

IN THE MATTER OF APPLICATION NOS. 2269373 AND 2269371 IN THE
NAME OF HELEN HYDE

AND IN THE MATTER OF OPPOSITIONS NOS. 80538 AND 80538 THERETO
BY REED MIDEM ORGANISATION SA

SECOND DECISION

Introduction

1. On 14 November 2005 I issued a written decision (“my first decision”) on appeals by the applicant and the opponent against the decision of Mr George Salthouse acting for the Registrar dated 16 May 2005 (O/135/05) in which he upheld the opposition in relation to Application No. 2269373, but dismissed it in relation to Application No. 2269371. In summary I held in relation to both applications that there was a likelihood of confusion in relation to the wide specification of goods and services applied for, but that there was no likelihood of confusion in relation to a narrower sub-set of services. Accordingly I allowed both parties’ appeals in part and dismissed both parties’ appeals in part.
2. On 15 November 2005 I received a letter from counsel for the opponent asking me to reconsider this decision. I invited and received written submissions from both parties on the issues raised by counsel’s letter. This is my decision on those issues.

Jurisdiction

3. Counsel for the applicant submits that I have no jurisdiction to reconsider my first decision. Counsel for the opponent submits that I have an inherent jurisdiction to reconsider my first decision, and that I should exercise my discretion to do so.

Relevant legislation and rules

4. Section 76 of the Trade Marks Act 1994 provides in relevant part:
 - (1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules...
 - (2) Any such appeal may be brought either to an appointed person or to the court.
 - ...
 - (4) Where an appeal is made to an appointed person and he does not refer it to the court, he shall hear and determine the appeal and his decision shall be final.
 - (5) The provisions of sections 68 and 69 (costs and security for costs; evidence) apply to proceedings before an appointed person as in relation to proceedings before the registrar.
5. The 1994 Act does not contain any provision setting out the powers of either an Appointed Person or the Court when disposing of an appeal (contrast sections 17 (7), 18(10) and 52 of the Trade Marks Act 1938). The implication appears to be that the Appointed Person or Court has the same powers as the Registrar except where the statute or rules expressly provide to the contrary (notably, in section 34(2) of the 1994 Act).
6. Rules 62, 63 and 65 of the Trade Marks Rules 2000 provide in relevant part:
 - 62.(1) When, in any proceedings before her, the registrar has made a decision, she shall send to each party to the proceedings written notice of it, and for the purposes of any appeal against that decision, subject to paragraph (2) below, the date on which the notice is sent shall be taken to be the date of the decision.
 - (2) Where a statement of reasons for the decision is not included in the notice sent under paragraph (1) above, any party may, within one month of the date on which the notice was sent to him, request the

registrar on form TM5 to send him a statement of the reasons for the decision and upon such request the registrar shall send such a statement; and the date upon which that statement is sent shall be deemed to be the date of the registrar's decision for the purpose of any appeal against it.

- 63.(1) Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant's grounds of appeal and his case in support of the appeal.
 - (1A) Such notice be filed with the registrar within the period of 28 days beginning on the date of the registrar's decision which is the subject of the appeal.
 - (2) The registrar shall send the notice and statement to the person appointed.
 - (3) Where any person other than the appellant was a party to the proceedings before the registrar in which the decision appealed against was made, the registrar shall send to that person a copy of the notice and the statement.
65. ...
- (4) Rules 55 to 58 and rules 60 to 61 shall apply to the person appointed and to proceedings before the person appointed as they apply to the registrar and to proceedings before the registrar.
 - (5) If there is an oral hearing of the appeal then rule 59 shall apply to the person appointed and to proceedings before the person appointed as it applied to the registrar and proceedings before the registrar.
 - (6) The person appointed shall send a copy of his decision, with a statement of his reasons therefore, to the registrar and to each person who was a party to the appeal.

Practice on appeals to the Appointed Person

7. One aspect of practice on appeals to the Appointed Person which is not apparent on the face of the 1994 Act or 2000 Rules is that the administration of such appeals is handled by the Treasury Solicitor, whose department acts in effect as the Appointed Persons' secretariat. Once a notice of appeal with grounds has been duly filed under rule 63, the Registry collates the relevant papers and sends them to the Treasury Solicitor. The Treasury Solicitor then sends the papers to the Appointed Person allocated to the appeal. Correspondence relating to the pending appeal is also dealt with by the Treasury Solicitor. If, for example, a party wishes to make some application or seek directions during the pendency of the appeal, such requests must be directed in the first instance to the Treasury Solicitor who will, if the matter

calls for a decision or guidance by the Appointed Person, pass the relevant correspondence to him and then disseminate any decision or directions he may give. Once the Appointed Person has issued a final decision determining the appeal, it is usual for the Treasury Solicitor to draw up a formal order embodying the decision.

Inherent jurisdiction to regulate procedure

8. In *Langley v North West Water Authority* [1991] 3 All ER 610 at 613j-614a Lord Donaldson of Lynton MR (with whom Woolf and Mann LJ agreed) said in relation to county courts:

Although there is no statutory authority for making local practice directions, none is needed because every court has inherent jurisdiction to regulate its own procedures, save in so far as any such direction is inconsistent with statute law or statutory rules of court.

