BL O/1142/25

THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3,770,879 IN THE NAME OF CUMMINS INC

AND IN THE MATTER OF THE OPPOSITION UNDER NO 436,777 IN THE NAME OF ACCELLERON SWITZERLAND LTD

AND IN THE MATTER OF AN APPEAL FROM THE DECISION OF AKIRA KLASS (O/598/25) DATED 1 JULY 2025

DECISION

Introduction

1. This is an appeal from the decision of Akira Klass, for the Registrar, dated 1 July 2025 (O/598/25). Accelleron Switzerland was partially successful and partially unsuccessful in its opposition to the registration of Cummins Inc's trade mark under sections 5(2)(b) of the Trade Marks Act 1994. Cummins appeals.

2. On 28 March 2022, Cummins applied to register the word mark ACCELERA (No 3,770,879) in Classes 7, 9, 11, 37, 39, 40 and 42. However, this appeal relates only to the following goods and services where the application was refused:

    Class 7
    Portable proton exchange membrane (PEM); hydrogen fuel dispensers for hydrogen fueling stations; hydrogen refuelers, namely hydrogen refueling stations.

    Class 9
    Hydrogen fuel cells; electrolyzers; hydrogen power storage systems, namely systems containing an electrolyzer for converting electrical energy to hydrogen gas, a means of storing the hydrogen and means for converting the hydrogen back to electrical energy.

    Class 11
    Hydrogen purifiers; rectifying demisters.

    Class 37
    Operation of hydrogen refueling stations and related services, namely maintenance and installation of hydrogen refueling stations

    Class 42
    Engineering services in the field of electrical power and natural gas production; consulting services in the field of design and development of fuel cell test stations, designing industrial and commercial hydrogen systems; technical operation of hydrogen refueling stations.

3. The application was opposed by Accelleron based on its earlier international trade mark (UK) ACCELLERON (No 1,677,646) for numerous goods and services (which are set out in Annex 1 to the Hearing Officer's decision).

Standard of appeal

4. 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 further explained in *Lifestyle Equities CV v Amazon UK Services Ltd* [2024] UKSC 8, [49] and *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc* [2025] UKSC 25, [93] and [94].

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

Grounds of appeal

6. The Appellant appealed the Hearing Officer's decision on six grounds, however all but two of these were abandoned before the hearing. The first ground of appeal before me relates to the construction of the goods and services being compared and the comparison of the parties' goods and services. The second ground of appeal relates to the Respondent's claim to priority from its earlier Swiss application. This second ground was not raised below and so I will also need to consider whether the Appellant should be allowed to run it at all.

Ground 1: Comparison of the goods and services

7. Mr Andrew Norris KC, for the Appellant, submits that the Hearing Officer made a series of errors in her assessment of the similarity of the goods and services. Before continuing, I remind myself of the deference which needs to be shown to the decisions of Hearing Officers when comparing goods and services as highlighted by Arnold LJ in *Extreme Networks Ltd v Extreme E Ltd* [2024] EWCA Civ 1386 at [31]:

   > It is common for hearing officers when assessing the similarity of goods or services to express their reasoning in highly compressed form. There are a number of reasons for this: first, their extensive experience in the field; secondly, comparison of goods or services is a routine exercise for them to have to undertake when writing decisions; thirdly, it is frequently necessary for them to have to undertake multiple comparisons in each decision; and fourthly, it is often the case that no evidence has been adduced by either party (leaving the hearing officer to rely upon their own knowledge and experience as a consumer) and that the parties have addressed the issue quite briefly in their submissions…

8. In this case, however, there is an additional difficulty. The goods and services in this case are relatively technical in nature as they relate to the utilisation of hydrogen. It is not a case where the Hearing Officer could necessarily rely on her own experience as a consumer. Indeed, it is made more complicated by the fact the Appellant did not file any evidence explaining the relevant technical terms in its trade mark specification, but left it to the Hearing Officer to establish their meaning based on her own experience. It would of course have been open to the Hearing Officer to direct the Appellant to file evidence explaining the specification, but this did not happen.

