

O-271-16

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPEAL FROM A DECISION ON BEHALF OF THE REGISTRAR IN CONSOLIDATED PROCEEDINGS BETWEEN PETER HOGAN AND (1) MILBRO SPORTS LIMITED; AND (2) REMINGTON OUTDOOR (UK) LIMITED

IN THE MATTER OF TRADE MARK REGISTRATION NO. 708886 AND IN THE MATTER OF APPLICATION FOR REVOCATION NO. 500460 THERETO IN THE NAME OF PETER HOGAN

AND IN THE MATTER OF TRADE MARK REGISTRATION NO. 865266 AND IN THE MATTER OF APPLICATION FOR REVOCATION NO. 500461 THERETO IN THE NAME OF PETER HOGAN

AND IN THE MATTER OF TRADE MARK REGISTRATION NO. 877721 AND IN THE MATTER OF APPLICATION FOR REVOCATION NO. 500462 THERETO IN THE NAME OF PETER HOGAN

AND IN THE MATTER OF TRADE MARK REGISTRATION NUMBER 2544283 IN THE NAME OF PETER HOGAN AND THE APPLICATION FOR INVALIDITY NO. 500440

DECISION

Introduction

1. This is an appeal concerning four consolidated proceedings. It is an appeal from the decision in those consolidated proceedings of Ms Louise White, acting for the Registrar, dated 9 July 2015, (O-321-15) as corrected by a second decision dated 9 July 2015, (O-325-15) in which she held that:

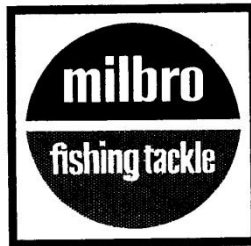
(1) Trade mark registration No. 865266 in respect of the mark MILBRO should be revoked with effect from 20 May 1990 save in respect of the following goods in Class 28:

Fishing tackle, namely hooks; bait boxes.

(2) Trade mark registration No. 708886 in respect of the mark MILBRO should be revoked with effect from 8 July 1990 save in respect of the following goods in Class 13:

Air guns and air gun accessories, namely moderators, darts, pellets, socks.

(3) Trade mark registration No. 877721 in respect of the mark



should be revoked with effect from 8 July 1990 save in respect of the following goods in Class 28:

Fishing tackle, namely hooks.

- (4) The application for invalidity No 500440 in respect of registered trade mark No. 2544283 for the mark MILBRO should be allowed in its entirety; and
- (5) Peter Hogan should pay to Milbro Sports Limited the sum of £1000.

2. The consolidated proceedings before the Hearing Officer consisted of:

- (1) An application under No 500 460 by Peter Hogan to revoke registration No 708 886 for the mark MILBRO in the name of Milbro Sports Limited. The registration was entered into the register on 14 July 1952 in respect of all goods in Class 13. The application sought revocation on grounds under section 46(1)(b) of the Trade Marks Act 1994 ("*the Act*") alleging that the mark has not been used in relation to Class 13 goods within a number of different five year periods.

Milbro Sports Limited filed a counterstatement in which it claimed it had made genuine use of the mark in respect of the following goods:

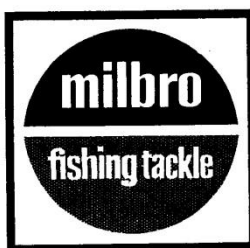
Air guns; air pistols; air gun pellets; pellets (ammunition); air gun darts; air pistol slugs; ammunition bags and tins; rifle slings, sheaths and moderators; air gun moderators; cleaning implements for air guns; sporting guns; air pistol slugs; slingshots; catapults (weapons-); bags adapted for guns; bullet and pellet moulds; mirrors (sighting-) for guns; non-optical and non-telescopic sights; rifle stocks; rifle straps; rifle and air gun covers; air gun slings; air gun silencers; pellet/ammunition pouches, tins or bags (specially adapted-).

- (2) An application under No 500 461 by Peter Hogan to revoke registration No 865 266 for the mark MILBRO in the name of Milbro Sports Limited. The registration was entered into the register on 5 June 1964 and registered in respect of the following goods: Fishing tackle (other than nets); and bait and gut, all for fishing

in Class 28. The application sought revocation on grounds under Section 46(1)(b) of the 1994 Act alleging that the mark has not been used on any of the goods for which it is registered within a number of different five year periods.

