

BL O/0974/24

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,783,894 IN THE NAME OF OLUWATOSIN OLUWOLE AJIBADE

AND IN THE MATTER OF THE OPPOSITION UNDER NO 436,991 IN THE NAME OF MEDION AG

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF LEE SCOTT (O/340/24) DATED 15 APRIL 2024

DECISION

Introduction

1. This is an appeal from the decision of Mr Lee Scott, for the Registrar, dated 15 April 2024 (O/340/24). Medion AG opposed the application of Oluwatosin Oluwole Ajibade under section 5(2)(b) of the Trade Marks Act 1994. The opposition was upheld in part and dismissed in part and now Mr Ajibade appeals.
2. Mr Ajibade applied to register a series of four marks—CHOPLIFE, ChopLife, CHOP LIFE and Chop Life—in Classes 9, 16, 25, 35, 38, 41 and 42 (No 3,783,894). Medion opposed the registration based on the earlier trade mark LIFE (No 916,673,171), which is registered in classes 9, 35, 38, 41 and 42.

Standard of appeal

3. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion nor a belief that the Hearing Officer has reached the wrong decision will suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer's findings were rationally insupportable. The principles to be applied were summarised by Joanna Smith J in *Axogen Corporation v Aviv Scientific Ltd* [2022] EWHC 95 (Ch), [24] and in relation to findings of fact this should now be read in light of the summary of Arnold LJ in *Lidl Great Britain Ltd v Tesco Stores Ltd* [2024] EWCA Civ 262, [110] and in terms of evaluative decisions the Supreme Court's guidance in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] where it stated that:
...on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out the balancing exercise afresh but must ask whether the decision of the judge was wrong by reason of an identifiable flaw in the judge's treatment of the question to be decided, such as a gap in logic, a lack of consistency, or a failure to take into account some material factor, which undermines the cogency of the conclusion.

4. When considering this appeal, and applying these principles, it is important to remember the high bar set.

Grounds of appeal

5. There are six grounds of appeal put forward by the Appellant, but two of those grounds were argued together. First, the Appellant submits that the Hearing Officer erroneously made factual findings that there might be co-branding in the market place despite this not having been pleaded. Secondly, the Appellant argues that the Hearing Officer failed to give the parties an opportunity to address the co-branding point. Thirdly, it is said the Hearing Officer made decisions on the similarity of goods and services which were rationally insupportable. Fourthly, it is submitted that the Hearing Officer erred when he concluded that LIFE in CHOP LIFE has independent distinctive character. Finally, the Appellant argues that the Hearing Officer fell into error when he said all the four marks in the series would be read as CHOP LIFE.

Ground 1: Failure to plead

6. The Appellant's first ground of appeal is based on part of the Hearing Officer's finding in Decision, [129] that there would be a likelihood of confusion between the marks because he was satisfied:
 - that the average consumer would believe that the goods and services, which I have found to identical or similar to a high degree, have been co branded and thus that there is an economic link between the parties.
7. Mr Wood submits that this finding was not open to the Hearing Officer because the Opponent (now Respondent) had not pleaded co-branding in its TM7. The importance of confining a case to that which is pleaded has been reiterated by the appellate courts many times; for instance, in *Satyam Enterprises Ltd v Burton* [2021] EWCA Civ 287, [36] the judge below was criticised for deciding:
 - the case on a basis that had neither been pleaded nor canvassed before him. In our system of civil litigation that is impermissible, and a misunderstanding of the judge's function which is to try the issues the parties have raised before him.
8. Accordingly, I accept Mr Wood's basic submission that a Hearing Officer cannot go beyond the pleaded case. Furthermore, it is right that in opposition proceedings the fundamental principles of pleading apply even if they do so with little of the vigour applied in the High Court.
9. Mr Wood goes on to say that in the High Court the pleadings would include Particulars of Likelihood of Confusion and these should, he says, include an allegation of co-branding. I accept that any allegation that there is co-branding actually happening in the marketplace should be pleaded (just like actual confusion). It is also true that in practice, both before the court and before the registry, things about the mark or market which point towards there being likelihood of confusion will be pleaded. But this sort of pleading is often little more than argument and it is not proper to plead "arguments, reasons or rhetoric": *Tchenguz v Grant Thornton UK LLP* [2015] EWHC 405 (Comm), [1]. This is because arguments should be made in written and oral submissions and not in pleadings.

