

In the matter of Trade Mark Application No.3248505 by Brendan Francis Carne to register a series of trade marks comprising SILVER SPECTRE in Class 12

and

Opposition No. 410692 thereto by Peter Ola Blomqvist (the Opponent)

and

In the matter of an Appeal to the Appointed Person by the Opponent against the Decision of the Hearing Officer O-632-18 for the Registrar, The Comptroller General dated 8 October 2018

DECISION

Introduction

1. On 6 August 2017, the Applicant applied under No. 3,248,505 to register a series of two marks comprising (i) SILVER SPECTRE and (ii) Silver Spectre for the following goods in Class 12: ‘Motor Cars’. The Application was published for opposition purposes on 18 August 2017.
2. The Opponent opposed under s.5(2)(b) of the Trade Marks Act 1994 (as amended, “the Act”), relying on his UK registered trade mark No. 2,167,102 for the word mark SPECTRE with a date of registration of 30 July 1999. As at the date of the Hearing Officer’s decision (8 October 2018) the expiration date of that registration (19 May 2018) had passed without the registration being renewed. However, the registration was subsequently renewed until 19 May 2028.
3. Since the Opponent’s mark completed its registration procedure more than 5 years prior to the publication date of the application, it was subject to the proof of use conditions as set out in s.6A of the Act. The Opponent made a statement of use only in relation to “motor land vehicles” and accordingly this formed the basis of the Opposition.
4. For reasons which I explain below, it will be necessary to consider aspects of the procedural history in more detail. However, by way of introduction it is sufficient to state that the principal issue in the Opposition was whether the Opponent’s evidence proved genuine use of his mark in the relevant five year period of 19 August 2012 to 18 August 2017.

5. Although the Opponent was professionally represented, both his written submissions and his witness statement were filed in the form of letters addressed to a representative of the UK IPO who had been corresponding with him about the Opposition. In his Counterstatement, the Applicant requested proof of use and made various observations about the Opposition which I will deal with below. Beyond those observations, the Applicant filed no evidence or written submissions. Neither party requested a hearing, so the Hearing Officer proceeded to reach her Decision on the papers which had been filed.
6. In her decision O-632-18 of 8 October 2018, the Hearing Officer Emily Venables decided that the Opponent's evidence was insufficiently solid to show there had been genuine use of the mark on or in relation to motor land vehicles. Accordingly, the Opposition was dismissed.

The Appeal

7. The Opponent appeals. Annexed to his TM55P were some relatively lengthy "Grounds of Appeal and Case in Support" which reveal two principal parts to the appeal:
 - 7.1. First, the Appellant says the Hearing Officer erred in her assessment of the evidence which was before her and/or in her assessment of the evidence required to prove genuine use;
 - 7.2. Second, the Appellant applies to adduce additional evidence on this appeal 'by way of corroboration, elaboration and clarification of the original evidence'.

Standard of Review

8. This appeal is by way of review such that the usual principles set out in *Reef Trade Mark* [2003] RPC 5 and other cases (including *BUD Trade Mark* [2003] RPC 25 and *Fage UK Ltd v Chobani UK Ltd* [2014] ETMR 26) apply. The same points are made at [5]-[6] of the judgment of Daniel Alexander Q.C. (sitting as a Deputy Judge of the High Court) in *Digipos Store Solutions Group Ltd v Digi International Inc.* [2008] RPC 24. I also take into account the more recent review of the appellate approach which Mr Alexander Q.C. carried out, this time as the Appointed Person, in *Talk for Writing Trade Marks* O-017-17 at [14] to [50] and his summary of the

principles at [52]. I will not lengthen this decision by citing any of these now well-known authorities.

