BL O/0465/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NOS.
UK00003825827
KOA

AND UK00003825830

and others (series of 4)
IN CLASS 43
IN THE NAME OF
ARK'S VISION FOR FOOD SUPPLIERS

AND

AND IN THE MATTER OF OPPOSITIONS THERETO
UNDER NOS. 438832 AND 438833
BY
KOAKULT GMBH
(formerly recorded on the register as KOASKULT GMBH)

IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY
ARK'S VISION FOR FOOD SUPPLIERS

AGAINST DECISION NO. BL O/0578/24
DATED 20 JUNE 2024

MS. DENISE McFARLAND of Counsel (instructed by Protopapas LLP) appeared for the Appellant/Applicant.
MR. IAN BARTLETT of Beck Greener LLP appeared for the Respondent/Opponent.

DECISION

Introduction & Background

1. This is an appeal by Ark's Vision For Food Suppliers ("the Applicant") against decision BL O/0578/24 of L Fayter, sitting as a Hearing Officer on behalf of the Registrar of Trade Marks, dated 20 June 2024. The respondent, as at the time of this appeal, is recorded on the register as Koakult GmbH ("the Opponent").

Registration History of the Earlier Trade Mark

2. The Opponent registered International Registration No. 1531402 KOA with the World Intellectual Property Organization ("WIPO") on 12 March 2020. The specification of the registration is:

   "Class 29 Game; edible oils; edible fats; poultry, not live; milk products; milk beverages, milk predominating; milk; jams; compotes; dried fruit; dried vegetables; cooked fruits; cooked vegetables; jellies; meat extracts; meat; fish; eggs.

   Class 30 Sugar; truffles [confectionery]; tea; edible ices; sauces [condiments]; mustard; chocolate-based beverages; salt; sago; rice, tapioca; rice; cocoa beverages with milk; treacle; flour; ice [frozen water]; candy coated confectionery; confectionery with chocolate coating; flour confectionery; dairy confectionery; cocoa powder; cocoa drinks in powder form; cocoa drinks; cocoa; artificial coffee; coffee; honey; yeast; spices; cereal preparations; pastries; vinegar; bread; baking powder.

   Class 32 Syrups for making beverages; aerated waters; carbonated mineral waters; fruit juices; fruit drinks; beers; non-alcoholic preparations for making beverages; non-alcoholic beverages".

3. The International Registration claimed a German priority of 2 October 2019. It designated the UK as one of the countries in which the registration should be protected and protection was duly granted by UK IPO on 17 December 2020 under No. WO000001531402 (("the IR").

4. Crucially, when the original International Registration was filed, it was recorded by WIPO that the name of the proprietor was **Koaskult** GmbH (emphasis added). It was this spelling of the IR proprietor's name which was recorded at UKIPO against designation No. WO000001531402.

5. On 19 June 2020 WIPO corrected the spelling of the Opponent's name to **Koakult** GmbH. For whatever reason, that correction does not appear to have been recorded at UKIPO against WO000001531402 by the time the instant proceedings were commenced although, as will become clear, it was corrected by at least 20 September 2024.

The Applications and Oppositions

6. On 2 September 2022 the Applicant applied to register:

   a) the trade mark KOA under No. 3825827;
   b) A series of 4 figurative marks under No. 3825830:

7. Both applications covered the same class 43 specification:

   “Services for providing food and drink; restaurant, cafe, bar and banqueting services; restaurant and bar management services; cocktail lounge services; food preparation services; catering services; provision of information, advice and consultancy in relation to all the aforementioned services”.

8. The Opponent filed notices of opposition to both applications on 24 January 2023 relying on its IR. Opposition No. 438832 was directed to Application No. 3825827 and Opposition No. 438833 was directed to Application No. 3825830. All of the goods for which the Earlier Trade Mark was protected were relied upon.

9. The oppositions were identical, based upon sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”), the Opponent claiming that there was a likelihood of confusion because the Earlier Trade Mark and the Applicant’s marks were identical/similar and the goods/services were similar.

10. Importantly, as it turns out, the Opponent filed both of its oppositions in the name **Koaskult** GmbH, the proprietor’s name recorded on the UK register at the date the opposition was filed, notwithstanding that by this time WIPO’s International Register recorded the proprietor under the corrected spelling of Koakult GmbH and had done so for some time.

11. The Applicant defended the Oppositions. The grounds of its defence were, in summary, that “having regard to the low similarity between the marks, and the dissimilarity between the Contested Services and the Opponent’s Goods, there is clearly no likelihood of confusion and no risk of association on the part of the public, even when allowing for interdependence and imperfect recollection”.

12. Specifically regarding the Opponent, the Applicant stated at [3] of its Counterstatements:

    “Koakult GmbH (“the Opponent”) is the owner of UK Trade Mark Registration No WO1531402 for the mark koa (“the Opponent’s Mark”) which is registered for food and non-alcoholic beverage products in classes 29, 30 and 32 (“the Opponent’s Goods”).”

13. Throughout the Opposition proceedings, the Applicant referred to the Opponent as “Koakult”. Furthermore, in evidence, the Applicant sought to adduce evidence of the Opponent’s activities under the name “Koakult”.

14. In contrast, until this appeal, all references to the Opponent’s identity in the documents and evidence filed by the Opponent maintained the use of the name Koaskult GmbH. The Opponent’s representatives made no attempt to explain or otherwise regularise the discrepancy prior to this appeal.

15. In due course the Oppositions were consolidated.

16. Neither party requested a hearing in the opposition proceedings. Both made written submissions to the Hearing Officer *in lieu*.

17. In its submissions, in addition to its arguments in support of the Application, the Applicant included a request that if the Hearing Officer was against the Applicant it should consider an “Auxiliary Specification Request” setting out an emended specification, in effect a fall-back specification restricting the Applicant’s services by reference to the qualifying term “fine dining”.