10. Trade mark oppositions are based on the notional use of the respective marks in the marketplace. Indeed, it is usually the case that the purchasing process and marketplace are constructed entirely from the Hearing Officer's own experience (as parties rarely lead evidence on the matter). This hypothetical marketplace and the transactions that occur within (such as the *potential* for co-branding) can be constructed by argument and reasoning alone. In such a case, there are no material facts to plead other than similarity of the marks, the similarity of the goods and that there is a likelihood of confusion. Accordingly, as I said in *Delta Air Lines, Inc v Ontro Ltd* [2021] RPC 21, [22]:

it is possible to make the objection entirely by completing the boxes on TM7. There is no need to file a separate Statement of Grounds. Of course, where certain things are alleged a Statement of Grounds will be needed, for instance where enhanced distinctiveness is claimed. Nevertheless, an Opponent has a fully pleaded claim based on the completion of the boxes on Form TM7 alone.

11. Accordingly, the Hearing Officer was entitled to find there might be co-branding even though no such allegation had not been pleaded on TM7. I therefore reject the first ground of appeal.

Ground 2: An unargued issue

12. The Appellant's second ground of appeal follows from the first. Co-branding was neither pleaded nor argued by the parties. Accordingly, Mr Wood submits, the Hearing Officer should not have based his judgment on an "unargued point".

13. It has long been acknowledged that a judge (or arbitrator) can raise points independently of the parties. This was explained by Bingham J in *Zermalt Holdings SA v Nu-Life Upholstery Repairs Ltd* [1985] 2 EGLR 14 at 15:

[T]he rules of natural justice do require ... that matters which are likely to form the subject of decision, in so far as they are specific matters, should be exposed for the comments and submissions of the parties. If an arbitrator is impressed by a point that has never been raised by either side then it is his duty to put it to them so that they have an opportunity to comment. If he feels that the proper approach is one that has not been explored or advanced in evidence or submission then again it is his duty to give the parties a chance to comment.... It is not right that a decision should be based on specific matters which the parties have never had the chance to deal with, nor is it right that a party should first learn of adverse points in the decision against him.

14. The rule was put succinctly by Lord Hamblen and Lord Burrows in *RAV Bahamas Ltd v Therapy Beach Club Incorporated (Bahamas)* [2021] UKPC 8, [46]:

...An arbitrator will not have acted fairly if a party is learning for the first time in the award about findings and matters in the decision of the arbitrator which that party has not had the opportunity to address.

15. In this case the Hearing Officer had only written submissions from the parties. Mr Wood submits that once the Hearing Officer thought co-branding might have been an issue he should have given the parties an opportunity to comment upon that position.

16. However, the duty to refer a point back to the parties does not extend to "each and every legal inference": *OAO Northern Shipping Company v Remolcadores De Marin SL (Remmar)* [2007] EWHC 1821 (Comm), [22]. The appropriate approach is that

identified by Tomlinson J in *ABB AG v Hochtief Airport GmbH* [2006] EWHC 388 (Comm), [2006] 2 Lloyd's Rep 1, [72] where he stated that what is important is whether "all of the essential elements" leading to the conclusion "were fairly in play or, to use a different expression, in the arena.". This approach was explained further by Popplewell J in *Reliance Industries Ltd v The Union of India* [2018] EWHC 822 (Comm), [32]:

"However where a point of construction is squarely in play and addressed by both parties, the tribunal is not obliged to put to the parties all aspects of the analysis in support of its conclusion in order to fulfil the ...duty of fairness. As is well known, construction is an iterative process involving consideration of the particular wording in question, the other provisions of the contract taken as a whole, and the commercial consequences which follow from the rival constructions. The relevant provisions may be lengthy and admit of many nuances in the analytical argument. If provisions are relevant, and have been adverted to and addressed in argument, it is not necessarily unfair for the tribunal to use them to support its reasoning, even where the other party has not done so in the same way as the tribunal. It is always important to keep in mind the distinction between a lack of opportunity to deal with a case and a failure to recognise or take such opportunity. It is commonplace in judicial decisions on points of construction that a judge may fashion his or her reasoning and analysis from the material upon which argument has been addressed without it necessarily being in terms which reflect those fully expressed by the winning party. There is not perceived to be, and is not, anything which is unfair in taking such a course. It is enough if the point is "in play" or "in the arena" in the proceedings, even if it is not precisely articulated. To use the language of Tomlinson J, as he then was, in *ABB AG v Hochtief Airport* [2006] 2 Lloyd's Rep 1 at [72], a party will usually have had a sufficient opportunity if the "essential building blocks" of the tribunal's analysis and reasoning were in play in relation to an issue, even where the argument was not articulated in the way adopted by the tribunal. Ultimately the question which arises ...[is] whether there has been a reasonable opportunity to present or meet a case, is one of fairness and will always be one of fact and degree which is sensitive to the specific circumstances of each individual case. That applies to points of construction as much as to other points in dispute.

17. Mr Wood accepted (albeit not using these phrases) that Hearing Officers, when considering whether there is a likelihood of confusion between two marks, should assess whether there is indirect confusion based on *L.A. Sugar Limited v Back Beat Inc* (O/375/10); it is therefore always "in play" and Hearing Officers are compelled to consider the issue. But Mr Wood disputed that "co-branding" as a form of indirect confusion was in the "arena".
18. I think Mr Wood was right to accept that indirect confusion is already "in play", but I do not accept his submission that "co-branding" was not. The leading case on indirect confusion is now the judgment of Arnold LJ in *Liverpool Gin Distillery Ltd v Sazerac Brands, LLC* [2021] EWCA Civ 1207 where co-branding was specifically said to be an example of indirect confusion ([12]). Accordingly, as a type of indirect confusion, acknowledged by the Court of Appeal, it too must be in arena.
19. As I have already said, the assessment of whether there is a likelihood of confusion is usually based on the Hearing Officer's own perceptions regarding the similarity between goods, the similarity between the marks, and purchasing behaviour. Assessing the likelihood of confusion is, therefore, an "iterative process" and so it is entirely appropriate for Hearing Officers to fashion their own reasoning and analysis from the submissions and evidence before them. Accordingly, it was open to the Hearing Officer to conclude that there was indirect confusion based on co-branding without the need to specifically refer it back to the parties. I therefore reject the second ground of appeal.

Ground 3 and 4: Similarity of goods

20. The third and fourth grounds of appeal are really a multitude of challenges to findings relating to the similarity of goods and services. The Hearing Officer found that any goods or services covered by the Appellant's mark which are identical or highly similar to those covered by the earlier mark should be refused. But where there was less similarity between the goods or services the opposition was dismissed. The Appellant made six challenges to the Hearing Officer's similarity findings (some other challenges were withdrawn during the hearing because the goods and services in question had not, in fact, been refused by the Hearing Officer).

Music software

21. The first challenge is to the Hearing Officer finding that "computer software to enable music artists and music labels to market and distribute their music" is identical to "music software" (Decision, [25]). The basis of the challenge is that the Hearing Officer subsequently found that the core meaning of "music software" is software for "playing or producing music" (Decision, [27]). Mr Wood argues that distributing and marketing music is not identical to playing or producing music.

22. While I agree distributing and marketing is not the same activity as playing music, it appears to me that each is the other side of the same coin. The same streaming software, for instance, will be used by an artist (or record company) to market and distribute software and by a consumer or user to play the music distributed. Indeed, even if these products were not found to be identical (as I find) they would certainly be highly similar. I therefore dismiss this challenge.