In reliance upon this dictum Pumfrey J said in *Pharmedica GmbH's Trade Mark Application* [2000] RPC 536 at 541 lines 25-29:

Notwithstanding the fact that the registrar is, like the county court, a tribunal which is established by statute, I have no doubt that the registrar has the power to regulate the procedure before her in such a way that she neither creates a substantial jurisdiction where none existed, nor exercises that power in a manner inconsistent with the express provisions conferring jurisdiction upon her.

I also note that in the same case at 545 lines 1-10 Pumfrey J approved the following statement of Simon Thorley QC sitting as the Appointed Person in *ACADEMY Trade Mark* [2000] RPC 35 at [32]:

It is plainly necessary for the system of appeals to the Appointed Person to work that the tribunal has an inherent power to regulate its own procedure so as to ensure that appeals before it are disposed of in a way calculated to do justice in an efficient and inexpensive manner.

9. It is clear from Pumfrey J's formulation of the inherent power to regulate procedure that the power is (to adopt the expression used by Geoffrey Hobbs

QC sitting as the Appointed Person in *KML Invest AB's Trade Mark Application* [2004] RPC 47 at [14] to describe the Registrar's power under rule 66 of the 2000 Rules) interstitial. That is to say, it can be used to fill the gaps in the statutory provisions but not to circumvent them.

The Barrell jurisdiction

10. The decisions of the Court of Appeal in a line of cases including *Millensted v Grosvenor House (Park Lane) Ltd* [1937] 1 KB 717, *Re Harrison's Share* [1955] 1 All ER 185, *In Re Barrell Enterprises Ltd* [1973] 1 WLR 19, *Pittalis v Sherefettin* [1986] QB 868, *Stewart v Engle* [2000] 1 WLR 2268, *Townsend v Achilleas* (unreported, 6 July 2000) and *Robinson v Fernsby* [2003] EWCA Civ 1820 establish that, where a court has given judgment but no order has been drawn up and entered giving effect to that judgment, the court retains jurisdiction to reconsider its decision and to receive further arguments and even new evidence. Once the order has been perfected, however, the court is *functus officio*¹ and normally has no jurisdiction to reconsider its decision: at that point the losing party's only remedy is normally to appeal (if possible). The jurisdiction to reconsider a judgment before the order is perfected is often referred to as the "*Barrell* jurisdiction". It extends to the county court: *Pittalis v Sherefettin* at 879D-E (Fox LJ), 882E-F (Dillon LJ) and 888G-H (Neill LJ agreeing).
11. The *Barrell* jurisdiction is to be distinguished from the "slip rule" now enshrined in CPR r. 40.12 which enables accidental errors and omissions in judgments and even orders to be corrected. It is also to be distinguished from the situation where the judgment does not dispose of all the issues between the parties or where the judgment leaves a matter open for further argument. In the present case counsel for the opponent has not suggested that the my first decision left any issues unresolved (except costs), nor has he sought to invoke the slip rule.

¹ Having performed or discharged his office.

12. The *Barrell* jurisdiction must be exercised “very cautiously and sparingly” (per Sir Christopher Slade and Roch LJ in *Stewart v Engle* at 2274E and 2291G). It requires “exceptional circumstances” (per May LJ, with whom Mance and Peter Gibson LJJ agreed, in *Robinson v Fernsby* at [83]-[84]).
13. In *PHILOSOPHY Trade Mark* (O/276/00) at [13]-[21] Simon Thorley QC sitting as the Appointed Person held that the *Barrell* jurisdiction extends to the Appointed Person. I note, however, that this was conceded by counsel in that case and the contrary was not argued.

The Taylor v Lawrence jurisdiction

14. In *Taylor v Lawrence* [2002] EWCA Civ 90, [2002] 2 All ER 353 the Court of Appeal held that, in exceptional circumstances and to avoid real injustice where there was no alternative effective remedy, it had power to re-open an appeal even after the order carrying its judgment into effect had been perfected. In *Seray-Wurie v Hackney LBC* [2002] EWCA 909, [2002] 3 All ER 448 the Court of Appeal held that High Court had a similar power when sitting as an appeal court. At [19], however, Brooke LJ (with whom Dyson and Simon Brown LJJ agreed) expressly left open the position of the county court, saying that different considerations applied.
15. So far as the exercise of the *Taylor v Lawrence* jurisdiction by the Court of Appeal and High Court is concerned, this is now regulated by CPR r. 52.17 and Section IV of the Practice Direction – Appeals. Rule 52.17(1) provides:
 - The Court of Appeal or the High Court will not re-open a final determination of any appeal unless-
 - (a) it is necessary to do so in order to avoid real injustice;
 - (b) the circumstances are exceptional and make it appropriate to reopen the appeal; and
 - (c) there is no alternative effective remedy.
16. Rule 52.17(1) does not refer to the position of county courts. The editors of *Civil Procedure* state at paragraph 52.17.2 that the power is vested only in the Court of Appeal and High Court and that the county courts have no such

power. No direct authority is cited in support of this proposition. Instead reference is made to *Gregory v Turner* [2003] EWCA Civ 183, [2003] 1 WLR 1149, where the Court of Appeal observed at [28] that the work of circuit judges in the county courts would be very badly disrupted if any such jurisdiction existed; but did not in terms hold that it did not. The Court of Appeal went on to recognise, following *R (Sivasubramaniam) v Wandsworth County Court* [2002] EWCA Civ 1738, [2003] 1 WLR 475, that in rare circumstances it might be possible to obtain judicial review by the Administrative Court of a county court decision.

