

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK trade mark 2347898  
in the name of HAUSTE RECEIVABLES LTD**

**AND IN THE MATTER OF INVALIDITY APPLICATION No. 83695  
in the name of CAUSEWAY TECHNOLOGIES LIMITED**

**APPEAL of the Proprietor from the decision of  
Mr D Landau dated 30th September 2011**

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**DECISION**

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1. This is an appeal against a decision of Mr David Landau, the Hearing Officer for the Registrar, dated 30 September 2011, in which he found that trade mark no. 2347898, TRADOCS, should be declared invalid on the basis that it had been registered in contravention of section 5(4)(a) of the Trade Marks Act 1994.

**Background**

2. Tradocs Ltd (“TL”) applied to register the trade mark TRADOCS on 5 November 2003. The registration was completed on 2 April 2004 and the mark was registered for “communication of information by electronic means” in Class 38.
3. On 25 February 2010 Causeway Technologies Limited (“Causeway”) filed an application for a declaration of invalidity of the services of the registration under section 47 of the Act, relying upon section 5(4)(a) and its prior use of the mark TRADEX in relation to services for the electronic transmission of documents and electronic data services.
4. Both parties filed evidence and the matter proceeded to a hearing in front of Mr Landau. He established that the relevant date for testing whether Causeway had a protectable goodwill which would have entitled it to prevent the registration of the TRADOCS mark was the date of application for registration, 5 November 2003, or the date of filing of the application for invalidation, 25 February 2010. However, TL accepted that Causeway's position in relation to the goodwill was no worse at the second material date, so that Mr Landau considered the

case only as at 5 November 2003. Indeed, TL's concession went further— in paragraph 211 of his decision, Mr Landau recorded a concession that "Causeway had a goodwill in relation to the sign upon which it relies" at that date. The sign in question was simply "Tradex." TL thus abandoned an argument which it had made in its counterstatement that if Causeway had goodwill at all it was in relation to the composite sign "Causeway Tradex," not Tradex alone.

5. After considering the evidence (some of which was confidential), the Hearing Officer went on to consider the merits of the invalidation application under a heading "Misrepresentation". In the first paragraph under the heading he said:

"41) Mr Alkin [TL's counsel] accepted the goodwill of Causeway in relation to the sign TRADEX as of both material dates. He also accepted that if at the relevant dates there had been an actionable misrepresentation this would have been liable to damage the goodwill of Causeway. Consequently, the issue in these proceedings crystallises to whether there would be a misrepresentation."

The Hearing Officer went on to summarise TL's submissions about the limitations of Causeway's goodwill. In paragraph 43 of his decision he referred to TL's reliance on a decision of Mr Christopher Floyd Q.C., as he then was, sitting as a Deputy Judge of the High Court) in a passing off case: *Teleworks Ltd v Telework Group PLC* [2002] R.P.C. 27. Mr Landau said:

"that judgment dealt with the actual goodwill of the businesses, not being a *quia timet* action. In this case one side of the coin is the actual goodwill of Causeway. The other side of the coin is the trade mark registration of TL and that must be considered in its full gamut, no extraneous limitation can be placed on the potential normal and fair use of the trade mark and the services for which it is registered. [TL's counsel] submitted that he was not doing this but it is difficult to see how he was not as he submitted that the individuals involved in the sale promotion of the TRADOCS services will be different to those involved in the Causeway business. Consequently, he was adding restrictions to the scope of registration which do not and cannot exist within the parameters of a trade mark registration."

He therefore found the *Teleworks* case "not to point" for this case.

6. The Hearing Officer went on to make the following findings in relation to passing off:

"45) In its statement of case Causeway claims that it has goodwill in relation to services for the electronic transmission of documents and electronic data services. Electronic data services is a term that covers a large number of services, it could

include the activities of an Internet service provider or a telecommunications company. In the agreement between Causeway and HSS Hire Services Group PLC the TRADEX service is described as a service that provides electronic document exchange. The usage has been on a commercial basis, not for individuals. Based upon the usage shown, and that it is not limited to construction companies, a fair description of the business in relation to which the sign TRADEX has been used is *commercial electronic document exchange*.

46) The services of the registration encompass these services and so identical services are involved.

