

O/512/20

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2571171
IDEAL HOME SHOW
IN THE NAME OF MEDIA 10 LIMITED**

**AND OPPOSITION THERETO NO. 410376
BY TI MEDIA LTD**

**AND IN THE MATTER OF TRADE MARK APPLICATION NO. 3035681
IDEAL HOME
IN THE NAME OF MEDIA 10 LIMITED**

**AND OPPOSITION THERETO NO. 411944
BY TI MEDIA LTD**

**IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
FROM THE DECISION OF MRS JUDI PIKE
DATED 24 SEPTEMBER 2019**

DECISION

1. This is an appeal from a decision of Mrs Judi Pike, on behalf of the Registrar, BL O/560/19. It is a skirmish in a long-standing war between Media 10 Limited, which is responsible for the well-known home interest show, the Ideal Home Show, and TI Media Ltd, the publisher of the well-known home interest magazine, Ideal Home. I will adopt the Hearing Officer's approach of referring to Media 10 Limited as "Show" and to TI Media Ltd as "Magazine."
2. The decision related to three trade mark applications for IDEAL HOME made by Magazine and opposed by Show, and to two applications for IDEAL HOME SHOW and IDEAL HOME respectively made by Show and opposed by Magazine. This appeal relates only to Show's applications. The Hearing Officer upheld in part Magazine's

oppositions to those applications on the basis of section 5 (4)(a) of the Act, and Show appeals that part of her decision.

Background

3. The appeal relates to Show's trade mark applications for IDEAL HOME SHOW and IDEAL HOME.
4. The words Ideal Home have been used as or as part of the names of a magazine and a show directed to home interest products since 1920. They were used by separate businesses which had co-existed and survived a certain amount of consumer confusion. As both sides sought to move into online retailing, trade mark infringement proceedings were brought by Magazine against Show. Show counterclaimed for the invalidity of Magazine's mark, IDEAL HOME, which was registered for certain retail services. Mr John Baldwin QC, sitting as a Deputy Judge of IPEC, decided in late 2013 that the infringement claim failed, as did the counterclaim for invalidity. Lengthy extracts from his judgment ([2013] EWHC 3796 (IPEC), [2014] F.S.R. 25) were set out by the Hearing Officer at paragraph 6 of the decision now under appeal.
5. Mr Baldwin QC found that since about 1920 IDEAL HOME had not signified a single business in the field of home interest goods or services, and there was existing confusion amongst the public as to whether the businesses were linked in some way. Both sides appealed. The Hearing Officer again set out a lengthy passage from the judgment of Kitchin LJ in her decision ([2014] EWCA Civ 1439, [2015] FSR 12). For present purposes, I think it suffices to note the following paragraphs:

"52. I turn then to consider the application of these principles in this case and in the light of the findings of fact that the deputy judge has made. The words Ideal Home have been used as or as part of the names of a magazine and a show directed to home interest products since 1920. The deputy judge has found that the reputation and goodwill attaching to each of the businesses is very substantial indeed. It follows that neither can complain about the honest use by the other of the words Ideal Home in relation to their respective core businesses,

that is to say, in the case of IPC, publishing a magazine concerned with home interest products, and, in the case of Media 10, operating shows of home interest products at which such products are sold. That is so despite the fact that, as the deputy judge also found, consumers may well think that the two businesses are one and the same or are at least connected.

53. In my judgment the same considerations apply to the provision of home interest retail services online by IPC under the name Ideal Home, and by Media 10 under the name Ideal Home Show. The deputy judge has found that these services are so closely related to the activities the parties have carried on for very many years that the words Ideal Home provide to consumers just the same guarantee that they have always provided, that is to say that the services are those of the entity responsible for running the show or the magazine or, to many consumers, the entity responsible for both of them. In other words, he has found on the facts that the name Ideal Home, when used in relation to such online retail services, does not denote and has never denoted to average consumers the services of a single entity. Rather, it denotes and has always denoted the services of both IPC and Media 10, that is to say the services of the businesses responsible for publishing Ideal Home magazine and running the Ideal Home show. Sometimes the circumstances of the use may suggest that the services are those of one business rather than the other. But that will not always be so. Further and in any event, many consumers believe the businesses are one and the same or are at least connected.

