be disproportionate and unnecessarily costly and burdensome, since in trade mark proceedings the evidence stages are sequential, providing opportunities to deal with points during the proceedings (*BRUTT Trade Marks* (2007) RPC 19). In addition, cross-examination may not be permitted if the truth or otherwise of the challenged statement manifestly has no bearing on the outcome of the case. Written submissions, or evidence which contradicts the witness's evidence, are therefore likely to be the most satisfactory ways to dispute the factual evidence of the other side in the majority of cases.

21. Thus, the usual practice (in contrast to court proceedings) is for issues to be raised sequentially, in writing. This practice is well-established.
22. Cross-examination was requested by PWB on 1 February 2023 in order to explore with two of Zabou's witnesses:
 - “- Zabou's prior knowledge of Pharrell Williams/PW Branding and the latter's interest in the HUMAN RACE brand.
 - Zabou's motivation in the use of its HUMAN RACE/HUMANRACE brand

particularly from 2017, including its "re-launch" in 2021."

This, it was said, went to the extent to which Zabou's use was "genuine" or simply designed to support the registration for the ulterior purpose of leveraging a sale of the mark to PWB.

23. The two witnesses concerned were Mr Huzaifa Moosa and Mr Lookman Patel.
24. These issues were raised initially by PWB in its evidence-in-chief in the non-use revocation proceedings it had brought against Zabou's registration No. 3059824. That evidence (in reality, submissions) was given in a witness statement dated 24 August 2022 by PWB's representative, Mr Ian Bartlett. He questioned Zabou's prior knowledge of his client at [4-9]. Mr Bartlett then queried the origination of Zabou's website at [8-11]. Then at [13] of his witness statement he challenged the motivation for Zabou's use since 2017, saying the evidence indicated an ulterior purpose based on leveraging a financial benefit.
25. Clearly, therefore, PWB/Mr Bartlett had put forward the relevant questions about prior knowledge and motivation for Zabou to answer evidentially.
26. Zabou dealt with this head-on. First, by way of the 2nd Witness Statement of Mr. Zuber Moosa dated 26 October 2022, made under a Statement of Truth (in fact, a Statement compliant with the more onerous requirements of the Civil Procedure Rules, containing an acknowledgement as to the risk of contempt proceedings if the statement proved to be untrue). He addressed "prior knowledge" at [4-10], the origination and design of the website at [11-19] and regarding motivation, at [22-23] he said:

"22. At paragraph 13, in a wholly speculative manner without any support at all, Mr Bartlett says that the use made of HUMAN RACE by Zabou was done (at least since after 2016) to maintain the registration and thus to leverage a sale by Zabou of the HUMAN RACE trade mark registration to PW or for some other financial benefit and thus it is not "genuine".

23. I entirely deny this and frankly find this speculation wholly offensive."
27. In subsequent sub-paragraphs Mr Moosa went on to elaborate on this denial in considerable detail.

28. PWB did not make any further written challenge to this evidence at this stage of the proceedings, whether by witness evidence in reply, or make any submissions as to why Mr Z. Moosa should not be believed.
29. Secondly, Mr Lookman Patel gave evidence in two witness statements regarding the creation of the website, the second of which specifically responded to Mr Bartlett's challenges about it. Again, PWB did not take the opportunity to challenge this evidence further.
30. Mr Huzaifa Moosa gave evidence on other matters but not on these specific issues, although as Mr Zuber Moosa and Mr Lookman had given that evidence, that is perhaps understandable. No challenge or further enquiry was put to Huzaifa Moosa about his evidence at this stage.
31. The above account illustrates that the issues the subject of the request for cross-examination were dealt with, in conformity with IPO practice, by sequential evidence/submissions. PWB asked its questions and received answers which it did not challenge further.
32. The request for cross-examination of Messrs H Moosa and Patel did not come until 1 February 2023. There was no request to cross-examine Mr Zooba Moosa.
33. Ultimately a Case Management Conference was held to determine the request. Both parties appeared and made detailed arguments. For PWB, Mr Bartlett submitted that the overall evidence was consistent with token, non-genuine use and "leveraging". For Zabou, Mr Tritton argued that there was no evidence of leveraging, that the issue had been dealt with sequentially in evidence and that the request was wholly speculative.
34. The outcome was that the PWB's request was refused. In a letter of 26 May 2023 the Hearing Officer gave a detailed resume of the arguments submitted, and a reasoned decision, which culminated thus:

"...the facts of the case do not appear to be consistent with situations in which one may consider use to have been made solely for the purposes of preserving the registration.