The application to adduce further evidence

9. The principles applicable to this application are now well settled: for example, see the analysis of Henry Carr J. in *Consolidated Developments Limited v Cooper* [2018] EWHC 1727 at [19]-[32] leading to his summary of the principles at [33]:

“33. The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:

i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;

ii) the Ladd v Marshall factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;

iii) it is useful to have regard to the Hunt-Wesson factors;

iv) relevant factors will vary, depending on the circumstances of each case. Neither the Ladd v Marshall factors nor the Hunt-Wesson factors are to be regarded as a straightjacket;

v) the admission of fresh evidence on appeal is the exception and not the rule;

vi) the Gucci decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and

vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence.

10. To understand that summary, however, one must have in mind, first, the *Ladd v Marshall* factors, namely:

“i) it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;

ii) the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and

iii) the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.”

11. Second, the *Hunt-Wesson* factors, listed as relevant to the exercise of the discretion whether to allow fresh evidence on an appeal from a trade mark opposition:

“i) whether the evidence could have been filed earlier and, if so, how much earlier;

ii) if it could have been, what explanation for the late filing had been offered to explain the delay;

iii) the nature of the mark;

iv) the nature of the objections to it;

v) the potential significance of the new evidence;

vi) whether or not the other side would be significantly prejudiced by the admission of the evidence in a way which could not be compensated, e.g. by an order for costs;

vii) the desirability of avoiding multiplicity of proceedings; and

viii) the public interest in not admitting onto the register invalid marks.”

12. When applying these principles to the application to adduce fresh evidence on this Appeal, it was clear to me that the fresh evidence divides very clearly into two very separate categories and that very different considerations apply to each of those categories.

13. In the first category, I place the page on YouTube at the link set out in POB1 and the video itself, the better copies of pages and images in existing exhibits POB2, POB3 and POB6.

14. As to this first category, I concluded it was appropriate to allow these pieces of evidence to be adduced on appeal, to allow defects in the original evidence to be corrected, as I explain in greater detail below.

15. In the second category, I place everything else. It is not necessary to set out what ‘everything else’ comprises, for a number of reasons but primarily because I reserved making any decision as to whether to admit or not admit this second

category pending the outcome of my consideration of the position with just the first category being taken into account. However, I record that all of this material was available to Mr Blomqvist, it could and should have been filed when he filed his evidence in the Opposition and that essentially there is no good reason why it was not filed at the appropriate time. In what follows, I put all the material in this second category out of my considerations (unless I state explicitly to the contrary).

Procedural History

16. I will now explain why it is necessary to delve into aspects of the procedural history.
17. The Opponent filed his ‘witness statement’ in the somewhat informal form of a letter dated 12th April 2018. It comprised a short summary of the use relied upon followed by a list of ‘the exhibits used to verify the trade mark use’. The Opponent’s summary began as follows:

Spectre cars are niche sports cars as identified in exhibits POB1 and POB2 which shows respectively the 2015 model P107 and the 2018 version which is currently being built by Elite Motorsport.

18. Exhibits POB1 and POB2 were listed as, respectively ‘The 2015 Spectre Sports Car and YouTube video’ and ‘The 2018 Spectre Sports Car’. Five further exhibits were listed along with descriptions, although in fact there were 8 exhibits, all of them comprising black and white photocopies of varying quality.
19. Exhibit POB1 is headed ‘The 2015 Spectre Sports Car and YouTube video’ but comprises three photographs of a car (one of which appears to be on some sort of track and the other two in an urban environment off a road). Underneath the third photograph was the text ‘New Spectre car on YouTube in 2015’ followed by a URL on youtube.com and then the further text ‘Video showing newly road registered Spectre prototype on 5th October 2015’. Neither an image of the youtube page on which the video itself is featured, nor the video itself formed part of the exhibit.
20. Exhibit POB2 is headed ‘The 2018 Spectre Sports Car’ and comprises three black and white images. The first two images show a sports car and, due to the quality of the photocopied images, it is difficult to tell whether the images show an actual car or some sort of computer generated image of a car. The third image appears to

show an actual car because a male is shown in the driving seat with his hands on the steering wheel. Both doors are open (they swivel upwards) as are the bonnet and the central rear panel. None of these images feature the word Spectre, and where the registration plate can be seen, it bears the words CP Automotive.