Milbro Sports Limited filed a counterstatement claiming genuine use of the mark in respect of the following goods in Class 28: bait pellets for fishing; fishing tackle, namely, catapults, catapults for spraying bait and bait boxes.

- (3) An application under No 500 462 by Peter Hogan to revoke registration No 877 721 for the mark



in the name of Milbro Sports Limited. The registration was entered into the register on 2 April 1965 and in respect of fishing tackle (other than nets); and bait and gut, all for fishing in Class 28. The application sought revocation on grounds under Section 46(1)(b) of the 1994 Act alleging that the mark has not been used on any of the goods for which it is registered within a number of different five year periods.

Milbro Sports Limited filed a counterstatement in which it claimed it had made genuine use of the mark in respect of the following goods in Class 28: bait pellets for fishing; fishing tackle, namely, catapults, catapults for spraying bait, bait boxes, fly hooks and specimen hooks.

- (4) An application under No 500 440 by Milbro Sports Limited to invalidate registration No 2 544 283 for the mark MILBRO in the name of Peter Hogan. The registration was entered into the register on 13 August 2010 and is registered in respect of catapult bait pouches sporting articles in Class 28. The application for invalidation is founded upon grounds under sections 5(1), 5(2)(a), 5(3) and 5(4)(a) of the Act relying on Milbro Sports Limited's earlier trade marks numbers 865 266 and 708 886 MILBRO and in respect of Section 5(4)(a) based upon use of the sign MILBRO in respect of goods in Classes 13 and 28 since 17 April 1997.

Peter Hogan filed a counterstatement denying the grounds of invalidation and requesting that Milbro Sports Limited prove use of its earlier trade marks relied upon in relation to slingshots; catapults (weapons-) after 1982 (earlier trade mark 708 886) and fishing tackle (other than nets); bait and guts, all for fishing after April 1997.

3. Both parties filed evidence in the consolidated proceedings.

4. By letter dated 30 April 2015 the Registrar stated as follows:

The decision in relation to this case will now be made on the basis of the evidence and/or submissions now accepted into the proceedings. The Hearing Officer will decide the case on the submissions currently before him or her. If however, the registered proprietor considers it has a fall-back position in the form of a limited specification, it should make this clear to the Hearing Officer (i.e. a limited specification should not be submitted for the first time at any appeal hearing). This will not represent a binding restriction of the specification and no inference will be made, by the Hearing Officer, if such limitation is, or is not offered.

5. By letter dated 5 May 2015 sent on behalf of Milbro Sports Limited it was made clear in respect of the trade mark specifications '*which are very old*' and '*cover "all goods in class"*' but that the counterstatements filed in the respective cancellation actions '*set out the specification which we feel fairly reflects our Client's use and for which the registration should be limited to.*' Revised specifications in line with those contained in the counterstatements were enclosed with the letter.

6. By letter dated 6 May 2014 sent on behalf of Peter Hogan the following was stated:

As regards the current specification of Trade Mark UK 2544283, the registered proprietor, Peter Hogan, respectfully proposes –

- amendment of the current specification for clarification purposes, namely punctuation so that the specification reads "*catapults; bait pouches; sporting articles*"; and
- on the basis that limitations offered at this stage in the proceedings do not constitute binding limitations, nor invite any inferences,
 - (i) the deletion of "bait pouches" from the specification, and
 - (ii) the limitation of the expression "sporting articles" to "sporting articles, namely catapults for hobby use"

so that the specification would read "*catapults; sporting articles, namely catapults for hobby use*".

7. No hearing was requested but both parties filed written submissions dated 28 May 2015. In the written submissions filed on behalf of Peter Hogan the following submission was made:

For the reasons stated hereinbefore and in view of the evidence attached hereto:

- UK 708886 must be declared at least partially invalid under Section 46(1)(b) and restricted to “*air guns; air pistols; air gun pellets; pellets (ammunition); air gun darts; ammunition bags and tins; rifle slings sheaths and covers; rifle stocks; air gun moderators; cleaning implements for air guns*” as of at least 06 July 1990.
- UK 865266 and UK 87721 must each be declared invalid under Section 46(1)(b) in their entirety, as of at least 06 July 1990.
- In the alternative, should the evidence of use filed by Mr Marshall be considered by the Office as evidence of use of UK 865266 and/or UK 877721 in relation to fishing hooks and bait boxes, then the respective scopes of UK 865266 and UK 877721 must each be restricted to “*fishing hooks and bait boxes*”.

