

## O-017-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3043083 BY PIE CORBETT CONSULTANCY LIMITED TO REGISTER THE TRADE MARK **TALK FOR WRITING** IN CLASS 41 AND IN THE MATTER OF OPPOSITION THERETO UNDER No. 402385 BY TT EDUCATION LIMITED AND

IN THE MATTER OF APPLICATION No. 3045061 BY TT EDUCATION LIMITED TO REGISTER THE TRADE MARK **TALK FOR LEARNING (IN LOGO FORM)** IN CLASSES 16 & 41 AND IN THE MATTER OF APPLICATION No. 3045065 BY TT EDUCATION LIMITED TO REGISTER THE TRADE MARK **TALK FOR MATHS (IN LOGO FORM)** IN CLASSES 16 & 41 AND IN THE MATTER OF OPPOSITIONS THERETO UNDER No. 402491 & 402492 BY PIE CORBETT CONSULTANCY LIMITED

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### DECISION

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#### A. INTRODUCTION AND SUMMARY

1. This is an appeal by TT Education Limited (“the appellant”) from the decision of Mr George Salthouse acting for the Registrar whereby he (a) rejected the opposition to registration of the word mark No. 3043083 TALK FOR WRITING in classes 41 and 16 (covering numerous goods and services focused mainly on education and training which were listed in full at the end of the decision) and (b) allowed the cross-opposition to registration of the marks Nos. 3045061 and 3045065 (for a wide range of similar goods and services):



2. Briefly summarized, the facts are as follows. Some years ago, Mr Pie Corbett, who had long experience in education, devised an approach to improving the teaching of writing for children. The approach involves a more intensive use of talking about writing for younger children than some other methods. He started to run training courses and produced materials using the term TALK FOR WRITING for this method. Mr Corbett now offers those services through his company (which is the applicant for the TALK FOR WRITING mark) Pie Corbett Consultancy Limited (“PCC”). His approach had considerable success and is now widely used in schools. It was, to a degree, incorporated into learning strategies by the Government. The hearing officer summarized Mr Corbett’s main evidence concerning his development of the TALK FOR WRITING approach and the use of that and other “TALK FOR...” terms as follows:

“10) [Mr Corbett]... provides a history of his career covering forty years, describing how he developed his ideas on teaching and learning and describing how the phrases “talk for writing” and “talk for learning” were first used as chapter titles in a book published in 2003. In 2006 he describes how he lead a nationwide project with the Department of Education in which “Talk for Writing” (TFW) were sent out to every primary school and thousands of teachers throughout the UK, with the CDROM having “Crown copyright by kind permission of Pie Corbett” upon it. This he states indicates that he developed and owns the ideas and that teachers link him with the phrases. In 2011 he published “Talk for writing across the curriculum” which he states has been an education best seller. Mr Corbett describes how he had been working with various groups in the field of maths for some time seeking to use his “talk for” approach in relation to maths. In March 2012 he joined with Lucy Sayce-Brown in an attempt to raise standards in a group of schools. On 4 December 2014 a conference was held in Reading which looked at how “Talk for Writing” and “Talk for Maths” used similar teaching approaches and understandings. This was followed by the teachers running workshops. Over 100 teachers attended the conference and it included talks on how the “talk for” method could be used across the curriculum. Schools in Portsmouth and Birmingham have been using the methodology and developing programmes.

11) Mr Corbett states that in January 2000 he set up as a freelance educational consultant and as his income grew he incorporated and became a limited company. Towards the end of 2012 he employed Mr Batty as the TFW co-ordinator, managing conferences, the website and also the work of eight consultants and five training centres. The consultants and training centres pay 20% of their earnings to PCC, and

their work is focussed upon TFW training. PCC also runs a research and development project which is free to participating schools, and which looks at how “talk for” can develop and grow. One such aspect is the “talk for maths” framework being developed. He states that the company turnover, see below, demonstrates the commercial value of the “talk for” brand.”

3. The hearing officer then quoted turnover figures of the business which, in recent years, has exceeded £1/2 million.
4. Mr David Maytham, the moving force behind the appellant, was previously one of those offering training courses as part of the network of trainers used by PCC. He set up on his own with the appellant as his corporate vehicle and, among the services he offers are similar training courses, using the marks the appellant has applied for, of which the dominant parts are TALK FOR MATHS and TALK FOR LERANING in the logo form as shown in paragraph 1 above.
5. Both sides have applied to register trade marks. PCC has applied for TALK FOR WRITING (which was allowed by the hearing officer in the face of an attack on the basis, in essence, that it was or had become descriptive). The appellant has applied for the logos above (which were rejected by the hearing officer on the basis that use would constitute passing off in the light of PCC’s earlier use of “TALK FOR WRITING” and that the applications were not made in good faith).
6. The principal evidence was given either by the main individuals concerned or by those in some way connected with them and there was limited independent evidence about what the relevant public thought and to the extent that there was, it was open to interpretation. The hearing officer therefore had to do his best in making the decisions he did on the basis of limited, ambiguous and to some extent tendentious material. There was a real conflict of evidence as to how much each side knew about the other’s activities and proposed activities but there was no cross-examination on either side.

7. A flavor of the conflict in perspective may be gained from the summaries by the hearing officer of the parties' evidence on this issue and on the question of bad faith and of which I reproduce extracts from the decision below:

*Mr Corbett's perspective in his evidence*

"12) Mr Corbett claims that his name is so synonymous with the teaching method that teachers often refer to "do Pie Corbett", or even "we Pie'd it". The system has, he contends, transformed the standards in many schools. As such there is considerable goodwill and value in the "talk for" brand and it is beginning to be used overseas. He states that The Education Department booklet refers to "incorporation of "talk for writing" time into literacy lessons" and the system has also been mentioned in Ofsted reports from 2011 onwards. In addition he states that he has spoken to over 100,000 teachers regarding the "talk for" approach as part of conferences run by the National Literacy Trust and through the National Primary Strategy Initiative. He has written in National newspapers such as The Times and magazines such as Junior Education and Teach Primary. A book "Talk for Writing across the curriculum" published in 2010 sold 10,000 copies in its first year and is now sold world-wide. There are also numerous Internet clips of Mr Corbett discussing his TFW approach. 13) Mr Corbett states that in 2007 Mr Maytham, who was in his first year as a teacher, was part of the "Teachers and Teaching Assistants as Writers" project run by Mr Corbett. Mr Corbett states that given the short time that Mr Maytham has been teaching he has not taught Mr Corbett anything about teaching and learning. Despite his limited experience Mr Maytham was used to offer limited advice in a project looking at the establishment of "writing schools". At this time Mr Maytham was working at a school in Essex and Mr Corbett visited the school to work on a further project, the Essex Writing Project, run by Mr Maytham. He states that Mr Maytham then left teaching and began working on Maths trails. This was an idea that had been used before, but was different to the "talk for" approach. Mr Corbett states that although he did not see how the "trails" idea would make money he encouraged Mr Maytham as best he could and even suggested to a publisher that the idea might be worth supporting. Mr Corbett provided a "blurb" for Mr Maytham's website but did not endorse his courses. Mr Corbett even supported the setting up of Treasure Trails Education (TTE). Mr Corbett states that in 2012 he was approached by Mr Maytham to view his Maths Trails idea and in May 2012 Mr Corbett did a conference for Mr Maytham, to generate funds to invest in further projects in Essex schools. At this time Mr Maytham was not working on "talk for maths". In mid 2013 Mr Maytham was employed by PCC as a training consultant for TFW. He states that in 2013 during a conversation with Mr Maytham he became aware that he was doing some work on "talk for maths". However, as PCC had been using this title for some time at this point he merely thought that Mr Maytham was developing PCC's ideas and did not think he would try to appropriate the brand. It was later in 2013 that PCC was contacted by

various contacts who informed PCC that Mr Maytham was offering a product and ideas close to those of PCC and even claiming that they were endorsed by PCC. Mr Corbett then wrote to Mr Maytham asking him to remove all references to him from the TTE website, but met with no success. 14) Mr Corbett states that in December 2013 Mr Maytham requested a meeting to hear about the Primary Writing Project. Mr Maytham put forward the idea of a business partnership, however, given his relative inexperience compared to that of Mr Corbett the idea was rejected. However, Mr Maytham was invited to be a trainer on the project. At this meeting Mr Corbett asserts that he informed Mr Maytham of his intention of trade marking TFW in order to ensure quality control. On 2 April 2014 Mr Maytham informed Mr Corbett of his intention of trade marking “Talk for Maths”. Mr Corbett stated that this was unacceptable, as he had been working in this field for a number of years and the research was not concluded. Mr Maytham had only been working in the area for a short while and it could affect the worth of TFW. Further, Mr Maytham’s work had taken a different approach i.e. Trails. It was at this time that Mr Corbett became aware that Mr Maytham had registered the domain names “talk for Learning” and “Talk for Maths”. A further meeting between the two men occurred on 2 May 2014 where Mr Corbett suggested that he use “Talk Maths” or “Maths Talk” instead. Despite claiming to have an entirely new approach not based on Mr Corbett’s work, when Mr Maytham described his “new” approach it was clearly based upon Talk for Writing. Although Mr Maytham produced minutes from this meeting these were not accepted as a true reflection of the meeting by Mr Corbett. Further meetings were considered but did not take place. Mr Corbett stated, in emails, that for Mr Maytham to trade mark “talk for Maths” would be “dishonest and immoral”, Mr Maytham’s own account of the meeting also indicates that he agreed to consider changing the “talk for maths” name. As Mr Maytham also made it clear that he would oppose Mr Corbett’s trade mark application for TFW his employment as a consultant was terminated....”

*Mr Maytham’s perspective in his evidence*

“20) [Mr Maytham], the Managing Director and Head of Education at TTE....states that he began developing his business in October 2011 but only incorporated in December 2012. He states that he has known Mr Corbett since 2008 and that over the years they developed a business relationship including collaboration with the development of teaching strategies as well as various teaching methods. He states that TFW is a phrase used to refer to a teaching methodology and that Mr Corbett, amongst others was involved in its development during which the phrase was widely used in a descriptive sense to refer to the teaching method. He points out that the mark applied for initially by PCC was a series of two which included “talk4writing” but as this differed from the mark in suit it could not be considered a series and so was dropped from the application. He states that he informed Mr Corbett of his intention of using Talk for Learning and Talk for Maths on 28 March 2012. He

claims that they spoke several times after regarding the use of these marks and that Mr Corbett supported him. He states that it was not until 7 April 2014 that any objection was raised to his using the two marks. He states that Mr Corbett is widely regarded as a literacy expert, but he has never had any interest in mathematics, nor did he make any use of the phrase TALK FOR as a reference to a teaching methodology other than for TFW. He states that over the past two years he has developed and used the mark Talk for Learning in relation to an underpinning methodology. He describes the methodology which to my mind sounds exactly the same as that in TFW. He states that he has delivered training in his technique to hundreds of teachers.”

...

“4)... Mr Maytham contests the claim by PCC to have only presented idea on “talk for” since 2010, he refers to exhibit 15 as evidence to the contrary. He also comments on Mr Corbett’s statement that the phrase “talk for writing” appears in Ofsted reports as an indication that the term is widely used in the education sector. He claims that Mr Corbett is known not by his brand. He states he was unaware of PCC carrying out work on Talk for Maths and reiterates his claims that PCC knew of his work on Talk for Maths. He points out that Mr Corbett agreed to provide a written statement for TTE to use it on its website, although I note that this was more of an endorsement of Mr Maytham personally, and does not refer to any use of Talk for Maths. He states that the TTE website has been cleared of all references to Mr Corbett, although other websites which advertise TTE courses may still carry a reference. He denies that Mr Corbett played a part in setting up TTE and states that in December 2013 Mr Corbett states he has no recollection of TTE. He also claims to have assisted PCC and refers to exhibit 20. Mr Maytham appears to believe that being asked to deliver training on dates where Mr Corbett cannot attend or being given permission to provide training under his company name to a known PCC client is an indication of the true nature of the relationship.”

8. Both sides referred to a number of exhibits, which the hearing officer summarized, some of which I discuss in greater detail below.

#### **The key issue underlying the dispute**

9. Underlying the dispute is a question as to whether the terms TALK FOR WRITING, TALK FOR MATHS and TALK FOR LEARNING denote the services and goods of a given trade source or whether they are descriptive of a methodology and are (or should be kept) free for use by others. The hearing officer was not persuaded that the terms were descriptive and instead thought that the evidence showed that they were perceived to be “proprietary”, at least

to a sufficient extent, not to preclude registration and to lead to a belief that the goods and services offered under the appellant's marks may be thought to be connected with PCC in a relevant way. That issue has formed the central attack by the appellant on the hearing officer's decision.

10. The appellant contends that the hearing officer evaluated the position erroneously, that he disregarded important evidence and did not have sufficient regard to the requirements of the law with respect to terms that may be used and had been used descriptively. PCC contends, in contrast, that the hearing officer was right and that his decision is not susceptible to reversal on appeal, particularly having regard to the proper function of this tribunal on appeals of this kind as set out in the *REEF* case and others. The issue of appellate approach formed an unusually significant part of the argument on this appeal and I shall therefore address it first.