Furthermore, I am not satisfied that PW's allegation, even if proved, would fall within the meaning of 'token' use, as established in case law, that being use which is "solely to preserve the rights conferred by the registration of the mark".

Even if Zabou's use of its registration was, in part, due to knowledge of PW's entrance into the market, that would not be solely to preserve the registration. This is particularly the case, given my comments above regarding what appears to be evidence of use for commercial purposes. Mr Bartlett could not refer me to any authorities where use of a trade mark was found to be token due to knowledge of a competitor, and I am not persuaded by his arguments. I agree with Mr Bartlett that the Registrar, undoubtedly,

has the power to order the cross examination of witnesses in proceedings before the Tribunal and that it can be of great assistance in determining those proceedings. However, PW has already challenged Zabou's evidence through the sequential evidence rounds, and Zabou has duly responded to that challenge. It is not clear, and I have not been sufficiently persuaded, that cross-examination would be of any material assistance in determining these proceedings. In my view, PW's request to cross-examine Zabou's witnesses is speculative, rather than arising out of a tangible basis for doing so.

In the circumstances, and taking all of the above into account, it is my view that cross-examination in these proceedings would be disproportionate, and unnecessarily costly and burdensome. I, therefore, uphold the preliminary view expressed in the official letter dated 17 February 2023 and PW's request to cross-examine Zabou's witnesses is hereby refused."

35. Matters did not end there, however. On 3 July 2023 (i.e. after PWB had appealed the interim decision refusing cross-examination) Zabou agreed ("conceded" as they put it, although it is not suggested this was a formal concession) to PWB's request for cross-examination. To this the Hearing Officer replied by a letter of the same day:

"Cross-examination

I note from Knights' email from earlier today that Zabou "concedes [PWBranding's] 23 June 2023 appeal regarding cross-examination and accedes to the cross-examination at the final hearing of this matter of Mr Huzaifa Moosa and Mr Lookman Patel".

However, please be advised that, as per the Tribunal's email dated 29 June 2023, the appeal against the decision to refuse PW Branding's cross-examination request will not be processed until the final determination of the proceedings. As the appeal cannot be lodged until I have issued a final written decision, there is nothing to concede at this moment in time.

It is not within my authority to predetermine the outcome of PW Branding's appeal. Moreover, given that I have made my decision on PW Branding's cross examination request, I am now functus officio and it would not be appropriate for me to revisit the matter.

Although Zabou no longer objects to PW Branding's request, that is not the end of the matter; the Registrar must be satisfied that cross-examination is material to the matters to be determined and proportionate in all the circumstances. It must not be unnecessarily costly or burdensome. The Registrar's position on the issue stands as per my decision expressed in the official letter dated 26 May 2023."

36. PWB did not press the matter itself, notwithstanding Zabou's "concession".
37. So much for the background. PWB now appeals that original refusal. In his skeleton, and before me, Mr Bartlett essentially doubled down on asserting that the evidence of Zabou's use of HUMAN RACE was so small as to be token and that

“the HO should in any event, and for the same reasons, have recognised the anomalies and inconsistencies in Zabou's evidence pointed out by PW and he should have accepted at least, that the issue warranted investigation by cross examination. That was particularly so given that what required investigation was the motivation, ie the state of mind, of those involved in the use of Zabou's HUMAN RACE "brand".”

38. Mr Bartlett cited in support *Tui v Griffiths* [2023] UKSC 48 where at [70] the Hodge LJ noted:

70. The general rule in civil cases, as stated in *Phipson*, 20th ed, para 12- 12, is that a party is required to challenge by cross-examination the evidence of any witness of the opposing party on a material point which he or she wishes to submit to the court should not be accepted. That rule extends to both witnesses as to fact and expert witnesses.