21. On receipt, the witness statement was reviewed in the normal course by the UK IPO. On 27 April 2018, the UK IPO wrote, noting that exhibit POB8 had not been referred to in the body of the statement and that the exhibit required a heading or front sheet. The Opponent was invited to attend to these deficiencies and suitably amended documents were filed on 3 May 2018.
22. To my understanding, the nature of this review is described in the Trade Marks Registry Work Manual at section 4.8.6 in the following terms:

Defective evidence

On receipt, the Tribunal will scrutinise the evidence for defects in its format. Defects may arise in the heading, content itself, exhibits or attestation. The defect(s) will be brought to the attention of the filer and an opportunity will be given to put matters in order. Under no circumstances will the Tribunal correct evidence on behalf of the filer; to do so may bring the admissibility of the evidence, particularly if it goes to appeal, into question.

A copy of the evidence will be kept on the dispute file by the Tribunal and the original evidence will be returned to the filer who will be invited to remedy matters within a specified period. Generally this will result in a suspension of the proceedings. Any amendments to the text of the evidence must be initialled by the declarant or deponent and the witness and returned to the Tribunal.

Ultimately the admissibility of evidence or otherwise will be a matter for the Tribunal and any appellate body. Where defects are minor, the Tribunal may accept the evidence as filed, but caution the filer that his evidence may be considered inadmissible at a later stage.

23. It is no part of the UK IPO's function to give advice to a party on how to improve its evidence. However, the extract from the Work Manual I have quoted seems to me to reflect a stated policy of correcting defects in format including defects in heading, the content itself, exhibits or attestation.
24. The Opposition then proceeded to a decision on the papers.

The Hearing Officer's assessment of the evidence of use

25. Having set out the background in the usual way, the Hearing Officer turned to assess the evidence of use in Mr Blomqvist's somewhat informal witness statement. For present purposes, I will only address the aspects of her assessment where I consider there was either an error or unfairness.

26. In relation to exhibit POB1 the Hearing Officer said this:

"10. Exhibit POB1 is labelled "The 2015 Spectre Sports Car and YouTube video". It consists of three photographs of an unbranded car, all from different angles, one of which displays the vehicle registration number HX65 LLO. None of the photographs show a make or model displayed on the vehicle, nor are they dated. Page two of the exhibit provides a link to a YouTube video, described as "showing [the] newly road registered Spectre prototype on 5th October 2015". As the video has been referred to by way of a link rather than being submitted into evidence in media format, I must disregard it. Nowhere in the exhibit, except in the opponent's own words, is the earlier mark visible."

27. The Hearing Officer's description of what can be seen on the two sheets which comprise POB1 is accurate. However, it must have come as something of a surprise to the Appellant that the YouTube video was disregarded altogether. In modern commercial communications between co-operative parties, if a link to a video is sent for a particular purpose (and the link is apparently trustworthy), the sender of the link normally assumes that the link is clicked on and the video viewed. Of course, if the recipient responds and gives a particular reason why he or she has not clicked on the link and has not seen the video, then the sender has the opportunity to address the issue and find a different way to send the video or similar content to the recipient.

28. The problem here, as it seems to me, is a combination of an incomplete review of defects in this evidence and the lack of a hearing. In terms of the review, the provision of a link to the YouTube video was plainly a defect so far as the UK IPO is concerned, but not a defect which was apparent to the Appellant. If a hearing had been attended, the Hearing Officer would have been bound to point out to the Appellant that the link had not been followed and so she had not seen the video. On being so informed, I infer that the Appellant is highly likely to have accessed the YouTube video on a phone, tablet or laptop and asked the Hearing Officer to

view it there and then. Unfortunately, the Appellant only learnt of the defect in his POB1 on receipt of the Hearing Officer's Decision.