54. I recognise, as did the deputy judge, that the confusion that occurred whilst the parties limited themselves to running a show and a magazine was more in the nature of an administrative inconvenience. I also accept the finding of the deputy judge that his conclusion opens up the possibility of some confusion between the parties' online retail businesses. But that, it seems to me, is the inevitable consequence of the use by two separate entities of the same or closely similar names in relation to such similar businesses, namely the running of a show of consumer interest products and the publishing of a magazine all about such products. I am satisfied that the provision of online retail services concerning such products was an entirely natural extension of the businesses of each of them. It

was not, as Mr Abrahams characterised it, a major departure for Media 10. Indeed, Media 10 referred the deputy judge to mail order marketing carried out by its predecessor in title, the Daily Mail Group, in the early 1990s; to the introduction of a credit card in the mid 1990s; and to the updating of the Ideal Home Show website in 2008 to include an online shop, although it merely enabled the purchase of goods from third parties. Of course Media 10 must not take any steps to increase the level of confusion beyond that which is inevitable and so encroach onto IPC's goodwill. But the deputy judge was satisfied that it has not done so and in that regard it is notable that it uses for its services the name Ideal Home Show, just as it does in relation to its core business.

55. ... when used in relation to online retail services the words Ideal Home denote what they have always denoted, namely that these are the services of the entities or entity responsible for the show and the magazine. The likelihood of confusion and the nature of that confusion are just the same as they would have been had the parties begun to offer such retail services at exactly the same time.

56. I therefore believe that this is one of those rare cases in which the use of the mark complained is indeed honest and that it has not had and will not have an adverse effect upon the essential function of the registered trade mark, and that is so because the guarantee of origin the mark provides is just the same as it has always been. The deputy judge referred to the trade mark as flawed. I prefer to say (as Sir Robin Jacob did) that the guarantee is different from that which it would have been had the mark only ever been used by a single entity.

57. I believe this deals with all of the submissions advanced by Mr Abrahams save the last. As to that, I do not accept that the reasoning of the deputy judge leads directly and inevitably to the conclusion that each party may now start using the name Ideal Home in relation to the core activities of the other. That, it seems to me, would be an expansion of a different nature from that which the parties have undertaken in relation to retail services on the internet, and that is so because it would involve an encroachment into precisely the area of business in relation to which each has generated a goodwill over very many years. As such I believe it would involve the use of the name in a different context and might well result in

the actionable deception of a significant number of persons. However, it is not a matter before us and so I prefer to express no final conclusion upon it.”

6. The consolidated oppositions related to trade mark applications made by Magazine between September 2011 and January 2014, all for IDEAL HOME, and applications made by Show in February 2011 for IDEAL HOME SHOW (No. 257171), and in December 2013 for IDEAL HOME *solus* (No. 3035681). This last application was filed just after Mr Baldwin QC’s decision.
7. The range of goods and services covered by Show’s current contested applications was extremely wide, covering more than 20 classes, and many kinds of goods and services which have no obvious relevance to home interest products, such as cosmetics in Class 3, vehicles in Class 12, precious metals in Class 14, and telecommunications in Class 38. The specifications applied for are set out in the Annex to the decision below and I do not propose to set them out in full. The parties opposed each other’s marks in part on the basis of their own earlier registered marks and earlier goodwill.
8. Before or at the hearing before the Hearing Officer, Magazine narrowed its opposition to the ‘171 application, as the Hearing Officer records at paragraph 29 of her decision. Magazine’s expressed intention was to concentrate upon the goods/services in its core field of business. In addition, Show withdrew magazines from its applications in Class 16 and qualified some of the terms in Classes 9 and 16 to exclude magazines. Magazine maintained the oppositions, saying that the amendments did not go far enough. Hence, the only goods and services in Show’s IDEAL HOME SHOW application remaining in issue by the time of the hearing were (with Show’s proposed limitations in bold/strikethrough):

Class 9: On-line electronic publications (**not including magazines**); electronic publications (downloadable **and not including magazines**).¹

¹ Mr Alkin’s skeleton argument said Magazine also maintained its opposition to CDs in Class 9. I am not clear why (if so) these were omitted from paragraph 29 of the decision. Nothing turns on this, as the mark was allowed to proceed to registration for CDs and there is no appeal about that.