39. This, Mr Bartlett said, meant that in accordance with the guidance of *Tui* PW was "required" to challenge by cross- examination the evidence of Zabou's witnesses. The HO, by refusing PWB's application, frustrated that requirement.

40. In response to this Mr Tritton pointed out that *Tui* relates to proceedings in court and that UKIPO has its own, independent procedure (as previously noted). He also referred me to BL O/0501/24 *VAPES BARS DIAMOND* in which Mr Allan James, sitting as a Hearing Officer, approved the essential tenets of *TUI* but noted also at [48-49]:

“The way the rules of evidence are applied must, of course, take account of the exceptions and alternatives to cross examination set out in *TUI v Griffiths*. They must also be adapted to recognise the specific procedural rules of this tribunal, which are not governed by the CPR. Instead, they are set out in the Trade Mark Rules 2008.

Rule 64(3) of the Rules states that:

“(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.”

49. Thus the Rules envisage a primarily written procedure for giving evidence, albeit The way the rules of evidence are applied must, of course, take account of the exceptions and alternatives to cross examination set out in *TUI v Griffiths*. They must also be adapted to recognise the specific procedural rules of this tribunal, which are not governed by the CPR. Instead, they are set out in the Trade Mark Rules 2008. Rule 64(3) of the Rules states that: “(3) The general rule is that evidence at hearings is to be by witness statement unless the registrar or any enactment requires otherwise.”

49. Thus the Rules envisage a primarily written procedure for giving evidence, albeit with provision for hearings, cross examination and disclosure. As Mr Arnold (again as the Appointed Person) pointed out in *Brutt TM* this has an important consequence, namely that:

“... in [Registry] proceedings such as these evidence is served sequentially and [in these circumstances] that giving a witness a proper opportunity to deal with a point will not necessarily require cross-examination.”

41. I endorse that position entirely. On this, therefore, I agree with Mr Tritton. *Tui* does not oblige the Registrar to order cross-examination since its principles can and should be adapted to the Registry’s own rules and procedures.

42. The Registrar’s power to order cross-examination is a discretionary case-management power. The discretion is a broad one. It must be exercised judicially, in accordance with the over-riding objective to deal with cases justly and proportionately. As Black LJ observed in *Re B (A Child)* [2012] EWCA Civ 1742, para [35]:

“a judge making case management decisions has a very wide discretion and anyone seeking to appeal against such a decision has an uphill task.”

43. The logic for this is that proceedings should not be hamstrung by interlocutory appeals on case management decisions, and this is especially true in Registry proceedings where in most cases the substantive decision will already have been issued (in which case success would require an entire re-hearing). Thus the bar is high and I should only interfere if the power has been exercised unreasonably or the decision is wrong.

44. In order to determine the issue, the Hearing Officer had to weigh up various factors. This was, therefore, a value judgment but against the background of the general rule in Rule 64 (3) that the default approach to evidence is by witness statements, given in sequence. To displace that general rule, the Hearing Officer had to weigh up whether cross-examination in these proceedings would be disproportionate, and unnecessarily costly and burdensome.

45. Before me, PWB’s argument, other than the *TUI* point, was essentially a re-run of the arguments already made to the Hearing Officer, namely that (in effect) the nature of the evidence somehow

suggested token or other use for an ulterior, non-genuine motive that could be unearthed further by examining the cited witnesses. In effect, Mr Bartlett's case was that if only the Hearing Officer had seen things his client's way, the request would have been granted.

