

**TRADE MARKS ACT 1994**

**IN THE MATTER of trade mark application 2464158  
by Plant Handling Ltd to register two marks  
EASYRAMP and EASY RAMPS as a series in Class 7**

**IN THE MATTER of Opposition No. 96863  
by Thorwold Industries Ltd**

**Appeal of the Applicant from the decision of  
Mrs. Judi Pike dated 29 September 2009**

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**DECISION**

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1. This is an appeal against a decision of Mrs Judi Pike, the Hearing Officer for the Registrar, dated 29 September 2009, in which she upheld an opposition to the registration of the marks EASYRAMP and EASYRAMPS for goods in Class 7. The applicant was Plant Handling Ltd, ("Plant Handling") and the opponent Thorwold Industries Ltd. ("Thorwold").

**Background**

2. There is quite a history behind this appeal.
3. On 3 March 2007, Thorworld Industries Ltd applied to register the mark "Easyramp" for "ramps for the loading and unloading of goods vehicles; wheelchair ramps; doorway/threshold ramps; and curb/step ramps" in Class 7. Its application (no. 2448353) was opposed by Plant Handling Limited under section 5(4)(a) of the Act on the basis of Plant Handling's prior use of the mark in relation to "container loading ramps."
4. Both parties filed evidence in relation to that opposition, but no hearing was sought, and neither party filed any written submissions. The Hearing Officer in that case, Mrs Corbett, therefore dealt with the opposition on the basis of the written evidence before her. Her decision dated 13 October 2008 was given reference number BL O-278-08. She found that the parties were competitors in respect of loading ramps, although the market for ramps is a large one. She also found that Plant Handling had accrued goodwill in the mark in relation to "container loading ramps" as at the

relevant date, whilst Thorwold was the “senior user” of the mark in relation to ramps for use by persons with a disability. On that basis, she found that the opposition succeeded in relation to “ramps for the loading and unloading of goods vehicles.” However, she permitted Thorworld’s application to proceed to registration in respect of “wheelchair ramps; doorway/threshold ramps; and curb/step ramps.”

5. Thorworld lodged an appeal against Mrs Corbett’s decision to the Appointed Person, on the basis that the Hearing Officer had been wrong to restrict its application as she did. Plant Handling did not cross-appeal nor did it take any part in the appeal proceedings. The appeal was heard by Professor Annand; her decision dated 20 July 2009 is found under reference number BL O-215-09. She held that the Hearing Officer had been entitled to arrive at the decision that she did under section 5(4)(a).
6. Moreover, Professor Annand commented that “Contrary to Thorworld’s perceptions there is no overall limitation to disabled or to domestic use.” As will be seen below, the scope of Thorwold’s specification and the lack of any limitation to “disabled or to domestic use” is a significant element in the current appeal.
7. Plant Handling's opposition to Thorwold’s application had been filed on 10 August 2007. On 14 August 2007, Plant Handling filed its own trade mark application (no. 2464158) to register the marks Easyramp and Easyramps as a series of two marks for a wider specification of goods in Class 7 (see Annex 1 to this judgment) which included all of the goods in Thorworld’s application. On 14 April 2008 (well before Mrs Corbett's decision was made), Thorwold lodged its own opposition to Plant Handling's application based on sections 5(1), 5(2) and 5(4)(a) of the Act.
8. Perhaps unfortunately, the parties did not apply to have the two oppositions heard together. Thorworld’s application, opposed by Plant Handling, was decided first by Mrs Corbett, and confirmed on appeal by Professor Annand. Plant Handling’s application, opposed by Thorworld, was later decided by Mrs Pike. Her decision, dated 29 September 2009, was made after Thorworld's trade mark had been registered.
9. Mrs Pike's decision was made on the basis of the written evidence filed by both parties but again without the benefit of any written submissions or a hearing.
10. Mrs Pike found, in essence, that:
  - a) The parties’ marks were identical. This is not contentious;
  - b) Thorwold’s opposition under s 5(4)(a) failed, because it had produced insufficient evidence to substantiate its claim to have established goodwill in the mark prior to Plant Handling’s use, which had commenced in 2004;