The Hearing Officer’s Decision

18. In summary, and to the extent necessary for this appeal, the Hearing Officer decided as follows:
    a) Specifically with regard to the Applicant’s evidence mentioning the identity of the Opponent, and its business in Germany carried on under the name Koakult, they held:
        i) “the opponent’s IR is owned by Koaskult GmbH, and the current proceedings have been brought under this name. Consequently, I cannot take this evidence into consideration as the website is not under the name of the registered opponent.”
        ii) Even if the evidence did relate to the Opponent, the Hearing Officer held it was irrelevant because it did not relate to the UK and that, if the evidence was intended to challenge the Opponent’s genuine use of its mark, the applicable provisions under S 6A of the Act did not apply because the Earlier Trade Mark had not completed its registration process more than five years before the relevant date (the filing date of the applicant’s marks.
    a) The Applicant’s “*Services for providing food and drink; restaurant, cafe, bar and banqueting services; food preparation services; catering services; cocktail lounge services”* were similar to the Opponent’s goods to a medium degree.
    b) “*Provision of information, advice and consultancy in relation to all the aforementioned Services”* were similar to a low degree.
    c) *“Restaurant and bar management services; provision of information, advice and*

consultancy services in relation to restaurant and bar management service" were dissimilar.

d) The opposition failed for "*Restaurant and bar management services".*

e) Application No. 3825827 was identical to the Opponent's IR.

f) Notwithstanding the additional elements within their figurative presentations, the series of marks the subject of Application No. 3825830 were, by reason of the common element KOA, visually highly similar and aurally identical to the Opponent's IR (conceptually the parties' marks were neutral).

g) There was a likelihood of direct confusion for both applications, and in addition a likelihood of indirect confusion in the case of No. 3825830 for all services having any level of similarity to the Opponent's goods, and both applications were refused for such services.

h) There was no likelihood of confusion as regards the Opponent's "Restaurant and bar management services", for which specification the Applications could succeed.

2. Notably, the Hearing Officer made no reference to the Applicant's "Auxiliary Specification Request".

<u>The Appeal</u>

3. The Applicant filed an appeal under S.76 of the Act on 18 July 2024. No Respondent's Notice was filed. At the Hearing, MS. DENISE McFarland of Counsel (instructed by Protopapas LLP) appeared for the Appellant/Applicant. Mr. Ian Bartlett of Beck Greener LLP appeared for the Respondent/Opponent.

<u>Standard of Appeal</u>

4. The standard of appeal is well-known. It is limited to a review, not a re-hearing, and I should only interfere with the Hearing Officer's findings if the decision was wrong. 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.

5. The Statement of Grounds raises four grounds of appeal.

Preliminary Issue -Opponent's Fresh Evidence on Appeal

6. The first ground of appeal concerns the Opponent's identity and its entitlement to oppose. The Applicant pointed to the discrepancy in the naming of the Opponent and contended that the Hearing Officer, seeing this, should have dismissed – or at least clarified – the opposition.

7. The way in which this matter was introduced gave rise to a preliminary issue. To buttress its case that Koakult GmbH and Koaskult GmbH were potentially two different entities, the Opponent annexed to its TM55 and Statement of Grounds copies of corresponding entries in the International and UK Registers. These were not certified copies, nor were they introduced under cover of a witness statement. Nevertheless, the Opponent took no point on this and it is not uncommon for such annexes to be included in pleadings before UKIPO (although unlike the other procedural forms for an opposition, the TM55 does not include a statement of truth nor was one included in the additional Statement of Grounds). I do not understand there to be any dispute that I can consider such annexes for what they are worth.

8. In response, for the Opponent Mr Bartlett made a witness statement dated 30 September 2024. In this, for the first time since the proceedings were commenced in January 2023, he finally identified the Opponent as Koakult GmbH. He also gave evidence that the name Koaskult was an erroneous recordal at WIPO, that this error was corrected by WIPO on 15 June 2020 but that it "took time" for the recordal to be processed by UKIPO. Mr Bartlett exhibited more recent copies of trade mark and German company register entries to confirm his account. This account was substantially repeated in his Skeleton Argument.

9. The veracity of Mr Bartlett's evidence was not formally challenged. However, on 28 October 2024 the Applicant's attorneys wrote to me contending that Mr Bartlett's evidence was fresh evidence on appeal, the admission of which should be refused on the basis of the standard authorities for such matters[1].

10. I invited both parties to address me on this issue and robust submissions followed, both in the parties' respective Skeleton Arguments and at the Hearing.

11. For the Applicant, Ms McFarland quite fairly argued that the Opponent's mis-spelling had persisted throughout, notwithstanding that the Applicant's evidence, pleadings and submissions clearly identified Koakult as the name of the opponent. She pointed out that the Opponent had made no effort to explain why this matter had not been dealt with earlier. It was, therefore, evidence which could and should have been submitted earlier and, as such, absent good reason it was too late to admit it now.

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[1] *Ladd v Marshall* [1954] EWCA Civ 1 (29 November 1954)
Consolidated Developments Ltd v Cooper [2018] EWHC 1727

12. Ms McFarland did concede that it was open to me to look at the WIPO and UKIPO register data and verify the register evidence myself, however.

13. Mr Bartlett submitted that his evidence was that of a Respondent simply bringing the state of the public record to the attention of the tribunal, and that furthermore the Applicant's own evidence showed it knew throughout that the Opponent was indeed Koakult GmbH notwithstanding the typo's persistence in the UKIPO record. Furthermore, given the persistence of that error in the UKIPO record, the various filings under and references to that name fairly reflected the register at all material times.