Class 16: Goods made from cardboard and paper, not included in other classes **and not including magazines**; printed matter (**not including magazines**); brochures; ~~magazines~~; newsletters; pamphlets.

Class 35: Retail and wholesale services, including via the Internet, mail order, electronic and printed publications, websites or other communication networks, connected with the sale of on-line electronic publications, electronic publications (downloadable), goods made from paper and cardboard, printed matter, brochures, magazines, newsletters, pamphlets, goods made of paper or cardboard, magazines, books, printed matter, publications.

Class 41: Publication of printed matter and printed publications; publishing and publication services; electronic publishing services; providing on-line publications (not downloadable); publication of electronic books and journals on-line; commissioned writing.

9. Magazine opposed the whole of the broad specification for the '681 mark, IDEAL HOME, save for "organisation of exhibitions and shows" in Class 41.
10. Each side put the other to proof of use and filed evidence for that purpose and to establish goodwill. The Hearing Officer said that the evidence filed before her was the same as that considered by the Court in the IPEC proceedings, and she records in the decision that the parties were content for the facts found in the IPEC proceedings to stand as evidence in the consolidated oppositions.
11. At the hearing below, the parties agreed that the oppositions could be disposed of on the basis of the section 5(4)(a) grounds. Mr Alkin, who appeared for Magazine below and on the appeal, told the Hearing Officer that the main area of contention related to Show's claim to the '681 mark for Ideal Home *solus*. In the light of the Court decisions mentioned above, both sides accepted that they should be able to coexist in the context of home interest goods and services, but Magazine could object in relation to its core business of magazines and Show in relation to its core business, the organisation of exhibitions and shows. Show submitted that products and services which did not fall within the "home interest description" should be assessed "in the usual way." The Hearing Officer noted at paragraph 24 of her decision "although the

judgments were concerned with retail services of home interest products, I do think that the rationale extends to home interest products (whether goods or services) themselves. Both parties have taken this view."

12. I do not think it is necessary for me to comment upon the Hearing Officer's findings in relation to Show's opposition to Magazine's applications. Neither side suggested that there was anything in that part of her decision which would affect the appeal.

13. Dealing with Magazine's opposition to the '171 IDEAL HOME SHOW mark, the Hearing Officer referred to her own earlier decision, BL O/384/16. That decision related to Magazine's opposition to Show's earlier application No. 2465468, also for the mark IDEAL HOME SHOW, which included in its specification a variety of goods in Class 16. Mrs Pike held there that Magazine's opposition to "brochures" was justified, but would have allowed Show to register the mark for "brochures relating to home interest goods and services" because such goods were a natural extension of Show's core business. Checking the Register, it seems that Show did not agree to that limitation. Moreover, "brochures" without any qualification were claimed in the '171 application and opposed by Magazine, despite the Hearing Officer's decision from 2016.

14. Perhaps not surprisingly, taking into account the basis of her decision in 2016, at paragraphs 31-32 the Hearing Officer accepted Magazine's view that the current proposed limitations to the '171 mark did not go far enough to avoid conflict. She found that the section 5(4)(a) objection succeeded in part but rejected the opposition for a narrower range of goods and services all strictly related to shows for home interest goods and brochures also relating to such goods/shows. Of the limited range of goods and services covered by the opposition, she permitted the registration of the Mark for:

Class 9: On-line and electronic brochures relating to home interest goods and services; on-line and electronic publications relating to home interest shows.

Class 16: Brochures relating to home interest goods and services; publications relating to home interest shows.

Class 35: Retail and wholesale of brochures relating to home interest goods and services; retail and wholesale of publications relating to home interest shows.

Class 41: Publication of brochures relating to home interest goods and services and of publications relating to home interest shows; providing on-line publications (not downloadable) of brochures relating to home interest goods and services and publications relating to home interest shows; publication of brochures relating to home interest goods and services and of publications relating to home interest shows on-line.

The result was that the '171 mark was allowed to proceed to registration for the very substantial remaining specification set out at pages 44 to 56 of the decision below.