9. In any event, the Respondent did file witness statements and these include the Respondent's view on what some of the technical terms in the specification meant. Mr Norris criticises the Hearing Officer for relying on this evidence in interpreting the Appellant's specification. However, if the Hearing Officer did not know the meaning of particular technical terms or particular facts about the goods or services in a specialist market such as the one here, and the only evidence before her was from the Respondent, I cannot see how she can be criticised for relying upon it.

10. In a case such as this where the products are technical or specialist and may not be within the common understanding of a Hearing Officer, parties take a huge risk if they do not file evidence to explain the terms in the specification. It may be that some Hearing Officers (or Appointed Persons) have the relevant technical or specialist knowledge about a particular field, but this cannot be assumed. Indeed, as it is not everyday knowledge, even if the tribunal happens by chance to have the relevant knowledge it should not be used in a judgment unless the parties have had an opportunity to comment upon it: *Bowman v DPP* [1991] RTR 263 at 269.

11. In any event, where a specification covers a technical or specialist field, and no relevant evidence is filed, it seems to me a Hearing Officer cannot be criticised (or overturned) on the basis the appellate tribunal believes (possibly erroneously) it has slightly better or different technical or specialist knowledge. This just risks one error being swapped for another: see by analogy, *O2 Holdings Ltd's Trade Mark Application* [2011] RPC 22 at [60].

12. I accept that this might mean in some cases that the Hearing Officers *in fact* misunderstood the nature or function of a technical or specialist product and this leads to results which those with the relevant knowledge know to be wrong, but this misunderstanding arises from one or both parties failing to assist the tribunal.

13. Indeed, a different approach whereby a party could rely on the potential technical or specialist knowledge of the appellate tribunal is in itself deeply problematic. There are some judges and Appointed Persons with strong technical backgrounds and others with little or none. The merits of an appeal should not depend on the personal knowledge of the person assigned to hear it. Nothing could be more arbitrary.

14. So even where a Hearing Officer was mistaken in his or her technical understanding about a product, it is difficult to see how this can be corrected on appeal where there is still no evidence before the tribunal and one party says the understanding was correct and the other argues the contrary (i.e. it might be different if both parties agree it was a mistake). There may be cases where an application to admit more evidence on appeal is appropriate, but in saying this I am not suggesting that the usual strict standards applying to such applications should be relaxed.

15. It is within these bounds that I will consider the comparisons of goods and services by the Hearing Officer.

Construction of "parts for…power generation systems'

16. Mr Norris began his challenge to the Hearing Officer's decision by suggesting she mid-construed the phrase "parts for…power generation systems" in "parts for motors, engines, propellers, propulsion systems and power generation systems" in Class 7.

17. The first criticism is that she erred by confusing the generation of hydrogen with the generation of electrical power using hydrogen. Mr Norris suggests this is akin to equating the production of sulphuric acid, used in car batteries, with the generation of electricity from car batteries. I accept Mr Norris's point that these are two different things, and I will take this into account where it is relevant.

18. The second criticism of the Hearing Officer was that her reasoning appeared to be predicated on the term "power generation systems" including stand-alone goods. Put simply, it is said that she includes in "power generation systems" all sorts of power systems up to and including power stations. Mr Norris submits that this term needs to be understood in the context of the other words included in the phrase and so it is limited to power generation systems involved in the propulsion of some object (but not, "road vehicles"). I accept Mr Norris's submission up to a point.

19. First, "parts for motors, engines, propellors, propulsion systems" all clearly relate to parts for creating movement whether this is the movement of a vehicle or other moving part (ie a spindle).