## **B. APPELLATE FUNCTION IN APPEALS TO THE APPOINTED PERSON**

11. It was contended by the appellant that the approach in *REEF* required some qualification in the light of the Supreme Court judgments in *Re:B (a child)* [2013] UKSC 33 and *Henderson v. Foxworth Investments* [2014] UKSC 41 at [58]-[59]. Since the *REEF* approach has been almost universally adopted by this tribunal, it is necessary to treat the argument that it requires modification at greater length than would ordinarily be appropriate.

### **Legislative framework**

12. The Trade Marks Act 1994, s.76(1) provides:

“An appeal lies from any decision of the registrar ... except as otherwise expressly provided by rules. For this purpose "decision" includes any act of the registrar in exercise of a discretion...”

13. The approach to an appeal to the Appointed Person is the same as the approach to appeals to the court. This is provided by CPR 52.11(3):

“The appeal court will allow an appeal where the decision of the lower court was - (a) wrong ...”.

## Appellate function - general

14. The Supreme Court and Court of Appeal have considered the issue of appellate function on numerous occasions in a range of contexts (including *Designers Guild*, *Biogen*, *Datec*, *REEF*, *BUD*, *Assicurazioni Generali*, *Todd*, *Fine & Country*). The effect of these decisions was summarized by Arnold J in *Dalsouple Societe Saumuroise Du Caoutchouc v Dalsouple Direct Ltd & Anor* [2014] EWHC 3963 (Ch) and in *Shanks v Unilever Plc & Ors* [2014] EWHC 1647 (Pat), a decision upheld by the Court of Appeal – see [2017] EWCA Civ 2, from which the following extract is reproduced, with particular reference to appeals from the Comptroller:

### “The role of the appeal court

27. The role of the appeal court was recently reviewed by Lewison LJ in *Fine & Country Ltd v Okotoks Ltd* [2013] EWCA Civ 672, [2014] FSR 11, where he 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.’

51. Where the appeal is (or involves) an appeal against a finding of fact, the role of an appeal court is as stated by Lord Mance in *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 at [46] approving a passage from the judgment of Clarke LJ in *Assicurazioni Generali SpA v Arab Insurance Group* [2003] 1 WLR 577, 580 – 581 as follows:

‘14. The approach of the court to any particular case will depend upon the nature of the issues kind of case determined by the judge. This has been recognised recently in, for example, *Todd v Adams & Chope (trading as Trelawney Fishing Co)* [2002] 2 Lloyd's Rep 293 and *Bessant v South Cone Inc* [2002] EWCA Civ 763. In some cases the trial judge will have reached conclusions of primary fact based almost entirely upon the view which he formed of the oral evidence of the witnesses. In most cases, however, the position is more complex. In many such cases the judge will have reached his conclusions of primary fact as a result partly of the view he formed of the oral evidence and partly from an analysis of the documents. In other such cases, the judge will have made findings of primary fact based entirely or almost entirely on the documents. Some findings of primary fact will be the result of direct evidence, whereas others will depend upon inference from direct evidence of such facts.

15. In appeals against conclusions of primary fact the approach of an appellate court will depend upon the weight to be attached to the findings of the judge and that weight will depend upon the extent to which, as the trial judge, the judge has an advantage over the appellate court; the greater that advantage the more reluctant the appellate court should be to interfere. As I see it, that was the approach of the Court of Appeal on a 'rehearing' under the RSC and should be its approach on a 'review' under the CPR 1998.

16. Some conclusions of fact are, however, not conclusions of primary fact of the kind to which I have just referred. They involve an assessment of a number of different factors which have to be weighed against each other. This is sometimes called an evaluation of the facts and is often a matter of degree upon which different judges can legitimately differ. Such cases may be closely analogous to the exercise of a discretion and, in my opinion, appellate courts should approach them in a similar way.’

52. I would add to that citation the statement of Lord Steyn in *Smith New Court Securities Ltd v Citibank NA* [1997] AC 254, 274:

‘The principle is well settled that where there has been no misdirection on an issue of fact by the trial judge the presumption is that his conclusion on issues of fact is correct. The Court of Appeal will only reverse the trial judge on an issue of fact when it is convinced that his view is wrong. In such a case, if the Court of Appeal is

left in doubt as to the correctness of the conclusion, it will not disturb it.’

53. This corresponds with the test under CPR Part 52.11(3)(a).”

28. I would add that the Comptroller-General of Patents is a specialist tribunal, and therefore the warning given by Baroness Hale of Richmond in *AH (Sudan) v Secretary of State for the Home Department* [2007] UKHL 49, [2008] 1 AC 678 at [30], which was approved by Sir John Dyson SCJ giving the judgment of the Supreme Court in *MA (Somalia) v Secretary of State for the Home Department* [2007] UKSC 49, [2011] 2 All ER 65 at [43], is apposite in this context:

“ ... This is an expert tribunal charged with administering a complex area of law in challenging circumstances. To paraphrase a view I have expressed about such expert tribunals in another context, the ordinary courts should approach appeals from them with an appropriate degree of caution; it is probable that in understanding and applying the law in their specialised field the tribunal will have got it right: see *Cooke v Secretary of State for Social Security* [2002] 3 All ER 279, para 16. They and they alone are the judges of the facts. It is not enough that their decision on those facts may seem harsh to people who have not heard and read the evidence and arguments which they have heard and read. Their decisions should be respected unless it is quite clear that they have misdirected themselves in law. Appellate courts should not rush to find such misdirections simply because they might have reached a different conclusion on the facts or expressed themselves differently. ... ””

15. The *Dalsouple* case involved a trade mark dispute and the *Shanks* case concerned an evaluation by the Comptroller of whether or not a patent had been of outstanding benefit under the Patents Act 1977. The latter case, in particular, involved an evaluation by reference to a standard which was not defined in detail.

### **Case law on appellate function in trade mark appeals**

#### **(i) REEF (2002)**

16. The appellate function specifically in trade mark appeals has been comprehensively treated by the higher courts and has widely been regarded as settled. Appointed Persons’ decisions on appellate function therefore tend to cite the headline propositions from *REEF (Besant v. South Cone Inc* [2002] EWCA Civ 763). However, in the light of the arguments advanced on the present appeal, it is worth keeping in mind the full extract from the judgment of

Walker LJ, as he then was, since it contains important observations on the reasons for appellate restraint in this context. He said, with the points of particular importance highlighted:

**“The first issue: the appellate function**

17. On the first, general issue as to the nature of his appellate function the judge began by referring to CPR 52.11(1):

“Every appeal will be limited to a review of the decision of the lower court unless – (a) a practice direction makes different provision for a particular category of appeal; or (b) the court considers that in the circumstances of an individual appeal it would be in the interests of justice to hold a re-hearing.” Neither side suggested that either of these exceptions applied. But that still leaves room for argument as to what the function of review amounts to on any particular category of appeal, and especially in relation to the sort of issue which often arises in appeals on trade marks, patents, copyright and design right.

18. The judge cited the observation of Buxton LJ in *Norowzian v Arks Ltd (No.2)* [2000] FSR 363, 370, an unusual (and unsuccessful) claim for breach of copyright in an avant-garde film said to have been infringed by a television commercial:

“ ... where it is not suggested that the judge has made an error of principle a party should not come to the Court of Appeal simply in the hope that the impression formed by the judges in this court, or at least by two of them, will be different from that of the trial judge.” That observation was approved by at least three members of the House of Lords in *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] 1 WLR 2416.

19. The judge also cited what Hoffmann LJ said in *Re Grayan Building Services Ltd* [1995] Ch 241, 254, applied by this court to the issue of fair dealing in *Pro Sieben Media AG v Carlton UK Television Ltd* [1999] 1 WLR 605, 612:

“The judge is deciding a question of mixed fact and law in that he is applying the standard laid down by the courts (*[in that case]* conduct appropriate to a person fit to be a director) to the facts of the case. It is in principle no different from the decision as to whether someone has been negligent or whether a patented invention was obvious: see *Benmax v Austin Motor Co Ltd* [1955] AC 370. On the other hand, the standards applied by the law in different contexts vary a great deal in precision and generally speaking, the vaguer the standard and the greater the number of factors which the court has to weigh up in deciding whether or not the standards have been met, the more reluctant an appellate court will be to interfere with the trial judge’s decision.”

20. The judge might also have cited what Lord Hoffmann has since said in *Biogen Inc v Medeva plc* [1997] RPC 1, 45,

“The question of whether an invention was obvious had been called “a kind of jury question” (see Jenkins LJ in *Allmanna Svenska Elektriska A/B v The Burntisland Shipbuilding Co Ltd* (1952) 69 RPC 63, 70) and should be treated with appropriate respect by an appellate court. It is true that in *Benmax v Austin Motor Co Ltd* [1955] AC 370 (1955) 72 RPC 39, 42, this House decided that, while the judge’s findings of primary fact, particularly if founded upon an assessment of the credibility of witnesses, were virtually unassailable, an appellate court would be more ready to differ from the judge’s evaluation of those facts by reference to some legal standard such as negligence or obviousness. In drawing this distinction, however, Viscount Simonds went on to observe, at page 374, that it was “subject only to the weight which should, as a matter of course, be given to the opinion of the learned judge”. The need for appellate caution in reversing the judge’s evaluation of the facts is based upon much more solid grounds than professional courtesy. It is because specific findings of fact, even by the most meticulous judge, are inherently an incomplete statement of the impression which was made upon him by the primary evidence. His expressed findings are always surrounded by a penumbra of imprecision as to emphasis, relative weight, minor qualification and nuance (as Renan said, *la vérité est dans une nuance*), of which time and language do not permit exact expression, but which may play an important part in the judge’s overall evaluation. It would in my view be wrong to treat *Benmax* as authorising or requiring an appellate court to undertake a *de novo* evaluation of the facts in all cases in which no question of the credibility of witnesses is involved. Where the application of a legal standard such as negligence or obviousness involves no question of principle but is simply a matter of degree, an appellate court should be very cautious in differing from the judge’s evaluation.”

21. At the end of that section of his judgment the judge set out what his approach would be:

“Findings of primary fact will not be disturbed unless the hearing officer made an error of principle or was plainly wrong on the evidence. His inferences from the primary facts may be reconsidered, but weight will be given to his experience. No question of the exercise of a discretion arises. In this way, error will be corrected, but a different appreciation will not be substituted for that of the hearing officer if he has arrived at his conclusion without error.”

22. Mr Wyand accepted the first sentence of this formulation but took issue with the second. He submitted that the judge should not have reconsidered inferences drawn from the primary facts unless the hearing officer had made an error of principle or was plainly wrong. As he went on to develop his case Mr Wyand submitted that the judge had been wrong in discerning an error of principle in the hearing officer’s decision when there was none – that is, that even if the judge set out to apply the right test, he did not apply it correctly (and that he reached inconsistent conclusions in relation to section 5(2) and section 5(4)). Mr Morcom supported the judge’s approach and his conclusions, and submitted that there was no significant inconsistency in them.

23. In my view the judge's approach was not wrong, but his formulation

“His inferences from the primary facts may be reconsidered, but weight will be given to his experience”

would, if taken in isolation, be a rather meagre summary of what is quite a complex point. The judge cannot, I think, have intended it to be taken in isolation. He cannot have overlooked the passages which he had just cited from *Norowzian* and *Pro Sieben*.

24. It is worth reflecting on what judges mean when they speak of ‘inferences’ in this context. An inference from a number of primary facts may itself be a simple matter of fact. That is an inference from circumstantial evidence, or what might be called the ‘smoking gun’ type of inference. (Inferences from a litigant’s failure to call a particular witness are also akin to this category.) In the present context, however, the inference is not a simple matter of fact because it involves a process of evaluation. It was put very clearly by Viscount Simonds in *Benmax v Austin Motor Co Ltd* [1955] AC 370, 373 (a patent case on obviousness):

“I cannot help thinking that some confusion may have arisen from failure to distinguish between the finding of a specific fact and a finding of fact which is really an inference from facts specifically found or, as it has sometimes been said, between the perception and evaluation of facts.”

25. A few months later in *Edwards v Bairstow* [1956] AC 14, 29 (a tax case about an ‘adventure in the nature of trade’) Viscount Simonds referred to the “inference or conclusion” which the general commissioners had drawn from the primary facts. Similar statements of high authority can be traced through to the recent decisions of the House of Lords in *Designers Guild* and *Biogen*.

26. How reluctant should an appellate court be to interfere with the trial judge's evaluation of, and conclusion on, the primary facts? As Hoffmann LJ made clear in *Grayan* there is no single standard which is appropriate to every case. The most important variables include the nature of the evaluation required, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence.

27. It is worth noting that *Biogen* was a case very close to the top end of the scale. It involved very complex biotechnology which was the subject of a lot of expert evidence given at a lengthy trial before a very experienced judge of the Patents Court. In the circumstances Lord Hoffmann's memorable reference to Renan was not (if I may respectfully say so) out of place. There are far fewer nuances to be picked up from a bundle of statutory declarations which contain a good deal of irrelevant or tendentious material and on which there is no cross-examination.