14. I asked Mr Bartlett when the error was known to the Opponent and why no steps had been taken to draw the error to the Registrar/Hearing Officer's attention. He responded that it was known there was a mismatch between the international register but since the UK register was still showing Koaskult as being the owner of the registration, there was concern the Opponent *"would have been criticised if we had filed it in the name of anything else."*

15. As to why the matter was never drawn to the attention of the Registry/Hearing Officer prior to Mr Bartlett's witness statement of 30 September 2024, Mr Bartlett's response was that it was not thought the identity of the Opponent was in issue but conceded that in hindsight, maybe the point should have been addressed.

16. As to how to deal with this preliminary issue, in my view this is not a case falling within *Ladd v Marshall* or *Consolidated Developments* as "fresh evidence on appeal" advanced by the Respondent/Opponent. If anything the fresh – albeit informal – evidence was the Register entries submitted by the Applicant with its Grounds of Appeal. Mr Bartlett's evidence was simply responsive. It would be absurd to suggest that, if I were to take account of the Applicant's new material, the Opponent could not have the opportunity to reply.

17. Furthermore, the Opponent's attorneys were always under a positive duty to appraise the Tribunal of the facts, and any errors in them, so as to avoid any risk the Tribunal would be misled. Once it was clear to them that the spelling discrepancy had assumed material significance, they put it right, albeit late in the day. Not to allow that clarification "in" – whether by witness statement or some other means – would also be absurd.

18. In any event, as Ms McFarland agreed, in so far as I need to do so I can take account of the state of the WIPO and UKIPO registers. I have looked at these public records myself and can see that there has been a "correction" to harmonise the Opponent's name on both registers. There is nothing to suggest a change of entity, which change would be evident on both registers if it had taken place. Mr Bartlett's evidence that the disputed register entry was just a spelling error was not challenged.

19. Thus, whichever route is taken, the information has found its way to me and to exclude Mr Bartlett's Witness Statement would pointless. I therefore take the Applicant's informal evidence *de bene esse* and since Mr Bartlett's evidence is responsive thereto and serves to assist the Tribunal, I admit it. Following on from that it is clear, and I find, that Koaskult GmbH and Koakult GmbH are and always were the same entity distinguished only by a typographical error.

Ground 1 – The Opponent's locus standi

20. This Ground of Appeal has two limbs.

21. First, the Applicant claimed that the Hearing Officer failed

> "*to ensure correct identity and "match" of the Opponent Party and Party entitled to rely on the "earlier trade mark" pleaded*".

Whilst this issue was developed in several different ways in the Applicant's Skeleton and at the Hearing, at its strongest it comes down to the proposition that the Hearing Officer should have dismissed the Oppositions on the basis that the named Opponent Koaskult GmbH had no *locus standi*, another party Koakult GmbH being the true proprietor of the IR and this being evident on the papers.

22. As noted above, on this Appeal there was evidence before me demonstrating that Koaskult and Koakult are one and the same party, distinguished only by a spelling error. However, that was not known to the Hearing Officer.

23. Ms McFarland accepted there was no expressly pleaded case in the Applicant's Counterstatement raising the issue of the Opponent's *locus standi.*

24. Instead, the Applicant protests that it did, in effect, put this matter before the Hearing Officer. All of its filed documents refer to the identity of the Opponent as "Koakult". Indeed, at [3] of both counterstatements, the Applicant stated:

> *"Koakult GmbH ("the Opponent") is the owner of UK Trade Mark Registration No WO1531402 for the mark koa ("the Opponent's Mark") which is registered for food and non-alcoholic beverage products in classes 29, 30 and 32 ("the Opponent's Goods")."*

25. That, however, merely serves as confirmation that the Applicant knew the Opponent was indeed Koakult, and by implication that it understood the spelling "Koaskult" was erroneous. I do not consider it puts the Opponent's identity and entitlement in dispute.

26. Absent from the pleadings, is any allegation that Koaskult GmbH was a separate entity disentitled to own the earlier trade mark and that the opposition should be dismissed. Neither was an invalidity attack launched on that basis.

27. Evidence for the Applicant was given by a Mr Bagedo. In [9] of in his Witness Statement Mr Bagedo stated:

> *"… (the Opponent is Koakult GmbH and not Koaskult GmbH)."*

28. This appears to be no more and no less than Mr Bagedo's recognition that he was aware the Opponent's actual name was KOAKULT, and that KOASKULT was a mere spelling error. He does not appear to be in any doubt as to the Opponent's actual identity nor to believe that it is not the proper owner of the IR.

29. Finally, there was no mention of any challenge to the Opponent's *locus standi* in the Applicant's written submissions to the Hearing Officer. On the contrary, it was positively stated:

> *"2. Koakult GmbH ("the Opponent") is the owner of UK Trade Mark Registration No WO1531402 for the mark koa ("the Opponent's Mark")"*

Note there is nothing to follow saying, in effect, "Koaskult GmbH is not the owner of UK Trade Mark Registration No WO1531402".

30. If the Applicant had intended to challenge the identity/*locus standi* of the Opponent, it would have - indeed, would have had to - put it "front and centre". However, it did not do so, and the obvious inference to draw is that this is because it knew at all material times that the spelling KOASKULT was no more than a typographical error and did not consider it to be in issue. There is nothing to suggest that the Applicant was surprised by the discrepancy in the register entries and, given its familiarity with the spelling as shown on the WIPO register, it is difficult to resist the conclusion that it was aware of it as a mere "typo" throughout.

31. It is not the task of a Hearing Officer to second guess a party. They were entitled to take the pleadings and the register at face value. I agree that it might have been expected that a different Hearing Officer might have sought clarification for the discrepancy, and had the matter been dealt with by "live"

advocacy rather than "on the papers" I think it highly likely the matter would have been cleared up then and there. But there is a world of difference between passively referencing a discrepancy in spelling and putting a party's identity and *locus standi* in issue. The Hearing Officer was entitled, absent more, to rely on the UKIPO register entry without enquiring further[2] and was not tasked with deciding whether the Opponent had good standing to oppose.