20. Secondly, I agree the reference to "power generation systems," as it is part of the same term, should be construed in the context of the terms around it. However, contrary to Mr Norris's submission, I think the words "power generation systems" could cover both power generators within propulsion systems as well as things like diesel generators or battery or hydrogen generators which provide electrical power for a particular business or residential premises (what I will call "portable" generators for simplicity). These can be very similar to power generators for propulsion and may well share similar parts. But I do not think the term "power generation system" can be seen to extend to all forms of power generation systems, such as power stations for producing electricity (eg oil, gas, wind or nuclear power stations). For instance, parts for "power generation systems" would not extend to the control rods used in a reactor within a nuclear power station.

21. I will now turn to consider each of the challenges to the particular goods and services.

Class 7: Portable proton exchange membranes (PEM)

22. The Hearing Officer explained her reasoning in relation to the above goods at [25]:

> The opponent compared the applicant's goods with "parts for motors, engines, propellers, propulsion systems and power generation systems" in its specification, it is between these goods that they submit there is identity. The applicant's witness statement outlined that applicant's goods are a type of fuel cell that generates electricity through the chemical reactions between hydrogen and oxygen. Accordingly, I consider that it falls in the broader category of "parts for […] power generation systems" as it is a "part" that is used within a hydrogen power generation system…

23. First, Mr Norris says the Hearing Officer erred when relying on the witness statement of Mr Bergmann as to what PEM means because he did not give any evidence on the point at all. However, in the table in his First Witness Statement Mr Bergmann says, "The opposed goods include fuels cells…and parts (e.g. membranes) of fuel cells". I assume that the Hearing Officer took this phrase to refer to membranes generally and so includes proton exchange membranes in particular. This criticism of the Hearing Officer is therefore unfounded.

24. Secondly, Mr Norris submits that a membrane is a selective barrier which allows some things to pass but stops others. It is not, he says, part of a propulsion system. First, I have already indicated that the term power generation system is not limited to propulsion systems, but even if it were, I do not agree with this submission. It is true that being a selective barrier is the purpose of a membrane, but PEM membranes are used in proton-exchange membrane fuel cells. It is therefore "part" of a fuel cell and there was nothing before the Hearing Officer to suggest that these sorts of fuel cells could not be used for propulsion (or portable generators). Therefore, the Hearing Officer's conclusion was one she was entitled to reach.

Class 7: Hydrogen fuel dispensers for hydrogen fueling stations; hydrogen refuelers, namely hydrogen fueling stations

25. In her decision at [27] and [28], the Hearing Officer considered the above goods:

> 27. It is my understanding that "hydrogen fuel dispensers for hydrogen fueling stations" in the applicant's specification, is akin to how a petrol station is used to refill petrol or diesel in vehicles; it is used to dispense hydrogen fuels into vehicles etc, either in a gas or liquid form. I also consider this to be the case in relation to "hydrogen refuelers, namely hydrogen refueling stations" in the applicant's specification. I will compare these goods collectively on that basis.
>
> 28. I will compare these goods with the opponent's "parts for motors, engines, propellers, propulsion systems and power generation systems" in the opponent's specification. It is my view that the goods will differ in nature and method of use. I consider that there may be an overlap in trade channels. I recognise that the trade channels will be more niche but consider that the relevant public may be able to purchase the goods via the same channels of trade. Further, I consider that there is a distinct possibility that the goods may be produced by the same providers, for example, in relation to hydrogen refuelers (which may be used in hydrogen power generation) and hydrogen power generation parts, as the provider may specialise in the field of hydrogen power generation. In addition, taking into consideration the relationship between the goods, as outlined by the opponent (which aligns with my understanding of the systems), I consider that there may be an overlap in users. This is on the basis that a hydrogen power generation company, for example, may use refuelers and purchase parts for its power generation systems to repair them. I do not consider that the goods are in competition, as a consumer looking to dispense hydrogen is not going to purchase a part for a motor, engine, propeller, propulsion system or power generation system as an alternative. As hydrogen refuellers may be the only method used by a hydrogen power generation plant to generate electricity from hydrogen (if they do not produce their own hydrogen), they may be used alongside parts of power generation systems to generate electricity. I already stated that I consider that there may be an overlap in producers. However, I do not consider that there may be a complementary relationship between the goods. It is not my view that a fuelling station and power generation system, are sufficiently close for parts of power generation systems to be important/indispensable to hydrogen fuel dispensers for hydrogen fueling stations in the way that the case law requires. Taking the above into account, I consider the goods to be similar to a low degree.