28. In this case the hearing officer had to make what he himself referred to as a multi-factorial comparison, evaluating similarity of marks, similarity of goods and other factors in order to reach conclusions about likelihood of

confusion and the outcome of a notional passing-off claim. It is not suggested that he was not experienced in this field, and there is nothing in the Civil Procedure Rules to diminish the degree of respect which has traditionally been shown to a hearing officer's specialised experience. (It is interesting to compare the observations made by Lord Radcliffe in *Edwards v Bairstow* [1956] AC 14, 38-9, about the general commissioners, a tribunal with a specialised function but often little specialised training.) On the other hand the hearing officer did not hear any oral evidence. In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle.

29. The appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed. The duty to give reasons must not be turned into an intolerable burden: see the recent judgment of this court in *English v Emery Reimbold & Strick Ltd* (and two other appeals heard with it) [2002] EWCA Civ 605, 30 April 2002, para 19:

“ ... the judgment must enable the appellate court to understand why the Judge reached his decision. This does not mean that every factor which weighed with the Judge in his appraisal of the evidence has to be identified and explained. But the issues the resolution of which were vital to the Judge's conclusion should be identified and the manner in which he resolved them explained. It is not possible to provide a template for this process. It need not involve a lengthy judgment. It does require the Judge to identify and record those matters which were critical to his decision.”

30. The judge did not go into these matters in detail and he is not to be criticised for not having done so. I have gone into them only because they figure prominently in the grounds of appeal. I am not persuaded that the judge did not set out with the right general approach to his task.”

(ii) ***BUD (2003)***

17. That approach was also adopted in *BUD Trade Mark* [2003] RPC 25, where Lord Walker of Gestingthorpe, sitting in the Court of Appeal, said:

52. Ultimately the issue on the first appeal is whether the deputy judge was right to discern two errors of principle in the hearing officer's approach, so opening the way for the deputy judge to substitute his own view. For the reasons which I have explained, I do not think that the hearing officer did make any significant error of principle which appears from his written decision. I do find his conclusion surprising and if this court had a free choice between the hearing officer's decision and that of the deputy judge I would unhesitatingly choose the latter.

53. However this court does not have a free choice, as Sir Martin Nourse has explained in his judgment. As Buxton LJ said in *Norowzian v Arks Ltd (No2)*

[2000] FSR 363, 370

“... where it is not suggested that the judge has made an error of principle a party should not come to the Court of Appeal simply in the hope that the impression formed by the judges in this court, or at least by two of them, will be different from that of the trial judge.”

The same principle applies to an appeal from a hearing officer to a judge of the Chancery Division. Although the hearing officer’s decision is one which I find surprising, I do not consider that it can be described as clearly wrong. Therefore I agree (although possibly with more hesitation than my lords) that the first appeal should be allowed.”

18. Lord Walker was one of the stronger exponents of appellate deference to the trial judge with respect to multifactorial evaluations. His judgment in *BUD* represents a clear expression of this, in keeping with his observations in *REEF* and *Datec*.

***(iii) DuPont (2003)***

19. The approach taken at around the same time by the Court of Appeal in *DuPont* (*EI Du Pont De Nemours & Company v S.T. Dupont* [2003] EWCA Civ 1368, a case under the 1938 Act) was, however, similar. The Court said at [94] (emphasis added):

“As the terms of rule 52.11(1) make clear, subject to exceptions, every appeal is limited to a review of the decision of the lower court. A review here is not to be equated with judicial review. It is closely akin to, although not conceptually identical with, the scope of an appeal to the Court of Appeal under the former Rules of the Supreme Court. The review will engage the merits of the appeal. It will accord appropriate respect to the decision of the lower court. Appropriate respect will be tempered by the nature of the lower court and its decision making process. There will also be a spectrum of appropriate respect depending on the nature of the decision of the lower court which is challenged. At one end of the spectrum will be decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum will be multifactorial decisions often dependent on inferences and an analysis of documentary material. Rule 52.11(4) expressly empowers the court to draw inferences. As Mr Arnold correctly submitted, the varying standard of review is discussed in paragraphs 17-30 of the judgment of Robert Walker LJ in *Reef Trade Mark*.”

***(iv) High Court and Appointed Person cases following the approach.***

20. Numerous other decisions, both of the Appointed Person and of the High Court, have followed this approach. One example is, *Digipos Store Solutions Group Ltd. v. Digi International Inc.* [2008] RPC 24, which sought to reflect the judgments of the Court of Appeal in *REEF* and *BUD*. I mention it because the case is quite often cited in appeals from the Registrar of which the present is no exception. I decided that case sitting as a Deputy High Court Judge and drew from *REEF* and *BUD* that neither surprise at a hearing officer's conclusion nor a belief that he has reached the wrong decision sufficed to justify appellate interference. A decision needed to be clearly wrong before it would be overturned. That case has been referred to with approval or its general approach adopted in a number of cases by the Appointed Person and the High Court (see for example Ms Emma Himsworth QC sitting as the Appointed Person in *FURNITURELAND BL-O-507-16* ("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"); *Meemi Ltd v Wardrobe (Beautiful Clothes) Ltd* [2012] EWHC 3617 (Ch) Robert Englehart QC (*Digipos* cited as an example of a case where doubt about correctness was not sufficient to warrant reversal); *Société Des Produits Nestlé S.A. v Cadbury UK Ltd* [2012] EWHC 2637 (Ch) HHJ Birss QC sitting as a High Court Judge ("I respectfully agree with the learned Deputy High Court Judge. I will approach this appeal on the basis summarised in *Digipos*"); *Envirotecnic v Gutterclear Uk Ltd* [2015] EWHC 3450 (Ch) Warren J ("The correct approach to appeals from the Registrar was set out by Mr Alexander QC in *Digipos*..."); *Tripadvisor LLC v Handsam Ltd* [2016] EWHC 1659 (Ch) "Usually, it will be necessary to show that the hearing officer made a distinct and material error of principle in making his decision or that it was clearly wrong, that is to say a decision which no reasonable hearing officer could have reached").

21. However, it is important to observe that, despite the expression of a cautious approach to appellate function which *REEF*, *BUD* and the digest of them in *Digipos* recommend, this has not stood in the way of an appellate tribunal reversing a decision of the Registrar if it is believed to be wrong. There are numerous examples of this before the Appointed Person and in the High Court.

For example, in *Meemi Ltd v Wardrobe (Beautiful Clothes) Ltd* the Deputy Judge cited *Digipos* but criticized the Registrar for failing to step back and consider whether the decision in question was correct, even though all relevant factors had been analysed. More recently in, *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch) Arnold J referred to the *REEF* principle (“real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle”). The evaluation of the Hearing Officer was nonetheless overturned, since the judge considered it to be wrong. In *Petmeds Limited* O-471-11, at [13], the position was summarised as follows: “the degree of caution [to be exercised by appellate tribunals] should not be so great as to permit decisions based on genuine errors of approach to go uncorrected.” I have not attempted a survey of all cases but there is no reason to think that this has not been the approach since *REEF* of the Appointed Person and the High Court in practice.

22. The reason for this is that none of the cases referring to the need for appellate caution in the context of trade mark or other appeals, were saying that there was a higher standard of error that a decision had to reach before appellate reversal was warranted (“clearly wrong” as opposed to “wrong” in which “clearly” is taken to be a descriptor of the degree of error - like “hopelessly” or “inexplicably”) albeit that the language was, in some respects, infelicitously chosen, including by me in *Digipos*). That would have been contrary to the requirements of CPR 52 which permit (indeed, require) a Court of Appeal to overturn a decision if it is “wrong”.

23. Rather, in my judgment, the point the courts and tribunals have been emphasizing is that the appellate court had to be sufficiently confident that the decision was wrong and was not merely one which the appellate tribunal would have taken differently had it been deciding the matter at first instance. Thus understood, appellate caution should be particularly exercised in the evaluation of whether a decision is wrong, not in declining to correct a decision which, following proper and careful evaluation, is wrong on the footing that it is not glaringly wrong. Put simply, there has to be sufficient clarity that there has been error (rather than mere difference in evaluation) not that the error itself has to

be a particularly clear one. That is the approach which, so far as it is possible to tell, has obtained in practice in appeals from the Registrar and which, in my judgement is what *REEF* and other cases require.

**The impact of *Re B* (2013)**

24. It is against that background that *Re: B* falls to be considered. The appellant argued that this has modified the required approach in appeals to the Appointed Person. It is therefore necessary to analyse the impact of that case somewhat more fully.
25. First, it should be noted that the case arose in a different factual context to that of trade mark appeals. In *Re: B* the ultimate decision concerned the course (adoption or otherwise) which would be in the best interests of a child having regard to her interests and the rights of parents and child arising under Article 8 ECHR. The trial judge had to decide whether to make a care order in respect of a child with a view to her being adopted against the wishes of her natural parents. To determine this point, the trial judge had to decide whether, in the light of the evidence, the threshold in section 31(2) of the Children Act 1989 was satisfied (including whether the child was "likely to suffer significant harm") and, if so, whether it was appropriate to make a care order given, inter alia, the impact on her and her natural family. That latter point gave rise to an issue of proportionality of the care order. The context was therefore far removed from the determinations required in trade mark appeals.
26. Second, *Re: B* was concerned with a very specific set of questions some of which involved evaluation of the probability of harm to a child occurring in future. In that case, evaluation was undertaken by the trial judge after lengthy evidence, including oral examination, involving, among other things, what amounted to a prolonged judicial interview of the parents.
27. Third, *Re:B* does not in terms suggest that the approach of *REEF* and following cases requires modification save in one respect, namely avoiding the use of adverbial qualifiers (such as "clearly" or "plainly") of "wrong".

*Relevant extracts from the judgments in the Supreme Court*

28. Lord Wilson, giving the first judgment in the Supreme Court, cited at [38] the passage from *G v. G* [1985] 1 WLR 647 at p 651-652:

"The Jurisdiction in such cases is one of great difficulty, as every judge who has had to exercise it must be aware. The main reason is that in most of these cases there is no right answer. All practicable answers are to some extent unsatisfactory and therefore to some extent wrong, and the best that can be done is to find an answer that is reasonably satisfactory. It is comparatively seldom that the Court of Appeal, even if it would itself have preferred a different answer, can say that the judge's decision was wrong, and unless it can say so, it will leave his decision undisturbed."

...

"Certainly it would not be useful to inquire whether different shades of meaning are intended to be conveyed by words such as 'blatant error' used by the President in the present case, and words such as 'clearly wrong', 'plainly wrong', or simply 'wrong' used by other judges in other cases. All these various expressions were used in order to emphasise the point that the appellate court should only interfere when they consider that the judge of first instance has not merely preferred an imperfect solution which is different from an alternative imperfect solution which the Court of Appeal might or would have adopted, but has exceeded the generous ambit within which a reasonable disagreement is possible."

29. Lord Wilson noted that the concept of the generous ambit of reasonable disagreement was derived from the judgment of Asquith LJ in *Bellenden (formerly Satterthwaite) v Satterthwaite* [1948] 1 All ER 343, at p 345. He further noted that an error in what was, in that case, a balancing exercise justifies appellate intervention only if it gave rise to a conclusion that the judge's determination was outside the generous ambit of reasonable disagreement or wrong within the meaning of the various expressions to which Lord Fraser had referred. In particular, drawing on his extensive experience in family law, Lord Wilson, observed at [42] that the function of the family judge in a child case of this kind:

"...transcends the need to decide issues of fact; and so his (or her) advantage over the appellate court transcends the conventional advantage of the fact-finder who has seen and heard the witnesses of fact. In a child case the judge develops a face-to-face, bench-to-witness-box, acquaintanceship with each of the candidates for the care of the child. Throughout their evidence his function is to ask himself not just "is this true?" or "is this sincere?" but "what does this evidence tell me about any future parenting of the child by this witness?" and, in a public law case, when always hoping to be able to answer his question

negatively, to ask "are the local authority's concerns about the future parenting of the child by this witness justified?" The function demands a high degree of wisdom on the part of the family judge; focussed training; and the allowance to him by the justice system of time to reflect and to choose the optimum expression of the reasons for his decision. But the corollary is the difficulty of mounting a successful appeal against a judge's decision about the future arrangements for a child."

30. At [45], he drew attention to the speech of Lord Nicholls in *In re B (A Minor) (Adoption: Natural Parent)* [\[2001\] UKHL 70](#), [\[2002\] 1 WLR 258](#), where he had said:

"16. ... There is no objectively certain answer on which of two or more possible courses is in the best interests of a child. In all save the most straightforward cases, there are competing factors, some pointing one way and some another. There is no means of demonstrating that one answer is clearly right and another clearly wrong. There are too many uncertainties involved in what, after all, is an attempt to peer into the future and assess the advantages and disadvantages which this or that course will or may have for the child. ... 19...Cases relating to the welfare of children tend to be towards the edge of the spectrum where an appellate court is particularly reluctant to interfere with the judge's decision."