- c) Thorwold's opposition under s 5(1) succeeded in respect of the identical goods in the two specifications, namely "wheelchair ramps; doorway/threshold ramps; and curb/step ramps" and
  - d) Thorwold's opposition under s 5(2) succeeded in respect of the remaining goods in Plant Handling's specification, which Mrs Pike found were all similar to those for which Thorwold's identical mark had been registered.
11. Plant Handling did not appeal the findings under section 5(1). Indeed, its TM55 was filed under cover of a letter in which it indicated its wish to delete from its proposed specification of goods "wheelchair ramps; doorway/threshold ramps; and curb/step ramps", that is, the goods which were identical to those in Thorwold's specification. Hence, its appeal relates only to the position under section 5(2). Nevertheless, Plant Handling's position expanded in some respects as the appeal proceeded, as I explain below. There was no cross-appeal by Thorwold on the section 5(4) grounds.
12. The Grounds of Appeal were brief, and I set them out in full:
- "1. The Hearing Officer erred in his [*sic*] interpretation of what constitutes similar goods under section 5(2).
  - 2. The goods applied for by [Plant Handling] found to be similar to those remaining goods protected under registration no. 2448353 under section 5(2) are not in competition with each other and are not complementary.
  - 3. The goods applied for by [Plant Handling] are sold within a different channel of trade to those remaining goods protected under registration no. 2448353.
  - 4. The goods applied for by [Plant Handling] are sold to a different type of consumer to the opponent [*sic*].
  - 5. The goods applied for by [Plant Handling] are of an entirely different nature and use to those protected under registration no. 2448353."
13. The thrust of all the Grounds was therefore the same: that the parties' respective goods were not similar. There was no reliance in the Grounds of Appeal upon any alleged inconsistency between the decisions of the Hearing Officers in the two oppositions. Nevertheless, a great deal of reliance was placed by Plant Handling, at the appeal before me, upon the findings made by Mrs Corbett in the first opposition. In his skeleton argument for the appeal, Mr Silcock who appeared on behalf of Plant Handling, not only challenged Mrs Pike's analysis of the similarity between the goods, but also argued (in essence) that because the words "ramps for the loading and unloading of goods vehicles" had been struck out of Thorwold's trade mark application by Mrs Corbett, Plant Handling was entitled to register its mark for those goods. He argued that the decisions made by the two Hearing Officers were not

consistent, contrary to Plant Handling's legitimate expectation that they would be. I examine this argument further below.

14. Mr Silcock opened his submissions on the appeal by indicating that his client wished to pursue its application, and the appeal, in relation to only some of the goods contained within the original specification. Instead of the rather long specification which I have set out at Annex 1 to this decision, Plant Handling had decided to pursue its application only in relation to "container ramps; mobile loading container ramps; ramps for the loading and unloading of goods vehicles; parts and fittings relating to the aforementioned." No notice of that late modification to Plant Handling's position had been given to Thorworld, even in Plant Handling's skeleton argument.
15. Furthermore, Mr Silcock's submissions on the appeal expanded his skeleton argument in two respects. First, he sought to rely upon the decision of Mr Hobbs QC in *Citybond trade mark* [2007] R.P.C. 301 in support of the point as to a right to registration (discussed at paragraphs 25 ff below) which did not appear in either the Grounds of Appeal, or his skeleton argument. Secondly, he addressed me on the issue of consistency between judgments (discussed at paragraphs 31 ff below), in a manner which went well beyond the legitimate expectation point made in his skeleton argument, and he relied upon an authority which had not been provided in advance to Mr St Quintin, who appeared for Thorworld. Normally, of course, an Appointed Person will be reluctant to entertain points on appeal which have not been taken below, all the more so where such points are not properly raised in the Grounds of Appeal. However I decided at the hearing that it would be appropriate for me in this case to consider the additional points raised by Plant Handling, and that the best way to deal with these points was to permit the parties to lodge further written submissions sequentially. Unhappily, that caused further delay in resolving the case, which had already taken a substantial time to get to the appeal hearing.

#### **Standard of review**

16. The standard of review for this appeal is helpfully set out at paragraphs 5-6 of the decision of Daniel Alexander QC in *Digipos Store Solutions Group Limited v. Digi International Inc* [2008] RPC 24:

"5... It is clear from *Reef Trade Mark* [2003] RPC 5 ("*Reef*") and *BUD Trade Mark* [2003] RPC 25 ("*BUD*") that neither surprise at a Hearing Officer's conclusion nor a belief that he has reached the wrong decision suffice to justify interference by this court. Before that is warranted, it is necessary for this court to be satisfied that there is a distinct and material error of principle

in the decision in question or that the Hearing Officer was clearly wrong (Reef). As Robert Walker LJ (as he then was) said:

*“...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” (Reef, para. 28)*

6. This was reinforced in *BUD*, where the Court of Appeal made it clear that it preferred the approach of the appellate judge but nonetheless held that there was no error of principle justifying departure from the Hearing Officer’s decision. As Lord Hoffmann said in *Biogen v. Medeva* [1997] RPC 1 at 45, appellate review of nuanced assessments requires an appellate court to be very cautious in differing from a judge’s evaluation. In the context of appeals from the Registrar relating to section 5(2)(b) of the Act, alleged errors that consist of wrongly assessing similarities between marks, attributing too much or too little discernment to the average consumer or giving too much or too little weight to certain factors in the multi-factorial global assessment are not errors of principle warranting interference.”