The powers of tribunals

17. Parliament has created a large number of special tribunals to exercise judicial or quasi-judicial functions in particular cases. Such tribunals form a large part of the machinery of administrative justice, and accordingly there is a considerable body of administrative law that applies to them. The principal legislation that applies to such tribunals is presently the Tribunals and Inquiries Act 1992, although both legislative change and change in the management of tribunals is underway.² Schedule 1 of the 1992 Act lists a considerable number of tribunals which are supervised by the Council on Tribunals and to which certain provisions of the Act apply. These include the Copyright Tribunal (paragraph 11), the Comptroller-General of Patents, Trade Marks and Designs (paragraph 34), the Controller of Plant Variety Rights (paragraph 36(a)) and the Plant Variety and Seeds Tribunal (paragraph 36(b)). They do not include either the Registered Designs Appeal Tribunal or the Appointed Person. Nevertheless it is clear in my view that both the Registered Designs Appeal Tribunal and the Appointed Person are statutory tribunals to which the relevant principles of the common law apply, save to the extent that the applicable legislation provides to the contrary. Thus it is well-established that the Registered Designs Appeal Tribunal is amenable to judicial review by

² Following the Leggatt report, *Tribunals for Users – One System, One Service*, published in August 2001 and a White Paper entitled *Transforming Public Services: Complaints, Redress and Tribunals* published in July 2004, the Tribunals Service, a new agency within the Department of Constitutional Affairs, will start work in April 1996. A draft Courts and Tribunals Bill has been published, but has not yet started its passage through Parliament.

the Administrative Court (see for example *Ford Motor Co Ltd's Design Applications* [1993] RPC 399 (RDAT), [1994] RPC 545 (Div Ct) and [1995] RPC 167 (HL)). In principle, I consider that the Appointed Person would also be amenable to judicial review notwithstanding section 76(4) of the 1994 Act, although I know of no case in which a successful application for judicial review of an Appointed Person's decision has been made.

18. At common law the general rule is that, slips apart, a statutory tribunal has no inherent power to reconsider its own decisions: *Akewushola v Secretary of State for the Home Department* [2000] 1 WLR 2295 at 2300H-2301H (Sedley LJ, with whom Laws and Peter Gibson LJ agreed). Nevertheless, it appears that tribunals have an exceptional power to re-open cases where the tribunal's decision was given in ignorance that something had gone wrong e.g. that a notice sent to one of the parties had miscarried: see Wade and Forsyth, *Administrative Law* (9th ed) p.938 citing *R v Kensington & Chelsea Rent Tribunal ex p. MacFarlane* [1974] 1 WLR 1486, *Charman v Palmers Ltd* [1979] ICR 335 and *Hanks v Ace High Productions Ltd* [1978] ICR 1155.

The position of the Registrar and Comptroller

19. In *OMITEC Trade Mark* (O/018/02) Simon Thorley QC sitting as the Appointed Person said at p. 8 of the transcript:

Once the Registrar has issued a decision revoking a trade mark she is *functus* and can thereafter not revisit her decision.

I have no doubt that as general statement of the position this is correct. Mr Thorley was not purporting to decide, however, whether or not there were any exceptions to this rule. In any event he was not considering the position of the Appointed Person, and there is no reason to think that, if he had been considering the position of the Appointed Person, he would have departed from what he had said in *PHILOSOPHY*.

20. In *Interfilta (UK) Ltd's Patent* [2003] RPC 22 the claimant applied to the Comptroller to revoke the patent in suit. Eight weeks after the oral hearing, but before the hearing officer had issued his decision, the defendants sought to advance further submissions. The parties were agreed that the hearing officer had a discretion as to whether to take such late submissions into account, but not as to the principles on which that discretion should be exercised. In his decision the hearing officer, Mr Haywood, considered a number of cases including *Re Barrell* and *Stewart v Engle*. He concluded at [33] that, since no substantive decision had been issued, he should take a slightly more liberal approach than that indicated in *Stewart v Engle*. Mr Haywood did not have to consider what the position would have been had he already issued his substantive decision, but as I read it the tenor of his decision is that he would have accepted that the *Barrell* jurisdiction extended to the Comptroller. I note that neither *PHILOSOPHY* nor *OMITEC* was cited.

Discussion and conclusion

21. In my judgment little assistance regarding the present issue can be gained from the sparse jurisprudence concerning the position of the Comptroller and the Registrar. In any event, the position of the Appointed Person is not necessarily the same. For example, it may be the case (I do not have to decide) that the Registrar could change a decision given under rule 62(1) when he came to give reasons under rule 62(2); but rule 62 does not apply to the Appointed Person.
22. I am not satisfied that the Appointed Person's general inherent power to regulate procedure before him is sufficient to enable me to reconsider a decision which has been issued unless either (a) the *Barrell* jurisdiction or (b) the *Taylor v Lawrence* jurisdiction or (c) the jurisdiction generally available to statutory tribunals applies.
23. So far as the *Taylor v Lawrence* jurisdiction is concerned, in my judgment this does not apply to the Appointed Person for two reasons. First, it is an exceptional jurisdiction possessed by the Court of Appeal and High Court,

which are superior courts. There is no warrant for extending it to an inferior tribunal, and *Gregory v Turner* and CPR r. 52.17 both indicate that it should not be so extended. Secondly, in the case of the Appointed Person there is the possibility of an alternative remedy in the form of an application for judicial review.

