

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3174036 IN THE NAME
OF DOMAIN CHANDON LLP**

**AND IN THE MATTER OF OPPOSITION NO. 407761 BY INFORMACION,
CONTROL Y PLANIFICACION, S.A.**

DECISION

Introduction

1. This is an appeal against the decision of Ms June Ralph, acting on behalf of the Registrar of Trade Marks (O-495-18) in which she allowed an opposition under section 5(2)(b) of the Trade Marks Act 1994 in its entirety (“*the Decision*”).

Procedural background

2. On 11 July 2016 Domain Chandon LLP (“*the Applicant*”) filed a Trade Mark Application No. 3174036 in respect of various goods and services in classes 9, 35, 37, 38 and 42 (“*the Application*”).
3. On 27 October 2016 Informacion, Control Y Planificacion S.A. (“*the Opponent*”) filed a Notice of Opposition. There was a single ground of opposition based on a single trade mark registration under section 5(2)(b) of the Trade Marks Act 1994 (“*the 1994 Act*”). The earlier mark relied upon was EUTM No. 13703293 which had been filed on 3 February 2015 and entered onto the register on 25 July 2015 in respect of goods and services in classes 9, 35, 37, 39 and 42 (“*the EUTM*”).
4. The Applicant filed a Counterstatement. In section 6 of the Counterstatement the Applicant identified related proceedings in the European Intellectual Property Office (“*EUIPO*”) namely opposition proceedings number B002822537. At paragraph 1 of the Statement of Grounds the Applicant stated as follows ‘*It is admitted that the Opponent is the Registered Proprietor in respect of EU Trade Mark Registration No 13703293 but no admissions are made with regard to validity of the registration*’.
5. Only the Applicant filed evidence. Neither party requested a hearing and the Opponent filed written submissions in lieu of attendance at the hearing. The Hearing Officer therefore made her decision on the basis of the papers before her.
6. In her Decision dated 10 August 2018 the Hearing Officer upheld the Opposition No. 407761 pursuant to section 5(2)(b) of the 1994 Act and ordered that the Applicant pay to the Opponent £600 as a contribution towards the Opponent’s costs of the opposition.
7. On 6 September 2018 an appeal was filed on behalf of the Applicant pursuant to section 76 of the 1994 Act.

8. On the 13 September 2018 a letter was sent on behalf of the Applicant to the UKIPO requesting a stay of the proceedings pending the determination of invalidity proceedings (No. 000027345 C) that had been commenced by the Applicant against the EUTM. It was submitted on behalf of the Applicant that because the EUTM was the sole basis of the opposition under section 5(2)(b) of the 1994 Act the appeal should not be determined pending the outcome of the invalidity proceedings.
9. On the 3 October 2018 the parties were notified pursuant to the 1994 Act of the date which had been fixed for the hearing of the appeal by the Appointed Person.
10. On the 4 October 2018 a letter was sent on behalf of the Applicant, enclosing the letter of the 13 September 2018 to the UKIPO, renewing the request for a stay of the appeal proceedings to the Appointed Person.
11. By letter dated 12 October 2018 the Opponent indicated that it was opposing the stay of the proceedings. Whilst not disputing that the invalidity proceedings had been filed against the EUTM it maintained that the request for a stay was '*untimely and unnecessary*' in the circumstances of the appeal.
12. A hearing of the application for a stay took place, at the time and date previously fixed in accordance with the 1994 Act for the determination of the appeal. At that hearing, which took place by telephone, the Applicant was represented by Ms Georgina Messenger. The Opponent was not represented requesting that the points made in its letter of 12 October 2018 be taken into account in lieu of attendance.
13. In a Decision dated 8 November 2018 (O-715-18) a stay of the appeal proceedings was granted pending the outcome of the invalidity proceedings relating to the EUTM.
14. On the 19 February 2024 an email was sent on behalf of the Applicant attaching a copy of a decision of the Second Board of Appeal dated 5 September 2023 (R 2219/2022-2) which was an appeal against decision of the Cancellation Division with respect to an application to revoke the EUTM on the basis of non-use. That is to say it was not a decision with respect to the invalidity proceedings that were the basis of the application for a stay that had been granted with respect to the appeal.
15. On the 20 February 2024 an email was sent to the parties directing that (emphasis as in the original):

. . . the parties to provide [Miss Himsworth KC] on or before **4 pm on Tuesday 5 March 2024** with an update as to their respective positions with regard to the further conduct of the above appeal in order that Miss Himsworth can then consider what next steps should be taken in that regard.