47) The nature of the services of Causeway will require careful consideration as to their suitability, their compatibility with existing systems of undertakings and their robustness, as failure of the system could have serious financial ramifications. Consequently, the services will have been purchased with a good deal of care. The nature of *communication of information by electronic means* is such that prior to purchase the consumer is likely to want to ascertain the compatibility and suitability of such services for equipment and systems that are already being used. Consequently, there is likely to be a good deal of care and consideration of the purchase of the service. The services of the registration are unlikely to [be] purchased on impulse.

48) Mr Alkin sought to rely upon *Office Cleaning Services, Ld v Westminster Window and General Cleaners, Ld* [1946] 63 RPC 30 ... The premise of Mr Alkin's argument is that TRADOCS and TRADEX are largely descriptive; trad referring to trade, docs to documents and ex to exchange. Mr Alkin's submission is predicated on the basis that the relevant consumer for the services will indulge in a philological analysis of the two names. There is no reason to suspect that this would happen, consumers, however sophisticated, do not normally burrow into names used in trade. The two names are invented words; they are not descriptive. The findings in *Office Cleaning Services, Ld v Westminster Window and General Cleaners, Ld* do not assist TL.

49) Mr Alkin submitted (as per his skeleton argument) that there are significant visual, aural and conceptual differences between TRADOCS and TRADEX:

“In the context of the products themselves, the –DOCS suffix would be understood as a reference to ‘documents’ and the –EX suffix as a reference to ‘exchange’. One therefore focuses on the document concept. The other

focuses on the exchange concept. There is no obvious harmony between these two alternative approaches to describing an e-business system.

In both cases the TRAD- prefix would be understood simply as a reference to trade. In view of sub-paragraph (1) above, such similarity as resides in the common, descriptive letters TRAD- is not the type of distinctive similarity as might give rise to the mistaken belief that one is a sub- or co-brand of the other (see decision O/375/10, Iain Purvis QC sitting as the Appointed Person)."

Both names start with TRAD and they both end with an x sound. In oral use the only difference will be the final vowel sound, a very limited difference. Neither name has a clear conceptual meaning. The case does not involve likelihood of confusion, however, there is no reason that the test in relation to the effect of conceptual difference for likelihood of confusion should not apply; at least one of the names at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case neither the sign nor the registered trade mark has a clear and specific meaning. Consequently, there is neither conceptual similarity nor dissimilarity; so from a conceptual point of view the position is neutral. Visually the names start with the same four letters. However, they end very differently; all of the successive letters being alien to each other. Taking into account the nature of the respective services, any purchase will involve viewing information in relation to the services and viewing the respective names. It must be borne in mind that, just as in cases under section 5(2) of the Act, that consumers are unlikely to be comparing the names directly but rely upon imperfect recollection. As neither name has a clear meaning there is no conceptual hook upon which the relevant consumer can rely, increasing the likely effects of imperfect recollection.

50) Taking all the above factors into account, use of the trade mark of TL at the material dates would give rise to a misrepresentation. As has been stated above, Mr Alkin accepted if it was found that there was a misrepresentation damage would follow.

51) The high degree of aural similarity would readily give rise to initial interest confusion as per the judgment of Arnold J in *Och-Ziff Management Europe Limited and another v Och Capital LLP and others* [2010] EWHC 2599 (Ch). ... Consequently, even if it were argued that there are enough visual differences to avoid

misrepresentation on a visual basis, there would be misrepresentation on an aural basis and resultant initial interest confusion.”

7. The Hearing Officer went on to consider whether there was scope to maintain TL’s specification in part. A letter dated 16 June 2011 had been sent by the UKIPO to the parties in which the possibility that the proprietor might wish to submit a limited specification had been raised. No proposal for an amended specification was put forward by TL before the hearing. However, at the hearing, it requested that if the decision were to go against it, the Hearing Officer should put forward a limited specification which would allow part of its specification to subsist, if possible. Considering that point at paragraph 54 of his decision, Mr Landau referred to the decision of the CJEU in Case 363/99 *Koninklijke KPN Nederland NV v Benelux Merkenbureau* which held that a registration could not be permitted for services only insofar as they "do not possess a particular characteristic." He concluded:

“Consequently, a limitation which excludes a particular characteristic would be contrary to law. It is not envisaged what sort of specification would be crafted which would avoid the finding of misrepresentation. Consequently the finding for Causeway must relate to all of the services of the registration.”
8. The application for invalidity therefore succeeded in its entirety and costs were awarded against TL in the sum of £2700.