24. I have had much more difficulty deciding whether the *Barrell* jurisdiction extends to the Appointed Person. It is tempting to say that it should, given that the Appointed Person has a jurisdiction co-extensive with that of the High Court over trade mark appeals and generally speaking applies the same law. It appears to me that this was Mr Thorley's reasoning in *PHILOSOPHY*. Nevertheless I consider that there are important differences. The Appointed Person is an alternative specialist tribunal which is intended to provide litigants with a less formal, speedier and cheaper route of appeal than the High Court. Unlike the High Court, the Appointed Person is entirely a creature of statute, and has no powers save those given to him by the 1994 Act and the 2000 Rules and his inherent power to regulate procedure before him. Section 76(4) of the 1994 Act provides that the Appointed Person's decision is final, whereas the decision of the High Court is subject to the possibility of further appeals. Importantly so far as the present issue is concerned, rule 65(6) appears to envisage that the operative event, so far as the Appointed Person's determination of an appeal is concerned, is the sending of a copy of the decision with reasons to the Registrar and the parties. The rules do not require, or even provide for, the drawing up of an order to give effect to the decision. While it is no doubt good practice for this be done, it does not appear to be essential. By contrast, it has long been the case that in the court system the decisive event is the making of the order. It is this factor which underpins the existence of the *Barrell* jurisdiction. For these reasons, I conclude, albeit with some hesitation, that the *Barrell* jurisdiction does not extend to the Appointed Person.
25. On the other hand, I see no reason why the more limited jurisdiction available to all statutory tribunals to reconsider their decisions in exceptional circumstances should not be available to the Appointed Person. On the

contrary, I can envisage circumstances where the Appointed Person might need such a power in order to achieve justice. The potential availability of judicial review as a remedy does not negate the existence of such a power, but does confirm that it should only be exercised in truly exceptional circumstances.

Should the jurisdiction be exercised in this case?

26. The principal ground advanced by counsel for the opponent for requesting that I reconsider my decision is that it is wrong or at least inadequately reasoned. In my judgment this is not a sufficient basis for invoking the exceptional jurisdiction which I have held to exist.
27. As part of his argument, however, counsel for opponent raises what I regard as a rather more serious complaint, which is that of procedural unfairness. In order to explain this complaint and examine its substance, it is necessary to describe the course of the proceedings.
28. In its statement of grounds the opponent alleged that there was a likelihood of confusion between the marks applied and its own marks giving rise to objections under section 5(2)(b) and 5(4)(a) of the 1994 Act. In its counterstatement the applicant denied that there was a likelihood of confusion. It also pleaded:
 3. ... Any such reputation [sc. of the opponent in the trade mark MIDEM] is quite separate and distinct from that of the Applicant's. The Applicant has been trading under MANAGING DIRECTIONS EVENT MANAGEMENT or its acronym MDEM since 1993 thereby creating a considerable and distinctive reputation in the trade mark MDEM which vests in the applicant.

In my view this pleading was clearly alleging that the applicant had built up an independent reputation in the marks applied for through use and thus there was no likelihood of confusion.

29. After the opponent had served its evidence, the applicant served evidence which included a witness statement of the applicant. I summarised the contents of this statement in paragraph [27] of my first decision. In the statement the applicant said *inter alia* as follows:

27. Until the current Opposition proceedings were brought to my attention, I had never heard of the Opponent, the name MIDEM, nor did I have any knowledge of the annual music conference held by it in the south of France.

28. To my knowledge, no actual confusion has arisen to date (no phone calls, emails, letters, faxes, etc.) between m.d.e.m. and Reed Midem. At no time since I adopted the name in May 2001 has any reference by a third party been made to Midem during the course of our business.

29. Although our respective businesses can very broadly be categorised as relating to 'events', there is no overlap in our activities whatsoever, emphasised by my lack of awareness of the name 'Midem'. Not only are our revenue streams entirely separate, but so are our respective clients and the services that we provide to them. Our core activities are 'behind the scenes' activities to the extent that those attending events in which we have been involved are unaware of our name or of our involvement...

30. Reed Midem's target audience is extremely far removed from those targeted by m.d.e.m....

In my view it is clear that from this that the applicant was saying that (a) her business was different to that of the opponent and (b) no actual confusion had been caused by her use of the mark applied for in relation to the services provided by her.

30. As noted in paragraph [29] of my first decision, the hearing officer did not deal in his decision with the applicant's argument that her evidence that there had been no actual confusion showed that there was no likelihood of confusion. In her statement of grounds of appeal to the Appointed Person the applicant pleaded *inter alia*:

7. The HO failed to consider the unchallenged evidence of Respondent which showed that there was no actual confusion between the marks since the date the Respondent's [sic] commenced use of the marks the subject of the Respondent's trade mark applications in May 2001 (as

per paragraph 28 of her witness statement) which material militated against a finding of a likelihood of confusion.