26. The Hearing Officer's basic analysis that "hydrogen fuel dispensers" could be seen as akin to petrol or diesel fuel dispensers used at a conventional petrol station is (in the absence of evidence) is reasonable. While not stated by the Hearing Officer, this clearly extends to boat yards where refuelling is provided to boats (as the Respondent's specification for "parts" does not extend to road vehicles).

27. I also accept her finding that the goods differ in nature and method of use, but that the providers of the goods might be the same as might the trade channels.

28. But I think the Hearing Officer went awry in her reasoning in relation to why she said the users might be the same. This is because she considered power generation systems in terms of "hydrogen power generation plants" and "power generation companies", and the words plant and company suggest to me that she was thinking of large scale power plants (like those using oil or nuclear power) to generate huge amounts of electricity. This seems to be reading the specification too widely.

29. However, in light of her other findings throughout the decision it is clear that she would have found the goods to be similar to a low degree even if the users had not been the same. Indeed, I would also accept that, say, a boat yard would purchase a hydrogen fuel dispenser to dispense fuel to customers. The same yard might also buy parts for propellors, power generation systems and so on. These parts would either be sold on to its customers or used to repair customers' boats. Accordingly, it is my view that the Hearing Officer (based on her earlier findings and properly directing herself) would still have grounds to find the user to be the same.

30. Therefore, it is my view that the error by the Hearing Officer is not material as if she considered the issue afresh she would still come to a similar conclusion on the overall similarity of the goods.

Class 7: Hydrogen fuel cells

31. The Hearing Officer accepted the Respondent's submission that one of the main applications of hydrogen fuel cells is in propulsion systems (Decision, [29]). She went on to find fuel cells to be included in "parts for motors, engines, propellers, propulsion systems and power generation systems". I agree with her reasoning in this respect.

Class 7: Electrolyzers

32. The Respondent put forward evidence that electrolyzers generate hydrogen power from electricity and are therefore used for generating power (Decision, [30]). There was no other evidence before the Hearing Officer as to what an electrolyzer does. Mr Norris submits that an electrolyzer does not generate energy but consumes it.

33. An electrolyzer has many uses but in this context the relevant use would probably be separating hydrogen and oxygen to create the fuel that can then be used to generate hydrogen power. However, there was nothing in the evidence before the Hearing Officer to suggest that the electrolyzer could not be part of a power generation system; that is, the same unit could separate out the hydrogen and then store the hydrogen, and then use that hydrogen in the power cell (and in that respect see the next Class 7 good).

Accordingly, I think the Hearing Officer was entitled to conclude that the goods were highly similar for the reasons she gives at [30].

Class 7: Hydrogen power storage systems, namely systems containing an electrolyzer for converting electrical energy to hydrogen gas, a means of storing the hydrogen and means for converting the hydrogen back to electrical energy.

34. The system described in the Appellant's specification appears to include all the elements of the process to generate hydrogen from water, beginning with electrolysis through storing the hydrogen produced from that process to generating electrical energy from the stored hydrogen. As I have found that the Hearing Officer was entitled to find that each of the elements of this process could be undertaken in a portable hydrogen generator she was also entitled to conclude (at [32]) that a system like this would be similar to a "low to medium" degree to the Respondent's "parts for…power generation systems".

Class 11: hydrogen purifiers

35. The Hearing Officer concluded that a hydrogen purifier might be used to remove impurities from hydrogen gas before it is used ([34]). She went on to consider that "parts for…power generation systems" and hydrogen purifiers had a different nature, purpose and method of use. However, she found that the trade channels and users of the goods might overlap. Her decision then contained the following sentence

> On the basis that hydrogen purifiers can be used in the hydrogen power generation system, to ensure the purity of hydrogen before it is used to convert hydrogen into electricity, I am unable to determine that generation systems use hydrogen purifiers.