The decision with regard to each of the issues in this case involved a multi-factorial assessment of the kind mentioned above.

17. In the somewhat unusual circumstances of this appeal, it seems to me that the first point which I ought to decide is whether the Hearing Officer erred in her appreciation of the similarity of the goods in the parties’ respective specifications (or at least those parts of Plant Handling’s specification which are still in issue). If she did, then I need not consider Mr Silcock’s additional arguments. If she did not, then (to the extent it is right to do so) I do need to address them.

#### **Issues about the similarity of the goods**

18. Plant Handling’s criticism of the Hearing Officer’s views as to the similarity of the goods in each specification was that the evidence (and Mrs Corbett’s and Professor Annand’s earlier decisions) showed that the parties were operating in "entirely separate fields of activity, and that the goods covered by the parties' respective specifications are in fact, to the average consumers of those goods, entirely different from one another.”
19. There is some force in the point that the evidence showed that the parties had been operating under the disputed marks in rather different parts of the broader ‘ramps’ market, although there was some evidence showing that Thorworld (which sells a variety of different types of ramps under other marks) had used the Easyramp mark in relation to a wider range of goods than just wheelchair/disability ramps. For instance, its evidence included a brochure showing a multi-purpose ramp, which it

said was for use by motorcycles or sack trucks as well as wheelchairs. The extent of such use was not proven.

20. The Hearing Officer started the relevant part of her decision by a discussion of the core legal principles of the assessment of a likelihood of confusion, set out in the usual manner. The appellant did not criticise her analysis but complained that she had failed to apply the law properly. Mrs Pike went on to compare the goods. For brevity, I have where possible removed references to parts of the specification not pursued, as well as Mrs Pike's footnotes, and/or inserted the names of cases cited:

"32) In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary [*Canon*]. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed.

33) Some of the goods listed in the application are evidently for use in commercial or industrial situations: container ramps; mobile loading container ramps; ... ramps for the unloading of goods vehicles. Loading ramps; lifting ramps; metal loading ramps; hydraulic lifting ramps; hydraulic mobile platforms could also be for use in commercial or industrial applications. These are not limited to an area of use; consequently, they cover non-commercial/industrial application. For instance, ramps are used in farming vehicles, temporary polling stations use ramps for accessibility for wheelchairs and parents with pushchairs, and swimming pools and theatres use hydraulic lifting platforms. Trailer ramps could be for commercial car transport trailers, agricultural trailers or for the boat enthusiast. In all cases, the purpose is to provide accessibility, whether for a person or for goods.

34) These are not self-serve consumer items. They are both in competition and complementary; one might choose a platform as providing more accessibility than a ramp. The goods in the application which are not actual ramps or platforms could form the parts and fittings of ramps and platforms and so are complementary in the sense that, for example, handles and hydraulic mechanisms require something to be attached to in order to perform their function.

35) An assessment of trade channels presents more difficulty owing to the array of possible uses for the goods which are unlimited as to area of use. Some of the evidence filed in these proceedings (exhibit JF9) shows that container ramps; mobile loading container ramps; trailer ramps; apparatus used for loading and unloading containers; ramps for the unloading of goods vehicles are purchased through specific trade channels, rather than retail/domestic channels. There has been little evidence filed in the proceedings to guide me as to whether, for example, domestic wheelchair ramps would or would not be sold through the same trade channels as ramps for the loading of goods vehicles. However, Thorworld's specification also includes doorway/threshold ramps and curb/step ramps. These could be for loading bay applications and so come much closer to container and goods

ramps. In medical, hotel, retail, domestic and community environments where accessibility is an issue, wheelchair ramps and lifting platforms perform interchangeable functions. The trade channels for each of these could be very close, or identical.

36) Taking into account the multiple uses of the applicant's unlimited goods and the unlimited nature of most of Thorworld's goods, my conclusion is that there is a high degree of similarity between the goods of the opponent and the following goods in the application (I have removed the goods which I have already found must be refused under section 5(1) of the Act):

*... container ramps; mobile loading container ramps; ... .*

37) ... Parts and fittings relating to the aforementioned are also highly similar to ramps; because the parts and fittings are for ramps, they are complementary to ramps [*Oakley*, Case T-116/06].

38) All the goods of the application are highly similar to those of the earlier mark.