32. Thus, in so far as the Appeal is that the Hearing Officer should have dismissed the opposition for the Opponent's lack of *locus standi*, I dismiss it. This was not an issue in dispute and the Applicant cannot complain that the Hearing Officer should somehow have inferred that it was. That is what pleadings are for.

33. Since a challenge to the Opponent's *locus standi* was not pleaded before the Hearing Officer, the subsequent evidence of Mr Bartlett (and the content of the parties' submissions) does not move the dial to any degree except to confirm the entitlement of the Opponent to oppose, notwithstanding the incorrect spelling of its name.

34. Secondly, the Applicant contends that the Hearing Officer was wrong to disregard the evidence of Mr Bagedo concerning the activities of the Opponent under its correct name "Koakult". Mr Bagedo said:

> *"9. The Opponent appears to be interested in caffeine cocoa, and not restaurant services. Exhibit AKB5 comprises a screenshot from a Google search with the term "koakult" (the Opponent is Koakult GmbH and not Koaskult GmbH). As can be seen for the entry on the right column called "Koakult GmbH", the website directs to www.koawach.de.*
>
> *10. Exhibit AKB6 shows screenshots of the Opponent's website at www.koawach.de with a Google English translation. The Opponent appears to be interested in caffeine cocoa products such as muesli, cocoa bars, cocoa drinks and cookies at relatively low costs – see Exhibit AKB7 which shows extracts of the Opponent's caffeine cocoa products together with the associated low pricing.*
>
> *11. I strongly believe that the Opponent's goods are not similar to our fine dining restaurant services. There is clearly no likelihood of association and no likelihood of confusion between the Opponent's low priced caffeine cocoa products (fast moving consumer goods) and our fine dining restaurant."*

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[2] See S. 72 Trade Marks Act 1994 "In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration…"

35. The Hearing Officer dealt with this evidence at [13]:

> *"13. I also note that Mr Bagedo has provided evidence in relation to the opponent, stating that the opponent is "Koakult GmbH" and not "Koaskult GmbH". On this basis, he found the website www.koawach.de, which is exhibited at AKB5 to AKB7, showing that it sells coffee, muesli, bars, drinks and cookies. Firstly, if this evidence was filed in support of the marks co-existing in the market place, it does not assist the applicant because it must show co-existence in the UK market, and the evidence is in relation to a German website (as indicted by the .de). Secondly, the opponent's IR is owned by Koaskult GmbH, and the current proceedings have been brought under this name. Consequently, I cannot take this evidence into consideration as the website is not under the name of the registered opponent."*

36. Given that KOAKULT and KOASKULT are in fact one and the same company, the Hearing Officer was technically in error when they held that they could not take the evidence into account for the reasons they gave in the third sentence of [13]. However, given the Opponent's complete failure to clarify matters at any point, it is not surprising the Hearing Officer was misled into thinking that two different entities might be involved.

37. Thus, to this minor extent the appeal is well-founded.

38. However, the Hearing Officer went on to consider the position if the evidence *did*, in fact, relate to the Opponent, at [14]:

> "*14. Regardless, even if the applicant could establish that the website provided at exhibits AKB5 to AKB7 belongs to the opponent, with the intention to show that the goods actually sold by the opponent are more limited than its specification, then this also does not assist the applicant. The IR upon which the opponent relies qualifies as an earlier IR because it was applied for at an earlier date than the applicant's trade mark pursuant to section 6 of the Act. The opponent's earlier IR had not completed its registration process more than five years before the relevant date (the filing date of the applicant's marks). Accordingly, the use provisions at section 6A of the Act do not apply and therefore the opponent is entitled to rely upon its full specification without having to show use of its IR."*

39. There is no appeal from this finding and, even if there was, it would fail for the reasons given by the Hearing Officer. Furthermore, even if, per WS/Bagedo [11] the evidence was intended to show (for the purpose of comparing the parties' services, including for the "fall-back specification) that the

Opponent's goods (in contrast to the Applicant's Services) were of low value, it would be irrelevant for the same reason – the actual nature of the use of the Opponent's trade mark was not in issue, by virtue of the operation of section 6A of the Act as noted by the Hearing Officer. Any comparisons to be made could only be based on the Opponent's specification as registered.

40. Thus, whilst the Hearing Officer was, through no fault of their own, technically wrong to exclude Mr Bagedo's evidence on the basis it referred to a different party, they were correct to exclude it for the additional reason that it was irrelevant in any event.

41. The first ground of appeal therefore fails.

Ground 2 – Failure to consider the "Auxiliary Specification Request" and evidence in support

42. Secondly, the Applicant contends that the Hearing Officer failed to consider the Applicant's fall-back specification contained in its "Auxiliary Specification Request". The Opponent's response to this was that the Hearing Officer was right not to address the fall-back specification because it was impermissible in law, and in any event would not avoid conflict with the IR.

43. The fall-back proposal was set out by the Applicant as follows:

> *42) It is clear from the evidence that the Applicant is interested in fine dining and high-end services which are far removed form (sic) the Opponent's low priced Goods. There is no likelihood of confusion. However, in the event that the Hearing Officer finds the Contested Services to be confusingly similar, the Applicant requests that the Hearing Officer considers the following amendments to the Contested Services ("Amended Contested Services"):*
>
> *• Class 43 – **Fine dining** services for providing food and drink; **fine dining** restaurant services; **fine dining** café services; **fine dining** bar services; banqueting services; **fine dining** restaurant and bar management services; **fine dining** cocktail lounge services; **fine dining** food preparation services; catering services; provision of information, advice and consultancy in relation to all the aforementioned services.*

44. Leaving aside the question of whether the offer of a fall-back specification was conditional or not, and how, procedurally, it could or should have been dealt with (the Opponent had no prior notice of it, for example) given that the Hearing Officer failed to make any reference to it whatsoever, even simply to dismiss it, I conclude that it was entirely overlooked. In that respect the Hearing Officer was in error, so this ground of appeal succeeds.

