

**BL O/0328/25**

TRADE MARKS ACT 1994

IN THE MATTER OF  
TRADE MARK APPLICATION NO. UK00003587255  
CERAD  
IN CLASS 41  
IN THE NAME OF  
FUTURE (AWARDS AND QUALIFICATIONS) LIMITED

AND

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 425171  
BY  
QUALSAFE LIMITED

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON  
BY QUALSAFE LIMITED  
AGAINST DECISION NO. BL O/0922/23  
DATED 28 SEPTEMBER 2023

MS. ALAINA NEWNES (instructed by Sonder & Clay) appeared for the Appellant.  
MS. VICTORIA JONES (instructed by IP-Active.com Limited) appeared for the Respondent.

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DECISION

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**Introduction & Background**

1. This is an appeal by Qualsafe Limited (“the Opponent”) against decision BL O/0922/23 of Mr Nathan Abraham, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 28 September 2023. In fact, it is the second appeal in these opposition proceedings.
2. Future (Awards And Qualifications) Limited (“the Applicant”) filed application No. UK00003587255 CERAD (“the Contested Mark”) on 29 January 2021. In due course the Opponent opposed this application, relying on, *inter alia*, Sections 3 (1) (b) & (c) of the Trade Marks Act 1994 (“the Act”) (a further objection taken under S. 3 (1) (d) was dismissed and is not relevant to this appeal).
3. The objections taken were:

- a) Under S. 3 (1) (b): CERAD is devoid of distinctive character as it constitutes the recognised acronym for 'Certificate in Emergency Response Ambulance Driving' and is not capable of distinguishing the services of one undertaking from another.
  - b) Under S. 3 (1) (c): The mark applied for serves in trade to designate the kind of goods and services, the intended purpose of the goods and services and other characteristics of the goods and services
4. For all practical purposes it is common ground that CERAD is indeed an acronym originally derived from the title of a course developed by the Applicant, namely "Certificate in Emergency Response Ambulance Driving". That does not, of itself, prevent it from qualifying as a distinctive mark if the relevant public had not been educated to see it as a descriptive acronym. As Professor Johnson said in the first appeal in these proceedings, BL O/969/22 (see below), the issue for determination is whether, on the evidence and at the relevant date (29 January 2021) *"the use of the Sign educated consumers to see CERAD as descriptive of a type of course or whether it educated them to see CERAD as linked to the Appellant's course only"*. Both parties had submitted relevant evidence in support of their respective positions.
  5. That opposition resulted in a first Decision No. BL O/561/22 refusing registration under sections 3(1) (b) and (c) of the Act.
  6. The Applicant successfully appealed Decision BL O/561/22 under SS 3 (1) (b) and (c) (there was no appeal against the dismissal of the S 3 (1) (d) ground). By Decision BL O/969/22, Mr Phillip Johnson sitting as the Appointed Person remitted the case back to the Registrar for reassessment by a different Hearing Officer.
  7. By the time the matter came back to the Registrar for determination, the application's specification had been limited to:

Class 41: Development of qualifications, standards, approval of training providers, quality assurance of training providers, awarding of certificates, assessment and certification services, all relating to the training of paramedics and ambulance personnel.

### **The Hearing Officer's Decision on the Remitted Proceedings**

8. In his reassessment, the Registrar's Hearing Officer Mr Abraham rejected the opposition in full. In summary, the Hearing Officer decided as follows:

- a) The average consumer was likely to be specialised [26];
- b) the expression from which CERAD is derived, 'Certificate in Emergency Response Ambulance Driving' is descriptive of, and therefore devoid of any distinctive character in relation to, the applicant's services [29-30];
- c) In the *prima facie*, CERAD was not descriptive [31-32];
- d) The Opponent's evidence failed to show that CERAD was, at the relevant date, "recognised and understood as an abbreviated form of the longer expression 'Certificate in Emergency Response Ambulance Driving'" [35-40];
- e) CERAD was therefore inherently distinctive [40];
- f) In consequence, the opposition failed as regards both grounds pleaded.

### **Appeal and Respondent's Notice**

9. The Opponent now appeals that Decision under S. 76 (1) of the Act, the appeal being dated 25 October 2023. There are two grounds, as follows:

- a) Ground 1: The Hearing Officer failed to consider the evidence as a whole. In particular, he
  - i) wrongly disregarded the Applicant's own evidence which tended to show descriptive understanding on the part of consumers;
  - ii) wrongly disregarded the Opponent's evidence of naming conventions/acronyms in the relevant field,.
- b) Ground 2: The Hearing Officer erred in finding the parties' evidence of "limited value" and giving insufficient weight to much of it on the basis it was undated or inconclusive as to its date.