#### *Average consumer and purchasing process*

39) ... I must consider the relevant public across the entire range of the goods and services. The matter must be judged through the eyes of the average consumer for the goods or services in question (*Sabel*), so I have to assess the nature of the average consumer and how they are most likely to encounter and/or purchase the goods.

40) I have already found that there is a large range of uses to which ramps and platforms can be put. The relevant user in materials handling is not the same as someone making their domestic premises more accessible. The goods will vary in price according to their nature: industrial hydraulic platforms will be more expensive than loading ramps. The average consumer is circumspect is to be regarded as reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change depending on the particular goods in question (see, for example, the decision of the CFI in *Inter-Ikea Systems BV v OHIM* (Case T-112/06). The purchase of a ramp, platform or lift is unlikely to be a casual purchase. It is likely to be an infrequent purchase. Prior to the purchase the product specification is likely to be examined for precise information about its functionality, weight restrictions, power rating and so on. The identification of the trade mark will be an element of the information gathering exercise, so it is primarily a visual purchase, and one that is made carefully.

#### *Conclusion in relation to likelihood of confusion*

41) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark (either by nature or nurture) the greater the likelihood of confusion. ... The trade mark identifies goods that are ramps which are easy to use. It is clearly allusive of the goods and will leave little to the imagination of the average, relevant consumer. Thorworld's evidence does not boost the earlier mark's inherently moderate distinctive character.

42) The marks are identical and so the likelihood of comparison hinges upon the comparison of goods because a greater degree of similarity between the marks may be offset by a lesser degree of similarity between the goods. I have found that there is a high degree of similarity between the goods. In making my prospective analysis of the likelihood of confusion, I consider that there would be a likelihood of confusion. The opposition succeeds in relation to all the goods of the application.”

21. Mrs Pike had therefore set out the essential matters to be considered in comparing the parties' respective specifications. At the hearing of the appeal, I expressed some concern as to whether she had followed that guidance through in relation to all of the categories of goods in Plant Handling's rather lengthy specification. However, on further consideration, it seems to me that my concern was misplaced; perhaps Mrs Pike could have expressed her decision more clearly, but in my judgment she did consider each of the factors relevant to an assessment of similarity of goods. In paragraph 33 she identified the fact that all of the goods in Plant Handling's specification could be used in either non-commercial or industrial applications, although she did not specifically say that that she was looking only at its specification. However, I think that becomes clear when one looks at paragraph 36 of her decision where she compares the "multiple uses of the applicant's unlimited goods" with the "unlimited nature of most of Thorworld's goods.”
22. In paragraph 34, again, it is not absolutely clear what comparison is being carried out, but given the narrower specification now sought by Plant Handling, I do not think that the slight qualms I have about the opacity of that paragraph are of significance to the appeal. Paragraph 35 discusses the question of trade channels and, because of the breadth of Thorworld's specification, as the Hearing Officer said, it seems to me that there is no error in her analysis.
23. In my judgment, the appellant's criticisms of the decision are misplaced insofar as they complain that “disabled ramps” are not similar to “container ramps.” The argument is misconceived because it is based upon a comparison of the goods previously sold by the each of the parties under the identical marks, rather than a comparison of their respective trade mark specifications. For the purposes of s 5(2), it is the specifications which must be compared (see e.g. Case C-171/06 P *T.I.M.E. ART Uluslararası Saat Ticareti ve dis Ticaret/OHİM - Devinec Développement Innovation Leclerc* [2007] ECR I-41). If Plant Handling was suggesting that the Hearing Officer in this case ought to have carried out a comparison between disabled ramps and container grounds, and erred because she did not do so, I do not accept that submission. As I have already mentioned, and as Professor Annand pointed out in the appeal before her, Thorworld's specification is not limited to ramps for disabled use: the “doorway/threshold ramps; and curb/step ramps” included within

its specification are not limited to ramps used for wheelchair or disabled access. In my judgment the Hearing Officer's consideration of a full range of types of ramps and platforms was appropriate and she did not err in the way Plant Handling suggests.

24. For the same reason, it does not seem to me that the Hearing Officer's analysis of the average consumer and purchasing process is plainly wrong; her conclusions flow logically from her earlier findings. I would, therefore, refuse the appeal on the basis of the straightforward basis set out in the Grounds of Appeal.

25. I move on to the first of Mr Silcock's additional points. In essence, his position was that Thorworld's registration could not prejudice any earlier unregistered rights that Plant Handling had in the mark, and that not only did this mean that Plant Handling could continue to *use* its mark, but that it was entitled to *register* it in relation to any goods in which it had an earlier unregistered right. Mr Silcock relied upon Article 16 (1) of the TRIPs Agreement, which provides:

"The owner of a registered trade mark shall have the exclusive right to prevent all third parties not having the owner's consent from using in the course of trade identical or similar signs for goods or services which are identical or similar to those in respect of which the trade mark is registered where such use would result in a likelihood of confusion ... the rights described above shall not prejudice any existing prior rights, nor shall they affect the possibility of Members making rights available on the basis of use."