45. However, that is not the end of it. There remains the question of how to deal with the fall-back specification. Should a decision on it be remitted, taking up still more time in the Registry, or is it a matter I should deal with myself?

46. Mr Bartlett, for the Opponent, reminded me of the observations of Mr Daniel Alexander KC sitting as the Appointed Person in BL O/410/11 *MULTISYS* as to how to approach fall-back specifications. After reviewing the arguments for and against dealing with a fall-back specification on appeal and accepting that the procedural position was imperfect [86] Mr Alexander said, "It is necessary to cut through to what really matters" and proceeded, pragmatically, to deal with the matter himself, inviting the parties to make further, brief written submissions.

47. For her part, Ms McFarland urged that it should be remitted.

48. In my view it is permissible and desirable for me to decide this matter myself. Like Mr Alexander in *MULTISYS*, it seems to me that it is best to cut through to the core of the matter. First, it is desirable to avoid, as far as reasonably possible, giving rise to multiple/collateral further proceedings, if justice is served.

49. Secondly, unlike *MULTISYS*, the Applicant raised the matter below and, in so doing, it could have fully argued its case. In fact it contented itself with asking only that the fall-back specification be considered, seeking to rely on the evidence of Mr Bagedo as an illustration of what is meant by the term and how this is differentiated from the Opponent's goods. Thus, the Applicant had had its bite at the cherry, even if it did not take a full mouthful.

50. Thirdly, as in *MULTISYS,* I do not think there is anything about the amended specification that requires yet further evidence. Insofar as I need it, sufficient information about the meaning of "fine dining" can be derived from Mr Bagedo's evidence to the Hearing Officer. Mr Bagedo's evidence as to what he calls the "low priced Goods" of the Opponent (Exhibits AKB 5-7) are no more relevant to this exercise than they were to Ground 1, since the comparison will still be to the Opponent's specification, not its use of the IR, so there is no need to reconsider the exclusion of that evidence. Thus, further submissions and argument are all that are required, taking the fall-back specification's language at face value.

51. I take into account the fact that, contrary to the situation in *MULTISYS,* the applicant did put forward the restricted specification at first instance, rather than for the first time on appeal and the outcome could itself have been the subject of an appeal by one side of the other – or not, as the case may be. However, on balance it seems to me the nature of the proposed amendments is not such as to give rise to any complexity as would particularly benefit from a remittal, and that it is better to bring finality to the issue.

52. Thus, I invited the parties to let me have their written sequential submissions on the acceptability of the fall-back specification in the event I found for the Applicant on this ground, which I have done. I pause here to note that:

a) In doing so, I was extending to the Applicant an additional opportunity to put forward submissions, notwithstanding it had failed to do so in depth at first instance; and

b) I stipulated that the parties should limit themselves to submissions only and that they should not file evidence.

53. This, in my view, was sufficient to enable me to give the matter just consideration without the need to remit.

54. Both parties responded to my invitation. Before I go on to consider the parties' substantive submissions, I note two points drawn to my attention by the Opponent.

55. First, the fall-back specification did not qualify the terms "banqueting services" or "catering services" by the addition of the term "fine dining". Thus these terms are outside the scope of the amendments requested and should continue to stand refused. I agree.

56. Secondly, notwithstanding my stipulation that no further evidence should be submitted, the Applicant added five "annexes" of dictionary and internet material to illustrate the nature of "fine dining". These annexes were not submitted under cover of a witness statement and I have ignored them. First, I have the existing evidence of Mr Bagedo, which the Applicant argued below, and on appeal, showed both that the Applicant's own services were "fine dining" and that it also provides sufficient context for understanding the term.

57. Secondly, the annexes add nothing. It so happens I agree with Ms McFarland's written submission that "*that the term "fine dining" is both clear and would be readily understood by persons understanding the English language*". I do not need additional evidence to inform me of the general meaning of "fine dining". It is a commonplace term the meaning of which – high quality dining services/experiences featuring high quality foods – I can take on judicial notice and which, as I understand it, accords in any event with the Applicant's view.

58. The question for determination is whether the specification as restricted by the qualification to "fine dining" - is acceptable *prima facie*.

59. The law on the drafting of specifications and restrictions is well established. First, specifications must be clear. Goods/services must

> “*be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”* (C-307/10 *IP TRANSLATOR* [49])

60. Furthermore, In the case of limitations, in Case C-363/99 *POSTKANTOOR* the Court of Justice of the European Union held at [141] that:

> *" ... it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic."*

61. The Opponent referred me in addition to BL O/043/05 *MERLIN* in which Mr Richard Arnold QC (as he then was) confirmed at [29] that the principle of *POSTKANTOOR* applies whether the characteristic in question is expressed positively or negatively.

62. Thus, the *prima facie* acceptability of the amendment turns on whether “fine dining” is:

    a) Sufficiently clear/precise; and
    b) a characteristic of the services in question.

63. Ms McFarland, for the Applicant, submitted that the term *“is both clear and would be readily understood by persons understanding the English language”* and in a broad sense I agree – as indicated above I understand which qualities the term seeks to imply about the services in question. But that is not enough. The issue is whether it is a term sufficiently clear that when used in a specification, other traders can tell whether their goods/services might fall foul of it.

64. In that regard “fine dining” lacks clarity and is imprecise. The underlying provision of restaurant services is not changed by adding ambience or luxury touches. It is a vague reference to quality and price expectations. It is impossible to know the boundary between “fine” and “ordinary” dining. In the real world there is a vast range of dining experiences and many describe themselves as “fine” notwithstanding that, in reality, many are anything but. Furthermore, how could a third party’s specification be phrased to fall outside the scope of the term? How would they know whether their style of dining/drinking experience was in breach of “fine dining” in a legal sense? Could something as simple as a refresh of a restaurants’s interior, waiter service and wine list suddenly bring it inadvertently within the scope of the amended specification?