The Hearing Officer’s Decision

8. For the purposes of this decision only certain parts of the Hearing Officer’s Decision are of relevance namely the findings under section 5(2)(a) of the 1994 Act in relation to the application under No 500 440 by Milbro Sports Limited to invalidate registration No 2 544 283 for the mark MILBRO in the name of Peter Hogan.
9. With regard to the assessment of the similarity of goods the Hearing Officer identified the relevant legal principles in paragraphs 29 and 30 of her Decision O-321-15. She went on in paragraph 30 of that Decision to identify the earlier goods as:

“Class 13:

Air guns and air gun accessories, namely moderators, darts, pellets, socks, cleaning cloths¹.

Class 28:

¹ It seems to me that the reference to ‘cleaning cloths should not have been included in paragraph 30 of the Decision. By a second corrective Decision the Hearing Officer removed the reference to ‘cleaning cloths’ from paragraphs 21, 25 and 43 for the reasons given in paragraph 22 of the Decision see Decision O-325-15. It would appear that the same correction should have been made to paragraph 30 of the Decision. However nothing turns on this for the purposes of the present appeal.

Fishing tackle, namely hooks; bait boxes.”

She went on to identify the challenged goods as:

“Class 28:

Catapult bait pouches sporting articles.”

10. The Hearing Officer’s findings in relation to similarity of goods were set out in paragraphs 31 to 35 as follows:

31. It is noted that punctuation is missing in the later goods. However, it is considered appropriate to interpret the specification to read: catapult; bait pouches; sporting articles.

32. The earlier class 13 goods are weapons and related accessories. In particular, the air guns can be used in sports such as hunting and other shooting sports, where proficiency such as speed and accuracy are measured. The later goods are catapults. These can also be used for leisure and accuracy and speed assessed. There is therefore a similarity as regards purpose here. Channels of trade may also coincide as it is considered to be entirely feasible for a shop selling guns to also sell catapults. They are considered to be similar to a moderate degree.

33. In respect of sporting articles, the term has not been fully qualified and so is broad. It can include the aforementioned catapults and so is at least similar to this extent to the earlier term. It can of course also include items which are not similar. However, PH has offered a fall back specification whereby the term is qualified as being sporting articles, namely catapults for hobby use. This does not help PH. Indeed the analysis from the previous paragraph can also be applied here as regards purpose and channels of trade. They are moderately similar.

34. The later bait pouches are clearly highly similar to the earlier bait boxes as each is containers for fishing bait. Further, the later term is similar to the earlier hooks as they are both fishing equipment and so the end user will coincide as will the channels of trade as both are for use in the same pastime activity.

35. PH’s fall back position has already been mentioned. This does not help its case in any way as it reads: Catapults; sporting articles namely catapults for hobby use. It does not distinguish its goods from those of MSL. If anything, the additional

clarification only serves to bring the respective goods closer together.

11. In paragraphs 36 to 38 the Hearing Officer considered the issue of the level of attention paid by the average consumer. Having set out the relevant law in paragraphs 36 and 37 for the Hearing Officer went on to conclude as follows:

38. The relevant consumer is likely to be comprised of the public at large, those with the requisite licences to fish/shoot and the professional sportsman. They would generally be sold in specialist shops or on specialist websites. The goods in question range in price from relatively cheap (hooks) to relatively expensive (air guns) and irrespective of price will likely be a fairly considered purchase as acquiring the correct equipment will be important. The level of attention expected to be displayed is considered to be at least medium.

12. With regard to the assessment of the likelihood of confusion the Hearing Officer stated the position very shortly in paragraph 41 of her Decision as follows:

In these proceedings, the respective marks are identical and the goods have been found to be similar, some moderately so, some highly so. Further, the earlier trade marks have a high degree of distinctive character. It is considered that confusion is not only likely, it is inevitable. The invalidation action succeeds in its entirety.

13. The Hearing Officer then concluded in paragraph 42 by indicating that as Milbro Sports Limited had been successful under Section 5(2)(a) of the Act there was not need to consider the remaining grounds of invalidation which she considered did not materially advance Milbro Sports Limited's case.