15. On the opposition to the '681 mark, IDEAL HOME, the Hearing Officer considered Magazine's argument that Show's intention to drop the word Show, in relation to goods and services not directly related to shows, disturbed the basis for the honest concurrent use defence. At paragraph 34, the Hearing Officer described Magazine's objection to the application as being "that Show has, in seeking to register IDEAL HOME without the word Show, stepped outside of the honest concurrent use defence as explained in the court decisions." She agreed at paragraph 35 that the application encroached upon Magazine's goodwill, and therefore said that she would refuse the parts of the application which related to home interest goods and services other than the "organisation of exhibitions and shows" in Class 41, and the goods and services forming Magazine's "core business area."

16. The Hearing Officer went on:

"36 Although there is already some degree of public confusion, dropping SHOW would cause some consumers who are not currently confused because they differentiate between IDEAL HOME and IDEAL HOME SHOW to become confused. It is well established that dropping a part of a mark that helps to distinguish two businesses can result in passing off; see *Sir Robert McAlpine Limited v Alfred McAlpine Plc* [2004] RPC 36 (HC). It is true that the word SHOW is descriptive of shows and its presence/omission is therefore not material in the context of services relating to shows. But SHOW is not descriptive of, for example, paint, so

the omission of this word makes some difference in the context of goods and services other than shows.

...

37 SHOW is entirely descriptive of shows, but not of Show's other goods and services. The omission of SHOW from the mark increases the confusion or deception (except for shows); it may not increase the likelihood of deception substantially, but it is sufficient that it increases the likelihood of deception amongst a substantial number of persons.

38. The question is whether, on the basis of the court judgments, Magazine's opposition should succeed in relation to goods and services which are not for home interest. My view is that it should not; Magazine is not able to prevent the use of IDEAL HOME in relation to goods and services which are clearly outside of this category, unless normal priority rules apply and one or more of its grounds succeeds against such goods and services. I have been through Show's lengthy specifications and I have identified the following as falling outside of the description of home interest goods and services. The parties have taken a broad view of 'home interest'. I will do likewise and I have also considered hobby and home improvement items to be included in the home interest description ..."
(emphasis added)

17. The Hearing Officer then set out in paragraph 38 a list of goods/services in Show's lengthy specification which she considered fell *outside* the category of home interest goods and services (which she indicated in her view extended to hobby and home improvement items). Her non-home interest list included quite a number of disparate goods and services, from materials of metal for railway tracks in Class 6, and credit cards in Class 16, to asphalt in Class 19 and the production of radio and television programmes in Class 41. At paragraph 39 she rejected the opposition for certain services in Class 41, not just the "organisation of exhibitions and shows" acceptable to Magazine, but also a slightly wider range of overlapping or similar services in Class 41, she did so as she considered that all of these were all closely tied to Show's core business area.

18. The Hearing Officer then had to decide whether the opposition succeeded against any of the non-home interest goods and services she had identified in paragraph 38. In paragraph 40 she considered the authorities on common field of activity (especially *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697 and *Lego Systems A/S v Lego M Lemelstrich Ltd* [1983] FSR 155), and she concluded

“41. Like Lego, Magazine’s sign IDEAL HOME is a household name and has been so for nearly a century. Without the context of SHOW, I find that a substantial part of Magazine’s customers will assume that the goods and services are in some way connected to or under the auspices of Magazine. IDEAL HOME is so famous that, like Lego, lack of similarity between fields of activity matters less. In relation to the advertising and marketing services, these are, in fact, not so far away from Magazine’s core business area of publishing magazines, which include advertisements for third parties.

42. Show’s application 3035681 IDEAL HOME is refused except in relation to production of shows; organisation of exhibitions and shows; organisation of exhibitions for cultural or educational purposes; arranging of tickets for sporting, cultural and entertainment, events, concerts and shows; information, advisory and consultancy services relating to all the aforesaid services; all the aforesaid services also provided on-line from a computer database and/or from the Internet, for which it may proceed to registration. ...”