65. Thus, fundamentally, notwithstanding the general impression conjured up by the term "fine dining", it is too vague and imprecise to pass the "certainty test" in the context of a trade mark specification. The extent of the protection sought cannot be identified by rival economic operators.

66. It is correct that whilst identifying goods and services by reference to their characteristics falls foul of *IP TRANSLATOR,* identifying them by reference to sub-categories does not. In this respect Ms McFarland further submitted, that "*where services are defined by their target market or "recipient" that is acceptable and that restrictions must be considered "contextually".*

67. For the Opponent, Mr Bartlett submitted the term does not identify a particular sector or recipient.

68. It is correct, as recognised in TPN 1/2024 para. 14 and in the *MERLIN* case referred to therein [3] that in the case of services, they may be defined by reference to the sector/recipients to which they are offered and that this is not, as such, a "characteristic" of the services.

69. However, in this I agree with Mr Bartlett and the Opponent. There is no "sectorisation" or division of recipient merely by reference to the term "fine dining", since all consumers may wish to partake of these services and enjoy their quality, notwithstanding that some may be more able to afford or appreciate "fine dining" than others. For her part, Ms McFarland did not identify a specific target market save, by implication, those that can afford the services. A target market of "anyone who can pay the price" is, in effect, anyone and everyone. The price point alone goes nowhere, and there is nothing else to tell me how the target market might be identified and differentiated.

70. It follows that I find the fall-back specification is unacceptable both for want of clarity and its dependence on restricting the Applicant's services by reference to a subjective characteristic of them.

71. Even if I had found it to be acceptable, then as Mr Bartlett submitted, the fall-back specification would still be in conflict with the Opponent's specification. There is no appeal against the Hearing Officer's findings as to similarity against the original, broad specification of the Application. The amended services are merely a narrower subset of the Applicant's original services. The Opponent's goods are unrestricted and could encompass goods used in or in a complementary relationship with any form or dining, low or high quality/expensive/fine. There would be no departure from the Hearing Officer's findings as to similarity.

72. Thus, although the Hearing Officer was wrong to omit to deal with the fall-back specification, I reject it as an acceptable alternative.

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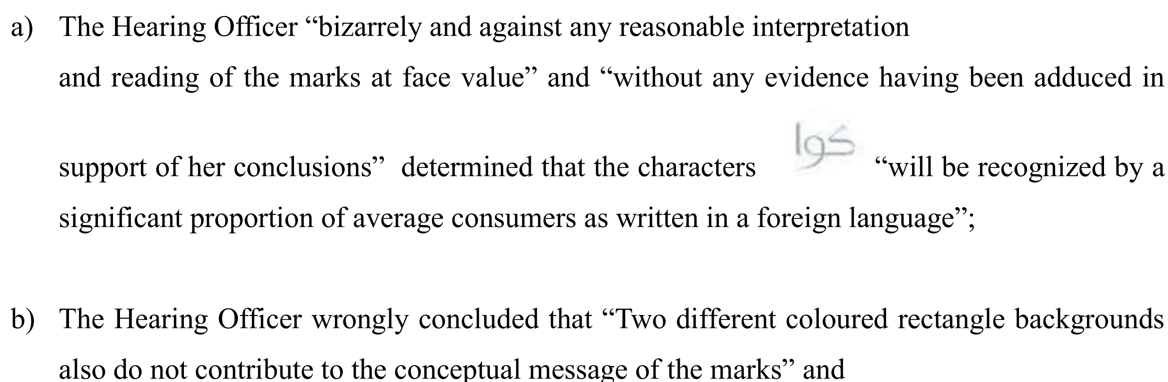
[3] BL O/043/05, at [29] per Mr Richard Arnold QC as he then was

Ground 3 – Opposition No. 438833 - Errors in the Comparison of Application No. 3825830 with the Earlier Trade Mark

73. There was no appeal from the Hearing Officer's conclusion that Opposition No. 438832 succeeded (save for certain services) against application No. 3825827.

74. As for application No. 3825830, the complaints are that:

a) The Hearing Officer "bizarrely and against any reasonable interpretation and reading of the marks at face value" and "without any evidence having been adduced in support of her conclusions" determined that the characters  "will be recognized by a significant proportion of average consumers as written in a foreign language";

b) The Hearing Officer wrongly concluded that "Two different coloured rectangle backgrounds also do not contribute to the conceptual message of the marks" and

75. In both cases it was said the Hearing Officer's conclusions represented "nothing more than a personal opinion, which the LHO fails to explain or seek to justify based on any evidence, or other facts or conceded issues".

76. Having set out the appropriate principles at [16] and [32-33] the Hearing Officer assessed the similarity of marks evaluatively, as follows:

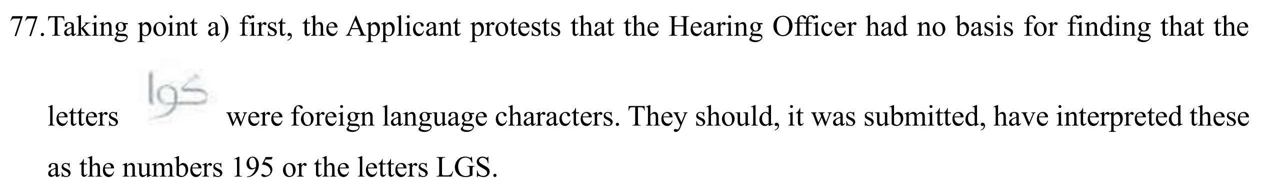
> *830 Marks*
>
> *37. The applicant's 830 Marks includes the addition of the smaller text, placed at the bottom of the mark, which I consider will be recognised by a significant proportion of average consumers as written in a foreign language. This, therefore, acts as a visual point of difference which will not go unnoticed by the average consumer. I do not, therefore, consider the opponent's IR and the applicant's 830 Marks to be identical.*
>
> *38. As section 5(2)(a) requires the marks to be identical, the opponent's claim under this ground falls at this hurdle in relation to the 830 Marks meaning the opposition under this ground is dismissed.*
>
> *39. However, the opponent also relies upon section 5(2)(b) of the Act, and therefore I will proceed with the comparison of the opponent's earlier IR and the applicant's 830 Marks:*
>
> *Similarity of the marks*
>
> *40. The opponent's IR consists of the invented word "Koa". There are no other elements to contribute to the overall impression that lies in the word itself.*
>
> *41. The applicant's 830 Marks consist of the stylised invented word "KOA", with the letters K and A being connected by a wavy line, which the letter O floats above.*