In my view it is clear from this that the applicant was relying upon the absence of confusion in relation to the services in relation to which she had actually use the marks. It is fair to say, however, that the applicant's appeal was filed in respect of the entire specification of goods and services applied for and her advisors did not put forward, even by way of a fall-back position, a more limited specification which more accurately reflected the applicant's actual use.

31. In paragraphs 27-30 of his skeleton argument in support of the applicant's appeal, counsel for the applicant enlarged upon the ground of appeal set out in paragraph 7 of the grounds. Again, however, he did not advance a more limited specification which more accurately reflected the applicant's actual use.

32. At the hearing counsel for the opponent opened the opponent's appeal first. In the course of his address, he dealt with the absence of confusion point. At page 17 line 22-page 21 line 8 of the transcript there was the following exchange:

18 THE APPOINTED PERSON: I follow that, but what strikes me about
19 this case is that both parties seem to have adopted, what one
20 might call, an all or nothing position, namely that either
21 there is a likelihood of confusion across the board in
22 relation to the specification applied for or there is not.
23 It seems to me that there is, at any rate, possibly
24 room for a middle ground whereby there would be a likelihood
25 of confusion across a broad spectrum of services, but
1 possibly not, if we had a spectrum of services that was
2 confined to what Ms. Hyde is actually doing. What is your
3 submission on that?
4 MR. MALYNICZ: My submission on that is at the moment, the
reason
5 for our uncompromising stance is because of the width of the
6 specification. The specification in its current form, class
7 39 and 41, is arranging and conducting conferences, seminars,
8 meetings and I am not sure it would be possible to
9 realistically confine that to behind the scenes, not dealing
10 with customers-type activities, although one could attempt
11 to.
12 THE APPOINTED PERSON: Why not? That is basically what was done
13 in CODA.³

³ CODAS Trade Mark [2001] RPC 14.

14 MR. MALYNICZ: I am not familiar with that.
15 THE APPOINTED PERSON: It is the decision of Mr. Foley reported
16 in about 2001 where he found that there had been concurrent
17 use of, what were on their face, similar trade marks. One
18 was CODA (the normal spelling), the other was CODAS in
19 respect of computer software. The parties were actually
20 trading in different fields, but he held that on the
21 specification applied for, there is a likelihood of
22 confusion, but that if the specification was strictly limited
23 to what the applicant had actually been doing, then there
24 would not be the likelihood of confusion because the proof of
25 the pudding is in the eating. There has been parallel trade
1 and no instances of confusion.
2 I agree with you that as it presently stands, this is a
3 fairly broad specification. The question I am asking of you
4 is: suppose a specification could be devised -- and leave
5 aside the question of drafting at the moment -- what I am
6 interested in is your reaction to the principle, if the
7 specification could be drafted in a way that was confined to
8 what Ms. Hyde has actually been doing on the face of her
9 evidence, and strictly limited to that, what would you then
10 say?
11 MR. MALYNICZ: I would say that Ms. Hyde's evidence presents the
12 problems because, whilst she says that she has been trading
13 in a certain way, of course, no trader necessarily wants to
14 be confined in their activities going forward. We say it
15 would be very difficult to find a workable formula.
16 Obviously, I would have to take instructions on any proposal
17 that is made either by you, sir----
18 THE APPOINTED PERSON: I am not asking whether your client will
19 give consent. That is a matter on which you plainly need
20 instructions. What I am asking for is your submissions on
21 the likelihood of confusion upon my hypothesis.
22 MR. MALYNICZ: That is quite difficult, we say, because
23 Ms. Hyde's evidence makes it difficult to see what it is she
24 has been doing and to see that it can be realistically
25 practically confined. What we found in the evidence is may
1 be, one could say, we have a reputation for music, music
2 clients exclusively or predominantly, and it might be said
3 she would not do anything in relation to the music industry,
4 and that may be one way of going forward.
5 The difficulty with that is she would say she could do
6 something in the entertainment field or something in other
7 fields and, of course, those would be considered to be
8 similar fields.

33. I was then addressed by counsel for the applicant on the opponent's appeal. At page 59 line 22-page 62 line 12 there was the following exchange:

22 THE APPOINTED PERSON: On the point of no confusion, what do you
23 say to what I was putting to Mr. Malynicz that the problem
24 with the argument of no confusion is the breath of the
25 specification applied for, but it might be a better argument
1 if the specification were to be limited? What do you say to
2 that?
3 MR. ENGELMAN: There are differences⁴ in terms of consent. The

⁴ I suspect that this is an error in the transcript and that counsel actually said "difficulties".