31. Lord Wilson concluded the analysis of appellate function by saying:

"[44]...But it is generally better to allow adjectives to speak for themselves without adverbial support. What does "plainly" add to "wrong"? Either the word adds nothing or it serves to treat the determination under challenge with some slight extra level of generosity apt to one which is discretionary but not to one which is evaluative. Like all other members of the court, I consider that appellate review of a determination whether the threshold is crossed should be conducted by reference simply to whether it was wrong."

32. Lord Neuberger's analysis of the appellate function, to which particular reference was made, was more general.

33. He made observations on appellate approach with respect to findings of primary fact at [53]:

"...where a trial judge has reached a conclusion on the primary facts, it is only in a rare case, such as where that conclusion was one (i) which there was no evidence to support, (ii) which was based on a misunderstanding of the evidence, or (iii) which no reasonable judge could have reached, that an appellate tribunal will interfere with it. This can also be justified on grounds of policy (parties should put forward

their best case on the facts at trial and not regard the potential to appeal as a second chance), cost (appeals on fact can be expensive), delay (appeals on fact often take a long time to get on), and practicality (in many cases, it is very hard to ascertain the facts with confidence, so a second, different, opinion is no more likely to be right than the first).”

34. However, in an important part of the judgment, he said at paragraph [60]:

“[60] When it comes to an evaluation, the extent to which the benefit of hearing the witnesses and watching the evidence unfold will result in the trial judge having a particular advantage over an appellate tribunal will vary from case to case. Accordingly, it is not possible to lay down any single clear general rule as to the proper approach for an appeal court to take where the appeal is against an evaluation (see also in this connection Robert Walker LJ in *Bessant v South Cone Inc* [2002] EWCA Civ 763, para 26, May LJ in *EI du Pont de Nemours & Co v ST Dupont* [2003] EWCA Civ 1368, para 94, and Laws LJ in *Subesh v Secretary of State for the Home Department* [2004] EWCA Civ 56, para 44). Accordingly, as already explained, even where the issue raised is not one of law, the reasons which justify a very high hurdle for an appeal on an issue of primary fact apply, often with somewhat less force, in relation to an appeal on an issue of evaluation.”

35. He agreed with Lord Wilson’s observations at [44] and Lord Kerr’s to similar effect. Lord Neuberger also provided a structured analysis of kinds and degrees of potential error, as follows, albeit mainly in the context of the discussion on proportionality:

“91. That conclusion leaves open the standard which an appellate court should apply when determining whether the trial judge was entitled to reach his conclusion on proportionality, once the appellate court is satisfied that the conclusion was based on justifiable primary facts and assessments. In my view, an appellate court should not interfere with the trial judge's conclusion on proportionality in such a case, unless it decides that that conclusion was wrong. I do not agree with the view that the appellate court has to consider that judge's conclusion was "plainly" wrong on the issue of proportionality before it can be varied or reversed. As Lord Wilson says in para 44, either "plainly" adds nothing, in which case it should be abandoned as it will cause confusion, or it means that an appellate court cannot vary or reverse a judge's conclusion on proportionality if it considers it to have been "merely" wrong. Whatever view the Strasbourg court may take of such a notion, I cannot accept it, as it appears to me to undermine the role of judges in the field of human rights.

92. I appreciate that the attachment of adverbs to "wrong" was impliedly approved by Lord Fraser in the passage cited from *G v G (Minors: Custody Appeal)* [1985] 1 WLR 647, 652, by Lord Wilson at para 38,

and has something of a pedigree – see eg per Ward LJ in *Assicurazioni* [2003] 1 WLR 577, para 195 (although aspects of his approach have been disapproved – see *Datec* [2007] 1 WLR 1325, para 46). However, at least where Convention questions such as proportionality are being considered on an appeal, I consider that, if after reviewing the trial judge's decision, an appeal court considers that he was wrong, then the appeal should be allowed. Thus, a finding that he was wrong is a sufficient condition for allowing an appeal against the trial judge's conclusion on proportionality, and, indeed, it is a necessary condition (save, conceivably, in very rare cases).

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 unsupported. 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.”

36. Lord Kerr said at [110]:

“110. Given that the determination as to whether the threshold has been crossed is one involving the exercise of judgment, what should the approach of the appellate court be to a review of that decision? Leaving aside for the moment the question of proportionality, there is much to be said for the proposition that the measure of deference that an appellate court should show to this decision approximates to that which is appropriate to a review of factual findings. Like Lord Neuberger, however, I believe that to cast the test of reviewability in this sphere as an examination of whether the judge was "plainly wrong" is potentially misleading. A finding on whether the threshold has been crossed will, in many cases, be a matter for fine judgment, however. The conclusion on this issue will be informed, at least to some extent, on the judge's

impression of the evidence. While the weight to be given to his or her conclusion as to whether the threshold has been crossed operates in a different way from that where the judge reaches a conclusion on disputed facts, since the assessment of the evidence is influential in the threshold decision, a degree of reticence on the part of an appellate court on whether to interfere with the decision is warranted. If the appellate court considers that the judge was wrong, however, it should not shrink from reversing his or her decision.”

37. Lord Clarke (who had given the leading judgment in the Court of Appeal in the *Assicurazioni Generali* case referred to above) said:

“137. In England and Wales the jurisdiction of the Court of Appeal is set out in CPR 52.11(3), which provides that "the appeal court will allow an appeal where the decision of the lower court was (a) wrong; or (b) unjust because of a serious procedural or other irregularity in the proceedings in the lower court". The rule does not require that the decision be "plainly wrong". However, the courts have traditionally required that the appeal court must hold that the judge was plainly wrong before it can interfere with his or her decision in a number of different classes of case. I referred to some of them in *Assicurazioni Generali SpA v Arab Insurance Group* [2003] 1 WLR 577, to which Lord Neuberger refers at para 57, at my paras 9 to 23. It seemed to me then and it seems to me now that the correct approach of an appellate court in a particular case may depend upon all the circumstances of that case. So, for example, it has traditionally been held that, absent an error of principle, the Court of Appeal will not interfere with the exercise of a discretion unless the judge was plainly wrong. On the other hand, where the process involves a consideration of a number of different factors, all will depend on the circumstances. As Hoffmann LJ put it in *In re Grayan Building Services Ltd* [1995] Ch 241 at 254,

"generally speaking, the vaguer the standard and the greater the number of factors which the court has to weigh up in deciding whether or not the standards have been met, the more reluctant an appellate court will be to interfere with the trial judge's decision." In the present context, it seems to me, in agreement with Lord Neuberger at para 58, that the court should have particular regard to the principles stated by Lord Hoffmann in *Piglowska v Piglowski* [1999] 1 WLR 1360 at 1372, which are quoted by Lord Wilson at para 41.

138. As I read their judgments, Lord Neuberger, Lord Kerr and Lord Wilson all conclude that on the question whether the section 31 threshold was crossed the test is whether the judge was wrong, not whether he was plainly wrong. Lord Neuberger and Lord Wilson have reached the same conclusion on the ultimate question, namely whether a care order should be made.

139. I agree with them. CPR 52.11(3) provides that the appeal court will allow an appeal where the decision of the lower court was "wrong". As already indicated, I appreciate that the courts have given the expression "wrong" a different meaning in different contexts. However, in the context of care orders, where the court must be satisfied that it is necessary make the order, the better course is to ask whether the judge was wrong to make the order and not to ask whether he was plainly wrong. In ordinary language there is a difference between wrong and plainly wrong. If a plainly wrong test is adopted, it will be possible for an appellate court to hold that the judge was wrong to make an adoption order but was not plainly wrong to do so. How it might then be asked can it be said that it was necessary to make the order? If it was a wrong order how can it have been a necessary order? This consideration seems to me to argue strongly for the approach adopted by Lord Neuberger and Lord Wilson. For simplicity, I would apply the same test to decisions as to whether or not the threshold is crossed.

140. For the avoidance of doubt, as I see it, this does not mean that the judge will only be held to be wrong if he or she has made a decision which no reasonable judge could have come to. It means that the judge's decision is wrong if the case is in one of the three categories identified by Lord Neuberger in para 93 as (v), (vi) or (vii). That is where the view expressed by the judge is one which the appellate court is doubtful about but on balance concludes was wrong, or one which the appellate court concludes was wrong or insupportable. These categories are to be contrasted with Lord Neuberger's categories (i), (ii), (iii) and (iv). They include category (iv), where the appellate court cannot say whether the judge's view was right or wrong. In short, I agree with the approach proposed by Lord Neuberger in paras 93 and 94."

38. Baroness Hale said the following, drawing particular attention to the different kinds of decisions involved in care proceedings:

*"The appellate function*

199. The judgments involved in care proceedings are of (at least) three different types. First are the decisions on the facts: for example, who did what to whom and in what circumstances. Second is the decision as to whether the threshold is crossed, which involves the various questions set out in para 193 above. In *In re MA (Care: Threshold)* [2010] 1 FLR 431, at para 56, Ward LJ was inclined to think that this was a value judgment rather than a finding of fact; and in the Court of Appeal in this case, Black LJ was also inclined to categorise it "as a value judgment rather than as a finding of fact or an exercise of discretion" (para 9). I agree and so, I think, do we all. It is certainly not a discretion and it will entail prior findings of fact but in the end it is a judgment as to whether those facts meet the criteria laid down in the statute. Third is the decision what order, if any, should be made. That is, on the face of it, a discretion.

But it is a discretion in which the requirements, not only of the Children Act 1989, but also of proportionality under the Human Rights Act 1998, must be observed. What is the role of an appellate court in relation to each of these three decisions?

200. As to the first, the position is clear. The Court of Appeal has jurisdiction to hear appeals on questions of fact as well as law. It can and sometimes does test the judge's factual findings against the contemporaneous documentation and inherent probabilities. But where findings depend upon the reliability and credibility of the witnesses, it will generally defer to the trial judge who has had the great advantage of seeing and hearing the witnesses give their evidence. The question is whether the findings made were open to him on the evidence. As Lord Hoffmann explained in *Biogen Inc v Medeva plc* [1997] RPC 1, the need for appellate caution is "based upon much more solid grounds than professional courtesy". Specific findings of fact are "inherently an incomplete statement of the impression which was made upon him by the primary evidence. His expressed findings are always surrounded by a penumbra of imprecision as to emphasis, relative weight, minor qualifications and nuance . . ." In child cases, as Lord Wilson points out, there is the additional very important factor that the court's role is as much to make predictions about the future as it is to make findings about the past.

201. As to the second, in *Piglowska v Piglowski* [1999] 1 WLR 1360, 1371, Lord Hoffmann cautioned the same appellate restraint in relation to the trial judge's *evaluation* of the facts as to his factual findings themselves. In *In re MA*, Wilson LJ would have allowed the appeal "on the stark basis that, on the evidence before him, it was not open to Roderic Wood J, of all people, to reach the conclusion which he did" (para 34). Hallett LJ considered the question to be one of fact and was "not persuaded that the judge was plainly wrong" to decline to find that the threshold has been crossed (para 44). Ward LJ, having inclined to the view that it was a value judgment rather than a finding of fact, held that "it does not matter for the test this court has to apply is essentially similar, namely whether he has exceeded the generous ambit within which there is room for reasonable disagreement" (para 56). In this case, Black LJ adopted the approach of Ward LJ in *In re MA* (para 9).

202. In fact, the "generous ambit" or "plainly wrong" tests were developed, not in the context of value judgments such as this but in the context of a true discretion. In *G v G (Minors: Custody Appeals)* [1985] 1 WLR 647, Lord Fraser of Tullybelton approved the statement of Asquith LJ in *Bellenden (formerly Satterthwaite) v Satterthwaite* [1948] 1 All ER 343, at 345:

"It is, of course, not enough for the wife to establish that this court might, or would, have made a different order. We are here concerned with a judicial discretion, and it is of the essence of such a discretion that on the same evidence two different minds

might reach widely different decisions without either being appealable. It is only where the decision exceeds the generous ambit within which reasonable disagreement is possible, and is, in fact, plainly wrong, that an appellate body is entitled to interfere."

203. In relation to evaluating whether the threshold has been crossed, we are all agreed that the proper appellate test is whether the trial judge was "wrong" to reach the conclusion he did. This is the test laid down in CPR 52.11(3) and there is no reason why it should not apply in this context. "Plainly" adds nothing helpful, unless it is simply to explain that the appellate court must be in one of the three states of mind described by Lord Neuberger at paragraph 93 considering the trial judge's decision (v) on balance wrong, (vi) wrong or (vii) insupportable.

39. Thus, in relation to the appellate approach to re-evaluation of the threshold question, the Supreme Court was unanimous that the approach of Lord Neuberger applied. Where there was greater divergence was the appellate approach to evaluations of proportionality. Since, in my view, the determinations in issue in trade mark proceedings are much more analogous to the evaluations of the threshold question, I do not think that this divergence of view on the approach to the proportionality test under Article 8 ECHR matters.