46. I have reviewed the Hearing Officer's Decision. It is clear that he took into account and balanced the various factors, and that ultimately he was simply not persuaded by PWB's arguments. PWB's appeal amounts to no more than a disagreement with that outcome. If I were to consider PWB's points afresh, I would in effect be conducting a re-hearing under the guise of a review.¹
47. Besides, mere disagreement with the Hearing Officer is plainly not enough. The issues were dealt with in sequential evidence and Zabou (through Mr Zooba Moosa in particular) gave clear answers to them. PWB gave no specific reason as to why the proposed witnesses should be questioned further and as was suggested by Zabou, the enquiry was on its face merely speculative and "fishing", perhaps in the hope that "something might come up".
48. That being the case, the Hearing Officer's decision was entirely reasonable and justified. PWB's case comes nowhere near establishing that the Hearing Officer's decision was outside the bounds of his discretion or "wrong" in that sense that it was "outside the bounds within which reasonable disagreement is possible".
49. As noted, Zabou subsequently agreed to the request. The Hearing Officer declined to take that further, taking the view that the original Decision put him in a position of *functus officio*. However there was nothing to stop PWB from renewing its request or making a fresh application based on this significant change in circumstances. This it did not do.
50. It follows that the appeal against the interim refusal of PWB's application to cross-examine Messrs H Moosa and Patel is dismissed.

Respondent's Notice – Use of a Variant Mark

51. I now turn to consider the primary ground of the Respondent's Notice, namely notwithstanding the Hearing Officer accepted that, overall, No. 3059824 had been put to genuine use, the Hearing Officer should have given as an additional reason that use of the 2016 Variant of the mark supported that genuine use.

¹ As to which see [35] of BL O/338/20 *NICO LONDON*, per Mr Geoffrey Hobbs KC

52. The reason for sequencing this for consideration at this juncture is that the outcome will impact on PWB's first ground of appeal.
53. As the Hearing Officer noted at [77], for the purposes of an application to revoke a trade mark for non-use, under S. 46 (2) of the Act,
 "...use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor)..."
54. The corollary of this is that the use of the registered mark in a form which differs in its distinctive character from the registration does not amount to the use of the registered mark.
55. Zabou's registration No. 3059824 is a "word" mark covering the words HUMAN RACE in plain typescript.
56. Zabou put forward evidence purporting to show the use of the mark in commerce and, as is not unusual for "word" marks, the evidence showed the words in a stylised font. There were two versions. The first version (i.e. the 2016 Variant, used on goods shipped in 2016), was essentially



The second version, used on goods shipped from 2017 onwards, was



57. In the event, neither side advanced its case before the Hearing Officer on the basis that there was any question the 2016 Variant was not an “acceptable variant that could be taken into account in establishing the use of No. 3059824, either in their detailed skeletons or in submissions at the Hearing. In fact, the issue did not come up at all, even in passing. The Hearing Officer was not addressed on it, made no mention of it himself and asked no questions in this respect.
58. Given that in all other respects the parties, and particularly PWB, had advanced their respective positions in great depth, and the Hearing Officer was fully cognizant of the parties’ respective positions but stayed silent, the abiding impression is that everyone involved was proceeding on the basis that this was not an issue requiring determination. Certainly, given the strength of their attacks on No. 3059824 in all other respects, it would have been surprising if PWB had not mentioned and pressed this had they thought it relevant.
59. However, when he issued his Decision, the Hearing Officer said this about the 2016 Variant:

82. The evidence suggests that Zabou’s ‘HUMAN RACE’ brand was established in 2014 by Zuber. The first purchase of ‘HUMAN RACE’ branded goods from overseas manufacturers was made on 7 April 2016. Invoices from the manufacturers indicate that these were ‘HUMAN RACE’ branded men’s denim jeans. Invoices have also been provided which demonstrate the sale of such goods to retailers in the UK. However, Zabou’s witnesses have indicated that the branding at that time included the words ‘HUMAN RACE’ in a heavily stylised font (as shown at paragraph 32). In my view, this is not acceptable variant use of Zabou’s mark. The distinctive character of Zabou’s mark lies in the words themselves. In the previous branding, the words are presented in a heavily stylised font, where the letters are either incomplete or filled in where gaps ordinarily appear. Whilst the words may still be identified, consumers would be required to add missing parts, or remove additional parts, of the letters. To my mind, this constitutes an alteration of the distinctive character of the word-only mark.¹⁴⁴ As a consequence, the sales from 2016 must be disregarded.