Audio-visual works & c

23. The second challenge is to the finding that the Respondent's "audio-visual devices and equipment" is identical to the Appellant's "Cinematographic apparatus; sound recording apparatus; apparatus for the transmission of sound; sound reproduction apparatus; image recording apparatus; image transmission apparatus; image reproduction apparatus; e-readers; virtual reality headsets; apparatus and instruments for recording, transmission or reproduction of sound or images; portable media players."

24. I accept that there is a reasonable argument that "audio-visual devices and equipment" means equipment for both sound *and* vision and not just sound or vision. But even if a device or equipment which produces only sound or produces only vision is not identical to "audio-visual devices" it is highly similar. Accordingly, even if the Hearing Officer were wrong it would make no difference to his eventual finding. I therefore reject this challenge as well.

Warning equipment

25. The next challenge was to the Hearing Officer's finding that "detectors" is identical to "warning equipment". A smoke or carbon monoxide detector will both detect and give a warning. Accordingly, there is clearly some overlap between these goods. I therefore reject the submission that the Hearing Officer erred.

On-line advertising on a computer network

26. Mr Wood submits that the Hearing Officer fell into error when he found that the Appellant's "Communication advice (advertising)" was highly similar to the Respondent's "on-line advertising on a computer network" in that the services are not closely allied or clearly important or indispensable for each other: Decision, [51]. He says that the Hearing Officer made findings without evidence that, for instance, these services share trade channels.
27. It is inevitable that Hearing Officers make findings of fact regarding the circumstances surrounding the sale of goods or services in the marketplace. And as I noted in *ELVIS JUICE* (O/48/18), [13] when they do this:
- ...Hearing Officers routinely rely on their own experience when making findings of fact. Indeed, as the quality of evidence filed by parties is sometimes so poor (or there is none at all), Hearing Officers are often compelled to make findings of fact without evidence at all as otherwise the outcome of oppositions might be arbitrary or capricious.
28. I also remind myself of the comments of Daniel Alexander QC, sitting as an Appointed Person, in *O2 Holdings Ltd TM App* [2011] RPC 22, [60].
- In the context of an appeal, once an experienced hearing officer has made an evaluation, an appellate tribunal needs to have very sound reasons for substituting its own view and implicitly thereby saying that it is better equipped with knowledge of the relevant field of commerce to evaluate the mark than the registrar.
29. The fact that Hearing Officers are compelled to make findings of fact based on their own perceptions (when no evidence has been filed), and the need for appellate modesty, makes it particularly difficult to establish that any such a finding by a Hearing Officer was rationally insupportable. I am in no better position than the Hearing Officer to decide whether (in the absence of evidence) these services share trade channels. And so, I am in no position to say his finding is insupportable. I therefore dismiss this challenge.

Providing access to multimedia content online

30. Once more, Mr Wood submits that the Hearing Officer erred in a factual finding, namely that "broadcasting and transmission" of content is identical to "providing access" to content (Decision, [67]). The Hearing Officer unfortunately provided no reasoning to explain why he found the two services to be identical. It may have been because the next service listed in the earlier mark was "providing access" to content which clearly was identical.
31. I accept that it might be said that "broadcasting and transmission" of content is the sending of the signal and "providing access" to content might be seen as the reception of a signal. But even if the services are not identical for this reason the use of one would be dependent on the other and so the services are clearly highly similar. And a finding of high similarity, rather than identity, would make no difference to the ultimate outcome. Therefore I reject this challenge also.

Entertainment

32. The Hearing Officer found that both “sporting activities” and the “provision of leisure facilities” claimed by the Appellant are similar to a high degree to “Entertainment” covered by the earlier mark (Decision, [85 and 86]). Mr Wood sought to draw a distinction between the provider of the entertainment and the entertained. As I have already said, it is very difficult to challenge these sorts of findings of fact in the absence of evidence. I see nothing in the Hearing Officer’s reasoning which makes his conclusion in this regard insupportable. Accordingly, this aspect of the challenge is also dismissed.
33. I have, therefore, dismissed all the Appellant’s challenges to the findings of fact made in respect of the similarity of goods and services. This means Grounds 3 and 4 are dismissed.

