

O-452-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3008392
BY ATTICUS LEGAL (NOMINEES) LTD
TO REGISTER THE SERIES OF TWO TRADE MARKS
EASYVERGE / EASY VERGE
IN CLASS 19
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 400958 BY
PERMAVENT LIMITED**

BACKGROUND

- 1) On 3 June 2013 Atticus Legal (Nominees) Ltd (hereinafter the applicant) applied to register the series of two trade marks EASYVERGE /EASY VERGE in respect of the following goods in Class 19: Non metallic building materials; building materials of plastics material; roofing products; roofing products of plastics material.
- 2) The application was examined and accepted, and subsequently published for opposition purposes on 28 June 2013 in Trade Marks Journal No.2013/026.
- 3) On 30 September 2013 Permavent Ltd filed a notice of opposition. The ground of the opposition is in summary:

The opponent contends that it has used the mark EASY VERGE in relation to “building materials and roofing products” in the UK since February 2009. The opponent claims to have acquired reputation and goodwill under the trade mark EASY VERGE. The opponent states that it has the mark EASY ROOF SYSTEMS registered as a CTM for goods in Classes 6 and 19 and the EASY ROOF SYSTEM includes a range of “EASY” prefixed products, including EASY SLATE, EASY VALLEY, EASY SOAKER, EASY TRAY, EASY SOLAR SYSTEM and EASY VERGE. The opponent contends that this family of marks increases the likelihood of a consumer erroneously associating the applicant’s products with those of the opponent. Such misrepresentation would cause damage to the opponent in terms of loss of sales and or damage to the opponent’s reputation. Use of the mark in suit would amount to passing off and as such the mark in suit offends against Section 5(4)(a) of the Act.

- 4) On 9 December 2013 the applicant filed a counterstatement denying the ground of opposition.
- 5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard but both sides did file written submissions which I shall refer to as and when necessary.

OPPONENT’S EVIDENCE

- 6) The opponent filed a witness statement, dated 28 February 2014, by Stephen Makin the Managing Director of Permavent Ltd a position he has held since the incorporation of the company in 2003. He states that his company specialises in roofing products and that it is a member of the National Federation of Roofing Contractors (NFRC) and Local Authority Building Control (LABC). It also holds a number of certificates in respect of its Permavent Breather Membranes. He states that his company began to use the mark EASY VERGE in respect of a roofing product which provided a continuous dry verge to form a watertight rot-prevention seal under slate roofs. He states that this is but one product which forms part of the EASY ROOF SYSTEM which includes EASY SOAKER, EASY SLATE, EASY RIDGE, EASY VALLEY, PLAIN EASY and EASY TRAY. He

claims that the Easy Verge product was approved as part of the Easy Roof System which was approved by LABC. Mr Makin states that the Easy Verge product is advertised in his company's brochure and on business cards which "are handed out to customers, potential clients and suppliers". Mr Makin claims that his company spends approximately £30,000 per annum on advertising, although he does not specify which mark this relates to or what form the advertising takes. He also states that his company has exhibited the Easy Verge products at numerous trade shows although some of those he lists are undated or after the relevant date. He states that since commencing use in 2009 total sales under the Easy Verge mark amount to £79,141. He states that each unit costs approximately £9, and so the sales amount to approximately 27,627 metres of the product. He also provides the following exhibits:

- SM1: details of trade mark registrations held in respect of all the marks mentioned in paragraph 6 above, with the exception of EASY VERGE.
- SM2: a copy of the LABC certificate which only mentions the Easy Roof System.
- SM3: a copy of an invoice dated July 2009 for a thousand copies of a 16 page magazine. The cost is £665, but no details of what mark is included in the magazine or to whom it was distributed are provided.
- SM4: a copy of the company website which shows the Easy Verge product, however this page is not dated.
- SM5: a copy of a page from the Wayback website. This shows a search for Permavent UK Products and shows use of "easy verge" and "easy soaker". It is dated 7 February 2009.
- SM6: a copy of the latest brochure and business card. I note that the business card only refers to Easy Roof Systems and that the 48 page brochure has no reference to a product called Easy Verge.
- SM7: a copy of what is described as the company's 2009 brochure. The brochure would appear to have been issued by Just Roofing (Leics) Ltd & Supplies, although it has a reference to www.permavent.co.uk and www.easyroofs.co.uk. It mentions the Easy Roof System and in particular Easy Verge. However, no details as to how many brochures were distributed or to whom are provided.
- SM8: a copy of an invoice addressed to Mr Makin, dated February 2009, for 10,000 A4 flyers for Easy Verge at a cost of £274. No details of to whom these were distributed is provided.
- SM9: a copy of a brochure which shows the Easy Roof System including a reference to Easy Verge. This is hand dated as 18 June 2009 and again no details are provided as to the distribution etc of the brochure.