36. I find this sentence to be entirely contradictory as it seems to suggest that purifiers can be used in power generation systems but then concludes that she cannot determine whether they are used. However, this sentence was followed by a finding there was no complementarity between the goods and so a factor pointing away from similarity. It therefore did not taint her broader finding.

37. In my view, a finding that the trade channels and users of portable generators might be the same as for a hydrogen purifier (in the absence of any evidence about the nature of such products before her) was one she was entitled to make. Accordingly, the finding that the goods were similar to a low degree was rationally supportable.

Class 11: Rectifying demisters

38. The Hearing Officer found (as there was no evidence on point) that rectifying demisters were used to convert mist into liquid ([35]). She went on to explain that the product would be used to remove condensation and improve vision, and this would be different from the Respondent's goods which would be used to repair motors, engines, propellors &c. Accordingly, she found the goods differed in nature and use but she concluded the trade channels and users may overlap. She went on to find the goods would not compete or be complementary to each other before concluding the goods were similar to a low degree. Mr Norris criticises her decision on the basis that there was limited reasoning provided by the Hearing Officer. However, as indicated by the Court of Appeal in *EXTREME*, when comparing goods or services, it is acceptable for Hearing Officers to

provide reasoning in "highly compressed form". I therefore reject the challenge to these goods.

Class 37: Operation of hydrogen refuelling stations and related services, namely maintenance and installation of hydrogen refuelling stations

39. The Hearing Officer compared the above services with the Respondent's Class 37 services "installation, maintenance and repair of plants, motors, engines, propulsion systems and power generator systems that contain turbochargers". She found there might be an overlap in users, providers, and trade channels, but that the goods were not complementary or in competition ([37]). Once more, she concluded the services were similar to a low degree.

40. Mr Norris's first criticism is that she has not limited "power generator systems" to those for mechanical power. I have already held that the "power generator systems" can extend to portable generators for generating electricity. His second criticism is that the Hearing Officer wrongly found that the same professional might maintain power generation systems and hydrogen refuelling stations. There was no evidence on this point and so, for the reasons outlined above, I think the Hearing Officer was entitled to conclude as she did.

41. His third criticism is that that there was an inconsistency with her finding in respect of hydrogen fuelling and dispensing services, which she found to be dissimilar ([38]). I disagree that her reasoning is inconsistent. She took the view that maintenance and installation of hydrogen refuelling and power generation systems might be done by the same person whereas the supply of hydrogen fuel would not.

Class 42: Engineering services in the field of electrical power and natural gas production

42. The Appellant's above services were compared with services in Class 42, in particular to "engineering services in the field of computer software and hardware for use in connection with turbochargers, motors, engines, propellers, propulsion systems and power generation systems" and "design, development, installation, maintenance and repair of electronic control and regulation devices for turbochargers, motors, engines, propellers, propulsion systems and power generation systems".

43. The Hearing Officer found the services might be supplied by the same person, share the same trade channels, and that there is an overlap in users and the nature and purpose of the services as they are both engineering services. Her reasoning included the following passage at [48]:

> In my view, a consumer looking to hire a company to operate a hydrogen refuelling station may also hire the opponent's services to potentially design, develop, install, maintain or repair a power generation system.

44. As Mr Norris submits, it is not clear why hydrogen refuelling stations were mentioned as these were not the goods being compared, I agree this seems out of place, but I am not sure this error affects the Hearing Officer's overall conclusion. He also criticises the Hearing Officer for giving a very wide meaning to "engineering services".

45. It is my view that “engineering services in the field of electrical power and natural gas production” is a wide term and wide terms risk overlap with many more specialist engineering services which fall within it. I see no reason why engineering services in the field of, say, electrical power cannot cover software engineering services within that field. And just as engineering services covers the software engineering in general it must also cover specialist software engineers within in that field such as control devices for (portable) power generation systems. Accordingly, I do not think the Hearing Officer’s finding (at [48]) that the goods are similar to a medium degree is an unreasonable one and I might have found them to be closer still.