*Application of the principles in Re: B and appellate restraint*

40. It is also instructive to consider the application of these principles in *Re: B* itself, since that gives these judgments some practical content. In *Re: B*, the basis upon which the child was removed from its natural mother, and, importantly, the reasons why the appellate courts would not interfere were set out in the judgments of Lord Wilson and Baroness Hale. It is noteworthy that Baroness Hale expressed the "gravest doubts as to whether, properly analysed, the harm which is feared here is of sufficient significance or sufficient likelihood to justify a finding that the threshold has been crossed". It was, to my mind, rather clear that had she been deciding the case at first instance on the facts as recited in the judgments, she would probably have taken a different view from that of the trial judge. Notwithstanding that, she said that the extremely careful and experienced judge had spent many weeks with this case and would have undoubtedly have acquired a "feel" for those questions of degree which no appellate judge could possibly acquire. With some hesitation, she was driven to the conclusion that the court was not in a position to interfere with the judge's

finding that the threshold was crossed in this case.

41. That is a notable practical expression of judicial restraint because, in that case, of the justices of the Supreme Court who expressed a view, Baroness Hale appeared, if anything, most concerned as to whether the judge at first instance had got the threshold question right. Nonetheless, she considered that the appellate court was not in a position to interfere. The other members of the Supreme Court also had doubts but these were not sufficient to lead them to disagree with the Court of Appeal's upholding of the trial judge's evaluation.

### **Other decisions on appellate function**

42. Although the parties to the present appeal did not cite the full spectrum of recent cases on appellate function, it would not be right to consider *Re:B* in isolation.

43. The range of House of Lords and Supreme Court decisions (none of which are said to depart from the other) includes one about the failed delivery of a package in which it was emphasized that appellate interference will only be warranted in limited circumstances but in which the House of Lords nonetheless upheld the Court of Appeal's substitution of a more serious finding of criminal conduct for a conclusion by the trial judge that this was not established on the evidence (*Datec*). But it also includes intellectual property cases in which the Supreme Court has re-iterated the need for appellate restraint in situations where an evaluation is called for by reference to a not wholly precise legal standard (see *PMS International Group Plc v Magmatic Ltd* [2016] UKSC 12 at [24]-[25] and cases there cited).

44. In *Henderson v Foxworth Investments* [2014] UKSC 41 at [58]-[67] which was referred to before me, the approach was formulated in the following way:

“62. Given that the Extra Division correctly identified that an appellate court can interfere where it is satisfied that the trial judge has gone "plainly wrong", and considered that that criterion was met in the present case, there may be some value in considering the meaning of that phrase. There is a risk that it may be misunderstood. The adverb "plainly" does not refer to the degree of confidence felt by the appellate court that it would not have reached the same conclusion as the trial judge. It does

not matter, with whatever degree of certainty, that the appellate court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

63. In *Thomas* itself, Lord Thankerton, with whose reasoning Lord Macmillan, Lord Simonds and Lord du Parcq agreed, said that in the absence of a misdirection of himself by the trial judge, an appellate court which was disposed to come to a different conclusion on the evidence should not do so "unless it is satisfied that any advantage enjoyed by the trial judge by reason of having seen and heard the witnesses could not be sufficient to explain or justify the trial judge's conclusion": 1947 SC (HL) 45, 54; [1947] AC 484, 487-488.

64. Lord du Parcq's speech is to similar effect. Distinguishing the instant case from "those very rare occasions" on which an appellate court would be justified in finding that the trial judge had formed a wrong opinion, he said:

"There are, no doubt, cases in which it is proper to say, after reading the printed record, that, after making allowance for possible exaggeration and giving full weight to the judge's estimate of the witnesses, no conclusion is possible except that his decision was wrong." (1947 SC (HL) 45, 63; [1947] AC 484, 493)

65. Viscount Simon, while disagreeing as to the result of the appeal, also emphasised the need for the appellate court to consider whether the trial judge's decision could reasonably be regarded as justified:

"If there is no evidence to support a particular conclusion (and this is really a question of law), the appellate court will not hesitate so to decide. But if the evidence as a whole can reasonably be regarded as justifying the conclusion arrived at at the trial, and especially if that conclusion has been arrived at on conflicting testimony by a tribunal which saw and heard the witnesses, the appellate court will bear in mind that it has not enjoyed this opportunity and that the view of the trial judge as to where credibility lies is entitled to great weight." (1947 SC (HL) 45, 47; [1947] AC 484, 486).

66. These dicta are couched in different language, but they are to the same general effect, and assist in understanding what Lord Macmillan is likely to have intended when he said that the trial judge might be shown "otherwise to have gone plainly wrong". Consistently with the approach adopted by Lord Thankerton in particular, the phrase can be understood as signifying that the decision of the trial judge cannot reasonably be explained or justified.

67. It follows that, in the absence of some other identifiable error, such

as (without attempting an exhaustive account) a material error of law, or the making of a critical finding of fact which has no basis in the evidence, or a demonstrable misunderstanding of relevant evidence, or a demonstrable failure to consider relevant evidence, an appellate court will interfere with the findings of fact made by a trial judge only if it is satisfied that his decision cannot reasonably be explained or justified.

68. This approach is consistent, as I have explained, with the Scottish authorities, and also with more recent authority in this court and in the Judicial Committee of the Privy Council (see, for example, *In re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33; [2013] 1 WLR 1911, paras 52-53, per Lord Neuberger). A similar approach has also been adopted by the Supreme Court of Canada (see *HL v Canada (Attorney General)* 2005 SCC 25; [2005] 1 SCR 401, paras 55-56) and by the United States Supreme Court (see *Anderson v Bessemer* 470 US 564 (1985), 573-574).”

45. That case was decided by a panel of the Supreme Court which included several judges with significant commercial experience. The above extracts from the leading judgment of Lord Kerr expressed the unanimous approach of the court to review a decision as to whether the alienation of certain property had been for “adequate consideration” under the Insolvency Act 1986. The trial judge of a proof before the Lord Ordinary, Lord Glennie, held that it had been. The Extra Division of the Inner House of the Court of Session overturned his decision on the basis that it was clearly wrong but the Supreme Court held that the Extra Division had, itself, been wrong to do so.
46. Nothing in that case, suggests that the Supreme Court was saying that appellate tribunals should apply a lower degree of restraint as a result of its somewhat earlier decision in *Re: B*. To the contrary, although expressed in somewhat different terms, it takes an approach consistent with that of earlier cases.
47. That, to my mind, provides a further indication that, regardless of the precise formulation of the principles, cases are sensitive to the context of their application and take into account the manner in which the original decision was reached and the relative ability of the appellate court to provide a better answer. It also provides support for the proposition that even if an appellate tribunal is clear that it would not have taken the decision in question, it does not follow that the decision was wrong (see above).

48. Finally, the Court of Appeal has itself cited *Re:B* as supporting a cautious approach. Lewison LJ said in a judgment, with which Longmore LJ agreed:

**“Appeals on fact**

114. Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva plc* [1977] RPC1; *Piglowska v Piglowski* [1999] 1 WLR 1360; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325; *Re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33 [2013] 1 WLR 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58 [2013] 1 WLR 2477. These are all decisions either of the House of Lords or of the Supreme Court. The reasons for this approach are many. They include

- i) The expertise of a trial judge is in determining what facts are relevant to the legal issues to be decided, and what those facts are if they are disputed.
- ii) The trial is not a dress rehearsal. It is the first and last night of the show.
- iii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court, and will seldom lead to a different outcome in an individual case.
- iv) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.
- v) The atmosphere of the courtroom cannot, in any event, be recreated by reference to documents (including transcripts of evidence).
- vi) Thus even if it were possible to duplicate the role of the trial judge, it cannot in practice be done.

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] UKCLR 1135.”

49. As to the latter point, an appellate tribunal is entitled to assume that, even if the lower court has not specifically mentioned an item of evidence, it has taken it into account. As the Supreme Court said in *Henderson v Foxworth Investments* at [48]:

“...An appellate court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration: *Thomas v Thomas* 1947 SC (HL) 45, 61; [1947] AC 484, 492, per Lord Simonds; see also *Housen v Nikolaisen* [2002] 2 SCR 235, para 72.”

50. In my view that approach applies with particular force where a hearing officer has conducted a systematic review of the evidence, as is often done, albeit where, in evaluating it, he or she has not again referred to a factor previously mentioned in the review. The *REEF* approach has again been referred to recently with approval by the Court of Appeal in *Shanks v. Unilever* cited above where Patten LJ said at [45]:

“We also have to bear in mind that we are dealing with the decision of what amounts to a specialist tribunal whose expertise needs to be acknowledged in any consideration of the merits of the decision under appeal. In practice, this means that the Court will show a real reluctance but perhaps not the very highest degree of reluctance to disturb the conclusions of the Hearing Officer on matters that are particularly within his expertise absent a clear and material error of principle: see *South Cone Inc v Bessant* [2002] EWCA Civ 763; [2003] RPC 5 at [28].”

## Summary

51. In the light of the above, in my judgment, *Re:B* has not made any substantive difference to the approach that the Appointed Person should take in considering appeals from the Registrar. Rather, it has drawn on and refined in a particular context points repeatedly made in earlier cases. I reach that conclusion partly because I take the view that the earlier case law had not set such a strict threshold that appellate interference would only be warranted (or in fact undertaken) where the error was of a particular kind. Rather, the case law drew attention to the fact that decision under appeal clearly had to be wrong and not

merely one which the appellate tribunal would not have taken on a topic where reasonable people could differ. Because of that, appellate tribunals, including the Appointed Person, have, in practice, reversed decisions of the Registrar when a genuine error was identified but have declined to do so merely where they would have decided the case differently. That accords with the approach required by *Re:B* as well as the body of case law, of which I have referred to the most important extracts above.

### **Principles so far as relevant to the present case**

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.
- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).
  - (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
  - (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).
  - (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the

Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).

- (v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be "clearly" or "plainly" wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

### **Further points**

- 53. Two further matters merit comment.

54. First, in the light of the above, I therefore respectfully agree with Mr Geoffrey Hobbs QC, sitting as the Appointed Person said in *ALDI/Sig Trading* (O-169-16) that the approach to appellate review set out in *Re:B* is of general application albeit, as I have indicated, it is necessary to bear in mind the context in which those observations were made should be borne in mind in translating them into the very different context of trade mark proceedings. I do not read *Re: B* or *ALDI/Sig Trading* as itself having fundamentally changed the nature of the appellate process in trade mark appeals as a result of the reference to *Re:B*.

55. Second, there is no fundamental difference in the approach that should be taken to appeals in different kinds of case although, as noted above, the respect to be accorded to the Registrar's determinations will depend on their nature. In *Sakura Tea Trade Mark* (BL O-131-16, 7 January 2016), Iain Purvis QC sitting as the Appointed Person said at paragraph 14:

"For the Opponent on this Appeal [Counsel] fairly accepted that he faced a heavy burden. Allegations of bad faith are classic instances of the application of (in Lord Hoffmann's words from *Designers Guild v Russell Williams* [2000] FSR 121 ) a 'not altogether precise legal standard' to a set of facts. They require a multi-factorial consideration and an exercise of judgment by the fact-finding tribunal. Where (as here) such a decision has been taken by an experienced Hearing Officer, having correctly directed him or herself as to the law, an appellate tribunal should be extremely unwilling to interfere with the result, unless something has plainly gone wrong in the Hearing Officer's understanding of the facts, or the result is simply irrational."

38. Subject to the qualification, explained above, that "plainly" is not to be taken as a term denoting a higher degree of wrongness but a degree of confidence that the Appointed Person should have that there is a genuine error rather than simply an evaluation which he or she would not have made, this is an impeccable approach. Where a hearing officer has made a determination that an application has been made in bad faith, an Appointed Person is likely to be well equipped to identify specific errors or approach or fact finding but ill equipped better to re-evaluate that matter entirely. Among those errors may of course be a failure properly to identify the threshold which needs to be satisfied for conduct to be characterized as bad faith (see for an example of an error criticized in this way in a different context: *MI (Pakistan) and MF (Venezuela)*)

*v. Secretary of State for the Home Department* [2014] EWCA Civ 826 at [27] – whether conduct amounts to “persecution”).

### **C. SUBSTANTIVE GROUNDS OF APPEAL**

39. I turn then to the substantive grounds of appeal which may be summarized under two main heads.

40. First, the appellant challenges the hearing officer’s rejection of the contention that the mark TALK FOR WRITING was insufficiently distinctive of the particular goods and services in question to be registrable. Second, that the appellant’s applications for registration of the logo marks TALK FOR LEARNING and TALK FOR MATHS were registrable in the light of the goodwill built up in TALK FOR WRITING and were registered in bad faith.

#### **The TALK FOR WRITING mark (ss. 3(1)(a), (b), (c), (d))**

40. The TALK FOR WRITING mark was opposed on the basis of all of sections 3(1)(a), (b), (c) & (d) of the Act. These provide:

“3(1) The following shall not be registered –

- (a) signs which do not satisfy the requirements of section 1(1),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,
- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

41. As the hearing officer noted, it is settled law that the various sections in 3(1) are independent and have differing general interests (see *SAT.1 Satelliten Fernsehen GmbH v OHIM*, Case C-329/02 P which he cited). However, the hearing officer recognised that in some respects, the underlying basis for the objections overlapped. He focussed on sections (3)(1)(c) and (d), as has this

appeal. I consider that this was right and that his analysis of section 3(1)(b) does not add anything.