4 same point arose in relation to my learned friend's position.
5 THE APPOINTED PERSON: Again, I am not asking you whether you
are
6 prepared to consent because obviously you do not have
7 instructions. What I am asking for is your submissions on
8 the likelihood of confusion upon my hypothesis?
9 MR. ENGELMAN: He has to establish that quotations marks are
10 special evidence as to his reputation. The test for
11 registered trade mark infringement and the test for passing
12 off are different and they differ in this particular way.
13 In registered trade mark infringement one has to apply
14 what, I would call, a mental gymnastics test, which is set
15 out in *Sabel v. Puma*. The very test that the hearing officer
16 correctly applied in this case. One has to look at the
17 distinctiveness of the mark. The visual, oral, conceptual
18 similarity and then one takes into account the goods or
19 services, the subject of the specification, and then applies
20 an interdependence test, as the case law was developed, to
21 determine whether the marks and goods are sufficiently
22 similar to give rise to a likelihood of confusion.
23 In passing off you have to establish evidence that the
24 public would associate the goods, the subject of the
25 specification, and connect them. That special evidence is
1 that cogent evidence that has been described in the case law
2 itself.
3 THE APPOINTED PERSON: I understand that point, but I do not
4 think it is an answer to my question. What you are
5 submitting to me is that not only does passing off add
6 nothing, from Mr. Malynicz's position, it is actually a worse
7 case. I understand that. Whether one looks at it through
8 the prism of passing off or whether one looks at it through
9 the prism of section 5(2)(b), either way, from the
10 perspective of your client's application, we have to consider
11 normal and fair use in relation to all services applied for.
12 MR. ENGELMAN: Except when there has been actual use, sir, with
13 the greatest respect. I did not stop my learned friend's
14 submission, but where you have actual use you just do not go
15 through the mental gymnastics of normal and fair use. You
16 look at the actual use the case law teaches us.
17 THE APPOINTED PERSON: You cannot limit consideration to the
18 actual use. It is certainly legitimate to take actual use
19 into account as illustrating notional and fair use, as for
20 example, in *COUNTRYWIDE*, but we still have to consider the
21 full breath of the specification applied for.
22 What I am asking you for is what is your submission if
23 I were to take the view that in relation to the full
24 specification of goods and services applied for there is a
25 likelihood of confusion, would you submit that there would
1 not be a likelihood of confusion upon a more limited
2 specification?
3 MR. ENGELMAN: Absolutely, sir, I would submit that because
4 actuality has proven that over and above the conceptual
5 argument. The actuality of the case is that my client has
6 used this mark, as we have said, for some five years prior to
7 the date of the hearing before Mr. Salthouse and there has
8 been no confusion in actuality and therefore were such a test
9 to apply, it should, if anything on that submission, assuming
10 my learned friend gets over the hurdle of passing off, cut
11 down the specification to the core activity she has been
12 participating in over that period.

34. Counsel for the opponent then replied. In the course of his reply he said this at page 68 lines 3-17:

3 The more important point is the question you put to my
4 learned friend about likelihood of confusion potentially in
5 relation to a restricted specification. I do not have very
6 much to add to what I said in opening other than to say the
7 *Canon* approach, when in doubt on this, is the thing that
8 needs to be grappled with. One has to look at the nature of
9 the goods. The nature of the services. The intended purpose
10 I think it is in the re-write of the *Canon* decision that has
11 just come out. Whether the services are complementary and
12 that sort of thing.
13 We say that applying *Canon* is very difficult. It is
14 very difficult to drive any kind of distinction between some
15 sort of narrower sub-category of services. Applying those
16 factors, one will see that they are almost certainly
17 complementary, what is overlapping customers etc.

35. Counsel for the applicant then opened the applicant's appeal. At page 91 line 5-page 92 line 24 there was the following exchange:

5 MR. ENGELMAN: With regard to confusion, we have already dealt
6 with this.

7 THE APPOINTED PERSON: Is there any difference, in your
8 submission, between the two trade marks so far as my limited
9 specification hypothesis is concerned?

10 MR. ENGELMAN: Your proposition is that because you have
narrowed

11 the specification, the limitation is referable to actual use
12 by Miss Hyde.

13 THE APPOINTED PERSON: At the moment, so far as your appeal is
14 concerned you have to persuade me that the hearing officer is
15 wrong to find a likelihood of confusion in relation to the
16 entire breadth of the specification.

17 MR. ENGELMAN: Yes.

18 THE APPOINTED PERSON: Hypothetically speaking, if one imagines
a

19 specification restricted to use, then you have an easier task
20 because it then becomes easier for you to argue that the
21 evidence that you have put in supports the proposition there
22 is no likelihood of confusion.

23 As I see it at the moment, that is an argument which,
24 be it right or wrong, is equally applicable to both
25 applications and therefore both appeals. At the moment, what
1 I am interested in is: are you saying there is any
2 difference?

3 MR. ENGELMAN: I am saying that the marks differ sufficiently -
4 - I hope I am answering your question, sir -- for the fact
5 there is an overlap in the class 41 specification which is
6 advised by case law where you have broad specifications to
7 review narrowly and given that their reputation, if there is
8 a reputation and there is a mark, is established with a
9 conference in Cannes, France, then I would say there is still
10 no likelihood of confusion.

11 THE APPOINTED PERSON: Of course, I understand that your
12 submission is the hearing officer is wrong to say there is a
13 likelihood of confusion and he is wrong in relation to the
14 entire specification of the goods and services applied for.
15 What I am interested in is what if I do not accept that? If
16 on the other hand I came to the view that it might have been
17 possible to reach a conclusion of no likelihood of confusion
18 on a more restricted specification?
19 MR. ENGELMAN: Yes, sir. If the conclusion you arrived at
20 aligned with Miss Hyde's actual use, we would find that an
21 acceptable proposal.
22 THE APPOINTED PERSON: Your submission is the point applies
23 equally to both applications?
24 MR. ENGELMAN: Yes.