14. At paragraphs 44 and 45 the Hearing Officer included some 'Final Remarks' as follows:

44. It has been noted that there has been some suggestion by PH that MSL have acquiesced as regards its invalidation action. Section 48 of the Trade Marks Act 1994 states as follows:

“48 Effect of acquiescence

(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right –

(a) to apply for a declaration that the registration of the later trade mark is invalid, or
(b) to oppose the use of the later trade mark in relation to the goods or services in relation to which it has been so used, unless the registration of the later mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark.”

45. According to his own evidence, PH began to show an interest in producing catapults in February 2010 and applied to register MILBRO in April of the same year. MSL filed to invalidate PH’s trade mark in May 2014. Clearly a five year period required by Section 48 of the Act had not elapsed. PH suggests that MSL should have filed to oppose its trade mark (and indicated that it intended to do so). However that it did not pursue this course of action is a matter for them. In any case, they have not been shown to have acquiesced and so this matter is set aside.

The Appeal

15. On 3 August 2015 Franks & Co Limited on behalf of Peter Hogan (hereinafter “*the Appellant*”) filed an appeal against the Decision under Section 76 of the Act. The appeal is solely concerned with the finding of invalidity in respect of registered trade mark No. 2544283.
16. In paragraph 30 of the Grounds of Appeal it was expressly accepted that on the basis of the evidence of use filed on behalf of Milbro Sports Limited (hereinafter “*the Respondent*”) the Hearing Officer was correct to make the findings she did as set out in sub-paragraphs (1) to (3) in paragraph 1 above.
17. In addition it was accepted in paragraphs 31 to 33 of the Grounds of Appeal that the Hearing Officer was correct to find:
 - (1) That the Appellant’s and Respondent’s trade marks are, as word marks, visually and orally identical and that the relevant provision on which to base validity was Section 5(2)(a) of Act;
 - (2) That the ‘*bait pouches*’ in the Appellant’s original specification are highly similar to the Respondent’s ‘*bait boxes*’ maintained in the specification of earlier trade

mark No. 885266 and should be excised from the Appellant's specification under Section 5(2)(a); and

(3) That '*sporting articles*' in the Appellant's original specification are insufficiently qualified to prevent overlap with the Respondent's '*fishing hooks*' and '*bait boxes*' goods maintained in the specification of earlier trade mark Nos. 865266 and 877721 and should be excised from, or restricted in the Appellant's specification under Section 5(2)(a).

18. There is no suggestion in the lengthy Grounds of Appeal that the Hearing Officer did not identify the correct legal basis for the assessment that she had to make rather the appeal is in substance that:

(1) The Hearing Officer made an improper assessment of the similarity of the goods and in particular was wrong in principle to find that the Appellant's '*catapults*' in class 28 bear any similarity to the Respondent's '*air guns*' maintained in class 13; and

(2) The Hearing Officer failed to carry out a proper global assessment of the likelihood of confusion (bearing in mind the interdependence of all relevant factors) and in particular the Hearing Officer failed to acknowledge the Appellant's '*earlier rights and goodwill*' in respect of '*catapult*' goods in class 28.

19. No Respondent's Notice was filed.

20. By letter dated 29 September 2015 the UK IPO indicated that the marks previously owned by the Respondent, Milbro Sports Limited (which went into liquidation during the pendency of the proceedings) had been assigned to Remington Outdoor (UK) Limited by the liquidators. In accordance with the usual practice, the UK IPO, on the same date, wrote to Remington Outdoor (UK) Limited to notify them of the appeal in the consolidated proceedings and to seek confirmation that it had: (1) had sight of any relevant forms; (2) stood by the grounds and/or counterstatements and that where the name of the original proprietor appears that should be read as though it was in their name; and (3) were aware of and would accept liability for any costs. By letter dated 12 October 2015 such confirmation was received.

21. On the basis of the confirmation and in line with the Decision of Geoffrey Hobbs QC sitting as the Appointed Person in Daawat Trade Mark [2003] RPC 11 I therefore direct that Remington Outdoor (UK) Limited be joined as an additional party i.e. an additional respondent to the appeal. For the purposes of this decision references to 'the Respondent' refers to Milbro Sports Limited and references to 'the Respondents' refers to Milbro Sports Limited and Remington Outdoor (UK) Limited.

22. None of the parties indicated that they wished to be heard on the appeal. No written submissions were filed in relation to the substance of the appeal.