It is worth noting, too, that Article 17 provides for certain "Exceptions"

"[Member states] may provide limited exceptions to the rights conferred by a trade mark, such as use of descriptive terms, provided that such exceptions take account of the legitimate interests of the owner of the trade mark and of third parties."

26. It is common ground, following Case C 245/02 *Anheuser-Busch Inc v Budejovicky Budvar NP* [2004] E.C.R. I-10989, [2005] ETMR 27, that the judicial authorities of the Member States are required to apply Community and national trade mark legislation so far as possible in a manner which is compatible with the wording and purpose of the TRIPs Agreement (see paragraphs 55-57). In *Anheuser-Busch*, the European Court of Justice confirmed that Article 16(1) protects unregistered earlier trade mark rights which must not be "prejudiced" by the later registration. The ECJ was not asked to consider whether the earlier unregistered right (there a trade name rather than a trade mark) might be registered as a trade mark. Mr Silcock referred me to the relevant passage in Daniel Gervais' book on TRIPs, but it does not seem to me that it is there suggested that Article 16(1) goes as far as to require a trade mark authority

to permit registration of the protected earlier mark. The ECJ itself said at paragraphs 88-90 of *Anheuser-Busch*:

"88 ... the first sentence of Art. 16 (1) of the TRIPs Agreement provides that that exclusive right must not prejudice any "existing prior right".

89 That provision must be understood as meaning that, where the proprietor of a trade name has a right falling within the scope of the TRIPs Agreement which arose prior to that conferred by the trade mark with which it is alleged to conflict and which entitles him to use a sign identical or similar to that trade mark, such use cannot be prohibited by virtue of the exclusive rights conferred by the trade mark on its proprietor under the first sentence of Art. 16 (1)...

90 For that provision, thus understood, to be applicable, the third party must first of all be able to rely on the right falling within the substantive scope of the TRIPs agreement."

The Court went on at paragraphs 98-9 to say

"98 Finally, "priority" of the right in question to the purposes of the third sentence of Art. 16 (1) ... means that the basis of the right concerned must have arisen at a time prior to the grant of the trade mark with which it is alleged conflict. ... That requirement is an expression of the principle of the primacy of the prior exclusive right, which is one of the basic principles of trade mark law ...

99 It should be added that the principle of priority is likewise enshrined in Directive 89/104 and, more specifically, in Arts 4 (2) and 6 (2) thereof."

Article 4(2) of the Directive is the provision permitting the owner of an earlier right to oppose a trade mark application, and Article 6(2) limits the effect of the trade mark registration to protect the use of the earlier right. The Court did not suggest that the principle of priority was reflected in any provision of the Directive entitling the earlier right to be protected by registration.

27. At the hearing before me, however, Mr Silcock relied upon the decision of Mr Geoffrey Hobbs QC sitting as the Appointed Person in *Citybond Trade Mark* [2007] RPC 13 (in which Mr Hobbs considered Art. 16 (1) and *Anheuser-Busch*) in support of his argument that Art. 16 (1) entitles the proprietor of an earlier unregistered right to register the right concurrently with the later trade mark registration. In *Citybond*, an application was made to register Citybond as a mark for various insurance services, including insurance travel services in class 36. The applicant claimed to have been using the mark since 1985 for travel insurance services and travel bonding. The application was opposed by Citibank, on the basis of several registrations, including a 1996 mark, Citibank, for insurance in Class 36. Commenting on *Anheuser-Busch*, Mr Hobbs QC said at paragraph 25:

“It thus appears that the [Citibank] trade mark registrations should be taken to have been granted without prejudice to [Citybond’s] earlier unregistered right to use CITYBOND for “*travel insurance services*” and “*travel bonding*.” “ Dealing with the section 5(2)(b) objection, which had been rejected across the board by the Hearing Officer, Mr Hobbs QC found at paragraph 45 that the Hearing Officer ought to have found

“that there were similarities (in terms of marks and services) that would combine to give rise to a likelihood of confusion in the event of concurrent use of Citibank and Citybond in relation to services in those areas where banking and insurance services converge ... for which they were respectively registered and proposed to be registered. The objectionable wording in the list of services the applicant chose to defend would, on that basis, be “insurance services”, “insurance brokerage” and “insurance consultancy”. ... The remainder of the applicant’s list of services should stand on the basis that the wording does not encompass trading activities in areas in which use of Citybond would appear to have the capacity to encroach upon the distinctiveness and reputation of Citibank. I also think it should be regarded as unobjectionable on the basis of the applicant’s earlier unregistered right to use of other such services.”