### **Section 3(1)(c) - descriptive**

42. The hearing officer referred to the decision of Arnold J in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) from which he quoted extensively. He also took into account *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, where the CJEU said:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40 However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41 Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

43. There is no challenge to the correctness of the hearing officer’s summary of the relevant law. The hearing officer went on to evaluate the TALK FOR WRITING under section (3)(1)(c) in the following way:

“34) It was agreed at the hearing that the broad term education and training services covers the services in class 41 applied for, and PCC accepted that the whole of their services stand or fall together. There is no doubt in my mind that, prima facie, TALK FOR WRITING does not create a descriptive impression of the training service it is used upon. In

educational terms “writing” can mean the simple act of marking a surface with letters or images in order to convey a message. Young children have to be taught to write which involves using ones hand to use an implement, typically a pen or pencil, to form letters. Once one has mastered this basic activity the student then progresses to learning the rules of English composition. Even if one accepts that the average consumer will understand that the word “writing” refers to “composition” it is not, to my mind, immediately obvious what services are on offer. As TTE acknowledges, PCC, on its website has to provide an explanation of what the term refers to (paragraph 31 point 5 above refers). To my mind the reason for this explanation is that the term “TALK FOR WRITING” does not describe the methodology used in providing the services, although it does allude to them. To my mind the mark is *prima facie* acceptable and does not fall foul of section 3(1)(c). The mark does not form a sign or indication “which may serve, in trade, to designate.... characteristics of goods or services.”

35) TTE clearly carried out extensive searches including on the internet, yet could not find instances of use of the term “Talk for Writing” in relation to education and training services which do not have the words in italics or quotation marks where it is clear that the use is in relation to a trade mark. The evidence of TTE is set out extensively at paragraph 20 earlier in this decision. I accept that the evidence does show that others, including TTE, use the words “talk for” as part of their trade marks. However, use by others as a brand name is not enough to engage this section. In *Nude Brands Ltd v Stella McCartney Ltd*, [2009] EWHC 2154 Ch, Floyd J. stated that:

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

36) Consequently, there is no need to exclude the marks from registration in order to give effect to the policy underlying s.3(1)(c), which is to prevent the registration of “descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought [so that they] may be freely used by all traders offering such goods or services.” **I therefore reject the section 3(1)(c) ground of opposition.”**

*The appellant's criticisms*

44. The appellant makes several criticisms of this evaluation.
45. First, it contends that this conclusion was inexplicable, unless it was based on a mistaken belief that describing characteristics at a high level of generality amounts to being allusive.
46. I do not consider this to be a well-founded criticism. The hearing officer was entitled to conclude that the mark TALK FOR WRITING was not directly descriptive of the services in question in the sense that it would make clear what the nature of the services was. In my view, an average consumer of those services would not immediately understand what the characteristics of those particular services were from the use of that phrase alone. Accordingly, this ground of appeal is not made out.
47. Second, it is said by the appellant that the hearing officer may have adopted the wrong standpoint with respect to all of the evaluations and forgot what he had said in para. [30] of his decision where he recorded, with apparent approval, that the parties agreed that the average consumer was an educational professional, trainer, teacher of local authority. It is said that he then substituted his own view, as a person who cannot be expected to be aware of current teaching practices. Further, it is said that, given the national adoption of the methodology by the DfEE, even ordinary members of the public such as parents would understand the phrase.
48. I am not satisfied that this is what he did in these paragraphs. The hearing officer had in mind the nature of the likely customer for the services of this kind. His observation about the average consumer was made in the context of saying that it was appropriate to take account of the meanings known to those in the relevant trade in evaluating distinctiveness. I am not persuaded by this argument.
49. Third, the hearing officer referred to the fact that the concept of TALK FOR WRITING was explained on the web-site of Mr Corbett which suggests that the

average consumer would not be expected to be aware of it. However, the appellant contends that there was no reason to suppose that PCC's website was only addressed to teaching professionals and, even if it was, all it showed is that some teaching professionals who are not as familiar with the methodology as others may benefit from explanation. Further, it is said that websites often contain explanations of things for which no explanation is needed and that there was in any event no evidence showing whether this part of the website was written before the DfEE widened knowledge of the methodology by adopting it as part of its literacy strategy. Accordingly, the appellant contends that the hearing officer was wrong to attach the significance he did to this issue.

50. I am also unpersuaded that the hearing officer was wrong in his reliance on this material. The hearing officer did not refer solely to the web-site in support of his conclusion that the mark was not self-explanatory or descriptive of a concept already widely known to the average consumer. In so far as he referred to this, his reliance on it seems to me justifiable on the basis that it was somewhat supportive of the position he had reached that the mark in question was not descriptive.
51. Fourth, the appellant points out that it is not a requirement for a section 3(1)(c) objection to apply for the description in question to be known to all in the field or to be in current use (see *Doublemint* and cases following it). The hearing officer cited the part of *Starbucks* which referred to this principle (“...a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at[32] and *Koninklijke KPN Nederland NV v Benelux- Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97]”).
52. The appellant contends that, despite this, the hearing officer did not address his mind properly to the question of whether there was a need to keep the mark free for use by others and whether one of the possible meanings designates a characteristics of goods or services. In this connection, the appellant criticises the hearing officer's evaluation of the evidence and ignored or misinterpreted

material parts of it. This was the aspect of the case more strongly emphasised in the skeleton argument and at the hearing and it is therefore necessary to examine the materials relied on by the hearing officer in greater detail.

*The exhibits said to show descriptive use*

53. In particular, the appellant referred to exhibits DM02 and DM14 and the documents published by the DfEE in 2008 (and since) included in those exhibits. It was argued that these documents show the phrase TALK FOR WRITING being used to designate a particular teaching methodology or more broadly a range of such methodologies, and not to indicate trade origin.
54. My attention was particularly drawn to the reference in DM14 where it is said that “many teachers” developed *Talk for writing* approaches after they were introduced to them by the National Strategies (with which Pie Corbett collaborated). It therefore appeared from this material that teachers were positively encouraged to develop their own versions of the TALK FOR WRITING approach independently of PCC and Pie Corbett and proceeded to do so.
55. This material supports the appellant’s case and suggest that there is, at least, some usage which is capable of being descriptive of a methodology, albeit not unequivocally, since what the authors of the document thought in referring to TALK FOR WRITING strategies is not entirely clear. In those circumstances, the appellant contends that it is unjustifiable for PCC to attempt to monopolise the phrase in the educational sphere and that both the teaching community and many members of the public with children in education know that phrase to indicate a commonly used teaching methodology or range of methodologies. More specifically, the appellant contends that this shows that the phrase TALK FOR WRITING is not only apt to describe a kind of approach to teaching writing but is actually in use to do so. It would, on this basis, be no more distinctive than the term “synthetic phonics”.
56. There is considerable force in the argument and I have had real doubts as to whether the hearing officer’s decision could be justified on *Doublemint*

grounds, for the reason given by the appellant. I have therefore undertaken the exercise of careful re-examination referred to above to determine whether the hearing officer's decision really is wrong or is, instead one which is sufficiently based on the material evidence, albeit not necessarily one which this tribunal would have reached had it been asked to evaluate the position at first instance.

57. I therefore focus on the materials that the hearing officer had upon which he based his decision.

58. In favour of the decision is the fact that the hearing officer based his conclusion on a comprehensive evaluation of the evidence which he conducted at paras. [10]-[25] of the decision. As well as the exhibits referred to by the appellant, this included the following evidence (I do not summarise all of it here).

- a. Evidence from Mr Pie Corbett to the effect that TALK FOR WRITING was regarded as a brand associated with him rather than purely descriptive of a method of teaching. In particular, Mr Corbett gave evidence that there had been significant turnover using the TALK FOR... brand and exhibited as PC1 a number of e-mails from Head Teachers/Deputy Head Teachers educational consultants, lecturers/professors in education and journalists who state that TALK FOR WRITING is widely associated in the educational industry with Mr Corbett. Although these present a somewhat mixed picture, at least some of the e-mails, which I have also reviewed, support the proposition that the mark TALK FOR WRITING may be regarded as distinctive of the services of Mr Corbett (e.g.: "synonymous with Pie Corbett"; "exclusively attributed to him by teachers and school leaders"; "it is his concept"; "directly associated with Pie Corbett" and so on) although it is not always clear what the authors of the document actually mean.
- b. Evidence from Ms Julia Strong, deputy director of the National Literacy Trust between 2005 and 2012 as follows:

- i. Ms Strong exhibited several e-mails indicating that the TALK FOR WRITING brand was associated with Mr Corbett and PCC.
- ii. She gave evidence, on which there was no cross-examination, to the effect that she and others set up a project delivered by Pie Corbett Consultancy supported by her as an adviser to develop the Talk for Writing approach in two regions of the UK. Primary National Strategy Advisors were trained in the approach by Pie Corbett and Talk for Writing documents and DVDs were distributed to all primary schools in England with training provided by the local advisors. Ms Strong says that the approach became very well known thereafter among primary teachers and “everyone recognised it as being Pie Corbett’s approach” – albeit a statement with questionable basis.
- iii. Ms Strong also refers to the fact that the subsequent book “Talk for Writing across the Curriculum” co-authored by her and Pie Corbett became a best seller in the field and increased the “value of the Talk for Writing” brand. According to her evidence, the commissioning editor of Routledge Education has said that Pie Corbett and the “Talk for Writing brand” are “the flagships of our professional publishing list”.
- iv. Ms Strong says that she was “astounded” when she heard that Mr Maytham was “blocking Pie Corbett’s Consultancy’s attempt to trade mark Talk for Writing because “the brand belongs so clearly to Pie Corbett Consultancy”.
- v. Ms Strong refers in her second statement to a teacher, Hanna Blackmore, who had assumed that when a training session on “Talk for Writing” was booked the academy for which she worked had “automatically” thought that it was a “legitimate “Talk for Writing” course being presented by one of Pie [Corbett’s] “Talk for Writing” consultants.” That provides

some, albeit not very compelling, evidence that third parties rely on the term “Talk for Writing” as a guarantee of origin.

- c. Evidence from John Stannard, a co-director with Pie Corbett of the Primary Writing project and a former HM inspector of schools with a long career in education. He is also not entirely independent of Mr Corbett but he also worked in developing the National Literacy Strategy. His evidence is, like Ms Strong’s, to the effect that TALK FOR WRITING is a brand and not merely a generic description.

59. In addition, there were references in the evidence to uses which at least had a proprietary flavour in third party materials and evidence from Mr Nick Batty which broadly supported that of Ms Strong.

60. That said, I do not regard the evidence as nearly as unequivocal as the hearing officer did. For example, Ms Strong says in para. 23 of her witness statement:

“23. By 2003, reference to Talk for Writing started to emerge. This referred to the work of Pie Corbett Consultancy. As explained above, the term Talk for Writing started to become part of common parlance from 2008. From this point onward, the term Talk for Writing has been commonly used by teachers and when they use the term they are referring to the specific approach developed by Pie Corbett Consultancy.”

61. That might be taken, on one reading, to support the appellant’s contentions that the term TALK FOR WRITING was no more than a term for an approach *originally* developed by Pie Corbett Consultancy but now a term in general use for such an approach. In some places in her evidence, it was unclear whether the statements she quoted from third parties intended to use TALK FOR WRITING to refer to an approach from a particular trade origin or a generic approach (see for example, the reviews of the “Talk for Writing across the Curriculum” book). Moreover, Ms Strong and Mr Corbett work together closely and she cannot be described as providing a wholly independent view. To the contrary, Ms Strong was clearly involved in the evidence gathering exercise encouraging people to assist and saying, with some justification “Creating confusion in the minds of the public’ is one of our arguments and it’s one that

we haven't really got that much on at the moment" (see e-mail of 5 March 2015, exhibited to Ms Strong's second statement).

62. Although it is true that some of the material is consistent with the phrase TALK FOR WRITING being associated with Mr Corbett only in the sense that it is something he devised – including, it should be said, much of the evidence in his own statements - in my judgment, there was sufficient material presented for the hearing officer reasonably to conclude that the term TALK FOR WRITING used alone was sufficiently denotive of trade origin rather than merely a method for this objection to registration to fail.

63. Moreover, this is a somewhat unusual case in that the undertaking alleging that the mark is merely descriptive has itself applied to register marks whose dominant elements (namely the words) are similar to TALK FOR WRITING (namely TALK FOR LEARNING and TALK FOR MATHS). The hearing officer was therefore faced with a situation of rival claims to proprietorship of marks with similar features rather than a situation in which the appellant was exclusively contending that signs of this kind were, in effect, free for all to use. The appellant's conduct therefore suggests that "TALK FOR \_\_\_\_\_" is to be regarded as a brand and that there is no need to keep such terms free to describe such methodologies generally. I think that the hearing officer was also entitled to give some weight, as he did, to the fact that a former director of the National Literacy Trust thought that TALK FOR WRITING when used in relation to the services and goods for which it is proposed to be registered was, and would be perceived to be, a brand.