19. Show contended on the appeal that the Hearing Officer had erred in:

- a. finding at paragraph 32 that the limitations it had proposed to the specification of the IDEAL HOME SHOW mark were insufficient to prevent encroachment upon Magazine's core business area; and
- b. concluding that dropping “SHOW” from the ‘681 mark would increase confusion, and was wrong in her conclusions that there would be a likelihood of passing off in paragraphs 41-42.

20. The Grounds of Appeal did not set out any reasons why the Hearing Officer was said to have made those errors and, as Magazine commented, this suggests that Show was in essence seeking to challenge the Hearing Officer’s assessment of the facts.

21. After various adjournments, the appeal was heard remotely over video link. I am grateful to both sides for their help and cooperation at the hearing.

Standard of appeal

22. The following principles are relevant to this appeal. The standard of appeal is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material error of principle in the decision in question or that the Hearing Officer was wrong. The relevant principles were set out in *TT Education Ltd v Pie Corbett Consultancy* [2017] RPC 17 by Daniel Alexander QC sitting as the Appointed Person at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc v Arcadia Trading Limited* [2017] EWHC 440 (Ch). Mr Alexander QC said in particular that

“... In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country* and others).”

23. Subsequently, the Supreme Court in *Actavis Group PTC v. ICOS Corporation* [2019] UKSC 1671 dealt with the role of the appellate court at [78] to [81]. Lord Hodge said:

“78. ... Where inferences from findings of primary fact involve an evaluation of numerous factors, the appropriateness of an intervention by an appellate court will depend on variables including the nature of the evaluation, the standing and experience of the fact-finding judge or tribunal, and the extent to which the judge or tribunal had to assess oral evidence: *South Cone Inc v*

Bessant , In re Reef Trade Mark [2002] EWCA Civ 763; [2003] RPC 5 , paras 25-28 per Robert Walker LJ.

...

80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible. ...

81. Thus, in the absence of a legal error by the trial judge, which might be asking the wrong question, failing to take account of relevant matters, or taking into account irrelevant matters, the Court of Appeal would be justified in differing from a trial judge's assessment of obviousness if the appellate court were to reach the view that the judge's conclusion was outside the bounds within which reasonable disagreement is possible. It must be satisfied that the trial judge was wrong ..."

Merits of the appeal on the '171 mark, IDEAL HOME SHOW

24. Show argued that the Hearing Officer failed to take into account the limitation proposed to its specification. It said that paragraph 57 of the Court of Appeal judgment meant that any objection would be limited to cases of encroachment into the other party's core field of business and by removing goods specifically referable to magazines Show had ensured that it would not encroach upon Magazine's core business. The Hearing Officer had also been wrong to have proceeded on the erroneous basis that Magazine had goodwill for publishing services, and should have treated Magazine's core business as no wider than for magazines. I note that in its Form TM7 Magazine claimed it had used IDEAL HOME for "printed publications and

periodicals; magazines,” although the Statement of Grounds was more broadly phrased, claiming goodwill attached to its “earlier goods and services.”

25. The Grounds of Appeal were unclear as to whether the decision was challenged in respect of all of the contested goods/services, or just some of them. Mr Krause submitted that they were all acceptable, but that Show would, if required to do so, be prepared to add a similar limitation of the services in Classes 35 and 41 to that offered for the goods Classes. Mr Krause also submitted that use of the mark on non-home interest goods and services could not be more damaging to Magazine’s goodwill than use of it for home interest goods and services.
26. Magazine submitted that Show had failed to identify any error of law or principle in the decision on the ‘171 mark. It accepted that there could be co-existence where the specifications related to goods/services outside the parties’ core fields of business, hence the limited opposition which it pursued to the hearing, but it argued that the limitation offered by Show was inadequate to protect its core business. For instance, Mr Alkin submitted that the publishing services for which Magazine had goodwill would be affected by the registration of Show’s mark, even if the publication concerned was not a magazine but, say, a book or newspaper supplement.
27. I think that the parties were right to consider that the Hearing Officer proceeded on the basis that Magazine had goodwill for publishing services. This was not explicitly mentioned in relation to Show’s applications, but she took it into account at paragraph 25, in which she considered Show’s opposition to Magazine’s ‘747 mark, as she said “Show also relies on its earlier mark 2465468. There are no goods or services covered by that registration which are similar to *publishing*. It also relies on passing off rights in, amongst other goods and services, printed publications and publishing services. It is difficult to see how Show could succeed in that claim given what the courts have said about the parties’ respective areas: publishing is Magazine’s core business, not Show’s.” Paragraph 52 of the Court of Appeal judgment described Magazine’s core business as “publishing a magazine concerned with home interest products.” In the circumstances, whilst in paragraph 31 the Hearing Officer did not explicitly identify

Magazine's core business, I think that she did consider that it included publishing services, and based that approach upon the Court judgments.