#### **Parties**

9. An appeal was lodged by TL on 27 October 2011. On 29 December 2011, TL changed its name to Alvested 11 Ltd and it went into voluntary liquidation on 20 January 2012. However, on 7 December 2011 the registration of the Mark had been assigned by TL to Hauste Receivables Limited (“Hauste”), a company registered in Ireland. Hauste has been registered as the proprietor of the mark and has, in effect, been substituted as the appellant in the proceedings. That prompted an application for security for costs by Causeway, which I granted, and security has been provided. Although I have some concerns about the manner in which that substitution was effected, it is not necessary to deal with that point in this judgment: Hauste has now provided the security for costs of the appeal and the costs below, it accepts liability for the costs below if that costs order stands, and it stands by the Grounds of Appeal lodged on TL’s behalf. For the sake of simplicity, I shall where possible refer to TL and Hauste interchangeably in this judgment as “TL.”

## The Appeal

10. It was common ground between the parties on the appeal that the appeal is by way of review. *Reef Trade Mark* [2003] RPC 5 (“*Reef*”) and *BUD Trade Mark* [2003] RPC 25 (“*BUD*”) show that neither surprise at a Hearing Officer’s conclusion, nor a belief that he has reached the wrong decision, suffice to justify interference in this sort of appeal. I would need 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).

Those principles have since been affirmed *inter alia* by the House of Lords in *Datec Electronics Holdings Ltd & Ors v. United Parcels Services Ltd* [2007] UKHL 23, [2007] 1 WLR 1325. Mr Daniel Alexander QC sitting as the Appointed Person in case BL O/471/11, *Petmeds*, 14 December 2011, summarised the current position thus:

“*Datec* and other cases since *REEF* and *BUD* all reinforce the need for caution before overturning a finding of the tribunal below of the kind in issue in this case. Difference of view is plainly not enough and, to that extent, the applicant’s submissions are correct. However, those cases and the practice of appellate tribunals specifically to trade mark registration disputes show that the degree of caution should not be so great as to permit decisions based on genuine errors of approach to go uncorrected.”

11. There were two main aspects to the appeal. The first related to the alleged misrepresentation and the second was the Article 13 point (as to whether the TRADOCs mark could be saved in part, maintaining a limited specification).

### Did the Hearing Officer err in relation to section 5(4)(a)?

12. Ms Reid, who appeared for TL/Hauste on the appeal, submitted that the Hearing Officer gave no indication of the test he would apply in assessing the misrepresentation and appears (especially in paragraph 49 of his decision) to have applied a test based on a theoretical assessment more appropriate to an objection under sub-section 5(2) than to sub-section 5(4)(a). Mr Landau did not cite the authority on section 5 (4)(a) usually applied by the Registrar, *Wild Child*, nor the first instance decision in *Reef* at [2002] R.P.C. 19, where

Pumfrey J dealt with and set out the *Wild Child* test. Ms Reid submitted that this was a flawed approach and led to an erroneous conclusion. She referred in particular to the well-known passage of *Reef* where Pumfrey J said:

“25. ...The objection in this case is under section 5(4)(a). It is said that the opponent can prevent use of the applicants' mark by invoking the law of passing off.

26 Where the applicants' mark is unused, this section presents a number of conceptual questions. ... As Mr Hobbs Q.C. said in *WILD CHILD Trade Mark* [1998] R.P.C. 455 the registrar is often required to act upon evidence that might be regarded as less than perfect when judged by the standards applied in High Court proceedings. The second question follows: how cogent must the evidence be upon which the registrar should act in upholding an opposition on this ground?

27 There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. ... The evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.

29 Here, the hearing officer directed himself in accordance with Mr Hobbs Q.C.'s correct statement in *WILD CHILD* of the “classical trinity” of ingredients in a passing off action—goodwill and reputation, deception, and damage. ...

30 In considering deception, he again followed what Mr Hobbs Q.C. said in *WILD CHILD*, quoting paragraph 184 of Vol. 48 of Halsbury's Laws (4th ed., 1995 reissue) now paragraph 316 of the 2000 reissue of Vol. 48:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

30 In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name, etc, used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark, etc, complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception or confusion is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

The hearing officer remarked that he had no evidence from the public as to whether they would be deceived. The question is primarily one for the court properly instructed as to the reputation of the opponent, and taking into account instances (if any) of actual deception. But this does not matter."