64. Fifth, the appellant specifically criticises para. [35] of the decision for stating that it had carried out extensive searches of the internet and could not find instances of the use of the phrase in relation to education and training services which did not have the words in italics or quotation marks "where it is clear that the use is in relation to a trade mark". It is true that there were a few web-pages which did not make it very clear what was being referred to and where there was an absence of italics/quotation marks but it is not in dispute that when

websites and documents refer to the methodology they do often use italics, quotations marks or capitalisation.

65. The appellant contends that the hearing officer was in any event wrong to rely on this material since it was unsurprising that when a teaching methodology was referred to (regardless of trade origin), it was referred to in that way and it does not follow that this was trade mark use. I agree that it does not follow that use to denote a named product of a kind available from multiple sources is not necessarily use to denote origin. However, I do not consider that this was really what the hearing officer was saying. In effect, he was saying that in general, the material showed use by third parties of the sign in question as denoting a specific trade origin rather than descriptively. One would not necessarily expect such documents to contain an additional identifier of trade origin if those using the term already thought that such methodologies were associated with a single trade source. As noted above, in my view he was entitled to reach that conclusion considering the evidence as a whole even though I do not consider the matter to be as clear as he did.

66. Sixth, I am not persuaded that the fact that TALK FOR WRITING approaches have been incorporated into the National Literacy Strategy wholly undermines the hearing officer's conclusion for two reasons. First, some of the government publications may have been using the term generically without the term thereby becoming generic generally (see above). In this connection, the hearing officer described exhibit DM02 in the following terms in the decision (para. [20]):

“This consists of a number of pages of uncertain origin as many are not identified, a number of which have “Crown Copyright 2008” printed upon them and are presumably ones which Mr Corbett was involved in as set out in his evidence. There are numerous references to TFW but all use it, in my opinion, in the form of a trade mark e.g. “using drama activities as a Talk for Writing strategy.”; “Such drama or talk activities can support children in creating and developing characters when writing fiction.” and “Each and all of these key Talk for Writing strategies”. Some have been downloaded from the internet recently, December 2014, but are otherwise undated. It includes a copy of *The National Literacy Strategy: Developing Early Writing* published by the Department for Education and Employment which makes many references to TFW all in a trade mark sense such as “working from the

talk for writing to show how a text is written”; “Talk for writing should be used to”; “These usually open with talk for writing and move into..”.

67. The appellant contends that the hearing officer failed adequately to engage with the points made on this and, in particular, the descriptive or generic use of “Talk for writing” in the National Literacy Strategy document. While several of the references in italics of “Talk for writing” could be taken as merely references to the methodology and that it does not follow that mere italicised reference is therefore use in a “trade mark sense”, the document says at the outset (p2):

“The *Talk for writing* approaches were initially developed through a series of workshops, which the National Strategies provided in collaboration with professional writer Pie Corbett...

...

The brief introduction to *Talk for writing* provided by this booklet is supplemented by extensive exemplification on two DVDs: one is an interactive resource drawing heavily on classroom video and case studies from schools that took part in the original workshops; the other offers key extracts from the *Talk for writing* CPD sessions presented by Pie Corbett on behalf of the National Strategies in May 2008.”

68. While I therefore accept the appellant’s criticisms of the hearing officer’s somewhat overgeneralised description of it, the document does make some link between the term TALK FOR WRITING and a specific origin of training services albeit that other parts of the document point in a different direction. Moreover, it is not impossible to conceive that a National Literacy Strategy would make use of some approaches which were only available from a single source (consider an education strategy which required every school child to be equipped with an “iPAD” – it would not follow that the sign “iPAD” was *ipso facto* generic).

#### *Discussion*

69. The position in the present case is that there was therefore evidence in favour and against the proposition that TALK FOR WRITING was a descriptive term – or more strictly, it appears to have been used in both senses in different contexts. Cases of this kind present real difficulties of evaluation, since marks of this kind generally fall on a spectrum of distinctiveness to descriptiveness/genericness. A tribunal has to make a binary decision as to

whether they are, in essence, sufficiently descriptive or generic, or may be used as such, for registration to be prevented, often on incomplete evidence as to the understanding of real consumers of the meaning of the term. Where a hearing officer has considered the evidence as a whole and has placed a mark on the “brand” side of an imperfectly defined line on the distinctiveness/descriptiveness spectrum, this tribunal is unlikely to be in a better position than the hearing officer to make a revaluation, especially where the primary position of the opponent to the mark is (in effect) that terms of this general kind are capable of being brands.

70. A well-known illustration of the difficulties of evaluation comes from the litigation over the mark BACH FLOWER REMEDIES (see the first instance decision *Healing Herbs Limited v. Bach Flower Remedies Limited* [1998] EWHC Patents 318). In that case, as here, there was evidence from the trade and members of the public, which presented a mixed picture: some regarded the mark as descriptive of a kind of product, others regarded the mark as denoting a specific trade origin. In that case, there was considerably more evidence than here including surveys (themselves equivocal) and many more witnesses, including experts. Cross-examination revealed that the witnesses were sometimes under a mis-apprehension which was not evident from their written statements or changed their view after questioning.

71. There was extensive reference in the judgment of the High Court to the case law on the caution required before conferring proprietary rights in respect of the name of new products, including the well known observations of Viscount Maugham in *The Shredded Wheat Co. Ltd -v- Kellogg Co. of Great Britain Ltd* (1940) 57 RPC 137.<sup>1</sup>

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<sup>1</sup> “[I]t may be useful to cite the statement by Mr Justice Parker in *In re Gramophone Company’s Application* [1910] 2 Ch. 423 at page 437 since he was a master in this branch of law: “For the purpose of putting a mark on the register, distinctiveness is the all-important point, and in my opinion, if a word which has once been the name of the article ought ever to be registered as a trade mark for that article, it can only be when the word has lost, or practically lost, its original meaning. As long as the word can appropriately be used in a description of the articles or class of articles in respect of which a trade mark is proposed to be registered, so long, in my opinion, ought the registration of that word for those articles or that class of article to be refused.”. See also *British Sugar* [1996] RPC 281 (“A manufacturer may coin a new word for a new product and be able to show massive use by him and him alone of that word for the product. Nonetheless the word is apt to be the name of the product and not a trade mark. Examples

72. Neuberger J, as he then was, ultimately concluded that the relevant marks fell foul of s.3(1) in various respects and said:

“There is no doubt that the evidence provides support for the applicant’s basic proposition that “Bach Flower Remedies” is and has been used to mean, and understood to mean, flower remedies prepared in accordance with the recipes of Dr Bach. However, it is also clear that there is evidence to support the respondent’s contention that the expression is both used to mean, and understood to mean, flower remedies from a particular source, namely the Bach Centre. Given that “Bach” is what is sometimes called a “fancy name” and that the evidence of some members of the public, practitioners and shopkeepers, and some of the printed material show that “Bach Flower Remedies” does operate, and did operate in 1979, as a badge of origin, there is no doubt that the respondent has made out a real case for maintaining the first mark.”

73. Despite there being some evidence to show that some members of the trade and public regarded the term as operating as a badge of origin, Neuberger J found that the mark was invalid being registered contrary to sections 3(1)(c) and (d) of the Act and that is one source of my doubts in this case.

74. There are, however, material factual differences here from that case and I mention it only to illustrate the nature of the issues that arise and the difficulties the hearing officer had in making a decision on the basis of much more limited and untested material. There was less evidence (on both sides) than in that case and the factual background was different. The evidence that was provided was not challenged or subject to the kind of expert criticism that the evidence of the proprietor faced in the *BACH FLOWER REMEDIES* case. That case was a full High Court trial conducted at what appears to be considerable expense, not a determination by the Registrar. Even in that case, the High Court reached its conclusion with some hesitation, since there was evidence supporting both sides of the argument. That well illustrates the point that these are kinds of cases

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from old well-known cases of this sort of thing abound. The *Shredded Wheat* saga is a good example: [in] the Canadian case.... (1938) 55 RPC 125... Lord Russell said at 145: "A word or words to be really distinctive of a person's goods must generally speaking be incapable of application to the goods of anyone else." It is precisely because a common laudatory word is naturally capable of application to the goods of any trader that one must be careful before concluding that merely its use however substantial has displaced its common meaning and has come to denote the mark of a particular trader.”).

where fine decisions have to be made but on the basis of evidence that rarely presents an unequivocal picture.

*Conclusion on s.3(1)(c)*

75. In my judgment, on the materials presented to the hearing officer in this case, there was, albeit marginally, sufficient basis for the conclusion that he reached. This is, however, a situation in which it is not possible to be confident that this tribunal would have decided it the same way, had it been evaluating the matter *de novo* or indeed that were such an issue to be revisited, for example in the context of infringement proceedings, there would be the same result.

76. The principles articulated above as to appellate restraint have some force here. For the reasons given above, the question is not whether I or others might have decided the case differently on the same evidence, still less whether they might do so on different evidence, but whether the hearing officer was wrong to have decided it in the way he did, on the evidence before him. In my view, at some points he somewhat overstated the position, which was more equivocal and nuanced than he was prepared to allow. However, I am not satisfied, taking the evidence as a whole, that the hearing officer was wrong to decide it as he did. Accordingly, this ground of appeal is not made out.

**Section 3(1)(d) – mark has become generic**

77. The Hearing Officer dealt with the objection under section 3(1)(d) as follows. First, he set out the law as summarized by the General Court in *Telefon & Buch Verlagsgesellschaft mbH v OHIM* (Case T-322/03) of which it suffices to quote just two paragraphs to which he referred, since the approach he took to the law is not criticised:

“49. Article 7(1)(d) of Regulation No 40/94 must be interpreted as precluding registration of a trade mark only where the signs or indications of which the mark is exclusively composed have become customary in the current language or in the bona fide and established practices of the trade to designate the goods or services in respect of which registration of that mark is sought (see, by analogy, Case C-517/99 *Merz & Krell* [2001] ECR I-6959,

paragraph 31, and Case T-237/01 *Alcon v OHIM – Dr. Robert Winzer Pharma* (BSS) [2003] ECR II-411, paragraph 37). Accordingly, whether a mark is customary can only be assessed, firstly, by reference to the goods or services in respect of which registration is sought, even though the provision in question does not explicitly refer to those goods or services, and, secondly, on the basis of the target public’s perception of the mark (*BSS*, paragraph 37).

50. With regard to the target public, the question whether a sign is customary must be assessed by taking account of the expectations which the average consumer, who is deemed to be reasonably well informed and reasonably observant and circumspect, is presumed to have in respect of the type of goods in question (*BSS*, paragraph 38).”

78. Second, the Hearing Officer went on to evaluate the objection as follows, referring back to the facts he had previously found:

“38) TTE contends that the mark in suit has become generic in the education industry. I accept that the term is well known in the industry and is used as the name of the methodology used by PCC, as such the use made of it by others in various documents is use of the mark as an indication of origin. The fact that the mark represents the name of a methodology does not mean that the objection is made good, so long as that methodology retains its proprietary nature, which I consider it does. The relevant public has been set out earlier in this decision. As set out earlier, the evidence shows no uses of the term “Talk for writing” in anything other than a trade mark sense that predate the use by PCC. TTE contends that the evidence shows that the expression TALK FOR WRITING was customary in the trade. The evidence falls a long way short of establishing such a proposition. I cannot hold that the evidence establishes that the term was “customary in the current language or in the bona fide and established practices of the trade” from the viewpoint of the relevant public at the relevant date. **Consequently, I reject the ground for invalidation based on section 3(1)(d) of the Act.**”

79. The appellant criticises this passage for failing properly to evaluate the whole of the evidence relating to use of TALK FOR WRITING. The appellant contends that the phrase had, long before the priority date come to indicate a particular type of educational service, namely the teaching of writing following the TALK FOR WRITING approach and that the hearing officer’s dismissal of this objection in para. [38] is plainly wrong because it asserts without any basis that the methodology “retains its proprietary nature”. The appellant draws particular attention to the fact that the methodology was made freely available to the teaching community as part of the National Literacy Strategy discussed

above. The appellant also refers to the uses of the term TALK FOR WRITING apparently as a descriptive term in some of the other exhibits.

80. At the hearing, rightly in my view, the case focused on section 3(1)(c) but it was said of section 3(1)(d) that if the mark was not descriptive, it had been made descriptive by the use that had been made of it both by PCC and others. The argument was very similar as were the materials referred to.

81. As with the section 3(1)(c) objection, there is some substance in the appellant's criticism and in my view the Hearing Officer again somewhat overstated the position. There are some uses of the term TALK FOR WRITING in a way where it is at least unclear whether it is used to refer to services with a particular origin or simply a kind of methodology. However, for essentially the same reasons given above, it seems to me that there are uses where the term TALK FOR WRITING is used by the author to refer specifically to the services provided by Mr Corbett and his consultancy. I have referred to some of these above. I have also set out above some of the material relating to the National Literacy Strategy. The points here are similar to those made above with respect to section 3(1)(c).