If the parties are agreed as to what the next steps should be then a joint update can be provided.

16. By email dated 5 March 2024 sent on behalf of the Applicant it was indicated that:

In relation to the progress of the proceedings, so far the parties have not reached any agreement. Bearing in mind that a final decision was issued, as informed with our email of 16 February

2024, we believe that a final decision can now be issued on the appeal.

17. No response was received from the Opponent.
18. Subsequently, a hearing of the appeal was fixed to take place by video link on 19 April 2024.

The basis for the appeal

19. A Form TM55P was filed on behalf of the Applicant dated 6 September 2018. It was accompanied by a page document headed Statement of Grounds of Appeal and Case in Support also dated 6 September 2018 (“*the Grounds of Appeal*”).
20. The errors identified by the Applicant were set out in paragraph 5 of the Grounds of Appeal as follows:

5. In reaching her decision the Hearing Officer made the following errors:

5.1 She made an error of principle and a clear error of assessment when considering the Opponent’s objection under s.5(2)(b) as applied to acronym type marks in relation to the highly sophisticated goods and services as covered by the Application

5.2 She made an error in addressing the Applicant’s earlier unregistered rights arguments and alternatively honest concurrent use in support of its Application

5.3 She fails to address and assess the significant evidence of use and reputation of the Applicant’s mark even when in paragraph 5 of the Decision she states that she made a decision on the papers before her

21. In paragraph 6 of the Grounds of Appeal it was stated as follows (emphasis added):

For reasons of procedural economy – **because the assessment and comparison of the services in question is not the substance of the appeal – the Applicant does not appeal against the Hearing Officer’s comparison of the services in question**, except in relation to the Hearing Officer’s assessment of the average consumer of the type of goods and services covered.

22. No Respondent’s Notice was filed on behalf of the Opponent.
23. A skeleton of argument and a bundle of documents was filed on behalf of the Applicant. At the hearing of the appeal the Applicant was represented by Mr Mathew Hiscox of Trade Mark Eagle Limited (assisted by Ms Rosario Knight).
24. The Opponent did not appear and was not represented but filed submissions in lieu of attendance.

The Standard of Review

25. Recently the Court of Appeal has addressed the question of the standard of review on appeals in Lidl Great Britain Ltd v. Tesco Stores Ltd [2024] EWVA Civ 262 at [110] where Arnold LJ stated the position to be as follows:

The test on appeal

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 LJ) , 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 Kitchen) .

26. See further the in the Supreme Court in Lifestyle Equities CV. Amazon UK Services Ltd [2024] UKSC 8 referred to by the Court of Appeal which likewise reaffirmed the approach to appeals of the kind at [46] to [50]. See also the summary set out in Stich Editing Ltd v. TikTok Information Technologies Ltd [2023] EWHC 1167 (Ch).
27. I have kept these principles in mind when considering the present appeal.

Decision

Preliminary matters

28. As noted above a stay was granted with respect to the appeal to await the outcome of the invalidity attack on the EUTM that was before the EUIPO.
29. In that Decision the reasons given for granting the stay were as follows:

26. It is against this background that I have to consider whether a stay of the present proceedings should be granted. On balance, I have decided that in the context of the present opposition proceedings that it is appropriate, having regard to the overriding objective, to grant a stay of Opposition No. 407761 pending the outcome of the invalidity proceedings relating to EUTM No. 13703293. My reasons are as follows:

(1) Whilst I acknowledge that there has been considerable delay in bringing the invalidity proceedings with respect to EUTM No. 13703293 as a result of the Applicant's own commercial decision making, I accept the explanation for the

delay provided to me at the hearing, as set out above, on behalf of the Applicant. However, it also seems to me that this explanation, whilst it cannot be totally ignored given that involves both parties to the current proceedings, carries with it little weight in the context of the present application for a stay. Moreover, for the avoidance of any doubt I would have reached the same conclusion on the present application in the absence of any such explanation for the further reasons set out below;

(2) It is correctly accepted by the Opponent that there are currently properly constituted invalidity proceedings before the EUIPO with respect to EUTM No. 13703293;

(3) The application for invalidity has been made prior to the decision in Opposition No. 13703293 becoming final;