28. The Hearing Officer's reasoning is not set out in any detail in paragraph 32, but Show did not complain that it could not follow her reasoning. In my judgment, by seeking to apply "the logic of the court decisions" she plainly intended to protect Magazine from encroachment by Show into its core business, whilst allowing Show to use the mark in relation to goods/services within its existing sphere of business. She did not specify that she took the view that the goods and services opposed by Magazine (set out at paragraph 8 above) all fell within Magazine's core business. Most of the goods and services self-evidently are core to Magazine's business. Mr Krause took issue with "goods made of paper and cardboard" and pamphlets in Class 16. However, the limitation which Show proposed to "goods made of paper and cardboard" indicates that the term includes publications such as magazines, so it is a distinction without a difference, whilst pamphlets seem to me hard to distinguish from magazines. It seems likely that the Hearing Officer's view was that all of those goods and services fell within Magazine's core business. Her approach was to identify a sub-set of the contested goods and services in relation to which Show had made honest concurrent use of the IDEAL HOME name, reject the opposition for that sub-set of goods and services, and uphold it for the rest.
29. In my view, the Hearing Officer was entitled to take the approach that she did in seeking to reflect both parties' established use of the IDEAL HOME/IDEAL HOME SHOW names. I agree with Magazine that no error of law or principle has been identified by Show in relation to this aspect of the decision. I reject the appeal in relation to the '171 mark.
30. As for the appeal in relation to the '681 mark, IDEAL HOME, again, the Grounds of Appeal say that the Hearing Officer was wrong, but no detail is pleaded as to the manner in which she erred. At the hearing, Mr Krause submitted that the Hearing Officer had erred in finding that confusion would be exacerbated by Show's use of IDEAL HOME, as she had ignored the significant level of existing confusion and in

ignoring the Court's decisions to the effect that use of IDEAL HOME by Show would not amount to passing off.

31. Mr Alkin referred me to Show's skeleton argument before the Hearing Officer, where it said in relation to the likelihood of confusion

"37 With regard to the IDEAL HOME SHOW mark, the addition of the word SHOW provides an immediate context which of itself would prevent any risk of consumers thinking that this mark might be linked to the business of the magazine."

The skeleton continued:

"38 With regard to the IDEAL HOME mark, because this has no guiding context, consumers will think that any home interest products come from either of the parties and so will be no more confused than they already are.

39 However, in respect of any non-home interest products, the consumers will not be confused because they will not connect this use of the IDEAL HOME mark with [Magazine's] earlier trade marks because, to the extent that they have been used, they have been used in respect of home interest products and services only."

31. Mr Alkin also relied upon paragraphs 54 and 57 of the judgment of Kitchin LJ, which I have set out above. He submitted that it was plain that Show's application for IDEAL HOME *solus* would not simply reflect the existing confusion, but amounted to the use of the name in a different context. As the Court of Appeal had said (whilst not deciding the point) a change of context might result in the actionable deception of a significant number of persons. Hence, he argued, the Hearing Officer had been entitled to conclude that use of this mark in relation to home interest goods and services would result in a greater degree of consumer confusion. As a result, Mr Alkin argued on behalf of Magazine that use by Show of the name IDEAL HOME alone in relation to home interest goods and services would result in passing off, so that the Hearing Officer's decision relation to those goods was correct.