Underneath is a text, presented in a smaller typeface, which as noted above, I consider will be recognised by a significant proportion of average consumers as written in a foreign language, although the specific language is unlikely to be identified. Both the invented word and text is either presented in dark blue or white, on a rectangle coloured background, either in the colour dark blue, cream or light blue. I consider that as the invented word "KOA" consists of identifiable letters from the English language, and therefore can be aurally pronounced by the average consumer, it is the distinctive and dominant part of the mark. Therefore, it will likely play a greater role in the overall impression, with the stylisation of the word KOA, the foreign language text and background playing a lesser role.

42. Visually, the opponent's IR and 830 Marks consist of, or include, the word KOA, which is the largest, dominant and distinctive part of the applicant's marks. This acts as a visual point of similarity. However, the word KOA in the 830 Marks are presented in a stylised typeface, contain the foreign language text presented in a smaller typeface and the rectangular backgrounds, which act as visual points of difference. I therefore consider that the marks are visually similar to a high degree.

43. Aurally, I consider that the UK average consumer will not pronounce the foreign language text in the applicant's 830 Marks. I therefore consider that the opponent's IR and the applicant's 830 Marks will most likely be pronounced as either KO-UH, or KAYOH-AYE, making them aurally identical.

44. Conceptually, neither party made any submissions as to the meaning of the word KOA. However, I consider that the average consumer will recognise it as an invented word with no conceptual meaning. I also consider that the foreign language text will not be attributed any identifiable meaning by the average consumer and will not, therefore, contribute to the conceptual meaning conveyed by the applicant's marks. The different coloured rectangle backgrounds also do not contribute to the conceptual message of the marks. On this basis, the opponent's IR and applicant's 830 Marks are conceptually neutral.

77. Taking point a) first, the Applicant protests that the Hearing Officer had no basis for finding that the letters  were foreign language characters. They should, it was submitted, have interpreted these as the numbers 195 or the letters LGS.

78. There are two problems with this. First, in paragraph 40 of its submissions to the Hearing Officer in lieu of a hearing, the Applicant's attorneys submitted:

"The Opponent's Logo comprises Arabic writing which informs the customer that there is a connection with the Middle East, which is very distinct to UK consumers. UK consumers are not well versed in Arabic and will pay great attention to the Arabic writing (as this is unusual) seeing this as exotic and that the Contested Services have a connection with the Middle East. This is not the case with the Opponent and so there is no risk of indirect confusion."

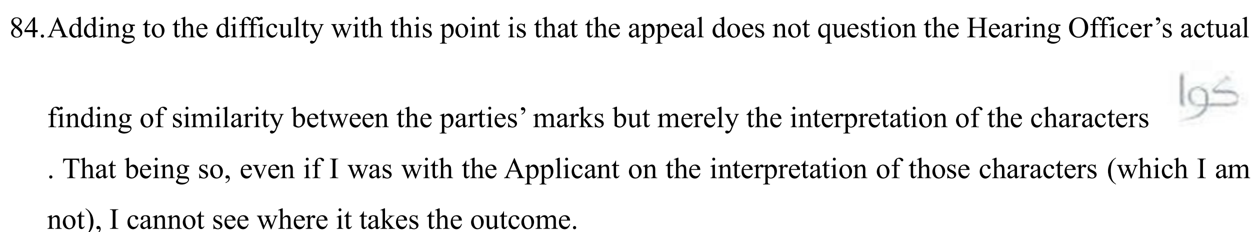
79. It seems to me that the reference to "the Opponent" in the first sentence is clearly a mistake and that the reference should be to the Applicant's mark. The Opponent's mark is not a logo, and it is presented in English script. The final sentence makes it clear that it is the Applicant's mark that is in Arabic and is being compared by the Applicant with the Opponent's mark.

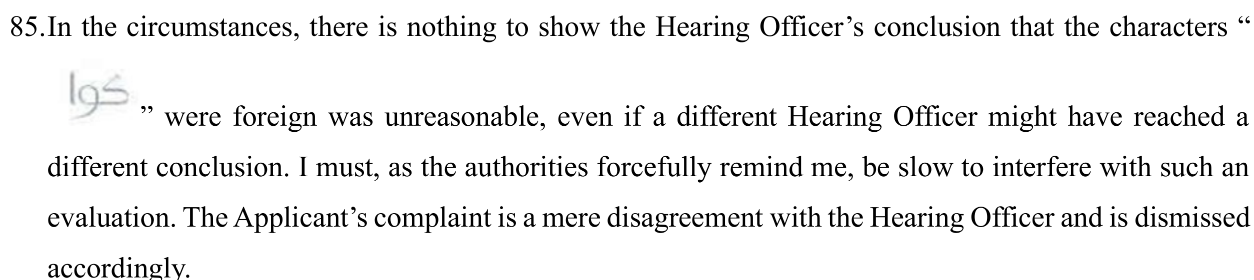
80. Thus the Applicant appears to confirm the use of a "foreign language" in its Logo. In addition it appears to be expressly relying on this as an argument against confusion.