29. In these circumstances, I viewed the video on YouTube, *de bene esse*. It is evident that the first photograph in POB1 is a still from the video, which shows this car with registration plate HX65 LLO being driven and then parked in a line-up of cars on some sort of race track. The final few seconds of the video show the car being driven around a public roundabout. The car is silver in colour albeit with very significant black zebra-type striping all over. The word Spectre is not visible on the car at any point in the video. However, it is the listing for the video and the comments beneath on the YouTube page which are important for present purposes. The video is captioned "FIRST LOOK: Spectre Angel prototype" and identified as published on 1 October 2015. Underneath that, it is explained: "A prototype of the Spectre Angel at Goodwood Breakfast Club". There are not a large number of comments on this video, but one reads "I was at Goodwood yesterday as well and saw the Spectre, it looks amazing."
30. So, despite the fact that 'Spectre' is not visible in the video on the car, it is clear that members of the public identified the car at the time as a Spectre, or Spectre Angel prototype.
31. In relation to exhibit POB2, the Hearing Officer made the following assessment:
- 11. Exhibit POB2 is labelled "The 2018 Spectre Sports Car". It consists of three computer-aided design ("CAD") images, in black and white, of a car, described by the opponent as the 2018 Spectre model. The images are undated, and the car shown in them is unbranded, except a number plate which reads "C2P AUTOMOTIVE". Again, nowhere in the exhibit is the earlier mark visible.*
32. Even looking at the rather poor black and white photocopy of this exhibit, it is apparent that these are not CAD images, because the third image shows a live person sitting in the driver's seat of the car, a point which establishes to my mind that a real car existed, identified by Mr Blomqvist in this evidence as the 2018 Spectre Sports Car. I take the Hearing Officer's point, however, that 2018 lies outside the relevant 5 year period.
33. In relation to exhibit POB3, the Hearing Officer said this:

12. Exhibit POB3 is labelled “Individual Approval Certificate (IVC) for Spectre Angel P107”. Its content is indistinct but I am able to make out the make and model as “SPECTRE ANGEL (P107)”, the year of manufacture as 2013, and a date of 23 June 2015 (although I cannot tell what this date specifically relates to).

34. Again, even on the poor black and white photocopy, I can (just about) make out that the date of 23 June 2015 relates to the date of issue of this Individual Approval Certificate for the Spectre Angel (P107). To be fair to the Hearing Officer, in the Appeal Documents I was also supplied with a much better photocopy of this document. I also note that the engine number recorded in this document ‘74767347-S001’ is the same as given in exhibit POB4, a Certificate of Newness of a Ford Mustang SVT engine, that certificate being signed and dated 9th March 2010..
35. In relation to exhibit POB6 (a poor photocopy of just part of a Registration Certificate) I was also supplied in the Appeal Documents with a full and much better photocopy of the UK Registration Certificate for HX65 LLO, date of first registration being 1 September 2015, which reveals that the Registered Keeper of the vehicle is Mr Mark Roonan.
36. Having conducted her assessment of the evidence, the Hearing Officer then directed herself as to the relevant legal principles, by reference to ss 6A and 100 of the Act, an extract from the judgment of Arnold J. in *Walton International Ltd v Verweij Fashion BV* [2018] EWHC 1608, extracts from decisions of Mr Daniel Alexander Q.C. sitting as the Appointed Person in *Awareness Ltd v Plymouth City Council* (Case BL O/230/13), and in *Guccio Gucci SpA v Gerry Weber International AG* (Case BL O/424/14), an extract from the decision of Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd* (Case BL O/404/13) and finally, an extract from the Judgment of Mr Henry Carr Q.C. (as he then was) in *Healey Sports Cars Switzerland Ltd v Jensen Cars Limited* [2014] EWHC 24. All of these extracts were entirely apposite (her reference to *Healey* concerning the relevance of a 2018 Spectre model to a 5 year period ending in August 2017). Overall, this was an excellent exposition of the relevant legal principles.