- SM10: a copy of the opponent's entry in the Royal Institute of British Architects (RIBA) product selector directory. This is dated 2012 and shows an entry for "Easy Verge".
- SM11: a sample selection of nine invoices showing sales of Easy Verge by the opponent. These are dated between February 2009 and March 2013 (excluding the invoice dated after the application date). These cover the South West and Midlands of England and total £2,462.
- SM12: a copy of a letter, dated 25 February 2014, by a Mr Ewings of Roofing Supplies (SW) Ltd which states that he has received enquiries where people were looking for the Easy Verge product only to state that the one offered by his company (the opponent's product) was not the product they were seeking.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is under Section 5(4)(a) which reads:

"5. (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

- (a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark."

9) In deciding whether the marks in question offend against this section, I intend to adopt the guidance given by Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 which provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

10) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"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.

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 confusion or deception 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.”

11) The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (AP)

12) First I must determine the date at which the opponent’s claim is to be assessed; this is known as the relevant date. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

40. Paragraph 51 of that judgment and the context in which the decision was made on the facts could therefore be interpreted as saying that events prior to the filing date were irrelevant to whether, at that date, the use of the mark applied for was liable to be prevented for the purpose of Article 8(4) of the CTM Regulation. Indeed, in a recent case before the Registrar, *J Sainsbury plc v. Active: 4Life Ltd* O-393-10 [2011] ETMR 36 it was argued that *Last Minute* had effected a fundamental change in the approach required before the Registrar to the date for assessment in a s.5(4)(a) case. In my view, that would be to read too much into paragraph [51] of *Last Minute* and neither party has advanced that radical argument in this case. If the General Court had meant to say that the relevant authority should take no account of well-established principles of English

law in deciding whether use of a mark could be prevented at the application date, it would have said so in clear terms. It is unlikely that this is what the General Court can have meant in the light of its observation a few paragraphs earlier at [49] that account had to be taken of national case law and judicial authorities. In my judgment, the better interpretation of *Last Minute*, is that the General Court was doing no more than emphasising that, in an Article 8(4) case, the *prima facie* date for determination of the opponent's goodwill was the date of the application. Thus interpreted, the approach of the General Court is no different from that of Floyd J in *Minimax*. However, given the consensus between the parties in this case, which I believe to be correct, that a date prior to the application date is relevant, it is not necessary to express a concluded view on that issue here.

41. There are at least three ways in which such use may have an impact. The underlying principles were summarised by Geoffrey Hobbs QC sitting as the Appointed Person in *Croom's TM* [2005] RPC 2 at [46] (omitting case references):

- (a) The right to protection conferred upon senior users at common law;
- (b) The common law rule that the legitimacy of the junior user's mark in issue must normally be determined as of the date of its inception;
- (c) The potential for co-existence to be permitted in accordance with equitable principles.

42. As to (b), it is well-established in English law in cases going back 30 years that the date for assessing whether a claimant has sufficient goodwill to maintain an action for passing off is the time of the first actual or threatened act of passing off: *J.C. Penney Inc. v. Penneys Ltd.* [1975] FSR 367; *Cadbury-Schweppes Pty Ltd v. The Pub Squash Co. Ltd* [1981] RPC 429 (PC); *Barnsley Brewery Company Ltd. v. RBNB* [1997] FSR 462; *Inter Lotto (UK) Ltd. v. Camelot Group plc* [2003] EWCA Civ 1132 [2004] 1 WLR 955: "date of commencement of the conduct complained of". If there was no right to prevent passing off at that date, ordinarily there will be no right to do so at the later date of application.

43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.'

13) The onus is upon the opponent to show that it has goodwill in its mark. I take note of the comments of Pumfrey J in *South Cone Incorporated v JackBessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* case, in which he said:

“27. There is one major problem in assessing a passing off 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 requirements of the objection itself are considerably more stringent than the enquiry under Section 11 of the 1938 Act (See Smith Hayden (OVAX) (1946) 63 RPC 97 as qualified by BALI [1969] RPC 472). Thus 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 at 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 possibilities that passing off will occur.”

14) I must also keep in mind the comments of Mr Justice Floyd in *Minimax GMBH & Co KG and Chubb Fire Limited* [2008] EWHC 1960 (Pat) in which he says of the above:

“Those observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent’s reputation extends to the goods comprised in the application in the applicant’s specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

15) In considering the issues I note that the opponent’s evidence, whilst substantially uncorroborated, is unchallenged. I take into account the comments of Mr Arnold Q.C (as he was) when acting as the Appointed Person in *Extreme O/161/07* where he commented on the issue of unchallenged evidence and cross examination:

“Unchallenged evidence

33. *Phipson on Evidence* (16th ed) states at paragraph 12-12:

In general a party is required to challenge in cross-examination the evidence of any witness of the opposing party if he wishes to submit to the court that the

evidence should not be accepted on that point. The rule applies in civil cases as it does in criminal. In general the CPR does not alter that position.