Ground 5: Independent distinctive character

34. The Appellant’s fifth ground of appeal is a challenge to the Hearing Officer’s findings that, first, there is “no obvious conceptual synergy between ‘Chop’ and ‘Life’” and, secondly, that the word LIFE has an independent distinctive role in CHOP LIFE (Decision, [109] and [128]). Mr Wood submits that, contrary to the Hearing Officer’s finding, CHOP qualifies LIFE and so the words do hang together.
35. The Hearing Officer’s findings that CHOP would not have been seen to qualify LIFE, and that LIFE would be seen as having independent distinctive character, are findings he is entitled to make. The Appellant sees the connection between the elements of the mark differently from the Hearing Officer. I accept that the Appellant’s position is rational and logical, but this does not make the Hearing Officer’s decision irrational. Indeed, it is my view that seeing CHOP and LIFE as not hanging together is also entirely rational and logical.
36. This is also not a case where the Hearing Officer can be criticised for not considering CHOP as qualifying LIFE (as an alternative way of viewing the mark). If some of the relevant public see CHOP and LIFE as not hanging together then that is enough for there to be a likelihood of confusion, even if other parts of that public see one word as qualifying the other.
37. Accordingly, the fifth ground of appeal is dismissed.

Ground 6: Considering one version of Chop Life mark

38. The Appellant applied to register a series of four marks: CHOPLIFE, ChopLife, CHOP LIFE and Chop Life. The Hearing Officer took the view that all four marks would be perceived as a combination of the two words “CHOP” and “LIFE”: Decision, [107]. Mr Wood submits that had “CHOPLIFE” been seen in isolation it would have been viewed by the Hearing Officer as a single word and not a combination of CHOP and LIFE.
39. The Hearing Officer correctly reminded himself of Kitchin LJ’s analysis of series marks in *Comic Enterprises Ltd v Twentieth Century Fox Film Corp* [2016] EWCA Civ 455.

The conclusion of this analysis was summarised by the Hearing Officer, but I think it is helpful to set out how Kitchen LJ ended his analysis at [66]:

An application for the registration of a series of trade marks is an application to register a bundle of trade marks under a single reference number. Each of the marks in the series must satisfy the requirements of the 1994 Act. If the application is accepted and any opposition proceedings have been resolved in favour of the applicant, then the series of marks will be registered, but it will remain what it always was, namely a bundle of different marks, albeit now registered under the same reference number.

40. It is therefore important for a Hearing Officer to consider whether each mark within a series is registrable or not. This does not mean, however, that marks within a series, which have shared characteristics, cannot be considered together in respect of those characteristics. The Hearing Officer concluded that all the marks would be perceived in the same way. It is mere speculation to suggest that the Hearing Officer would have seen CHOPLIFE as one word if he had not seen it alongside CHOP LIFE. It must be assumed, in the absence of any indication to the contrary, that the Hearing Officer considered matters properly, and that the Hearing Officer would have seen CHOPLIFE as effectively CHOP LIFE even if that had been the only mark under consideration.

41. Accordingly, I dismiss this ground of appeal as well.

Conclusion

42. I have upheld the Hearing Officer's decision and dismissed the appeal in its entirety.

43. The Respondent provided brief written submissions, but did not appear. Accordingly, a costs award is appropriate, but a small one. I therefore order the Appellant to pay a contribution of £250 towards the Respondent's costs by 5pm on 4 November 2024.

PHILLIP JOHNSON
THE APPOINTED PERSON
12 October 2024

Representatives:

For the Appellant: Mr Aaron Wood (instructed by Joshi-IP.Law)

For the Respondent: Stratagem IPM Limited