36. Counsel for the opponent then addressed me on the applicant's appeal and counsel for the applicant replied. Nothing further was said about the limited specification hypothesis.

37. In my decision dated 14 November 2005 I stated:

30. In my judgment the absence of actual confusion does not support the conclusion that there is no likelihood of confusion in relation to the goods and services specified in the applications for the simple reason that the range of services in relation to which the applicant has actually used the marks is much narrower. As explained in *Professional Cycle* at [37]-[39], since oppositions must be determined upon the hypothesis of normal and fair use of the marks applied for across the whole width of the specification, absence of actual confusion cannot be probative if the use actually made of the marks does not correspond to this hypothetical situation.

31. At my suggestion, during the hearing counsel for the applicant adopted a fall-back position, which was to argue that there would be no likelihood of confusion if the applicant's specification were tightly restricted to the services she has actually provided to date. It is clear that the hearing officer was not asked to consider this fall-back position, and therefore he cannot be criticised for not doing so. Counsel for the opponent did not raise any objection of principle to this approach, but did not accept that such a restricted specification would suffice to avoid a likelihood of confusion. It is convenient to defer expressing my conclusion on this point until after I have considered the points raised by the opponent's appeal with regard to section 5(2)(b).

...

42. Turning to the applicant's fall-back position, it seems to me that the following specification of services covers the services that the applicant actually provides:

Class 39: Provision of logistical advice concerning conferences and similar events to corporate clients; hiring of transport for conferences and similar events on behalf of corporate clients.

Class 41: Provision of behind-the-scenes event management services for conferences and similar events to corporate clients.

Class 42: Carrying out research into venues for conferences and similar events for corporate clients; hiring of venues, caterers, entertainers and other suppliers for conferences and similar events on behalf of corporate clients.

43. In my judgment the absence of actual confusion in relation to these services is not conclusive of the absence of a likelihood of confusion, but it is a relevant consideration to take into account.
44. More importantly, it seems to me that the services provided by the opponent are different to those covered by the opponent's CTM. As the hearing officer rightly noted, Jacob J stated in *Avnet Inc v Isoact Ltd* [1998] that specifications of services should be interpreted as being confined to the core of the possible meanings of the terms used. The opponent's closest services are those in Class 35 and Class 41, and in essence these cover arranging and conducting conferences and the like. Thus in principle the opponent could be a customer for the applicant's services. By contrast the opponent's customers are those who attend its conferences etc. Moreover, the opponent's reputation is in a narrower field still, namely those connected with the UK music industry.
45. Another relevant factor is the identities of the average consumers of the respective services. The consumers of the applicant's services are the appropriate employees of companies on whose behalf the applicant provides its services: training managers, procurement directors, HR managers, facilities managers and the like. These are knowledgeable persons acquiring very specialised services. Moreover, it is clear from the applicant's evidence that this is field in which personal contacts are very important. The consumers of the opponent's services are the appropriate employees of its customers: marketing directors, sales directors and the like. In the case of the opponent's services these will be people employed by companies connected with the UK music industry. Again these are knowledgeable persons acquiring specialised services.
46. Looking at the matter in the round, it is my judgment that the use of the applicant's marks in relation to the services set out in paragraph 42 above will not give rise to a likelihood of confusion.

38. Counsel for the opponent submits that (a) I was incorrect to say in paragraph [31] of my first decision that the counsel for the applicant had adopted the suggested fall-back position, (b) I was incorrect to say in the same paragraph that he had raised no objection of principle and (c) it was in any event procedurally unfair for me to suggest such a fall-back position in the way that I did since it deprived the opponent of the opportunity of adducing evidence and arguments directed to the revised specification set out in paragraph [42].
39. I have to say that I am surprised by the submissions I have labelled (a) and (b). I believe that the extracts from the transcript reproduced above show that counsel for the applicant did adopt the suggested fall-back position, and that counsel for the opponent did not raise any objection of principle to it as opposed to arguing that there would still be a likelihood of confusion even on a more limited specification having regard in particular to the decision of the European Court of Justice in Case C-39/97 *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc* [1998] ECR I-5507.
40. As for the submission I have labelled (c), I do not accept that the course I adopted was procedurally unfair for the following reasons. First, the opponent was aware from the filing of the applicant's counterstatement that she was relying upon a contention that she had an independent reputation acquired through use and therefore there was no likelihood of confusion. Furthermore, her witness statement clearly set out the services in relation to which she had used the marks applied for and her evidence that no confusion had been caused thereby. The opponent had a full opportunity to serve evidence in reply to this, and did serve evidence in reply. Secondly, the applicant contended both before the hearing officer and on appeal that the absence of actual confusion militated against a finding of likelihood of confusion. This was obviously an argument that applied with more force to the services in respect of which there had been actual use than to the broader specification applied. Thirdly, the point was clearly raised at the hearing before me and addressed by both counsel. Counsel for the opponent did not suggest at the time that he had been taken by surprise, nor did he apply for an adjournment to deal with the

point. On the contrary, he advanced submissions dealing with it. Fourthly, in both oppositions the onus lay upon the opponent to establish a likelihood of confusion in relation to all the goods and services applied for. The essence of my decision was that the opponent had established a likelihood of confusion in relation to the goods and some services applied for, but not in relation to other services. It followed that the oppositions failed in relation to the services for which no likelihood of confusion was established. It also followed that the applications in relation those services were entitled to proceed to registration.