10. For its part the Applicant filed a Respondent's Notice dated 16 November 2023. As well as supporting the original Decision it pleaded the following additional grounds for its maintenance:

Ground 1 - If for any reason the Hearing Officer's assessment of the average consumer is found to be wrong, this should not affect the overall outcome;

Ground 2 - Even if the Hearing Officer erred in assessing the evidence, it nevertheless falls short of establishing that CERAD is descriptive;

Ground 3 - The Decision should be upheld on the basis that "Certificate in Emergency Response Ambulance Driving" is not descriptive of and/or devoid of any distinctive character in relation to the Relevant Services.

11. A further ground directed to the acquired distinctive of the application was not pursued.

#### **Standard of Review**

12. An appeal is by way of review, not re-hearing. I remind myself of the principles to be applied, which were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch) at [24]. They are well-established and do not need to be set out here at length.

13. Of particular relevance to this case which, to a great extent, concerns the Hearing Officer's consideration of the evidence, is *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch) where Sir Anthony Mann held (at paragraphs [6] to [8]):

"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in *Instagram LLC v Meta 404 Ltd* [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in *Volpi v Volpi* [2022] EWCA Civ 464.

i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that

it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

### **Merits**

14. After considering the submissions of the parties and the papers, it seems to me that the Opponent's best case is Ground 1 (i), namely that the Hearing Officer erred by failing to consider the impact of the Applicant's own evidence in his assessment of the Contested Mark's alleged descriptiveness/distinctiveness. I shall therefore consider this first.

15. By way of background, both parties had filed evidence. The Opponent's witness Mr Nigel Barraclough made two witness statements with 15 exhibits (NB1-15). For the Applicant, Mr Christopher Young gave a Witness Statement supported by Exhibits CY1-8.

16. Obviously, the Parties differed as to what their respective evidence sought to prove. The Opponent's was intended to show that CERAD was descriptive/non-distinctive, the Applicant's that the reverse was true.

17. However, the Opponent made submissions (both in Ms Newnes' skeleton and at the Hearing on the following evidence from the Applicant:

a) First, at [9] of his Witness Statement, Mr Young says:

*“Internally within our company, we referred to this qualification as ‘CERAD’ from the earliest days and as the qualification became more widely known, this acronym was soon being used by customers and within the field of ambulance driver training.”* This, submitted Ms Newnes, showed that the Applicant treated the sign as an acronym rather than a fanciful invented word and further that consumers had, by the Relevant Date, been educated that it was a descriptive acronym.

- b) Secondly, it was submitted that elements of Exhibit CY5, put forward by the Applicant in support of its case on distinctiveness, in fact supported the Opponent’s case.

18. The Opponent’s case on appeal is that the Hearing Officer failed to give proper consideration to this evidence and what it was worth.

19. I have the papers from, and a transcript of, the Hearing below. From these I can see that these matters were expressly raised by the Opponent. In particular, both parties made submissions on the interpretation of Mr. Young’s statement quoted above. That being so, and since the matter goes to a central issue in the case it would be expected that it would be expressly considered by the Hearing Officer.

20. In his Decision, the Hearing Officer did indeed review the evidence of both parties at [13-18]. He concluded by saying it was, on both sides, of limited value. However the Hearing Officer does not add any context, in particular as to whether he has considered this disputed evidence for its value in supporting the Opponent’s submissions or in the light of the debate at the hearing. The impression is that he was considering the evidence only from the perspective of the party putting it forward and what, primarily, they intended it to prove.

21. At [34] *et seq* there are more signs that the Hearing Officer considered only the Opponent’s evidence in assessing the distinctiveness of CERAD:

34. ...As indicated at paragraph 31 above, I have nothing from either party indicating that the sign ‘CERAD’ has any inherent meaning in relation to the services claimed. **What I do have is submissions from the opponent alleging that the sign is both descriptive and non-distinctive on account of its common usage as an acronym for the descriptive expression ‘Certificate in Emergency Response Ambulance Driving’, by more than one provider, and to the extent that it is recognisable amongst relevant consumers as being an origin-neutral sign.** As a result, my assessment must be purely factual. If the evidence

fails to support the opponent's claim because it does not show that 'CERAD' is a descriptive and/or non-distinctive term, then the opposition under sections 3(1)(b) and (c) will also fail. If, on the other hand, the **opponent's evidence** does show that, at the relevant date, the sign 'CERAD' was recognisable amongst the relevant public as an acronym for the phrase 'Certificate in Emergency Response Ambulance Driving', then I would conclude that the sign is descriptive and devoid of any distinctive character.

22. In the course of this paragraph it can be seen that the Hearing Officer is "zooming in" on the Opponent's evidence, not the evidence as a whole or the Applicant's evidence in particular, despite being expressly pointed to it by the Opponent and it being a contested matter in the Hearing.

23. Next, under the heading "Impact of Opponent's Evidence" at [35-40] the Hearing Officer considers the Opponent's own evidence and concludes it is insufficient to prove the Opponent's case that at the relevant date CERAD was descriptive under S. 3 (1) (c).