37. With the relevant legal principles in mind, the Hearing Officer then proceeded to state her conclusions:

28. In the present case, there are not even any press releases, advertisements or websites in operation to show that the 2018 Spectre model is about to be marketed. It is not apparent where the three images at exhibit POB2 are taken from (be it a website or a brochure, for example), or whether the public has seen them. Similarly, the brochure at exhibit POB8 does not evidence where it was made available (if at all), or how many were produced, issued or requested. These exhibits are wholly unconvincing and call into question whether they were in fact intended to create a market for the goods amongst potential customers for motor vehicles. To me, they do not build a picture of goods that are about to be marketed, not just because the evidence is minimal, but because in the context of new or upcoming motor vehicles, marketing material would exist and little is provided. In any event, the relevant period ended in August 2017, I am unaware of when in 2018 the car was to be launched, and neither of the exhibits are dated. Consequently, they do not show genuine use of the mark.

29. The only exhibits that are dated within the relevant period are the YouTube video at page 2 of exhibit POB1 (which I have already disregarded), the Individual Approval Certificate and the UK Registration Certificate. The certificates are internal documents that would not be available to the public and, as such, do not show use by way of real commercial exploitation of the mark on the market for the relevant goods.

30. Contrary to the witness statement, there is no evidence of any other vehicles registered in the UK, any other sales, or a community of “devoted enthusiasts”. I would expect there to be, for example, invoices for previous sales, a website or some form of advertising platform, discussion groups for those interested in the cars. None of this has been evidenced. As far as the evidence shows, one vehicle (as a ‘kit car’) has been sold to one purchaser outside the relevant period. I am not satisfied that this maintains or creates a share in the market of the goods.

31. Taking into account all the circumstances of the case, the evidence filed is insufficiently solid to show that there has been genuine use of the mark on or in relation to the goods upon which the opponent relies.

38. On her assessment of the evidence, these conclusions were appropriate. However, with the different views of POB1-3 & 6 inclusive which I have set out above, in my view the evidence in totality establishes a rather different picture, which I summarise as follows, keeping in mind that the relevant five year period is from August 2012 to August 2017.

39. One starts with the sale of the kit of parts, including the engine to Mr Roonan in March 2010. It appears it took some 3 years for this car to be completed i.e. in 2013 and a further 2 years before it was registered (1 September 2015) and then shown in public at Goodwood (late September 2015, presumably). Although the UK Registration Certificate and Individual Vehicle Approval were, as the Hearing Officer correctly held, internal documents, their significance is that the car could thereafter be driven on public roads, in and around Chichester and, in particular, to and from Goodwood. At the Goodwood track, the car was seen by a community of enthusiasts who attended the event, even though by no means all of them would necessarily have been sufficiently interested in this car to learn or find out what it was called. I remind myself that this 2015 car does not appear to have been badged Spectre, yet the YouTube video evidences the fact that members of the public understood the car to be a Spectre or Spectre Angel, which itself means there must have been some outward and public use of the mark Spectre
40. The fact that the images in POB2 show an actual car, which Mr Blomqvist testifies to be the 2018 car, permits an inference to be drawn that this car was likely to have been in production during the 5 year period ending in August 2017. In all the circumstances, it is reasonable to suppose the manufacture of each of the 2015 and 2018 cars was essentially bespoke manufacture of individual cars, measured in years and not months. Although the images in POB2 do not evidence any actual use of the mark SPECTRE, they do evidence real commercial activity aimed at continuing (i.e. following on from the 2015 car) to create a market for SPECTRE cars.
41. As the Hearing Officer quite rightly held, the 8 page brochure in POB8 is not dated, nor did Mr Blomqvist provide any date for it in his witness statement. However, there is a link, albeit comparatively slender, between that 8 page brochure and the images shown in POB2 because at least some of the images appear to have been taken on the same occasion. I am not prepared to infer that the 8 page brochure was in fact used outwardly or publicly during the relevant period, precisely because it would have been very easy for that fact to have been stated in evidence. However, the existence of that brochure (albeit existing outside the relevant period) together with the existence of the actual 2018 car shown in the images, further supports the

conclusion of real commercial activity during the relevant period aimed at continuing to create a market for cars under the mark SPECTRE.