The result was that he found that Citybond was registrable in relation to travel insurance services and travel bonding.

28. It seems to me that in paragraph 25 of his decision, Mr Hobbs QC was referring to Citybond’s right to use its earlier unregistered right despite the later Citibank registrations, pursuant to Art. 16(1), and (in that case) under the provisions of the Trade Marks Act 1938, as continued under the 1994 Act. Mr Hobbs did not say in paragraph 45 that Art. 16(1) gave the applicant in that case a right to register its mark because it had earlier unregistered rights in it. On the contrary, his view was that it was acceptable to permit the applicant to register its mark for a narrow specification of services (travel insurance services and travel bonding) because, on a proper global appreciation of the likelihood of confusion in that case, the use of its similar mark in relation to those services was not likely to cause confusion with Citibank’s wider registrations. Citybond’s earlier trade under the mark in relation to those services supported his view that there was no likelihood of confusion. I do not, therefore, consider that *Citybond* is authority for the proposition made by Plant Handling.
29. I draw an analogy (albeit an imperfect one) with the rather similar issue which came before another Appointed Person, Ms Anna Carboni, in *Muddies trade mark*, BL O-211-09. There the appellant claimed that its unregistered, earlier right of ‘mere local

significance' entitled it to register its mark. Ms Carboni rejected that submission, saying at paragraphs 47-8:

"Even if the evidence were sufficient to establish the existence of an earlier right within a locality, of the sort recognised under article 6(2) [of the Directive], that provision is about the owner of such a right being able to continue using it notwithstanding the registration of a national trade mark by a third party. As implemented in the Act, section 11(3) could be relied on to defend an action for infringement of a UK trade mark if, say, the defendant owned a local passing off right. I agree with the hearing officer that there is nothing in either article 6(2) (or, I would add, section 11(3)) to assist the Applicant in the second step of the argument to the effect that the owner of such a locally based right should itself be entitled to register the mark underlying its earlier right. If that were the position, the Applicant would thereby expand its local unregistered right into a national registered right by virtue of the fact that an unrelated third party had chosen to register a conflicting national trade mark. This would be a bizarre result. In this case, we are in any event dealing with a registered CTM, rather than a national trade mark, so article 6(2)/section 11(3) do not even come into play.

48 Article 107 of the Regulation does at least relate to conflicts between a later registered CTM and an earlier local right, but I do not think that it gets the Applicant

any further. Article 107(1) would enable the Applicant to rely on its claimed earlier local right (if established) to oppose the Opponents' use of the CTM; and article 107(3) would give the Applicant a defence to a CTM infringement claim. As Laddie J said, "in the case of a national unregistered mark, it appears clear that the effect of Art. 107(3) is to give immunity from infringement proceedings brought on the basis of a subsequent CTM": *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [52]. But I do not see why a provision that is plainly aimed at protecting the owner of a local right should be construed so as to turn such a right of continued local user into the right to a national registration."

30. For these reasons, I reject this basis of the appeal before me.
31. Next, Mr Silcock raised an issue based upon the inconsistency, as he claims, between the decisions of Mrs Corbett and Mrs Pike. Again, this is not a matter which appeared in the Grounds of Appeal. In his skeleton argument, Mr Silcock set out in some detail the findings made by Mrs Corbett in her decision, complained that Mrs Pike reached her own conclusions on the section 5(2)(b) grounds without reference to the earlier decision, and concluded that her decision was not only wrong but "was in direct conflict" and "fundamentally inconsistent" with the earlier decision.

Plant Handling wished to rely in particular on Mrs Corbett's finding that "container loading ramps and ramps for use by persons with a disability are within very different sectors of the ramp market" It seems that Mrs Corbett considered that use of the same marks on such different types of ramp would not be likely to cause confusion. That can be contrasted with Mrs Pike's findings which I have already discussed. The point was explored fully in the written arguments submitted to me after the hearing of the appeal.