Standard of review

23. As correctly recognised in the Grounds of Appeal the appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he has reached the wrong decision 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 was clearly wrong. See Reef Trade Mark [2003] RPC 5, and BUD Trade Mark [2003] RPC 25.

24. In Fine & Country Ltd v Okotoks Ltd (formerly Spicerhaart Ltd) [2013] EWCA Civ 672; [2014] FSR 11 Lewison LJ said:

50. The Court of Appeal is not here to retry the case. Our function is to review the judgment and order of the trial judge to see if it is wrong. If the judge has applied the wrong legal test, then it is our duty to say so. But in many cases the appellant's complaint is not that the judge has misdirected himself in law, but that he has incorrectly applied the right test. In the case of many of the grounds of appeal this is the position here. Many of the points which the judge was called upon to decide were essentially value judgments, or what in the current jargon are called multi-factorial assessments. An appeal court must be especially cautious about interfering with a trial judge's decisions of this kind. There are many examples of statements to this effect. I take as representative Lord Hoffmann's statement in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416 , 2423:

‘Secondly, because the decision involves the application of a not altogether precise legal standard to a combination of features of varying importance, I think that this falls within the class of case in which an appellate court should not reverse a judge's decision unless he has erred in principle.’

25. This approach was reiterated by the Court of Appeal in Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115]. Moreover in paragraph [115] Lewison LJ said:

115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties

and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: see *Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

26. The position has been more recently set out in the decision of Geoffrey Hobbs Q.C. in ALTI Trade Mark (O-169-16) at paragraphs [19] to [20] where he referred to the general applicability of the observations of Lord Neuberger PSC in *Re B (a child) (Care Order Proceedings)* [2013] UKSC 33 at paragraphs [93] and [94]:

[93] There is a danger in over-analysis, but I would add this. An appellate judge may conclude that the trial judge's conclusion on proportionality was (i) the only possible view, (ii) a view which she considers was right, (iii) a view on which she has doubts, but on balance considers was right, (iv) a view which she cannot say was right or wrong, (v) a view on which she has doubts, but on balance considers was wrong, (vi) a view which she considers was wrong, or (vii) a view which is unsupportable. The appeal must be dismissed if the appellate judge's view is in category (i) to (iv) and allowed if it is in category (vi) or (vii).

[94] As to category (iv), there will be a number of cases where an appellate court may think that there is no right answer, in the sense that reasonable judges could differ in their conclusions. As with many evaluative assessments, cases raising an issue on proportionality will include those where the answer is in a grey area, as well as those where the answer is in a black or a white area. An appellate court is much less likely to conclude that category (iv) applies in cases where the trial judge's decision was not based on his assessment of the witnesses' reliability or likely future conduct. So far as category (v) is concerned, the appellate judge should think very carefully about the benefit the trial judge had in seeing the witnesses and hearing the evidence, which are factors whose significance depends on the particular case. However, if, after such anxious consideration, an appellate judge adheres to her view that the trial judge's decision was wrong, then I think that she should allow the appeal.

27. It is necessary to bear these principles in mind on this appeal.

Decision

The error in the assessment of similarity Ground of Appeal

28. The principles governing assessment of the similarity of goods and services were identified by the Court of Justice of the European Union (“*CJEU*”) in Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn-Meyer Inc at paragraph [23] (emphasis added):

In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, **all the relevant factors relating to those goods or services themselves should be taken into account**. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

29. Advocate General Jacobs in Case C-39/97 Canon (above) referred to, without disapproval, the factors for consideration in assessing similarity identified by Jacob J. in British Sugar Plc v. James Robertson & sons Ltd [1996] RPC 281 as follows:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

I have reproduced the factors identified by Jacob J. as the quotation contained in paragraph 30 of the Decision was unfortunately incomplete in that it omitted (a) above. However, for the reasons that will be apparent from my finding below, the omission is not to be regarded as a material error. Moreover this omission is not identified in the extensive Grounds of Appeal and indeed, in my view quite correctly, the Appellant accepted that the Hearing Officer had identified the correct legal principles to be applied to the assessment that she was required to make.