Class 42: Technical operation of hydrogen refueling stations

46. The Appellant also challenges the Hearing Officer’s finding that the abovementioned goods are similar to a low degree to the Respondent’s “design, development, installation, maintenance and repair of electronic control and regulation devices for turbochargers, motors, engines, propellers, propulsion systems and power generation systems”.

47. Mr Norris’s criticisms of the Hearing Officer in this respect are similar to those he made in respect of earlier goods and services, namely that “power generation systems” is not a standalone term and that the providers of the services would be different. For the reasons I have outlined already, in the absence of any evidence, I think the Hearing Officer was entitled to find these services to be similar to a low degree.

Class 42: Consulting services in the field of design and development of fuel cell test stations, designing industrial and commercial hydrogen systems

48. The Hearing Officer compared the above services of the Appellant with the Respondent’s “industrial analysis and industrial research services in the area of turbochargers, motors, engines, propellers, propulsion systems and power generation systems” and “engineering services in the fields of computer software and hardware for use in connection with turbochargers, motors, engines, propellers, propulsion systems and power generation systems”.

49. The Hearing Officer conclusions were in [51]:

> I consider that the services operate in the same field of energy generation and that there may be an overlap in users. I consider that the purposes and methods of use of the services will differ, as analysis/research services will study data and provide information that can be used to make decisions. They will use their findings to develop strategies and implement them, usually by working directly with employees to adjust processes and procedures. Whereas in a consultancy service, the consultant provides expert advice on a range of topics in a particular area (in this case energy generation). They will work with clients to address challenges that organisations face, and unlike analysts and researchers, they do not make changes within the company, rather they advise clients on how to handle situations more effectively to achieve the desired results. Despite this, I do consider that they may be provided by the same undertaking, and they will share the same trade channels. I do not consider that the services are in competition. Taking all the above into account, I consider that the services are similar to at least a low degree.

50. Mr Norris criticises the Hearing Officer for generalising at too high a level when she says the services are both in the field of energy generation. I agree that this is a too high level of generalisation. As I have concluded that references to “power generation

systems" only extend to "portable" systems it does seem to me to be a very different market with very different users and providers from those of both "fuel cell test stations" and "industrial and commercial hydrogen systems," and so my view is the Hearing Officer erred and these services are actually dissimilar.

Ground 2: Priority

51. The second ground of appeal was not argued below and it relates to the claim of priority from the Swiss registration (No. 773553) made by the Respondent and whether it extends to some of the goods and services covered by its international trade mark (UK), but not all of those goods and services (what is called a claim of "partial priority").

52. There are some goods and services, Mr Norris submits, which are covered by the international trade mark (UK) but which are not entitled to claim the earlier priority date from the Swiss registration. This in turn means in respect of those goods and services, the Respondent's trade mark is not an earlier mark and so cannot be used to ground an opposition.

53. Mr Silcock, for the Respondent, submits that this point is entirely new and therefore the Appellant should not be permitted to argue it on appeal. He relies both on principle and on how the Appellant's case was pleaded.

54. In terms of the principles to be applied, the correct approach to a point being raised on appeal for the first time was summarised by the Court of Appeal in *Singh v Dass* [2019] EWCA Civ 360 at [15]-[18]:

> 15. The following legal principles apply where a party seeks to raise a new point on appeal which was not raised below.
>
> 16. First, an appellate court will be cautious about allowing a new point to be raised on appeal that was not raised before the first instance court.
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> 17. Second, an appellate court will not, generally, permit a new point to be raised on appeal if that point is such that either (a) it would necessitate new evidence or (b), had it been run below, it would have resulted in the trial being conducted differently with regards to the evidence at the trial (*Mullarkey v Broad* [2009] EWCA Civ 2 at [30] and [49]).
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> 18. Third, even where the point might be considered a 'pure point of law', the appellate court will only allow it to be raised if three criteria are satisfied: (a) the other party has had adequate time to deal with the point; (b) the other party has not acted to his detriment on the faith of the earlier omission to raise it; and (c) the other party can be adequately protected in costs. (*R (on the application of Humphreys) v Parking and Traffic Appeals Service* [2017] EWCA Civ 24; [2017] RTR 22 at [29]).