24. Notably, however, nothing is said about the Opponent's submissions on the evidence of the Applicant, nor about the impact/interpretation of the Applicant's evidence in the light of those submissions.

25. To this, Ms Jones submitted to me that [13-18] clearly showed the Hearing Officer was aware of the evidence in question, had given it no weight and that this ground of appeal represented no more than an attempt to effect a re-hearing. She also, quite correctly, reminded me in particular of the specific constraints on appellate intervention enunciated in *Stitch Editing*, including that:

*"An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it"*

And that

*"An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationaly insupportable."*

(emphasis added).

26. The words “bound”, “compelling” and “rationally unsupportable” are strong, for good reason, and seem intended to suggest I should give the Hearing Officer the benefit of the doubt, absent more. It is therefore clear that the bar for intervention where the appeal concerns the Hearing Officer’s approach to evidence is high.

27. With that in mind, in considering how to approach that bar, I have regard to the case of *Stitch Editing* itself. In that case Sir Anthony Mann was reviewing (amongst other things) a Hearing Officer’s approach to considering evidence of acquired distinctive character. As in this case, the Hearing Officer had listed the relevant evidence, but had not commented on its relevance or significance, nor that it was being referred to in a specific context. Crucially, Sir Mann noted that the Hearing Officer did not deal with all of the sets of evidence when considering its impact but dealt with only certain factors. Sir Mann – clearly aware of the appellate constraints – held at [44]:

“I am aware that a judgment is not impeachable just because it does not expressly articulate each and every little step towards a conclusion, and overall assessments are permitted without specifying all their ingredients, but the way this Decision is expressed leads to the conclusion that the omission to consider the way in which the evidence was put is or might well be because the point was not fully considered. That makes the Decision impeachable on an appeal.”

28. From *Stitch*, therefore, it seems a “compelling reason” to intervene is, for example, if the way the decision is expressed leads to the conclusion the evidence was, or might well not have been, fully considered.

29. As for the requirement that the outcome is “rationally insupportable”, like a sum missing a number a failure to expressly take into and resolve evidence and submissions central to the pleaded case would, in my view, argue against the outcome being rationally supportable.

30. I perceive parallels here. The Hearing Officer has listed the evidence concerned. True, he also commented that the evidence as a whole was of limited value, but there is nothing to show he considered Young [9] or the impact of Exhibit CY5 in the light of the Opponent’s submissions. Further, the Hearing Officer emphasises the impact and relevance of the Opponent’s evidence, without once dealing with the Opponent’s submissions on the impact of the Applicant’s evidence. Indeed, whilst one section is headed “Impact of Opponent’s Evidence”, there is no corresponding section dealing with

the impact/interpretation of the Applicant's evidence in the light of the Opponent's submissions. That set of evidence was not obviously considered in the light of the Opponent's submissions. An obvious inference, therefore, is that only the Opponent's evidence was considered.

31. Thus, as in *Stitch Editing*, the way in which this decision was expressed has led me to the conclusion that the omission to deal with the impact/interpretation of the Applicant's evidence in the light of the Opponent's submissions is or might well be because the point was not fully considered. As in *Stitch*, that makes the Decision impeachable on an appeal.

32. In the light of the above, I conclude that the Hearing Officer's Decision is flawed and cannot stand. I allow the appeal.

33. I stress that that in doing so I take no position on what the evidence/submissions – those in dispute or indeed any of it – does or does not show/prove. The success of the Appeal arises solely because of the absence of a proper consideration. As ordered below, It will be for a new Hearing Officer to determine all matters afresh.

#### **Disposal, Other Grounds of Appeal/Respondent's Notice**

34. A proper consideration of the evidence and submissions affects all aspects of the Decision. If I were to try to assess the matter myself I would, in effect, be re-hearing the case. Thus I do not consider it would be appropriate or indeed practical, for me to embark on either a further consideration of this issue, or the parties' other Grounds of Appeal/the Respondent's Notice, or to otherwise attempt to determine the matter myself. Whilst in principle I am loathe to have to remit this case back to the Registrar for a third determination, in practice I can see no alternative.

35. I therefore order that the matter be remitted to a different Hearing Officer for a fresh determination of the objections under section 3(1)(b) and (c) of the Trade Marks Act 1994. I encourage but do not mandate the parties to consider, in view of the efforts already expended, to consider whether written submissions will suffice as regards matters which have already been exhaustively aired.

#### **Costs**

36. The position on costs is becoming somewhat complex, given the "see-saw" in the parties' respective fortunes at each stage of this process (this being the fourth such stage with, almost certainly, a fifth to follow at least). Even though the Opponent has been successful in this appeal it may still be

unsuccessful going forward. I award the Opponent £3000 towards its costs but will leave it to the Hearing Officer who re-hears the matter to determine the final allocation of costs depending on which party is ultimately successful.

Philip Harris  
Appointed Person

7 April 2025