13. It is right to say that in this case the Hearing Officer did not set out those principles. Instead, he considered the issue of a 'likelihood of misrepresentation' in very much the same way as if he had been considering whether there was a 'likelihood of confusion' in relation to an objection under sub-section 5(2)(b) of the Act. That is certainly an unusual feature of Mr

Landau's decision. However, that approach was, it seems, suggested to the Hearing Officer by TL's skeleton argument below. Moreover, as Mr Campbell argued before me on Causeway's behalf, that approach may not have led the Hearing Officer into error if he nevertheless carried out a proper assessment of the factors listed at (a)-(e). Indeed, it is clear from the penultimate sentence of paragraph 49 of the decision that the Hearing Officer appreciated that he was drawing an analogy with a section 5(2)(b) case. Ms Reid accepted that the Hearing Officer had considered factors (a) to (c), albeit rather as if it had been an objection under sub-section 5(2)(b), but she submitted that he had failed to consider factors (d) or to some extent, (e).

14. TL submitted that one of the factors which the Hearing Officer had failed to consider sufficiently was how Causeway used its mark, and how that should be compared with the Tradocs mark. It submitted Causeway had tended to use the mark Tradex in conjunction with its name Causeway and Ms Reid showed me a number of exhibits to make good that point, suggesting that the Hearing Officer should have taken that into account when considering the likelihood of a misrepresentation arising. However, the Hearing Officer noted at paragraph 22 of his decision that there was a large amount of use of Tradex on its own and it was submitted to me on Causeway's behalf that the exhibits showed a decreased reliance upon the name Causeway as time went on. More significantly, at the hearing in front of Mr Landau, TL's then counsel *conceded* that Causeway's goodwill resided in the mark Tradex alone, rather than only as part of the name Causeway Tradex. The Hearing Officer plainly took that point into consideration in assessing the nature and extent of reputation upon which Causeway was relying and which had to be compared or contrasted to the manner in which the Tradocs mark would be used across its specification. It does not seem to me that he can now be said to have been wrong to do so, especially in the light of TL's concession, and this in my judgment counters Ms Reid's argument that the Hearing Officer failed to pay proper attention to the manner in which Causeway used its sign.
15. TL also criticised the Hearing Officer's analysis on the basis that he had failed to take into account the nature of Causeway's business, as shown by the documents it had exhibited. It argued that contracts for Causeway's Tradex products/services would be negotiated with care and were expensive, so that customers would take care with the purchase; as a result, the likelihood of a misrepresentation was reduced. That may well be a good point in the light of the evidence. However, it seems to me that it clearly was taken into consideration by the

Hearing Officer in paragraphs 47 and 49 of his decision. Equally, in paragraph 47 he held that the services within Tradocs' registration would be purchased with care and not on impulse. He rejected TL's argument, reflected in Ground 5(1) of the Grounds of Appeal, that Causeway's reputation lay only with a few clients in the construction industry, which was not pursued in any event at the hearing of the appeal. If relevant, in my view the evidence establishes that the Hearing Officer had some grounds to make the finding (in paragraph 42) that Causeway's goodwill was not so limited. In the circumstances, I do not find any error in his consideration of factor (e) above in these respects.

16. Next, TL submitted that the best evidence of normal and fair use of the Tradocs mark was the evidence of how it had been used prior to the relevant date, and the Hearing Officer had erred in failing to consider this and in declining to follow the decision in the passing off case of *Teleworks* [2002] R.P.C. 27. In *Teleworks* the court took into account the manner of use of the mark in order to assess how descriptive it was, but also held that significant differences between the activities of the parties precluded confusion. The Hearing Officer considered that *Teleworks* was of limited relevance to his decision in this case; in paragraph 43 he said he thought it necessary to consider whether use of the mark in relation to the full range of services within Tradocs' trade mark specification could have been prevented by a passing off action at the relevant date. That analysis appears to me to be correct. I note that in *Teleworks*, Mr Floyd QC held at paragraph [7] that in a passing off action the court should look not only at the past acts of the defendant but at threatened acts as well, for a tangible threat to trade in a significantly different way in future might give rise to deception or confusion. Equally, in my judgment, the Hearing Officer was right not to restrict his consideration to TL's evidence as to the manner of use of its mark, as he had to consider normal and fair use of the mark across the specification.
17. Next, TL submitted that the Hearing Officer had erred in saying that neither of the marks at issue was descriptive, and in suggesting in paragraph 48 that the average consumer would not "indulge in a philological analysis" of the marks to find the descriptive terms behind them. TL submitted that both marks had descriptive connotations, and relied upon the decision in *Teleworks*, where it was held that whilst far from being a *Chicago Pizza* or an *Office Cleaning Services*, there was nevertheless "a strong descriptive element in the name which seems to me to indicate that a customer would not be surprised to learn that there were two companies both using the name." TL also relied upon Case T-189/05, *Usinor SA v*

*OHIM*, 14 February 2008, in which the marks “Galvalloy” and “Galvallia” were both held likely to be perceived as making a reference to galvanization.