30. The factors identified by Jacob J. in British Sugar (above) are non-exhaustive and are to be regarded as helpful practical guidelines for what is a ‘global’ assessment. They are not and should not be regarded as ‘the test’ for similarity to be rigidly applied, whether by way of a check list or otherwise, as suggested by the Appellant in his Grounds of Appeal. Such a finding would be contrary to the well established case law of the CJEU.
31. As regard to the assessment of similarity made by the Hearing Officer it is clear from paragraph 32 of her Decision that she considered that the goods were similar to a moderate degree. Having identified the correct legal approach to the assessment she explained the reasons for that finding by reference to Jacob J.’s factors (a) and (d) above. It seems to me that this was a finding that the Hearing Officer was entitled to make on the materials before her.
32. I do not accept that the Hearing Officer, in reaching that finding, ‘reclassified’ the catapults specified by the Appellant in Class 28 to Class 13. It is clear from her findings in paragraph 30 of her decision that the assessment she was making was between Class 13 goods (and in particular airguns) on the one hand and catapults in Class 28 on the other. Moreover, it is also clear from paragraph 30 that the Hearing Officer was making the relevant assessment for the purposes of the invalidity proceedings *only* by reference to the limited specification for which she had found that the Respondent had satisfied the requirement for proof of use under the Act.
33. I also do not accept that it can be said that the Hearing Officer failed to consider the statutory regime applicable, even if it could be said to be relevant, to the sale and possession of air guns in circumstances where: (a) it would not appear that any such statutory/regulatory materials are contained in the evidence or were the subject of any submissions that were before the Hearing Officer; and (b) from her assessment of the average consumer in paragraph 38 of her Decision the Hearing Officer clearly had in mind that licences may be required to shoot (or fish).
34. Nor do I accept that she erred in her assessment of the respective channels of trade by failing to take into account either that: (a) air guns cannot legally be sold via the internet; and/or (b) the Appellant only sells his catapults via the internet. With regard to the first point there does not seem to have been any direct evidence on the issue before the Hearing Officer and in any event, whilst reference is made in paragraph 38 of her Decision to “*specialist shops*” and “*specialist websites*” when considering the identity of the relevant average consumer for all the goods with which she was concerned, in paragraph 32 when considering the issue of similarity of airguns and catapults the Hearing Officer restricted her assessment to “*shops*”. With regard to the second point for the purposes of the assessment that the Hearing Officer was required to make (i.e. normal and fair usage of the mark with respect to the specified goods) the fact that the Appellant has only sold his catapults via the internet is irrelevant. In

any case it is apparent from the evidence that catapults can be and are sold both in shops and via the internet (generally being specialist shops or specialist websites).

35. With regard to the fall back specifications referred to in paragraphs 33 and 35 of the decision the Grounds of Appeal simply state that the Hearing Officer was wrong with no further elaboration. In these circumstances and having reviewed the relevant paragraphs for myself it seems to me that the Hearing Office was entitled to take the view that she did.

The error in the global assessment Ground of Appeal

36. There are in substance two errors of principle identified by the Appellant with regard to the approach taken by the Hearing Officer to the global assessment. First, that she failed in making that assessment to take into account ***the Appellant's*** 'earlier rights and goodwill' in relation to catapults; and second, that there was no relevant evidence of actual confusion.
37. With regard to the assessment that the Hearing Officer was required to make this was in the context of an application for invalidity of the Appellant's trade mark registration No 2544283 which was entered onto the register on 13 April 2010. The 13 April 2010 is therefore the relevant date for the purposes of the assessment that the Hearing Officer was required to make. The trade marks relied upon in support of that application for invalidity under, *inter alia*, Section 5(2)(a) of the Act i.e. the earlier marks were trade mark registration No 708886 which was entered onto the register on 14 July 1952; trade mark registration No 865266 which was entered into the register on 5 June 1964; and trade mark registration No 877721 which was entered into the register on 2 April 1965.
38. As noted in paragraph the Appellant accepts i.e. there is no challenge to the findings of the Hearing Officer that the earlier marks relied upon were validly registered in respect of certain goods as set out in sub-paragraphs (1) to (3) in paragraph 1 above.
39. Whilst it is correct to say that for the purposes of any assessment under Section 5(2)(a) the Hearing Officer was required to consider any acquired distinctiveness or reputation of the earlier marks relied upon, it is not correct that any reputation or acquired distinctiveness in relation to the use of *the later mark*, in the present case said to arise through the use of the later mark in relation to catapults, is or can be relevant in the way suggested by the Appellant (*c.f.* Case C-498/07 P *Aceites del Sur-Coosur SA, formerly Aceites del Sur SA v. OHIM*).
40. In fact, in the present case, as found by the Hearing Officer at paragraph 39, there was no evidence of acquired distinctiveness or reputation with respect to the limited goods in respect of which the earlier registrations were maintained.