42. Finally, although Mr Blomqvist does not explain this, I think it is reasonable to infer that the use of SPECTRE that he addresses in his witness statement was carried out with his consent and under a degree of control exercised by him. I can infer that from the fact that Mr Blomqvist was evidently supplied with documents by Mr Roonan, the owner of the 2015 car.
43. For all these reasons, and although this case is very very close to the line, in my view the evidence just establishes genuine use in the relevant five year period of the mark SPECTRE in relation to ‘motor land vehicles’, but specifically ‘motor cars’.
44. By way of postscript, I point out that this case is yet another illustration as to why, when called upon to prove genuine use of a registered trade mark, the registered proprietor must provide the best evidence first time around or risk losing the mark. The evidence which I did not admit into this appeal shows that the proprietor could and should have done a much better job first time around. His registration has only been saved because of the unusual circumstances which arose in this case where defects in the evidence were not corrected which led to or contributed to a less favourable assessment of the evidence filed than was warranted with the defects corrected. Even with the defects corrected, the evidence was exiguous in the extreme.

The remainder of the Opposition.

45. Since I have come to a different conclusion to the Hearing Officer on the issue of genuine use, there is a basis for Mr Blomqvist’s opposition under s.5(2)(b), based on his SPECTRE registration.
46. In the light of my fresh assessment of the evidence, I considered whether I should remit this case to the UK IPO. In the end, I concluded this would only cause additional delay and expense and that it would be best if I determined the remaining issues, not least because they are very straightforward.

47. The Application seeks to register the series of two marks: SILVER SPECTRE and Silver Spectre in Class 12 in respect of ‘Motor Cars’. These goods are identical to ‘Motor Land Vehicles’ or ‘Motor Cars’, in respect of which I have held that Mr Blomqvist satisfied the use conditions of s.6A.
48. The respective marks are similar to a high degree, visually, aurally and conceptually. Either of the two marks in the Application includes the whole of the earlier mark. Furthermore, the SPECTRE element of the two marks in the Application is the most distinctive element, because SILVER is seen by the average consumer as the colour of the car in question. Silver is a normal colour for motor cars. Without any use to generate any additional distinctiveness, the mark SPECTRE in relation to motor cars has a reasonably high degree of inherent distinctive character.
49. Taking into account all relevant factors in the required global appreciation, I have no doubt that there exists a likelihood of confusion between the earlier mark SPECTRE and the two marks in the series of the Application. Accordingly, the Opposition succeeds under s.5(2)(b) of the Act and Mr Carne’s Application must be refused.

Costs.

50. The Hearing Officer ordered each party to bear its own costs, for the reasons she gave. Even though the Appeal has succeeded, it has only done so on the limited success of the application to adduce further evidence. Although, as I have explained above, the need for the Appeal arose from an unfortunate combination of circumstances, no Appeal would have been necessary had Mr Blomqvist done even a slightly better job of his evidence of use. If he had done so, his Opposition would have succeeded first time around and he would have been entitled to scale costs relating to the preparation of his Counterstatement and his evidence. On any view, these would have been modest. However, because a considerable part of the blame for the poor evidence of use must lie at Mr Blomqvist’s door, and even though the Opposition has ultimately succeeded, I consider the fair order for costs, both at first instance and on Appeal is that each party must bear their own costs.

JAMES MELLOR QC

The Appointed Person

20th May 2019