32. Plant Handling submitted that this was an absurd result, and that Mrs Pike had reached conclusions which the parties could not themselves properly have advanced. However, the difficulty with Plant Handling's argument arises out of the rather unusual status of decisions in trade mark oppositions, which was considered by the Court of Appeal in *Special Effects v L'Oréal SA* [2007] R.P.C. 15. The Court held that an opposition is not a final decision capable of being the basis of an issue estoppel. Plant Handling had therefore to seek an alternative basis for its complaint about lack of the consistency between the two decisions.
33. In the field of trade mark law, Plant Handling relied upon the UKIPO's encouragement to trade mark examiners to apply consistent criteria to trade mark applications, and on a passage in *Madame trade mark* [1966] FSR 324, referring to "uniformity of treatment" as desirable in the context of the examination of trade mark applications. Mr Silcock referred to a "tension" between the need to balance consistency of approach, and the importance of taking the facts of each case into account, but no real difficulty of that nature was identified in *Madame trade mark*. The applicant there had sought to rely upon other marks already on the register as indicating the registrability of its own mark. However, Mr Tookey QC recognised that differences between the application under consideration and prior registrations may well affect a decision on registrability. Individual applications are treated on their own merits so that the desire for administrative consistency alone does not help Plant Handling. No reliance can or will be placed upon prior registrations, as indicated by Mr Tookey QC in *Madame*, and by Jacob J in *British Sugar* [1996] RPC 281 at 305.
34. I did not have before me the evidence which was before Mrs Corbett, and Mr St Quintin for Thorworld referred to a number of passages in the evidence before me which indicate that the evidence was not the same as the evidence before Mrs Pike. It therefore seems to me that *Madame trade mark* suggests that Mrs Corbett's decision on Thorworld's application was irrelevant to Mrs Pike's decision on Plant Handling's application, because of the differences between the parties' applications, the bases of the oppositions and the evidence filed in the two proceedings.

35. At the hearing before me, Mr Silcock cited the decision of the Privy Council in *Matadeen v Pointu* [1999] 1 AC 98 in which Lord Hoffman when considering the central principle of equality before the law said that "treating like cases alike and unlike cases differently is a general axiom of rational behaviour". The facts of that case were far removed from this trade mark appeal; it related to complaints arising from changes to school examination regulations which were alleged to have led to the unequal treatment of candidates, and it is difficult to draw a helpful analogy with the case before me. In my judgment, that general principle, which seems to me to refer to the need for consistency in the approach to be taken to administrative decisions, is not particularly helpful in deciding whether it was wrong for Mrs Pike not to have regard to and to follow the earlier decision of Mrs Corbett.
36. Mr Silcock also referred to a number of decisions, mainly in the field of immigration law, which approved practices designed to ensure consistency between cases with a similar factual basis, such as *Shirazi v Secretary of State for the Home Department* [2004] 2 All ER 602 and *Januzi v Secretary of State for the Home Department* [2006] 2 AC 426 in the field of immigration law, and *Cadogan v Sportelli* [2008] 1 W.L.R. 2142 in leasehold valuation cases. In my judgment, these decisions do not help Plant Handling, because they relate to exceptional cases in which a judicial policy has been adopted, deliberately and with particular care, in relation to particular facts common to identifiable classes of case, such as the "country guidance cases" relevant to asylum claims. Moreover, as Lord Hope said in *Januzi* (at paragraph 50) "in the end of the day each case, whether or not such guidance is available, must depend on an objective and fair assessment of its own facts." In my judgment, this line of authority does not advance Plant Handling's basic argument, which I have already rejected, that Mrs Pike erred in her assessment of the facts of this case.
37. Lastly, Plant Handling referred me to a line of immigration/asylum cases about the "Devaseelan Guidelines" adopted by the Immigration Appeal Tribunal in *Devaseelan v Secretary of State for the Home Department* [2002] UKIAT 007023. That was a "starred" determination giving the Tribunal's view of a number of issues raised by human rights appeals, and especially as to how a second immigration adjudicator should approach the determination of another adjudicator who had heard an earlier appeal by the same appellant. At paragraphs 37 and 38, the IAT pointed out that the first adjudication was not binding on the second adjudicator, and that the second adjudicator must be careful to recognise that the issue before him is not the issue that was before the first adjudicator. The IAT set out a list of eight guidelines for a second adjudicator in such circumstances, the first of which was that the first adjudicator's determination should always be the starting point for the second adjudicator's decision, and others of which recognised that differences in the evidence before the two adjudicators could naturally affect the result.

38. Plant Handling also referred me to two Court of Appeal cases in which the "Devaseelan Guidelines" were approved and slightly amended: *Djebbar v Secretary of State for the Home Department* [2004] EWCA Civ 804, and *AA (Somalia) v Secretary of State for the Home Department* [2007] EWCA Civ 1040. In *Djebbar*, whilst approving the guidelines, Lord Justice Judge giving the judgment of the Court said at paragraph 30

"Perhaps the most important feature of the guidance is that the fundamental obligation of every special adjudicator independently to decide each new application on its own individual merit was preserved. The guidance was expressed is subject to this overriding principle ...