81. Furthermore, the evidence of Mr Bagedo is that the Applicant is based in Saudi Arabia and that it has a restaurant there (WS/Bagedo, Introduction, [1] and Exhibit AKB1).

82. It is not clear whether these points influenced the Hearing Officer but I am bound to assume they read them and took them into account. In any event, no further assistance was given to the Hearing Officer so the Applicant was, in effect, leaving it to them to make their own determination based on the materials before them. Since they are not obviously in English-language script, a finding that the characters were in a foreign language is one of the interpretations the Hearing Officer was free to apply using their own experience and evaluative judgment. If the Applicant had wished to argue for an alternative interpretation, it should have done so in its submissions.

83. As to the complaint that the Hearing Officer's evaluative conclusion was "nothing more than a personal opinion" that entirely misses the point that, ultimately, all findings of fact are essentially judicial opinions - *Hollington v. Hewthorn* 2 KB 587. The evidence relied on for forming that "opinion" is "at least in part) the presentation of the Applicant's marks. If the opinion is arrived at by applying the proper principles, it is unimpeachable.

84. Adding to the difficulty with this point is that the appeal does not question the Hearing Officer's actual finding of similarity between the parties' marks but merely the interpretation of the characters . That being so, even if I was with the Applicant on the interpretation of those characters (which I am not), I cannot see where it takes the outcome.

85. In the circumstances, there is nothing to show the Hearing Officer's conclusion that the characters "  " were foreign was unreasonable, even if a different Hearing Officer might have reached a different conclusion. I must, as the authorities forcefully remind me, be slow to interfere with such an evaluation. The Applicant's complaint is a mere disagreement with the Hearing Officer and is dismissed accordingly.

86. As to point b), nothing was said in the Applicant's skeleton argument and it was not pressed with any great strength by Ms McFarland at the Hearing, in my view rightly so. The complaint is, in essence, that the Hearing Officer should not have discounted the coloured rectangular backgrounds in the series marks in the conceptual comparison. I asked Ms McFarland what concept was embodied in these elements and she submitted that only they were "memorable".

87. For my part, I cannot understand how the presence of these banal design elements can be said to contribute to the conceptual message of the Applicant's marks. They may be relevant to distinctiveness and to the visual comparison, but the Hearing Officer's (entirely fair) conclusion that these elements were outweighed by the word dominant and distinctive word KOA is not appealed. The Applicant made no submissions on this point to the Hearing Officer so, once again, it was open to the Hearing Officer to reach their own view. The Hearing Officer's finding that the coloured rectangular designs did not contribute to the conceptual message of the marks was entirely within the range of assessments open to them.

88. Ground 3 is therefore dismissed.

Ground 4 – Error in Finalising the Specification for which the Applicant's Marks were Accepted

89. Fourthly, the Applicant complains that having determined that the oppositions must fail for all services found to be dissimilar to the Opponent's goods - namely "*Restaurant and bar management services; provision of information, advice and consultancy services in relation to restaurant and bar management services"* - the Hearing Officer then recorded at [26] and [60] that the opposition failed only for the more limited specification "*Restaurant and bar management services".*

90. The Applicant is correct. The Hearing Officer appears simply to have made an error in recording the full specification for which the applications could proceed. This could have been dealt with more conveniently as an application to the Hearing Officer post-Decision to remedy an obvious procedural irregularity (and I would encourage parties faced with such errors to at least approach the Registry to explore such a remedy first), but it can equally be dealt with here. Furthermore the Opponent, quite rightly, conceded the point.

91. Thus, the Applications should be permitted to proceed, for at least:

> *"Restaurant and bar management services; provision of information, advice and consultancy services in relation to restaurant and bar management services "*
> in Class 43.

Overall Outcome

92. The Decision stands in all respects save that the applications can proceed to registration in respect of the following services, for which the oppositions have been unsuccessful

> *"Restaurant and bar management services; provision of information, advice and consultancy services in relation to restaurant and bar management services "*
> In Class 43.

Costs

93. Whilst the Opponent has achieved the greater success overall, a great deal of time, effort and resources was wasted by the parties and this Tribunal by reason of the Opponent's failure to draw the mis-spelling of KOASKULT to the timely attention of the Hearing Officer.

94. It is safe to say that the way that matter was addressed was unsatisfactory. Attorneys owe the same duties to the Tribunal as they do to a court to act in a way that upholds the proper administration of justice and that includes drawing material errors to the attention of the Tribunal at the earliest opportunity. An error can be material, or can assume material proportions, even if it is initially thought to be minor. As this case illustrates, even a relatively minor issue such as a mis-spelled name can lead to confusion and wasted time and expense if it calls proprietorship into question.

95. That is what has happened here. The Opponent's attorneys clearly knew about this issue from the outset. The correct identification of a party is material to the proceedings. Thus, to my mind, the Opponent's attorneys could, and should, have taken active steps to clarify the situation either when filing the Notice of Opposition or at the latest as soon as it arose in the Applicant's evidence, rather than passively assuming all was clear to the Hearing Officer. It is not an answer to say "this is what was on the register" if the attorney knows it to be incorrect, all the more so if in the case of an IR it knows there is a discrepancy with the WIPO register which remains unresolved at UKIPO. A simple letter to the Registry, or if necessary a witness statement, would have done the job. Despite the attorneys' concerns, no criticism could have been attached to them for lodging such a clarification and even if it was, fear of criticism is not a reason to keep silent.

96. Ultimately the Opponent's attorneys' passive approach, notwithstanding they may have thought the mis-spelling was minor or not in issue, initiated a "butterfly effect" which led the Hearing Officer to be misled which, in turn, unnecessarily increased the cost to the parties and took up the time and resources of this Tribunal.

97. I therefore decline to award any further costs of the appeal to the Opponent.

98. The Hearing Officer's award to the Opponent of £1000 stands and is payable within 21 days from the date of issue of this Decision.

Philip Harris
Appointed Person

27 May 2025