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60. As can be seen, therefore, the 2016 Variant, on the face of it, did not count in the Hearing Officer’s assessment. Nevertheless, even without taking it into account he ultimately determined that there had been genuine use of the registration. However, part of PWB’s appeal is that the Hearing Officer erroneously counted sales volumes of goods under the 2016 Variant when considering genuine use,

despite having said that they should be disregarded. If these sales had been properly disregarded, they say, the total sales would have been much lower and the finding of genuine use could not have been made on that basis.

61. Conversely if Zabou is correct that the use of the 2016 Variant should have been taken into account as evidence of use, PWB's first ground of appeal on that point essentially falls away.

62. Before me, Mr Tritton pointed out that the case referred to by the Hearing Officer, *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22 was not really "on point". I agree. That was a case which turned on the distinctive character of the get-up of the registration, not the words within it, which is the issue here. The same is true of the principal case cited as authority in *Lactalis*, T-146/15 *HYPEN v EUIPO*. The Hearing Officer expressly acknowledges that "The distinctive character of Zabou's mark lies in the words themselves" and it is from that recognition that the analysis should start.

63. Mr Tritton referred me instead to a decision of the General Court, T-233/15 *Cofra Holding AG v EUIPO* where at [75] the court said:

"In that regard, it should be noted that the specific representation of a word mark is not generally of such a nature as to alter the distinctive character of that mark as registered (see judgment of 23 September 2015, *L'Oreal v OHIM - Cosmetica Cabinas (AINHOA)*, T-426/13, not published, EU:T:2015:669, paragraph 28 and the case-law cited). In the present case, since the earlier mark is a word mark, it may be used with a different script. Moreover, its three principal components remain legible and identifiable in the forms used."

64. Mr Tritton referred me additionally to T-426/13 *AINHOA* where at [28] the General Court said:

"As regards the graphic representation of the contested mark, it should be noted that that mark is a word mark. As such, the precise presentation of such a mark is of no importance. Indeed, the concrete representation of a word mark is generally not such as to alter the distinctive character of that mark as registered (judgment of 21 November 2013, *Recaro v OHIM – Certino Mode (RECARO)*, T-524/12, EU:T:2013:604, paragraph 42).

65. Mr Tritton submitted that had the Hearing Officer received proper submissions on this point and been taken to these authorities, he could not have reached the conclusion that he did. The words HUMAN

RACE in the 2016 Variant were identifiable and legible, notwithstanding the stylisation. That, he said, was acceptable variant use. The Hearing Officer had erred in his logic and approach.

66. For his part, Mr Bartlett asserted that the Hearing Officer was correct to find as he did and referred me to T-146/15 *Hypen v EUIPO* where, in [27] the Court refers to “slight” and “insignificant” variations as the limit for acceptable variant use. He also, with reference to [73] of *Cofra*, pointed out that the stylisation of the 2016 Variant went beyond “banal and incidental” changes and thus amounted to an unacceptable variant. However, in *Cofra* that point was directed at figurative elements accompanying the words in question, not the stylisation of the word mark itself.
67. Although I was not referred to it, I am also aware of T-24/17 *La Superquimica v EUIPO* where at [39] the General Court said:

“...it should be noted that a word mark is a mark consisting entirely of letters, words or groups of words, without any specific figurative element. The protection which results from registration of a word mark thus relates to the word mentioned in the application for registration and not the specific figurative or stylistic aspects which that mark might have. As a result, the font in which the word sign might be presented must not be taken into account. It follows that a word mark may be used in any form, in any colour or font type (see judgment of 28 June 2017, *Josel v EUIPO — Nationale-Nederlanden Nederland (NN)*, T-333/15, not published, EU:T:2017:444, paragraphs 37 and 38 and the case-law cited).”