41. Moreover, given the date identified in paragraph 37 above and the evidence referred to in paragraph 45(1) below, it is not understood on what basis it can be said on behalf of the Appellant that there are relevant 'earlier rights' in relation to catapults for the purposes of the assessment under Section 5(2)(a) in the invalidity proceedings under appeal.
42. With regard to the submission that there was no relevant evidence of actual confusion, as a preliminary observation it is worth noting that it is an assessment of the *likelihood* of confusion that is required to be made under Section 5(2) of the Act.
43. In the present case the Hearing Officer found that confusion was '*not only likely*' but was *inevitable*' (paragraph 41 of the Decision). The Appellant submits in paragraph 49 of the Grounds of Appeal that the finding '*is simply not borne out in any way by the actual evidence filed in the proceedings by the parties*' and seeks to suggest on the basis of some sort of concurrent use that the absence of such evidence is conclusive.
44. I do not accept this. As has been made clear in a number of cases by Arnold J. including in his judgment, in the context of a claim for trade mark infringement, in Jack Wills Ltd v House of Fraser (Stores) Ltd [2014] ETMR 28 at paragraph [99] the absence of confusion is not fatal to a claim under Section 10(2) of the Act. The same is equally true in the context of opposition or invalidity proceedings under Section 5(2) of the Act. That is all the more so given that such an assessment may need to be made in circumstances where neither side is actually using the mark for the relevant i.e. specified goods as at the relevant date for the purposes of the assessment.
45. Moreover, I do not find the absence of any evidence of confusion on the facts of the present case particularly surprising given: (1) the length of time of the concurrent use (which could have only begun from the date when the Appellant first used the mark and which on the basis of the Appellant's evidence only commenced on or about the time that the trade mark was filed); (2) the scale of use involved; and (3) the well-recognised difficulties involved in identifying instances of actual confusion. I also note that in the evidence filed on behalf of the Appellant, including a witness statement from Peter Hogan dated 20 February 2015, did not include any evidence to the effect that the Appellant was unaware of any such confusion.
46. Further in this connection it is to be noted that: (1) in my view the material that was before the Hearing Officer was not such as to establish concurrent use of the type referred to in Case C-245/02 Anheuser-Busch Inc.v. Budějovický Budvar, národní podnik; and (2) the Hearing Officer rejected the suggestion that the Respondent had acquiesced as regards the invalidation action (paragraphs 44 and 45) such finding not being the subject of the present appeal.
47. In the circumstances, it seems to me that the absence of evidence of confusion does not undermine the findings of confusion made by the Hearing Officer in the present

case on the basis that: (1) the marks were identical; (2) the goods were moderately or highly similar; and (3) the earlier marks had a high degree of inherent distinctive character. In my view taking these factors together as the Hearing Officer was required to do she was entitled to make the findings that she did. In this connection I would note that (a) the findings in sub-paragraphs (1) and (2) were not challenged on this appeal; and (b) the finding by the Hearing Officer that confusion was ‘*inevitable*’ was not strictly necessary in circumstances where the Hearing Officer had also made the finding that confusion was ‘*likely*’ (paragraph 41 of the Decision) however nothing turns on this for the purposes of the present appeal.

Conclusion

48. In the circumstances, it does not seem to me that the Appellant has identified any material error of principle in the Hearing Officer’s analysis or that the Hearing Officer was plainly wrong. In the result I have decided that the Hearing Officer was entitled to make the findings that she did.
49. In the result the appeal fails.
50. Neither side has asked for any special order as to costs. Since the appeal has been dismissed, the Respondents are entitled to their costs of the Appeal. Neither of the Respondents filed any written submissions and therefore their costs which would have included reviewing the lengthy Grounds of Appeal would have been nominal. I will therefore make a modest award of £50 to each of the Respondents for the costs of the appeal. With respect to Milbro Sports Limited this award of £50 should be added to the costs of £1000 awarded by the Hearing Officer (i.e. £1050 in total). I therefore order that Peter Hogan to pay (1) £50 to Remington Outdoor (UK) Limited; and (2) £1050 to Milbro Sports Limited within 14 days of the date of this decision.

Emma Himsworth Q.C.

Appointed Person

26 May 2016