*Conclusion on s.3(1)(d)*

82. In my judgment, the hearing officer was entitled to conclude that the evidence taken as a whole fell short of showing that the term TALK FOR WRITING had become generic and that it was precluded from registration by section 3(1)(d) of the Act. The hearing officer expressed this point in a somewhat shorthand way by saying that the mark had not lost its proprietary nature and, in my judgment, although that was a somewhat abbreviated expression of a complex determination, it was one which he was entitled to make.

83. Ultimately, it was accepted that the argument on section 3(1)(b) did not add anything. The case based on section 3(1)(a) was not pursued.

84. Stepping back from the detail of the case and the criticisms made of the hearing officer's decision, this seems to me a case in which the overall justice of the situation is best served by giving this trade mark and the hearing officer's decision concerning it the benefit of the distinctiveness doubt on this opposition while inviting subsequent tribunals, should it come to be asserted, to engage in more intensive scrutiny of the question of descriptiveness including possibly section 11 of the Act, in the event that particular uses of the term TALK FOR WRITING or similar terms are challenged. Nothing in this decision should be taken as warranting a "complete monopoly" (in the appellant's words) in respect of all uses of TALK FOR WRITING in the educational field which was a key objection advanced by the appellant.

#### **Conclusion on the TALK FOR WRITING mark**

85. For the reasons given above, the appeal in respect of the TALK FOR WRITING mark will be dismissed.

#### **TTE's TALK FOR MATHS and TALK FOR LEARNING marks**

86. The appellant contends that the hearing officer should have allowed the registration of the two word marks in logo form as shown above.

87. The hearing officer held that the marks were precluded from registration on the grounds that use of them would constitute passing off (section 4(1)(a)) and that they were applied for in bad faith (section 3(6)). The appellant contends that the evidence did not come close to establishing either ground of objection and that its marks should have been registered, just as Talk for Writing was registered.

#### **Section 4(1)(a) – passing off**

88. The hearing officer first set out the well-known principles of law largely derived from *WILD CHILD* in a manner which is not criticised and which I do not need to reproduce and then said:

"51) In its evidence PCC has clearly shown that it has used the mark TALK FOR WRITING (TFW) since 2003. Initially as a sole trader and then as PCC Mr Corbett has built a significant reputation in the educational industry in the UK for his methodology which he branded

Talk For Writing. In 2006 the Department for Education engaged him to lead a nationwide project based around his TFW teaching system. He even employed a young inexperienced teacher, Mr Maytham, as part of the team delivering training in schools in 2007. A number of independent witnesses have provided evidence, albeit not necessarily in the form of witness statements, to the effect that TFW is associated with PCC. I am therefore persuaded that PCC has cleared the first hurdle in that it has goodwill in the mark TFW in relation to the provision of education and training as of December 2006.

52) It is accepted that a common field of activity is not required as stated in *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA). In the instant case TTE have sought to register its marks for goods in class 16 and services in class 41. To my mind, the services in class 41 can be summed up as being educational and training services similar to which PCC has goodwill and reputation. I accept that the goodwill of PCC is in relation more to literacy education and that some of the services of TTE are couched in terms which are clearly not literacy education based there is still some similarity. With regard to the goods in Class 16 these would appear to be designed to be used as part of the delivery of the education and training services and as such must be considered at least moderately similar to the services in which PCC has goodwill.

53) The marks applied for are shown on the front cover. Whilst they are in a slightly stylised font they are not particularly unusual. Both have coloured backgrounds but there is no colour claim made for either mark. To my mind the signs would be viewed as being similar in all ways to the mark used by PCC, albeit with the subject matter of the education being varied (writing/learning maths). **In the instant case with both parties offering, broadly speaking, education and training services, and goods used in the delivery of said services, and both using highly similar signs there is no doubt in my mind that there will be misrepresentation, as a substantial number of people will understand the applied for marks as an extension of the already established TFW system that they have already experienced and that it would be offered by PCC or by some form of economically linked undertaking.”**

89. The appellant contends that this evaluation was erroneous for the following main reasons, summarising its skeleton argument on this appeal.

90. First, it is said that had the Hearing Officer found that TALK FOR WRITING was descriptive to the relevant consumers of a methodology *per se*, whether inherently or due to education by its use as the name of that methodology by governmental bodies and Pie Corbett and/or PCC themselves, then his findings that the phrase was distinctive of PCC (in para. [51] of the decision) and that

use of it amounted to a misrepresentation (in para. [53] of the decision) would not have followed.

91. In my judgment, the appellant's logic is correct but the premise of the argument is not well-founded. The hearing officer held that the phrase was at least sufficiently distinctive, not descriptive and not generic and I have not overturned that decision on this appeal. Accordingly, in my view this aspect of the case falls to be resolved in the same way as the case on descriptiveness/generic meaning discussed above. While reasonable people may differ, I do not consider that the hearing officer's evaluation can be described as wrong. This ground of appeal is not made out.
92. Second, the appellant contends that the hearing officer's finding was additionally flawed in that he did not give proper consideration (especially in para. [53] of the decision) to the fact that the appellant's applications include different text to the TALK FOR WRITING mark and also figurative elements.
93. The appellant observes that the hearing officer found that the signs were "highly similar" which amounted to a finding in effect that the "TALK FOR" element of the marks was the part distinctive of PCC. That finding effectively required him to conclude that "TALK FOR" by itself indicated PCC, whereas it is said that the evidence showed that this prefix was not of itself distinctive exclusively of PCC. The appellant refers particularly to exhibit DM06 which showed the use by third parties of "Improving Talk for Teaching and Learning" (a programme directed to improve the quality of teaching through dialogic teaching developed by Professors Alexander and Hardman); "Talk for Change" (psychological help for Sussex residents); "Talk for Health" (a social enterprise programme set up to provide talk based routes to well-being); "Talk for Learning" (A North Yorkshire Talk for Learning project); A "Talk for Learning" session given by Dr Lyn Daws, Senior Lecturer in Education at the University of Northampton. This material is supportive of the appellant's case that "TALK FOR LEARNING" is not a term which uniquely denotes the services of a single undertaking.

94. The problem, however, is that in applying for the trade marks in the form in question, the appellant has, in effect, asserted that it and only it, is entitled to make use of the term TALK FOR LEARNING and TALK FOR MATHS in providing courses in the educational field – it has not disavowed any exclusive use of such terms. Moreover, these marks proclaim themselves to be brands rather than descriptions. The fact that the words TALK FOR LEARNING and TALK FOR MATHS are in the particular logo form is, if anything, likely to lead those who see the marks to think that they are signally a specific trade origin and that the “brand” is “TALK FOR” to a greater extent than if they were simply applications for the combination of the words as such which are, as noted above, more ambiguous as to their nature as designators of origin.
95. In my judgment, and in contrast to the uses referred to in DM06 which appear to me more naturally viewed as descriptive, a consumer of the services seeing the marks in question used in relation to the services for which they are proposed to be registered would be more likely to think that they were denoting trade origin rather than simply a type of service. That, in turn, would give rise to the immediate question for consumers: what trade origin? In my judgment, on the basis of the factual findings concerning the goodwill established by PCC in respect of TALK FOR WRITING and the (albeit limited) evidence of potential confusion as to origin in the evidence, there was sufficient basis for him to conclude, on the admittedly thin material on this issue provided on both sides, that a sufficiently significant number of relevant individuals would consider that the services were connected in a relevant way with PCC for section 4(1)(a) to be satisfied. I can understand how the hearing officer could have concluded, in substance, that a substantial proportion of people familiar with the TALK FOR WRITING courses and materials provided by PCC, would think that similar courses and materials which were branded TALK FOR MATHS or TALK FOR LEARNING were spin-offs connected with the same trade source, if that were the only branding used which (in contrast to a “real” action for passing off) is the basis upon which the notional evaluation must be made under the Act.
96. I am not persuaded that the hearing officer gave no real consideration to the issue of alleged descriptiveness of the mark in this connection. The part of the

decision concerning section 4(1)(a) followed directly from the analysis of whether the mark TALK FOR WRITING was or was not descriptive or generic and he must have had this issue in mind at least generally. In my judgment, he did not fall into the error alleged in holding that a substantial number of people would understand the marks applied for as denoting services offered by PCC or by some form of economically linked undertaking.

97. Accordingly, this ground of appeal is not made out.

### **Section 3(6) – bad faith**

98. In view of my conclusions on section 4(1)(a), I do not need to go on to consider the appeal based on section 3(6).

99. However, I have real doubts as to whether the brief and general analysis by the hearing officer of this issue in the decision did proper justice to the facts of the case and was sufficiently focussed on the requirements of the law to show that the applicant effectively knew and intended to shut the legitimate proprietor of a mark out from using it or otherwise wrongfully appropriating it in such a way that the conduct fell short of the required standard expected of reasonable businesspeople.

100. Mr Maytham has given evidence to the effect that he was not seeking to shut out PCC from using the terms TALK FOR WRITING or TALK FOR MATHS or any other term and that, in applying to register the marks, he was trying to protect that which he believed he was entitled to and had himself developed, namely TALK FOR MATHS and TALK FOR LEARNING. He has also given evidence that he drew Mr Corbett's attention to what he was doing and what he was proposing commercially and did not meet objection to it until a later stage (see summary above). None of that evidence was challenged by cross-examination. There are real conflicts of evidence, summarised above, which the hearing officer did not attempt to resolve in his evaluation of bad faith.

101. The hearing officer appears to have taken the view that Mr Maytham's conduct in, in essence, setting up a potentially rival business in a slightly different area of focus to that of his previous supporter was open to criticism on the basis that

he knew of the use and goodwill attaching to a brand which was, in effect, “TALK FOR....”.

102. That, in my judgment, is not sufficient. A person is entitled to compete with that of a previous employer, even where that employer has supported the ex-employee or contractor and is entitled to apply to register trade marks to do so even if that has a damaging business impact on the previous employer and might be regarded as a somewhat disloyal repayment for past support provided that doing so does not fall below the standards to be expected of reasonable business people.
103. There is a fundamental difference between pursuing an aggressive, self-interested but nonetheless bona fide trade mark application strategy with a view to seeking maximum protection for one’s own business and limiting the freedom of others to use marks known to be theirs or otherwise acting in bad faith. As Arnold J said in *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited and others*. Arnold J. said:

“189. In my judgment it follows from the foregoing considerations that it does not constitute bad faith for a party to apply to register a Community trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. For example, it is not uncommon for prospective claimants who intend to sue a prospective defendant for passing off first to file an application for registration to strengthen their position. Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration. The applicant may not intend to seek to enforce the trade mark against the third parties and/or may know or believe that the third parties would have a defence to a claim for infringement on one of the bases discussed above. In particular, the applicant may wish to secure exclusivity in the bulk of the Community while knowing that third parties have local rights in certain areas. An applicant who proceeds on the basis explicitly provided for in Article 107 can hardly be said to be abusing the Community trade mark system.”

104. This illustrates the important difference between making a bona fide claim to a mark which is not ultimately justified and making an application in bad faith.

In my view, the hearing officer's analysis did not do sufficient justice to that distinction.

105. Taken as a whole, I am not therefore persuaded that the finding of bad faith was justifiable and, for my part, would not have held it made out on the evidence in this case, had I had to decide the matter at first instance. I think there is also considerable force in some of the other points made by the appellant to the effect that the hearing officer failed to make relevant findings as to the precise intentions of the appellant in applying for the marks and that he was required to do so by the case law. However, in the light of my conclusions above, those points do not matter to the ultimate outcome of the appeal and it is not appropriate to analyse them further.

#### **D. OVERALL CONCLUSION**

106. For the reasons given, the appeal will be dismissed.
107. It will however be evident from the above that, while I have rejected the appeal and have not held the hearing officer to be wrong on the materials before him, there remain real doubts as to the extent to which exclusivity in the use of the term TALK FOR WRITING is justified in the light of the full facts. Should that mark come to be asserted, a court will need to scrutinise afresh, with the benefit of fuller evidence and cross-examination of the kind undertaken in the *BACH FLOWER REMEDIES* and other cases, the contentions that the mark is descriptive or has become generic and, in particular, whether any given use by a third party is bona fide descriptive use, protected by section 11 of the Act. A different tribunal on different evidence may reach conclusions different from those of the hearing officer and which I have, albeit with some hesitation, not thought it right to overturn.

#### **E. COSTS**

108. The hearing of the appeal occupied less than a day but there were reasonably comprehensive skeleton arguments which would have taken some time to prepare. The hearing officer awarded PCC £1100 in respect of preparing for and attending the hearing and costs of £3300 overall. An award of costs of £750 in

favour of PCC in respect of this appeal is appropriate and has regard to the fact that PCC has not succeeded in every respect. Importantly, in my view for Mr Maytham and his business, I have not endorsed the hearing officer's finding of bad faith and have held that certain aspects of the criticisms of the hearing officer's decision were justified.

109. That sum, together with the costs ordered below, should be paid within 14 days.

DANIEL ALEXANDER QC

APPOINTED PERSON

19 January 2017

**Representation**

Mr Jonathan Hill, instructed by Sanderson & Co appeared for the Appellant

Miss Charlotte Scott, instructed by Chadwick Lawrence LLP appeared for the Respondent