68. It is somewhat surprising that the Hearing Officer did not refer to this case, since he did refer to BL O/091/19 *Dreamersclub Ltd v KTS Group Ltd* - which in turn quotes the above paragraph - when assessing the genuine use of the other font variants at [83]. Those fonts, he says (with reference to *Dreamersclub*) were “an expression of the mark in normal and fair use; it does not alter the distinctive character of the mark as registered” but there is nothing in that Decision to limit the principle of *La Superquimica* to fonts that are “normal and fair”. It is quite clear – the font must not be taken into account in considering the use of word marks. The protection is for the distinctive character of the words themselves, not the form in which they are presented. There is no indication in the Hearing Officer’s reasoning as to whether he took *La Superquimica* into account or of not, why not.
69. As noted above, neither the Hearing Officer nor the parties in their written or oral submissions to him addressed what is, in effect, a well-known rule². In my view, given this issue was not considered at the Hearing, the Hearing Officer should have invited further submissions from the parties once he

² BL O/091/19 *DREAMERSCLUB* at [13] per Professor Phillip Johnson

decided to go down this path. In any event, having concluded that the 2016 Variant was a “font” and that the words were “identifiable”, the Hearing Officer should have applied *La Superquimica* and the other authorities referred to, to find that the use of the 2016 Variant was acceptable use. In not doing so, therefore, he fell into error.

70. It follows from the above that I uphold Ground 1 of the Respondent’s Notice. The Decision should be upheld for the additional reason that the use of the 2016 Variant amounted to acceptable use of Registration No. 3059824 within the meaning of S. 46 (2) of the Act and should not have been disregarded.

CA504005

Ground 1 – Sufficiency of Evidence of Use

71. First, PWB raises one specific challenge to the sufficiency of the evidence of Zabou’s use. It says that having dismissed the use of the 2016 Variant, the Hearing Officer mistakenly continued to count sales of goods made from 2016 shipments in subsequent years in reckoning total sales. Summing up at [84] the Hearing Officer had assessed total sales at around £50,000, whereas had he followed through on his exclusion of goods bearing the 2016 Variant, total sales would have been less than half that at £23,600.

72. It does indeed seem that the Hearing Officer erred in assessing total sales when judged against his decision to exclude sales of goods under the 2016 Variant [82]. Thus, technically, this ground succeeds. However, I have already determined that the Hearing Officer should have treated use of the 2016 Variant as acceptable use of the registered mark. It therefore follows that the total sales to be taken into account are at least the same as the £50,000 assessed by the Hearing Officer, if not a higher value of £59,400 referred to in a table contained in [35].

73. In my view, therefore, the mistake has been cancelled out. Ultimately, in my judgment, the Hearing Officer would have reached the same decision, notwithstanding this mathematical error.

74. In more general terms it is fair to say that, notwithstanding a lengthy critique of the evidence, and the Hearing Officer’s approach to it, Mr Bartlett did not identify any specific error of principle in the Hearing Officer’s evaluative approach to assessing the sufficiency of use. In truth the criticisms were simply that the Hearing Officer was “uncritical” or failed to make a proper assessment of the evidence.

75. Reviewing the evidence is exactly the kind of evaluative function undertaken by the first-instance decision maker with which I should, absent very good cause, be reluctant to interfere. The task is to

reach an overall assessment, to look at the wood, not just the trees. Mr Bartlett sought to examine not just the trees, but the individual leaves and branches, but without any identification of an actual error of principle.

76. It is also fair to say that all of these issues were comprehensively aired before the Hearing Officer, and many of the criticisms go over the same, and no less stoney, ground. It will serve no purpose for me to go through each individual point, line-by-line.

77. Notwithstanding the length and detail of the submissions, PWB's case is essentially no more than a difference of opinion with the conclusions reached by the Hearing Officer.

78. It follows that this ground of appeal is dismissed.

Ground 2 – Ulterior Purpose

79. PWB's narrative, pressed consistently, was that Zabou's use from at least 2017 was intended to leverage a sale of its mark to PWB and that this rendered such use "token" or non-genuine.

80. The Hearing Officer dealt with this at [89-96]. At [90] he said:

90. Firstly, there is a distinct lack of evidence which demonstrates that Zabou attempted to leverage a sale of its mark to PWB. This was accepted by Mr Bartlett at the hearing. Further, I am not satisfied that the evidence in these proceedings suggests that this was the case, or that Zabou had an ulterior motive in using its mark.