(4) The application for a stay of the opposition proceedings was made promptly after the application for invalidity had been made and in the first instance prior to the notification of the hearing of the appeal in Opposition No. 407761;

(5) The application for invalidity is in respect of the entire specification of the EUTM No. 13703293;

(6) In the event that EUTM No. 13703292 is found to be invalid then the single ground of opposition under section 5(2)(b) in the present proceedings falls entirely away on the basis that such a determination by the EUIPO results in the EUTM relied upon for the purposes of Opposition No. 13703293 having no effect as from the date of filing;

(7) Opposition No. 13703293 is one of two related proceedings between the parties. As noted in the chronology set out above the Applicant filed applications for two trade marks one in the UKIPO and one in the EUIPO on the same date. The mark the subject of the two applications was the same. Both applications were opposed by the Opponent on, in all material respects, the basis of the same grounds. That is to say in both cases the earlier EUTM No. 13703293 was relied upon. Having filed the application for a declaration of invalidity of that EUTM the Applicant requested a stay of both proceedings pending the determination of that application. Subsequently, the EUIPO granted a stay of the opposition proceedings filed before it pending the determination of the invalidity proceedings;

(8) If the application is not stayed, the Applicant if successful in its invalidity proceedings, will be prejudiced in that it will have been deprived of its property in the form of its UK Trade Mark Application No. 3174036 which has a filing date of 11 July 2016. Moreover, it would be deprived of such property in

circumstances where the earlier EUTM No. 13703293 is already under threat;

(9) With regard to the Opponent whilst it is true that if a stay is granted there is a delay with regard to the final determination of the appeal, the Opponent has not suggested that it will suffer any other prejudice as a result of the stay. That the Opponent will not suffer any prejudice or any real prejudice is all the more the case given that the EUIPO has already granted a stay of the related opposition proceedings; and

(10) In the event that the present appeal was to proceed, but with the effect of the appeal if unsuccessful being suspended pending the outcome of the invalidity proceedings as per JUCY DIAMONDS (above) and the invalidity proceedings were subsequently successful, then the parties would have unnecessarily incurred the costs of the hearing of the substantive appeal in Opposition No. 407761. Alternatively; in the event that the invalidity proceedings were not successful or only partially successful then Opposition No. 407761 could proceed on a proper basis with no unnecessary costs being incurred albeit at a later date than might otherwise be the case.

30. In the skeleton of argument filed on behalf of the Applicant set out a chronology and made submissions on the basis of:

- (1) The outcome of the invalidity proceedings with respect to the EUTM in the EUIPO. The decision of the EUIPO on the invalidity of the EUTM was delivered on 13 March 2020 and the appeal decision by the EUIPO Board of Appeal on 2 March 2021; and
- (2) The outcome of the application for revocation which was made with respect to EUTM in the EUIPO (Revocation No. 000046770C). The application for revocation was made on 14 October 2020. Following a decision by the Cancellation Division an appeal was brought to the Board of Appeal in the EUIPO which issued a decision on 5 September 2023 (R-2219/2022-2) in which the decision at first instance to partially revoke the EUTM as from 14 October 2020 was upheld.

That is to say the submissions put forward before me on appeal on the basis of a 'cut down' specification of the EUTM relied on. It was maintained that the specification of the EUTM had been cut down by (1) the decision at first instance in the EUIPO on the application for invalidity; and (2) further cut down on the basis of the subsequent application for revocation of the EUTM on the basis of non-use.

31. At no stage have I been provided with an explanation as to why no update was provided to the Appointed Person secretariat as to the progress of the invalidity proceedings in the EUIPO. Proceedings that were complete by 2 March 2021 and which formed the basis of the stay of the present appeal proceedings. That was and is unacceptable.