This is not the language of *res judicata* nor estoppel. And it is not open to be construed as such. "

39. In *AA*, the Court of Appeal had to consider two appeals in cases where there was overlapping evidence of fact in two separate cases and the issue which had arisen was as to the weight that should be given to findings in one asylum/human rights appeal in a later appeal by a different party. In *AA's* case, the question of the appellant's ethnicity was relevant to the appeal. There had been a previous judicial determination of the appellant's sister's asylum application, in which a finding had been made as to the sister's ethnicity. Nevertheless, the appellant had not produced the decision in his sister's case to the adjudicator in his own case, nor relied upon it, although he was represented by counsel. In those circumstances, the Court of Appeal agreed with the Tribunal below that a determination in the sister's case was not before the second adjudicator and so he did not err in law by failing to take account of its contents.
40. Thorworld argued that the same point applied here. However, the position is slightly more complicated than in *AA*. Plant Handling did not seek to amend its TM8 following the decision in Thorworld's application, to rely upon the earlier opposition, and did not provide a copy of the earlier decision to the UKIPO, but it did refer to Mrs Corbett's decision in its evidence.
41. In paragraph 52 of Mr Fagan's witness statement, he explained that Plant Handling's opposition had been successful in respect of certain goods and that Thorworld's application succeeded for its limited specification as this was "the only area where there had been evidence of use". He did not exhibit a copy of Mrs Corbett's decision, which may not be very significant, as such decisions are all readily available on-line. However, in my view it is more significant that he did not draw attention to any particular elements of the earlier decision upon which Plant Handling wished to rely. He did not suggest that Mrs Pike ought to follow the earlier decision, nor make any comments as to how that earlier decision affected the later opposition proceedings.

Moreover, Plant Handling made no written or oral submissions in which it might have argued that there was a need or justification for consistency with Mrs Corbett's decision.

42. Mr St Quintin took me to a number of points in Plant Handling's evidence in this matter which, he submitted, suggest that it had taken a deliberate decision not to refer to the earlier decision, in order to re-run arguments rejected by Mrs Corbett. I do not think that I can draw any such conclusion from the evidence, nor do I need to do so.
43. In my judgment, in the circumstances of this case, nothing in the authorities on the "Devaseelan Guidelines" would indicate that Mrs Pike erred in failing to take particular findings in Mrs Corbett's decision into account in her own reasoning. Mrs Pike did take into account the result of Mrs Corbett's decision, in terms of the reduced specification of Thorworld's registration. That was precisely what Mr Fagan had drawn attention to in his evidence. I do not think that Mrs Pike can be said to have erred in failing to go further and consider any of Mrs Corbett's findings of fact.
44. For all these reasons, the appeal fails.

### **Costs**

45. The Hearing Officer's costs order will stand and the costs of the appeal will follow the event. Mr St Quintin asked in his written submissions that I should award costs off the usual scale, on the basis that Plant Handling had caused a significant increase in the costs of the appeal by the way in which it was handled, as described above. He referred in particular to Plant Handling's last minute concession as to parts of its specification, and the inadequacies of the Grounds of Appeal and the skeleton argument, which meant that the arguments had to be addressed on paper after the hearing of the appeal, at additional expense.
46. In my judgment, this is a case of the kind identified in paragraphs 8 and 9 of Tribunal Practice Note 2/2000, where the appellant's conduct of the appeal led the respondent to incur additional costs. I am therefore minded to make an order for costs off the scale, for the reasons given by Mr St Quintin, to reflect in particular the costs of the additional written submissions made on behalf of Thorworld following the oral hearing.
47. I would invite the parties to seek to agree an Order as to costs and to that end Thorworld should provide Plant Handling with a schedule of its costs, identifying in

particular the costs of making those additional submissions, within 14 days of the date of this decision. If no agreement can be reached as to the amount of costs to be paid by Plant Handling, each party should provide me with a summary of its position on costs, 21 days thereafter.

Amanda Michaels  
21 February 2011

Mr Ian Silcock, instructed by Messrs ip21 Ltd, appeared on behalf of the Applicant/Appellant  
Mr Thomas St Quintin, instructed by Messrs Hulse & Co, appeared on behalf of the Opponent/Respondent

### **Annex 1**

Plant Handling's original specification:

"loading ramps; lifting ramps; metal loading ramps; container ramps; mobile loading container ramps; trailer ramps; platform ramps; apparatus used for loading and unloading containers; hydraulic lifting ramps; hydraulic mechanisms; hydraulic pumps; hydraulic mobile platforms; handles being part of mechanically operated tools; wheel chocks; clamp attachments; ramps for the loading and unloading of goods vehicles; wheelchair ramps; doorway/threshold ramps; curb/step ramps; parts and fittings relating to the aforementioned."