18. It seems to me that the Hearing Officer was justified in distinguishing *Office Cleaning* which concerned utterly descriptive, indeed, banal marks, from this case where there is at least an element of inventiveness in the marks. *Usinor* does not, in my view, take the matter further, for such cases inevitably turn on their particular facts. Although the marks have a descriptive element to them, it does not seem to me that the Hearing Officer was plainly wrong to conclude that they would nevertheless be seen as invented words, nor that he erred in principle in doing so. The Hearing Officer was right to consider whether the marks were and would be seen as simply descriptive. He decided that they were not, but amounted to invented words, presumably because of the elision of the words ‘trade’ and ‘exchange’ on the one hand and ‘trade’ and ‘documents’ on the other which he considered would not be broken down by the average consumer.
19. In my judgment, TL was justified in saying that both marks have a descriptive element to them, and in suggesting that the Hearing Officer expressed himself in unusual terms in paragraph 48 of the decision. He may have over-estimated the amount of analysis which the average consumer would need to undertake to discern the descriptive element of the marks. However, in my judgment the marks are not so plainly, wholly or directly descriptive that I can say that the Hearing Officer must have made an error in deciding that they amounted to invented words. I do not consider that he was manifestly in error in finding that these are invented word marks.
20. TL also submitted that the Hearing Officer was wrong not to take into account a lack of evidence of confusion despite a substantial period of parallel trading by the parties. There was one instance of confusion identified by Causeway’s Mr Cole. The Hearing Officer discussed this at paragraphs 40 and 44 of his decision, but does not seem to have relied upon it, as he considered it would not be “determinative or even particularly indicative.” He nevertheless concluded that there was a likelihood of a misrepresentation occurring. On appeal, TL suggested that the single alleged incident of confusion was not cogent evidence of confusion and that had there been real confusion in the circumstances it would have come to light.

21. There are two problems with that point. First, Causeway submitted that there had in fact been little parallel trading in the UK prior to the relevant date, that TL's evidence established (at best) a tiny number of sales in the UK generating a small level of turnover, and tended to show use of the name Tradocs in the company name rather than as a trade mark. There seems to me to be some force in those submissions. Secondly, again, TL faces the difficulty that the Hearing Officer was considering the possibility that there might be a misrepresentation if the Tradocs Mark was used in a normal and fair manner across the whole of its specification, not the discrete part for which it was said to have been used. I do not consider that he erred in this regard either.
22. None of TL's points therefore suggest to me that the Hearing Officer had failed to consider the facts relevant to factors (d) or (e) of the test set out above. I do not find that his decision is either mistaken in principle or obviously wrong on the facts, and I reject the appeal on the basis that the Hearing Officer misapplied section 5(4)(a).
23. The Hearing Officer also relied on the possibility of initial interest confusion arising. TL initially complained that he had unfairly taken this point without giving it a suitable opportunity to address him on it, but that objection was dropped on the appeal, when it appeared that the case had been discussed at the hearing below. Whether or not the Hearing Officer was right to apply the reasoning in *Och Ziff* to this case, given my findings on the appeal so far I need take this point no further.

**Did the Hearing Officer err in relation to Article 13?**

24. The second part of the appeal related to the Hearing Officer's failure to apply Article 13 of the Directive (as to partial invalidity) and the Tribunal Practice Notice as to how partial invalidity should be treated (at the time it was TPN 1/2011 – that has now been replaced by TPN 1/2012). TL submitted that if the invalidity decision was maintained, it should not be maintained for the whole of its specification, as parts would not conflict with Causeway's goodwill. It said that the Hearing Officer had erred in failing to propose a more limited specification for the challenged mark, and in failing to give the parties a proper opportunity to deal with the specification.
25. Article 13 provides:

"Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has

been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only."