32. I turn to consider what the outcome of the invalidity proceedings before the EUIPO. Initially, prior to the submissions filed on behalf of the Opponent, I was only provided with the decision by the Cancellation Division dated 13 March 2020 in which the application for invalidity was partially upheld (Cancellation No 27 345 C). However, as the Applicant pointed out, in a decision dated 2 March 2021 the Fourth Board of Appeal upheld the appeal against that decision (Case R-1000/2020-4). It did so on the basis that the invalidity application against the contested mark relied exclusively on grounds under Article 8(4) of the EUTMR in conjunction with Article 60(1)(c) on the basis of ‘*the common law tort of passing off as it arises in the UK, based on an unregistered mark*’ and that as of 1 January 2021 there could be no conflict with the EUTM as a result of the UK leaving the EU.
33. Since 1 January 2021 EU trade marks (EUTMs) are no longer protected trade marks in the UK. However, the UKIPO created a comparable UK trademark for every registered EUTM. Where an EU trade mark was the subject of ongoing cancellation proceedings, as the EUTM was in the present case, and was subsequently cancelled the outcome shall be applied to the comparable right. In this connection it is to be further noted that derogation from a decision of the EUIPO so far as the comparable right is concerned is possible if the grounds for cancelling the mark would not be applicable in the UK.
34. In the present case the comparable trade mark is UK00913703293 which as of 28 May 2024 is registered with respect to various services in Classes 37, 39 and 42. A copy of a certified copy of the registration provided by the Registrar was supplied to me. However, this comparable mark was only entered onto the register on 10 May 2024 after a request made by email dated 3 June 2024. That is to say it would appear to have been entered onto the register *after* the conclusion of both the aforementioned invalidity and revocation proceedings. That is to say it would appear to show the details of the comparable mark as of that date and does not show as it would have done if the comparable trade mark had been created at the correct date. For the avoidance of doubt, it would seem that there was no application for derogation in the context of the present case from the outcome of either the invalidity or the revocation proceedings.
35. In any event as the opposition proceedings were existing proceedings such proceedings (and this appeal) must proceed on the basis of the law as it stood before 1 January 2021. See Lipton v. BA Cityflyer Ltd [2024] UKSC 24.
36. It was rightly accepted by Mr Hiscox in the course of the hearing that the relevant date for the purposes of making the assessment of the grounds of opposition was the filing date of the trade mark application. In this case the filing date of the Application was **11 July 2016**.
37. Further, as noted above one of the reasons for the grant of a stay was (emphasis added) ‘*In the event that EUTM No. 13703292 is found to be invalid then the single ground of opposition under section 5(2)(b) in the present proceedings falls entirely away **on the basis that such a determination by the EUIPO results in the EUTM relied upon for the purposes of Opposition No. 13703293 having no effect as from the date of filing***’. There is no suggestion that that is not the correct position.

Therefore, the outcome of the invalidity proceedings before the EUIPO *could* be of relevance to the present appeal.

38. In the event the invalidity proceedings were unsuccessful, albeit on the basis that the UK earlier right could no longer be relied upon in the context of those proceedings, and in those circumstances on this appeal, absent an application for derogation, the scope of the specification of the mark relied upon for the purposes of the opposition would seem to me to be the same as that which was before the Hearing Officer.
39. However, the same is not correct of an application for revocation on the ground of non-use of the mark. In this case at paragraph 14 of the Applicant's skeleton argument it was stated that (emphasis added) '*The application for revocation was partially upheld. The [EUTM] was **revoked from 14 October 2020** for some of the contested goods and services*'.
40. That is to say the application to revoke the EUTM could not at any stage have had any relevance to anything that is before me on this appeal. I have therefore disregarded all submissions put forward on the basis of the outcome of the revocation proceedings in relation to the EUTM.
41. Lastly, this appeal is only concerned with the Decision. That is to say the only matters that are of relevance, subject to the outcome of the invalidity, are the issues and the evidence that were before the Hearing Officer. The appellate tribunal is not concerned with either the issues or the evidence that may or may not have been before the EUIPO in the context of the application for invalidity that formed the basis of the stay of the appeal proceedings. In so far as there was an attempt by the Applicant to rely on such materials, I reject it on the basis that they are irrelevant.

Substantive appeal

42. As noted above there are three grounds of appeal set out in the Grounds of Appeal. Other than being identified none of those grounds were referred to in the written submissions that were filed for the purposes of the present appeal. Instead, the only points made was that there was no similarity between the '*remaining services*' i.e. those remaining once the findings on invalidity (at first instance) and the revocation proceedings before the EUIPO had been taken into account.
43. However, there are two problems with that submission. First this appeal is not confined to the '*remaining services*' but even if it was, second, as noted above there was no challenge on this appeal to the findings made by the Hearing Officer with respect to the similarity of services.
44. Therefore, to the extent that the Applicant seeks to simply rely upon the dissimilarity of the services as an answer to the findings by the Hearing Officer on this appeal I reject such submissions. That is the case whether it is appropriate to consider the conflict by reference to the '*remaining services*' or the services that were considered by the Hearing Officer below.
45. I now turn to the grounds of appeal in the present case upon which submissions were made at the hearing of the appeal.