This rule [sic] serves the important function of giving the witness the opportunity of explaining any contradiction or alleged problem with his evidence. If a party has decided not to cross-examine on a particular important point, he will be in difficulty in submitting that the evidence should be rejected.

However the rule is not an inflexible one...

34. The authority cited in support of this statement of the law is the decision of the House of Lords in *Browne v Dunn* (1894) 6 R 67. The relevant passages from the speeches are set out in the judgment of Hunt J in *Allied Pastoral Holdings v Federal Commissioner of Taxation* (1983) 44 ALR 607, the material parts of which are quoted in the judgment of the Court of Appeal in *Markem Corp v Zipher Ltd* [2005] EWCA Civ 267, [2005] RPC 31 at [59]-[60].

35. In my judgment the learned editors of *Phillips* are correct to say that the rule is not an inflexible one. There are at least two well-established exceptions to it. The first is that, as the speech of Lord Herschell LC in *Browne v Dunn* makes clear, it may not be necessary to cross-examine on a point if the witness has been given full notice of it before making his statement. As I pointed out in *BRUTT Trade Marks* [2007] RPC 19 at [23], this may be significant in registry proceedings where evidence is given sequentially. The second is that a court is not obliged to accept a witness's evidence in the absence of cross-examination if it is obviously incredible: see *National Westminster Bank plc v Daniel* [1993] 1 WLR 1453.

36. Where, however, evidence is given in a witness statement filed on behalf of a party to registry proceedings which is not obviously incredible and the opposing party has neither given the witness advance notice that his evidence is to be challenged nor challenged his evidence in cross-examination nor adduced evidence to contradict the witness's evidence despite having had the opportunity to do so, then I consider that the rule in *Brown v Dunn* applies and it is not open to the opposing party to invite the tribunal to disbelieve the witness's evidence.

37. Despite this, it is not an uncommon experience to find parties in registry hearings making submissions about such unchallenged evidence which amount to cross-examination of the witness in his absence and an invitation to the hearing officer to disbelieve or discount his evidence. There have been a number of cases in which appeals have been allowed against the decisions of hearing officers who have accepted such submissions. Two recent examples where this appears to have happened which were cited by counsel for the proprietor are *Score Draw Ltd v Finch* [2007] EWHC 462 (Ch), [2007] BusLR 864 and *EINSTEIN Trade Mark (O/068/07)*. Another recent example is *Scholl Ltd's Application (O/199/06)*. I consider that hearing officers should guard themselves against being beguiled by

such submissions (which is not, of course, to say that they should assess evidence uncritically).”

16) In the instant case the evidence is not overly compelling and it could have benefitted from further corroboration. Most of the exhibits are of little evidential value, and I rely only upon the following:

- SM5: This shows the mark EASY VERGE being used on the company website on 7 February 2009.
- SM7: A brochure dated 2009 which was clearly supplied to a third party, Just Roofing (Leics) Ltd & Supplies. Although no details were provided as to how many were issued or to whom, it does show that the brochure did reach a builders merchant.
- SM8: An invoice addressed to Mr Makin dated February 2009 for 10,000 flyers which mention EASY VERGE, although I note that no details are provided as to what happened to these flyers.
- SM10: A copy of the opponent’s entry in the 2012 RIBA product selector directory which shows the mark EASY VERGE.
- SM11: A selection of invoices dated between February 2009 and March 2013 which show sales of EASY VERGE products to customers in the South West and Midlands of England. Although these invoices total only £2,462 they are only a sample.

17) Individually none of these exhibits are determinative. However, they do support what is a cogent narrative from the person who has headed the opponent company since its inception. He states quite clearly that the mark has been used as part of an EASY ROOFING system and that the flyers and brochures were commissioned in order to market the product. He states that since 2009 sales under the EASY VERGE mark have totalled £79,141 and the sample of invoices shows that customers were spread over a reasonably wide geographical area. The applicant contended that because the mark EASY VERGE is part of a family of marks and that prominent use has been made of the EASY ROOF SYSTEMS mark that EASY VERGE would simply be seen as a component part of Easy Roof Systems. Even if this were the case it would not diminish the fact that the mark Easy Verge had been used, albeit under a “house” mark. I also remind myself that this evidence has not been challenged. **I conclude that the opponent has shown that it has goodwill under the mark EASY VERGE in respect of a roofing product.**

18) It is well established that it is not necessary for the parties to a passing-off action to be in the same area of trade or even a related area of trade. The point can be supported by reference to the following passage from Millet L.J.’s judgment in *Harrods Ltd v Harrodian School Ltd* [1996] RPC 697:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in *McCulloch v May* [1948] 65 RPC 58 when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd v John Griffiths Cycle Corporation Ltd* (1898) 15 RPC 105 (cameras and bicycles); *Walter v Ashton* (1902) 2 Ch. 282 (The Times Newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing-off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the *Lego* case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing-off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration.”