55. Further, in *Notting Hill Finance Ltd v Sheikh* [2019] EWCA Civ 1337 at [26] to [28] (after referring to *Singh*) the Court of Appeal explained that at one end of the spectrum were cases where there had been a full trial involving live evidence whereas at the other end of the spectrum are cases which are pure law and can be run on the basis of facts found by the judge of the lower court.

56. In this case, if I allow the appeal and it were successful, the validity of each priority claim would have to be determined. However, this is not a factual determination as such

but a point of legal construction (albeit it might involve the construction of technical terms). It therefore seems to me to be a matter which is close to being pure law.

57. In terms of the pleading point, Mr Silcock points to the fact that in its Counter-Statement, the Appellant admitted the first five paragraphs of the Statement of Grounds which include at paragraph 1, "The Owner is the owner of the following UK Designation…." and at paragraph 2 "The Designation dates from 06 April 2022, with a priority claim of 05 November 2021". This, Mr Silcock says, is the Appellant admitting it is entitled to claim priority for each of the goods and services covered by the specification.

58. I do not think admitting that there has been a claim of priority is an admission that the claim was properly made or that it covered each and every good and service in the application in suit. The Appellant's argument on priority is quite straightforward: the goods covered by the Swiss application (the Convention application as defined in section 35(1)) are not as broad as those covered by the international trade mark (UK), but he is not denying the priority claim to the extent that it is valid.

59. Accordingly, it seems to me the new ground is not precluded on principle or by pleading. I will therefore allow it to be argued.

60. Mr Silcock makes two substantive arguments why the priority claim from the Swiss application cannot be considered by the registrar (or me).

61. First, he submits that because the validity of the earlier mark was not challenged, the registrar (and I) must treat the mark as valid. I accept this submission. However, this does not help Mr Silcock. There is no suggestion that the Respondent's mark is not valid, but rather that the relevant date for assessing which rights take precedence differs between those goods and services where there is a right of priority and those goods and services where there is not.

62. Secondly, he submits that the registrar has no jurisdiction to assess the priority claim because this is an application under the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks (Madrid Protocol). He points to Article 3(1) of the Protocol and Rule 9(5)(d)(vi) of the Regulations made under the Agreement and Protocol.

63. It might help to explain in outline how the Madrid Protocol works. An international application under the Protocol requires a "basic application" or a "basic registration" to exist in a contracting country. An international application is then filed at the office of origin, which is the trade mark office where the basic application or basic registration has been made, and this office passes the international application to the International Bureau.

64. When the office of origin sends the international application to the International Bureau it must, in accordance with Article 3(1), "certify that the particulars appearing in the international application correspond to the particulars appearing, at the time of the

certification, in the basic application or basic registration, as the case may be" (which is supported by a declaration: rule 9(5)(d)(vi)).

65. In relation to the list of goods and services it is clear what needs to correspond between the two applications as it is explicitly stated in the WIPO, *Guide to the Madrid System: International Registration of Marks Under the Madrid Protocol* (2024) at [288]:

> The list of goods and services set out in the international application (the main list) must fall within the scope of the goods and services set out in the basic mark. This means that the list in the international application may be narrower, but it cannot be broader or contain different goods and services. The terms used in the international application do not have to be exactly the same, but they must however, be equivalent to those used in the basic registration or application...