In *Sensornet Trade Mark* BL O/136/06, Mr Richard Arnold Q.C., as he then was, sitting as the Appointed Person held that Article 13 required that where an objection to registrability only applied to some goods or services in the specification applied for, then the application should only be refused in so far as it covers those goods or services and should be allowed to proceed in respect of the remainder. In *Giorgio Armani SpA v Sunrich Clothing Ltd* [2010] EWHC 2939, Mann J considered that this could be done in a variety of ways: "blue penciling" an express qualification ("save for [the goods in respect of which the opposition succeeded]") or particular reformulation of the specification.

26. TPN 1/2011 and now TPN 1/2012, explain how that guidance shall be applied in cases of a defended invalidity application. There are 3 possible approaches, depending on the facts:
- a. The Hearing Officer may undertake a "blue pencil" partial deletion;
  - b. The Hearing Officer may qualify the specification by adding the words " save for" and the goods/services to be taken out of the specification; or
  - c. If neither a deletion or a "save for" exclusion will do, the Hearing Officer "may indicate the extent to which the proceedings succeed in his/her own words. The parties will then be invited to provide submissions/proposals as to the appropriate wording" of a narrower specification. The amended TPN says that will be done only in cases where the Hearing Officer considers that there is "real practical scope to give effect to Article 13." Where the invalidation succeeds against goods/services covered by "a broad term" it may be disproportionate to embark on a process to formulate proposals "which are unlikely to result in a narrower specification of any substance or cover the goods or services provided by the owner's business..."
27. I have set out at paragraph 7 above the background to this point and the Hearing Officer's decision based upon "*Postkantoor*". Mr Landau made no reference to *Sensornet*, *Armani* or TPN 1/2011, and unfortunately it is not apparent that he had considered the impact of the TPN at all. Had he done so, in the light of his findings I think it likely that he would have dismissed both approaches (a) or (b) as inappropriate in this case. Indeed, I think that in paragraph 54 he effectively considered (and rejected) approach (b). It is less clear to me whether he considered the potential for reformulating the specification, still less whether he

thought was a realistic approach, as put in the new TPN, that as the challenged specification is a “broad term,” any amended specification might not result in a narrower specification of any substance, or cover the goods or services provided by TL’s business.

28. In my view the issue of whether an unobjectionable amended specification could have been devised ought to have been addressed by the Hearing Officer by reference not just to *Postkantoor* but also by reference to TPN 1/2011. I consider that he ought at least to have considered the possibility of formulating a narrower specification for the TRADOCs mark which would not fall foul of Causeway’s rights in accordance with the TPN guidance, and it is not apparent from his decision that he did so. To that extent he did fall into error.
29. I have a good deal of sympathy for Causeway’s submissions that this is a case in which it may not be possible to produce a sensible/workable narrowed specification, and that any narrower specification which avoids any likelihood of passing off may fail to cover the goods or services provided by TL’s business. Unless a more limited specification for TL’s mark can be devised which is clearly not objectionable, the Hearing Officer’s decision invalidating the mark in its entirety will stand.
30. I am also sympathetic to Causeway’s complaint that even by the time the appeal was heard, no amended specification had been formulated by TL. On the other hand, unlike the position faced by Mr Daniel Alexander QC sitting as the Appointed Person in *Multisys*, BL O-410-11, the request for remission of the question of a limited specification had at least been raised in TL’s Grounds of Appeal.
31. I was invited, if I found that it would be appropriate to consider a possible limited specification, to consider whether to remit the point to the Registry, or invite the parties to make representations to me as to an appropriate amendment. I do not propose to make a definitive decision as to whether to remit the case at this stage. Instead, in the first instance, I propose to invite the parties to supply me with sequential written submissions in accordance with the following timetable:
  - a. TL shall put forward a proposal of an amended specification compatible with the Hearing Officer’s findings under s 5(4)(a) by 5 pm on Tuesday 16 October 2012;
  - b. Causeway may respond, setting out any objections to the proposal, by 5 pm on Tuesday 30 October 2012;
  - c. TL may reply by 5 pm on Tuesday 6 November 2012.

I shall defer a decision as to whether I consider it appropriate to remit the matter to the Registry or can decide the point myself until I have those submissions.

32. I will also defer dealing with the costs of the appeal until that decision is made.

Amanda Michaels  
The Appointed Person  
1 October 2012

MS. JACQUELINE REID (instructed by iLaw Legal Services) appeared  
on behalf of the Applicant/Appellant.

MR. DOUGLAS CAMPBELL (instructed by Graham Coles & Co.) Appeared  
on behalf of the Opponent/Respondent.