32. Mr Krause relied upon the use by Show of permutations on the Ideal Home name. Historically it had used the name Ideal Home Exhibition and there had also been some use of permutations such as Ideal Home Personal Loan, Ideal Home Shop and Ideal Home Plus, including in relation to a credit card. Mr Krause submitted that this was accepted by the Court as use of IDEAL HOME rather than IDEAL HOME SHOW, so that removal of the word Show was accepted as not increasing the likelihood of confusion. It is right that the judgments describe the parties as having made honest concurrent use of IDEAL HOME, however it is clear from paragraph 54 of the Court of Appeal's judgment that this did not give Show a *carte blanche* to encroach upon Magazine's goodwill, especially as it had been using IDEAL HOME SHOW, not IDEAL HOME. Mr Krause submitted that removing the word Show would not increase the risk of deception because this had already occurred, but it does not seem to me that the somewhat limited evidence of its historic use of names other than IDEAL HOME SHOW proved that was the case. Furthermore, Show itself had acknowledged that adding the word SHOW would prevent a risk of confusion with Magazine.
33. In my judgment, Show has not identified any error in the Hearing Officer's decision in relation to the home interest goods within the '681 specification. It does not seem to me that she can be criticised for having found that confusion was likely to arise if Show started to use IDEAL HOME alone on home interest goods, nor do I accept Show's submission that she erred in ignoring the significant level of existing confusion between the two businesses, as she dealt specifically with that point at paragraph 36.
34. The position in relation to the non-home interest goods identified in paragraph 38 is different. The manner in which the Hearing Officer set out her findings in relation to those goods and services may perhaps leave something to be desired, in particular because the beginning of paragraph 38 rather suggested that she was going to reject the opposition in relation to all of them, but in paragraphs 39 to 41 she went on to uphold the opposition against them. However, her conclusion was consistent with the view she had expressed at paragraph 24 of the decision (relating to one of Magazine's applications): Mr Krause had submitted that the goods and services in issue could coexist even if they were not home interest goods and services because of the fame

of the parties' marks, but the Hearing Officer stated that she did not understand the rationale of the court judgments to go that far.

35. Show submitted that use of IDEAL HOME in relation to goods and services with no connection to either party's business would bring to mind whichever of the parties of was known to an individual consumer, or both parties, and so would not deceive. In addition, it submitted that the Hearing Officer had been wrong to hold that Magazine's goodwill extended as far as to the goods and services listed under paragraph 38 of the decision.
36. The Courts' findings in relation to honest concurrent use are irrelevant to these parts of Show's specification, as neither party had established use of IDEAL HOME in relation to them. That disposes, to my mind, of Show's primary submission that use of the mark on these non-home interest goods and services could not amount to a misrepresentation.
37. In my view, the IPEC and Court of Appeal judgments left unanswered the question of what rights each party might have in respect of non-home interest goods/services. The Hearing Officer was right to approach the matter on the basis of the general law of passing off. She cited the appropriate authorities as to the need (or not) for there to be a common field of activity in order to establish a risk that use of the mark would amount to a misrepresentation, and there was no criticism of her approach from that point of view.
38. The range of goods and services listed under paragraph 38 is wide and at least some of the items are far removed from Magazine's core business. In the circumstances, I accept that the Hearing Officer's conclusion that use of IDEAL HOME would amount to a misrepresentation in relation to all of them is rather surprising. However, surprise at a Hearing Officer's conclusion does not justify interference in this sort of appeal, but it is necessary to identify an error in the Hearing Officer's reasoning. In my view, Show has failed to do that. The factual basis of her findings on this point is set out at paragraph 41 of her decision. It was her view that IDEAL HOME is a household name

and has been so for nearly a century, giving it a very broad penumbra of protection. It does not seem to me that the Hearing Officer can be said to have erred in finding that "IDEAL HOME is so famous that, like *Lego*, lack of similarity between fields of activity matters less." It seems to me that this was a conclusion which it was open to the Hearing Officer to reach, and explains her decision on this point. For these reasons, the appeal also fails on this point.

39. As the appeal has failed, the Respondent is entitled to a contribution towards its costs, based upon the usual scale. I will order the Appellant to pay the Respondent the sum of £1500 in respect of the costs of the appeal, to be paid by 5 PM on Friday, 30 October 2020.

Mr Martin Krause of Haseltine Lake Kempner LLP, appeared for the Appellant.

Mr Thomas Alkin, instructed by **HGF Law LLP**, appeared for the Respondent.

Amanda Michaels
The Appointed Person
15 October 2020