It is further explained at [959] and [961]:

> The Office of origin must check that the goods and services indicated in the international application are covered by the list of goods and services appearing in the basic mark at the time when the Office certifies the international application; that is, each of the goods and services mentioned in the international application must either appear in the list in the basic mark, or must fall within a broader term included in that list; the list of goods and services in the international application may, however, be narrower than that in the basic mark. The Office should look at the specific terms to see if they correspond, and not necessarily be bound by the indicated class number of the Nice Classification. This may especially relevant where the basic mark is an older registration, as certain terms, set out in the international application, may now fall under a different class of the Nice Classification, than what was the case for the classification of the goods and services in the basic mark. [Rule 9(5)(d)(vi)]

…

> When determining whether the goods and services covered by the international application correspond to those covered by the basic mark, it is important to remember that the terms do not need to match exactly (for many Offices the lists will be in different languages), nor do they need to be as broad in nature as the basic mark (i.e., the international application can cover a narrower scope of protection)…

66. There is no mechanism under the Madrid Protocol for a Contracting State to challenge any claim to priority in an international trade mark on the grounds that the goods and services covered by the international application are broader than those covered by the basic application (or registration).

67. Where the basic application (or registration) was filed within six months of the application it is possible to claim priority from the basic application in accordance with Article 4 of the Paris Convention for the Protection of Industrial Property.

68. It is possible, although rare in practice, that priority can be claimed from an application which is earlier than the basic application, but was still filed less than six months before the international application (see WIPO, *Guide to the Madrid System*, [252]). In such a case, the priority claim is not from the basic application (or registration) and so it is possible to have only some of the goods and services covered by the international application enjoying priority from that earlier application.

69. However, where priority is claimed from the basic application then it is inherent in the Madrid system that the goods and services in the international application are entirely

covered by the priority application and so each and every one of the goods and services enjoys the priority date of the basic application.

70. Indeed, section 35(5) of the Trade Marks Act 1994 (which gives the Secretary of State power to make rules relating to the claiming of priority) is replaced for international trade marks by a provision making it clear that the manner of claiming priority for international trade marks is determined in accordance with the Madrid Protocol and the Common Regulations: see Trade Marks (International Registration) Order 2008 (SI 2008/2206), Sch 2, para 3.

71. Furthermore, rule 6 of the Trade Marks Rules 2008 (SI 2008/1797), which relates to how priority is claimed and gives the registrar power to require documents to substantiate priority, does not apply to international trade marks: see Trade Marks (International Registration) Order 2008, Sch 1, Pt 2.

72. I therefore accept Mr Silcock's submission that the registrar (and likewise the Appointed Person) is bound to accept that where an international trade mark (UK) claims priority from the basic application (or registration) that claim must extend to each and every good covered by the international trade mark (UK). And there is no mechanism open to the registrar or to me to consider any challenge to the validity of the claim of priority. I therefore dismiss this ground of appeal.

73. I should say, however, that I see no reason why this rule does not play the other way as well. The interpretation of a good or service covered by the international trade mark must take into account the corresponding wording of the good or service in the basic application (or registration). Accordingly, the registrar should, so far as possible, construe the terms used in the international application in such a way as to ensure that those terms are not broader than the corresponding term in the basic application (or registration).

Conclusion

74. I have dismissed the appeal in respect of all the goods and services except "Consulting services in the field of design and development of fuel cell test stations, designing industrial and commercial hydrogen systems" where the services can go on to registration.

75. Mr Silcock, for the Respondent, sought off-scale costs on the basis of the Appellant's unreasonable conduct, in particular by introducing a new argument on appeal. I have allowed the new argument to be run, albeit I rejected it, and I generally find nothing unreasonable in the conduct of the Appellant.

76. The overall winner of the appeal is the Respondent although the Appellant has had success in relation to one service. Accordingly, I order the Appellant to pay the Respondent £3,000 by 4pm on 22 December 2025 as a contribution towards the Respondent's costs.

PHILLIP JOHNSON
THE APPOINTED PERSON
5 December 2025

Representation:
For the Appellant: Mr Andrew Norris KC (instructed by Edwin Coe LLP)
For the Respondent: Mr Ian Silcock (instructed by Wilson Gunn)