19) Also:

“It is not in my opinion sufficient to demonstrate that there must be a connection of some kind between the defendant and the plaintiff, if it is not a connection which would lead the public to suppose that the plaintiff has made himself responsible for the quality of the defendant’s goods or services.”

20) And:

“Passing off is a wrongful invasion of a right of property vested in the plaintiff, but the property which is protected in an action for passing off is not the plaintiff’s proprietary right in the name or get-up which the defendant has misappropriated but the goodwill and reputation of the business which is likely to be harmed by the defendant’s misrepresentations.”

21) I also take into account the comments of Morritt L J in the Court of Appeal in *Neutrogena Corporation and Another. v Golden Limited and Another* [1996] RPC 473, when he said, in effect, that the correct test on the issue of deception or confusion was whether, on the balance of probabilities, a substantial number of members of the public would be misled into purchasing the applicant’s products/goods in the belief that they were economically connected to the opponent’s goods.

22) I further note that in the Court of Appeal in *Marks and Spencer PLC v Interflora*, Lewinson L.J. cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “a substantial number” of the relevant public are deceived, which might not mean that the average consumer is confused. However, as both tests are intended to be partly qualitative measures intended to exclude those who are unusually careful or careless, it is doubtful whether the difference between the legal tests will often result in different outcomes.

23) The opponent’s goodwill under its “EASY VERGE” mark is in respect of “roofing products”. The applicant has, broadly speaking, applied for registration in respect of “building materials and roofing products” under its mark “EASYVERGE / EASY VERGE”. Given the identical nature of the marks and the fact that the goods are also identical or very similar I believe that a substantial number of the relevant public (businesses and the general public), on the balance of probabilities, would be misled into believing that the goods of the applicant are connected to the opponent’s. **Use of the mark in suit on the goods applied for, will lead to misrepresentation**

24) I must now go on to consider if the opponent has suffered, or is likely to suffer, damage as a result of this misrepresentation. Lord Fraser in *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1980] RPC 31 HL, stated that the opponent must show that “he has suffered, or is really likely to suffer, substantial damage to his property in the goodwill”.

25) In a *quia timet* action it is clearly not possible to show that damage has been suffered. In *Draper v Trist and Trisbestos Brake Linings Ltd* 56 RPC 429 Goddard L.J. stated:

“But in passing-off cases, the true basis of the action is that the passing-off by the defendant of his goods as the goods of the plaintiff injures the right of property in the plaintiff, that right of property being his right to the goodwill of his business. The law assumes, or presumes, that if the goodwill of a man’s business has been interfered with by the passing-off of goods, damage results therefrom. He need not wait to show that damage has resulted, he can bring his action as soon as he can prove passing-off; because it is one of the class of cases in which the law presumes that the Plaintiff has suffered damage. It is in fact, I think, in the same category in this respect as an action for libel. We know that for written defamation a plaintiff need prove no actual damage. He proves his defamation. So, with a trader; the law has always been particularly tender to the reputation and goodwill of traders. If a trader is slandered in the way of his business, an action lies without proof of damage.”

26) Consequently in the instant case as the opponent has established a goodwill and shown misrepresentation then damage can be considered as the automatic sequitur and the three elements of the classic trinity of passing-off have been established. **The**

consequence of my findings is that the opposition under Section 5(4) (a) of the Act is successful in relation to roofing products.

CONCLUSION

27) The opponent has been successful in its opposition under Section 5(4)(a). The applicant's specification in Class 19 is "Non metallic building materials; building materials of plastics material; roofing products; roofing products of plastics material". As the opponent has only shown that it has goodwill in roofing products, consideration must be given to whether the applicant's mark can proceed with a reduced specification. In the instant case the opponent's goods are encompassed by each of the terms used in the applicant's specification. It is not therefore possible to blue line parts of the specification in order to overcome the opposition. On 13 June 2014 the Registry wrote to the applicant providing the opponent with the opportunity of providing a "fall-back position in the form of a limited specification, it should make this clear to the Hearing Officer (i.e. a limited specification should not be submitted for the first time at any appeal hearing)". **The applicant chose not to provide a fall back position and so therefore the application in total fails.**

COSTS

28) As the opponent has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side's statement	£200
Expenses	£200
Preparing evidence	£300
Written submissions	£400
TOTAL	£1100

29) I order Atticus Legal (Nominees) Ltd to pay Permavent Limited the sum of £1100. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20th day of October 2014

**George W Salthouse
For the Registrar,
the Comptroller-General**