And at [96]:

"It is also worth mentioning that there is no bad faith pleading in these proceedings. Whilst PWB argues that Zabou's intentions are relevant to the question of whether its use of its mark was 'token', this has been characterised in the case law as being use which is "solely to preserve the rights conferred by the registration of the mark". Even if Zabou was aware of Mr Williams and his alleged entrance into the market under the contested marks, there has been real commercial use of Zabou's mark; as such, that would not be solely to preserve the registration. The evidence discussed above, albeit showing use on a small scale, points to use for commercial purposes, i.e. it is not indicative of token use..."

81. Mr Bartlett pointed specifically at the reference in [96] to the absence of a "bad faith pleading" as a "misplaced comment" given that this was not a defence available to it in the opposition. However, I do not think the Hearing Officer meant any more than that PWB had not made any general allegation that the use it claimed was token or for an ulterior purpose was use made in bad faith such as to exclude it as genuine use. In any event, I do not consider the comment, which was an aside, had any bearing on the ultimate outcome

82. In all other respects, PWB's case was, once again, no more than a re-run of the arguments previously put to the Hearing Officer accompanied by submissions that a different evaluation should necessarily have been the outcome. It is fair to say the issue was laboured repeatedly but was found wanting for lack of any evidence to that effect.
83. Thus, absent anything other than a disagreement with the Hearing Officer's conclusion and, in effect, an invitation to me to re-hear the arguments, this ground of appeal must be dismissed.

OP425084

Ground 3 – Striking Out

84. PWB asserted that the Notice of Opposition should be struck out as an abusive because it contained under a statement of truth, a false fact, namely that Registration No. 3059824 had been used for all of the goods for which it was registered.
85. There is no dispute the statement of use was untrue, although how it came to be made is not explained by Zabou. I note that despite seeking in submissions to imply this was down to Zabou's original representatives acting without proper instruction, no-one from Zabou gave evidence on the point either way. I mention in passing that I do not think it was appropriate for Zabou to try to "pass the buck" in this way without giving at least some account of what had been its own role in the making of that statement.
86. In any event, in time Zabou acknowledged narrower use and whilst the Notice of Opposition was never formally amended, matters proceeded on the basis of that narrower claim to use.
87. In response to PWB's strike-out application (dealt with as a preliminary issue) the Hearing Officer said:
3. Whilst these comments are noted, I do not consider this to be a basis to strike out Zabou's opposition. I acknowledge that Zabou did, in fact, state that it had used its mark in relation to "all goods and services". However, Zabou's mark is not registered for a particularly wide range of goods. Rather, it is limited to relatively short lists of goods in classes 18 and 25. Moreover, it would have become clearer which goods Zabou could substantiate its statement of use for relatively early in the proceedings, i.e. once its evidence was filed. Further, it is not uncommon for parties in proceedings before the Tribunal to claim use in relation to a wider range of goods and/or services than what the evidence later shows. Although I agree that it is preferable for parties to provide more precise statements of use as early as possible in proceedings, it is a party's prerogative to

argue its case as it sees fit. In my view, that is not abusive, particularly if it is in the bounds of reasonableness.

88. PWB strongly criticizes this somewhat insouciant approach to a statement of truth. I agree, at least in principle. true. This is not simply a “tick-box” exercise. Parties and their professional representatives must give proper consideration to how far they can assert the use of a mark under a statement of truth. In this day and technological age, any party required to state the nature of its use should have the information available to it at the press of a button and a glance at a spreadsheet or other record, in at least sufficient detail to make a reasonably correct and truthful statement. This matters, because the opposing party (in particular a litigant in person) will make decisions on how best to defend, pursue or even settle their case based, amongst other things, on trusting the supposed truth of the facts of use put to them in the pleadings.
89. Truth is self-evidently at the heart of the interests of justice, which is why under the Civil Procedure Rules, making a false statement of truth can result in contempt proceedings. Indeed, that is presumably why the Registry requires statements of truth. So, whilst a party is free to make any properly arguable case based on the facts of its case, that freedom does not extend to basing it on or stating facts which are demonstrably untrue on any reasonable basis.
90. I accept a party might reasonably put a properly arguable wide interpretation on the general identification of goods supported by its actual use, and as the Hearing Officer says, these claims do need not be precise (at least at the filing stage of a claim) but that is a world away from claiming use where there manifestly is none and the party knows or should reasonably know that to be the case. That was the case here, where (for example) use was claimed for Class 18 when Zabou, had it turned its mind to the issue, must surely have known that no such use had taken place.
91. Unlike the Court, the Registrar has no power to punish summarily for contempt (Trade Mark Rules 2008 (as amended) , rule 65). The question, then, is what sanction should be applied? Mr Bartlett, for PWB, argued that the default was so fundamental it justified the striking out of the entire opposition using the Registrar’s general powers. If not, what is the point of a statement of truth?
92. Mr Tritton, for Zabou, argued that this “nuclear option” was disproportionate, not least because the true extent of Zabou’s use became clear relatively early in proceedings and there was no prejudice to PWB (in effect, stressing the grounds in his client’s Respondent’s Notice).
93. After the Hearing had concluded I identified TPN 1/2000 which says:

“Confirming accuracy and truth of a statement of case

27. The Office has decided to adopt Lord Woolf's recommendation that claims and defences should contain a declaration on behalf of the parties confirming the accuracy and truth of the matter contained in them. Such a declaration is required for trade marks proceedings and encouraged in other proceedings. It should be noted that such a declaration is necessary if a party wanted, in any subsequent appeal to the High Court, a statement of case to be taken into account as evidence.

28. Examples of a declaration that would be acceptable are:

"I/we confirm that the information contained in this statement of case is true to the best of my/our knowledge and belief."

or

"I/we believe the information contained in this statement of case to be true."

29. If, in the event, a statement or counterstatement proves to be inaccurate or untrue then, in the absence of any clear and justified explanation for the breach, the Hearing Officer will take this into account when making an award for costs.” (emphasis added).

94. This clearly indicates that (without my deciding anything in relation to the Registrar's general power to strike out proceedings) the appropriate sanction for an inaccurate or untrue statement, the cause of which is not properly explained, is in costs and, of course, in appropriate cases these could be off-scale.
95. I asked the parties to address me in writing on this TPN. Mr Bartlett referred me to *Sherlock Systems v Apple* 0-015-17 for confirmation of the Registrar's general power to strike out abusive proceedings (see Mr Allan James at [24-25]). He referred me also to *Woodhouse UK Plc v Architectural Lighting Systems (trading as Aquila Design), Urbis Lighting Limited* [2005] EWPC (Des) 25, 2005 WL 2893811. However, that was a case concerned with the validity of a registered design based on an untrue proprietorship claim, not the making of a false statement of truth. I do not find it to be of assistance.
96. Zabou says that, in effect, TPN 1/2000 is the correct approach and that if there is to be a sanction it should be in costs.
97. I agree. Without putting any fetter on the general powers of the Registrar to strike out a case as an abuse of process, in general the appropriate sanction in a cases such as this is in costs as per TPN 1/2000.

98. In this case, ultimately there was no prejudice to PWB and the proceedings went forward on the basis of a proper understanding of Zabou's actual use. Thus, notwithstanding I do not entirely endorse the Hearing Officer's reasoning, I concur with his rejection of the application to strike out the opposition. PWB's appeal on this ground is dismissed.

Respondent's Notice – Additional Grounds

99. Since I have rejected PWB's Appeal in all respects, and upheld Ground 1 of the Respondent's Notice, I do not need to determine the remaining grounds of the Respondent's Notice.

Conclusion

100. Overall PWB's appeal is dismissed, notwithstanding its specific criticism of the Hearing Officer's summing of the sales figures was upheld.

101. The Respondent's Notice is upheld to the extent that the Appeal should have succeeded for the additional reason that use of the 2016 Variant mark



constituted acceptable use of registration

no. 3059824.

102. The overall outcomes remain as determined by the Hearing Officer at [162-166] of his Decision.

Costs

103. Zabou has been successful and is entitled to its costs, over and above the £4120 awarded by the Hearing Officer.

104. Both parties were in agreement that the standard scale should apply.

105. I award Zabou £3000 in costs for the 2 appeals and attendant preparation and appearance at the hearing before me.

106. The total of £7120 is to be paid by PWB to Zabou within 21 days of the date of this Decision.

Philip Harris

Appointed Person

14 March 2025