46. The first ground goes to whether the Hearing Officer failed, in the assessment under section 5(2)(b) of the 1994 Act, ‘*as applied to acronym type marks*’.
47. The Hearing Officer made the comparison of the marks in issue at paragraphs [30] to [36] of the Decision before going on to consider the distinctive character of the earlier mark at paragraphs [38] and [39] of the Decision. I note that in those paragraphs the Hearing Officer does not make any reference to ‘*acronym type marks*’.
48. I also note that in the witness statement of Mr Archer filed on behalf of the Applicant that he states that the Applicant is the IP holding company for ICP Networks Limited. Mr Archer goes on to state that ICP Networks Limited was originally called International Computer Purchasing Limited. However, there would appear to be no other evidence in support of the proposition that the mark applied for is one that should be categorised as an ‘*acronym type mark*’; or any evidence that IPC would be regarded as an acronym of the Opponent’s corporate name Informacion, Control Y Planificacion, SA. Moreover, there is no evidence to support the suggestion that the relevant average consumer of the relevant goods or services would have perceived the letters ICP in either mark as an acronym or abbreviation.
49. Against that background it was not clear to me why it was said that approach that the Hearing Officer took, i.e. in her assessment of the marks in issue and in particular the contribution of the letters ICP, was wrong.
50. I can see from the Decision that the Hearing Officer directed herself correctly as to the applicable legal principles at paragraphs [8], [9], [29], [30] and [37] of her Decision and then applied them to the marks that she was assessing for the purposes of conflict.
51. I should emphasise that the evaluation that the Hearing Officer was required to make in considering a ground of objection under section 5(2)(b) of the 1994 Act is predominately of a factual nature. Therefore, as noted in the case law set out above and conveniently summarised by Geoffrey Hobbs KC in paragraph [10] of his Decision in LADY LOUISA WATERFORD TM (O-0646-24):

Her Decision is not liable to be set aside by this Tribunal on appeal unless it can be regarded as rationally insupportable, whether by reason of an identifiable flaw in the treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account a material factor, which undermines the cogency of the conclusion, or for being contrary to principle or plainly wrong: *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8 at paras [46] to [50] per Lord Briggs and Lord Kitchin SCJJ (with whom Lord Hodge, Lord Hamblen and Lord Burrows SCJJ agreed); *Volpi v Volpi* [2022] EWCA Civ. 464 at paras [2], [3] per Lewison LJ (with whom Males and Snowden L.JJ agreed).

52. In order to resolve the objection to registration, the Hearing Officer had to make a realistic appraisal of the net effect to the similarities and differences between the

marks in issue from the perspective of the average consumer. It was also necessary for her to consider the distinctive character of the earlier mark.

53. That is what the Hearing Officer did. In order to maintain the required distance between the role of the decision taker at first instance and the decision taker on appeal it is necessary for this Tribunal to proceed on the basis that the Decision below should stand unless the matters on which the Applicant relies are by force of what they reveal are sufficient to establish that the Decision is vitiated by error. See paragraph [19] of LADY LOUISA WATERFORD TM (above).
54. I have reviewed the Hearing Officer's Decision in the light of the Applicant's criticisms. Having done so, I am satisfied that that these do not reveal any substantive mistakes on the part of the Hearing Officer such as to establish that the Hearing Officer's findings with respect to her assessment of the similarity of marks, the distinctive character of the earlier mark or her conclusion as to the likelihood of confusion are liable to be set aside. For that reason, the first ground of appeal is dismissed.
55. The second that third grounds of appeal can be taken together. As correctly noted by the Applicant at paragraph [7] of the Decision the Hearing Officer said this (emphasis as in the original):

The applicant filed considerable evidence demonstrating use of the mark prior to making its application in 2016. As was pointed out in the Tribunal letter dated 3 January 2018, it is unclear why the applicant considered this evidence relevant. It is of no relevance to the notional and objective assessment that I have to make of the likelihood of confusion between the respective marks in in the light of their corresponding goods and services as filed and I have therefore, not taken it into account.