41. I accept that, with the benefit of hindsight, it would have been better if I had required counsel for the applicant to draft a proposed specification of services for the fall-back position so that the parties could have made any submissions they wished to make about the drafting of the specification. Given that I did not, it would have been open to counsel for the opponent to request that this be done at the hearing, but he did not do so. In any event, I do not believe that the opponent has suffered any injustice as result of being deprived of the opportunity of commenting on the precise drafting of the revised specification.
42. Accordingly, I conclude that opponent has not shown that there are grounds which would justify me in re-opening my first decision.

Would it make any difference?

43. Even if I had been persuaded to re-open the decision, having considered the submissions which have now been advanced by the opponent I am satisfied that they would make no difference to the result. Counsel for the opponent advances two arguments which I shall deal with in turn.

Amendment to the specification

44. First, counsel for the opponent submits that an applicant can only amend his specification of goods or services by an application under section 39 of the 1994 Act and rule 18 of the 2000 Rules. Such an application may be opposed under rule 18(2). Such an opposition would then have to be determined in the

normal way. In the absence of any such application or at least an open offer to restrict the specification made before the first instance hearing, so counsel submits, the application can only be considered on the basis of the original specification applied for.

45. In my judgment this argument is flawed for one of the reasons set out above. If an opponent only succeeds in relation to part of the specification applied for, then the application will proceed to registration in respect of the remainder. This does not require the applicant to file an application to amend.
46. In any event, as I have previously held in *SVM Asset Management Ltd's Trade Mark Application* (O/043/05) at [21], it is acceptable for an applicant to offer an amendment to the specification during the course of proceedings without making a formal application until they have been concluded. It makes no difference whether this offer is made at first instance or on appeal, as shown by *Land Securities plc's Trade Mark Application* (BL O/339/04) at [10] and *SVM* at [23]. If it is held that the application as proposed to be amended is acceptable, a Form TM21 can then be filed at the conclusion of the proceedings. Normally that would not entitle an existing opponent to oppose all over again.
47. Counsel for the opponent seeks to draw an analogy with *Nikken Koskusho Works v Pioneer Trading Co* [2005] EWCA Civ 906, [2006] FSR 4. In that case the Court of Appeal held that, where a patent had been held invalid at trial, it was an abuse of process for the patentee to apply after judgment to amend the claims if that would involve a second trial on validity. I do not accept this argument. If there is an analogy with patent cases, which I doubt, I would regard the present case as much more analogous to a case where the patent has been held partially valid and partially invalid. In such a case the patentee can usually apply to amend the claims to excise the invalid parts after judgment.

Acceptability of the revised specification

48. Secondly, counsel for the opponent submits that the revised specification set out in paragraph [42] of my first decision is objectionable in the light of the judgment of the European Court of Justice in Case C-363/99 *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (POSTKANTOOR)* [2004] ETMR 57. In that case the national court asked *inter alia* whether it was consistent with Council Directive No 89/104/EEC to approximate the law of the Member States relating to trade marks and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration only applied in so far as they did not possess certain characteristics, for example registration of the sign POSTKANTOOR (which means “post office”) for direct-mail campaign services and the issue of postage stamps provided they were not connected with a post office. The Court replied:
114. ... where registration is applied in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.
115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties – particularly competitors – would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.
116. Since the Directive precludes such a practice, there is no need to examine the request for an interpretation of the Paris Convention.
49. The application of these principles has been considered by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom’s Trade Mark Application* [2005] RPC 2 at [28]-[30] and by myself in *Oska’s Ltd’s Trade Mark Application* [2005] RPC 20 at [56] and in *SVM* at [24]-[29]. I held in the latter case that disclaimers which operated as restrictions on the scope of the services embraced by the specification were permissible since they were not

disclaimers framed by reference to the absence of particular characteristics of the services.

50. Counsel for the opponent accepts this interpretation of *POSTKANTOOR*, but submits that the revised specification set out in paragraph [42] of my first decision is objectionable because it is framed by reference to the presence or absence of characteristics of the services. He points in particular to inclusion within the Class 41 specification of “behind-the-scenes event management services”.
51. I do not accept this argument. Firstly, the description “behind-the-scenes event management services” is at worst a reference to services which have certain characteristics, not to ones that do not have a particular characteristic. Secondly, it is evident from the applicant’s evidence that “behind-the-scenes event management services” is recognised class of services provided by traders such as herself.

Conclusions

52. In summary I conclude:
- (1) The Appointed Person has a limited jurisdiction to reconsider a decision in exceptional circumstances.
 - (2) Such exceptional circumstances do not exist in the present case.
 - (3) In any event the new arguments presented by the opponent would not affect the conclusion I reached in my previous decision.

Costs

53. The opponent requested that I defer consideration of costs until after dealing with its request to re-open the earlier decision, and I agreed to do so. Despite this I have received submissions on costs from the applicant. I have not looked

at the applicant's submissions. I will entertain further written submissions on costs from both parties provided that they are filed within 21 days of the date of this decision.

22 December 2005

RICHARD ARNOLD QC

Mark Engelman, instructed by Be, acted for the applicant.

Simon Malynicz, instructed by Fry Heath Spence, acted for the opponent.