56. In the Statement of Grounds in Support of Trade Mark Application No. 3174036 provided with the TM8 filed by the Applicant there was a heading '*The Applicant's earlier unregistered use*' in which pleas relating to the earlier use by the Applicant were set out. The final paragraph of this section stated as follows:
25. In view of the long previous history of the mark ICP Networks for some considerable time before the UK Application in issue was filed which also predated the right relied on, use of the ICP Networks mark and registration of its trademark would clearly be with due cause.
57. Subsequently, the Applicant filed evidence in the form of the witness statement of Matthew Archer referred to above together with 31 Exhibits. This evidence was the subject of the letter from the Tribunal dated 3 January 2018 referred to by the Hearing Officer in paragraph [7] of the Decision.
58. In that letter it was stated *inter alia* as follows:

In the light of the volume of the evidence, it has been reviewed to ascertain its relevance to the ground of opposition. In this

connection, it is noted that the opposition is based upon a single earlier mark under section 5(2)(b) of the Act which is not subject to proof of use. The applicant's evidence goes to showing that its mark was "already well known and recognised within Europe" at the relevant date. It is not clear what the relevance of this evidence is to the section 5(2)(b) ground which involves a notional and objective assessment of the likelihood of confusion.

59. No reference to 'honest concurrent use' was made in the Statement of Grounds nor was any evidence of use other than '*The Applicant's earlier unregistered use*' filed in these proceedings i.e. there was no evidence of concurrent use of the marks in issue. Therefore, there was no plea or evidential basis put forward before the Hearing Officer to support a claim to honest concurrent use.
60. Following the issue of the Decision, on 14 August 2018, the Applicant emailed the Registrar and queried why the evidence of earlier use by the Applicant had not been considered on the basis that '*it must be clear that the applicant filed this [evidence] to demonstrate its earlier use and reputation, which would allow its acceptance under Section 7 of the Act*'. The email concluded by stating '*Would you please review and let us know whether our client's evidence was considered in accordance with Section 7 of the Act*'.
61. By letter dated 17 August 2018 a letter was sent on behalf of the Registrar in which it was stated as follows:
- The hearing officer did not consider the applicant's evidence in accordance with Section 7 of the Act. Section 7 as it refers to Honest Concurrent Use is only applicable when an application is made i.e. at the examination stage. Once an earlier rights owner opposes a trade mark application, the issue of relative rights has to be assessed by reference to the relevant part of Section 5, in this case section 5(2)(b). This view was confirmed by Anna Carboni, sitting as the Appointed person in *Ion Associates Limited v. Philp Stainton & Jeffrey Stainton*, BL O/211/09, in particular paragraph 52 refers (sic).
62. It is to be noted that no reference to section 7 of the 1994 Act was made in the Statement of Grounds of Appeal nor in the course of the submissions made on behalf of the Applicant before me. In addition, not of the above correspondence was brought to my attention at any stage. At the very least this approach was unhelpful.
63. Against this background it is my view that the second and third grounds of appeal do not assist the Applicant. First, it seems to me that to the extent that these grounds were maintained on the basis of section 7 of the 1994 Act they were misconceived for the reasons given by Ms Carboni in the decision referred to by the Registrar. Second, to the extent that it was maintained that *concurrent* use might be relevant to any part of the assessment required under section 5(2)(b) of the 1994 Act no plea was before the Hearing Officer; and such evidence as had been filed did not support a claim of concurrent use there being no evidence of use by the Opponent. In the premises, the Hearing Officer cannot be criticised for not considering the evidence of the

Applicant's earlier use of the mark in issue. For those reasons, the second and third grounds of appeal are dismissed.

Conclusion

64. In the premises, it does not seem to me that the Applicant has identified any error of principle or material error in the Hearing Officer's Decision. Moreover, it is not in my view appropriate to interfere with the evaluations that the Hearing Officer made in reaching the decision that she did. In the result the appeal fails and is dismissed.
65. Since the appeal has been dismissed the Opponent is entitled to a contribution towards its costs. In the exercise of my discretion, I will therefore make, having regard to the fact that the Opponent filed written submissions on this appeal, an order that the Applicant pay to the Opponent a contribution of £200 towards its costs of the appeal.
66. The Hearing Officer ordered a contribution of £600 to be paid by the Applicant to the Opponent with respect to its costs at first instance.
67. I therefore order that Domain Chandon LLP pay to Informacion, Control Y Planificacion S.A. the total sum of £800 on or before 4 pm on 15 August 2024.

Emma Himsworth KC

Appointed Person

25 July 2024