

In the matter of THE TRADE MARKS ACT 1994

And in the matter of Application No. 3222803

**in the name of JOHN NICHOLAS HEATH to register the following series of Trade
Marks**



in classes 9, 35 and 42

and Opposition thereto no. 409717

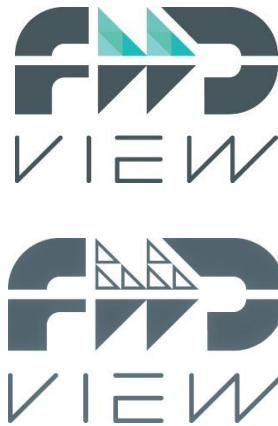
by VALDIMIR PTE LTD

On appeal from the decision of Mr MARTIN BOYLE dated 14 September 2018

DECISION OF THE APPOINTED PERSON

Introduction

1. This is an appeal from the decision of the Hearing Officer, Mr Martin Boyle, rejecting the Opposition brought by the Opponents, Valdimir Pte Limited, against the application of Mr John Nicholas Heath to register a trade mark.
2. The mark is the following series of 2 devices:



3. The application is made for the following goods and services:

Class 9: Software development tools; Software.

Class 35: Business management consulting services in the field of information technology; Consulting services in business organization and management; Business consulting.

Class 42: Information technology [IT] consulting services; Consulting in the field of cloud computing networks and applications; Consulting services relating to computer software; Software development, programming and implementation; Software as a service [SaaS].

4. It was opposed by Valdimir Pte Ltd under s5(2)(b) of the Trade Marks Act based on the following trade mark registrations:

- (1) EUTM 11891108 for the sign:

FWD

- (2) EUTM 12074589 for the sign:

FWD

- (3) EUTM 12074605 for the sign:



5. All 3 registrations cover a very long and wide-ranging list of goods and services, and were not subject to the proof of use conditions contained in section 6A of the Act, their respective registration procedures not having been completed more than five years before the publication of the mark applied for. It is not necessary to go into any detail about the scope of the goods and services for which the Opponent's marks are registered, since it is not in dispute that they can be treated as being identical to all the goods and services which are the subject of the Application in suit.

6. The Hearing Officer carried out his analysis of the likelihood of confusion by reference to just one of the Opponent's marks, namely 12074589 ('589'), considering that it represented the Opponent's 'best case'. He concluded that there was only a low level of visual similarity between 589 and the mark applied for, a medium degree of aural similarity and a low degree of conceptual similarity. The 589 mark had a normal degree of distinctive character, not enhanced by use. The mark applied for contained figurative elements not present in the 589 mark which were both *'skilful and memorable in design'* and played *'an important distinctive role in the overall impression of the opposed mark.'* His global assessment was as follows:

'despite the similarities with the Opponent's mark which I have noted, even taking into account imperfect recollection these striking figurative elements of the opposed mark, together with the omission of the letter W and addition of the word VIEW in Mr Heath's marks, suffice to ensure that the marks will not be mistaken for one another, ie there will be no direct confusion.'

7. Turning to the possibility of indirect confusion, he also considered that despite the common conceptual link to the word 'forward' in the marks, the differences he had identified would also preclude any instinctive reaction by an average consumer that services presented under the two marks were provided by economically linked

undertakings (as opposed simply to one mark simply bringing the other to mind). Accordingly there was no likelihood of indirect confusion.

8. Appearing on behalf of the Opponent on this Appeal, Ms Jacqueline Reid submitted that the Hearing Officer had erred in principle in a number of respects.
9. Her first and second grounds of appeal concerned the Opposition founded on the word mark 11891108 ('the 108 Mark').
10. The first ground was that the Hearing Officer had given no (or no adequate) reasons for failing to carry out a global assessment of the likelihood of confusion based on the 108 Mark. This was, she submitted, relying on authorities such as R. (on the application of Miah) v Independent Police Complaints Commission [2016] EWHC 3310 (Admin) and the speech of Lord Brown in South Bucks District Council and another v Porter (No 2) [2004] 1 WLR 1953, a breach of the requirement of natural justice. Without such reasons, she submitted, the appropriate course was simply to remit the matter back to the Registry for determination of the Opposition based on the 108 Mark.
11. Whilst it is certainly a requirement of natural justice, and part of the right of any litigant to a fair trial under Article 6 of the European Convention on Human Rights, that a tribunal should give reasons for its decision, it is worth remembering that the reasons can be expressed briefly and, in many cases, without elaboration. As Lord Brown said in the South Bucks case at paragraph 36:

The reasons for a decision must be intelligible and they must be adequate. They must enable the reader to understand why the matter was decided as it was and what conclusions were reached on the principal important controversial issues, disclosing how any issue of law or fact was resolved. Reasons can be briefly stated, the degree of particularity required depending entirely on the nature of the issues falling for decision.
12. In the present case, the Hearing Officer did give reasons for his decision to consider only the 589 Mark, albeit briefly expressed. At paragraph 21 of his Decision, he said this:

'The letter combination FWD appears in all the earlier marks, being shown in stylised form in EUTM 12074589 and EUTM 12074605. Both EUTM 12074589 and EUTM 12074605 also contain a figurative element consisting of a simple arrow device pointing right, and which, as I shall discuss further below, can be said to present some aspect of similarity with components of the central figurative element in the upper part of Mr Heath's marks. EUTM 12074605 also contains a further figurative element, in the form of a group of running figures, which has no counterpart in Mr Heath's marks and therefore takes this earlier mark further away from them. For these reasons, I consider that the earlier mark EUTM 12074589 represents the Opponent's best case, and I shall make my comparison of the marks on that basis. I have already made my comparison of goods and services by reference to the specification of EUTM 12074589, noting that neither of the other two earlier marks offers a more advantageous comparison from the Opponent's point of view.

13. In summary, he considered that the triangular arrow pointing to the right which appears in both the device marks including 589 has an element of similarity with the triangular arrows which appear in the mark applied for. This arrow is not present in the 108 mark, so the device marks are closer in appearance to the mark applied for than is the 108 word mark. Of the two device marks, the 589 is the most similar to the mark applied for because it does not have the extra 'running figures' element present in the 605 mark (which has no counterpart in the mark applied for). Since the 589 is the closest in appearance to the mark applied for, it is the Opponent's 'best case' and the Opposition can be dealt with on the basis of that mark alone.

14. I therefore do not consider that the Hearing Officer failed to give reasons for his approach. However, that is not to say that I consider that it was a correct approach to take. Whilst it is understandable and generally desirable for a Hearing Officer to seek to limit the number of points which he has to consider, this has to be done with some care. A decision to exclude some earlier marks from consideration at the outset in a s5 case gives rise to two particular problems:

- (i) The effect of excluding a mark from consideration is there is no reasoned Decision in relation to it. Thus, if the Opposition were to succeed on the

earlier mark which survived the ‘cull’, but this decision is overturned on appeal, the parties are left with no reasoned Decision in relation to the excluded earlier marks. This may not matter if the parties are in agreement that the cases stand or fall together, but there may be no such agreement, and certainly the tribunal cannot know in advance that there will be such agreement. The Respondent can of course file a Respondent’s Notice in relation to those earlier marks, but this puts the Appellate tribunal in a difficult position which may involve having to send the case back to the Registry. That is not fair on litigants who are entitled to have their cases decided efficiently.

- (ii) The other problem is that the decision to cull an earlier mark effectively prejudices the effect of the ‘global assessment’ in relation to that mark. The tribunal is implicitly predicting in advance that a global assessment would produce either the same result as the surviving mark or one which is worse for the Opponent. There are obviously cases in which this may confidently be predicted. Taking the present case, it is hard to see how an opposition based on the 605 mark (which differs from the 589 mark only in the addition of the extra ‘running figures’ element) could ever succeed if one based on the 589 mark failed (absent some extraneous issue such as a different situation on proof of use). However, other cases are less clear-cut, and it is almost inevitable in such a case that an Opponent whose case is rejected on the surviving earlier mark will feel aggrieved and deprived of a fair trial if no actual assessment of the likelihood of confusion has been made based on the other earlier marks.

15. In my view, the right course, even where the tribunal is convinced that one (or more) of the earlier marks cannot produce a better result for the Opponent, is to carry out the global assessment on that mark anyway. It is perfectly acceptable in many cases to deal first with the earlier mark which the Hearing Officer considers presents the best case for the Opponent, and then to turn to the other mark(s) and explain shortly how (if at all) the differences affect the analysis. That way both parties get a reasoned decision on all the marks which have been advanced, whilst repetition is avoided. I do not rule out in principle the idea of ‘culling’ some earlier marks on the basis of procedural efficiency, but any such proposal should be made and dealt with in

advance of the hearing or written determination of the case, so the parties can have a proper opportunity to express their views on the subject.

16. Turning to the present case, Ms Reid's second ground of appeal contends that the Opposition based on the 108 mark should have succeeded, because a global assessment would have resulted in a finding that there was a likelihood of confusion. It is hard to see how this can properly be dealt with by way of appeal, when the Hearing Officer has not actually carried out such a global assessment.
17. Although there are obviously close similarities between the 589 mark dealt with by the Hearing Officer and the 108 mark, there are also notable differences. In particular 108 is a word mark, and therefore covers all ways in which the letters FWD (in that order) are presented. It therefore does not contain certain elements found in the 589 mark which are not present in the mark applied for, such as (i) the triangular arrow within the D, or (ii) the fact that the letters are joined together rather than separate. The visual (and potentially even the conceptual) comparison between the earlier mark and the mark applied for which must take place as part of the global assessment of the likelihood of confusion will not be the same in the case of the 108 mark as it was for the 589 mark. Of course, these matters may make no difference to the ultimate result, but the point is that the process of reasoning to get to that result will not be the same.
18. I thus cannot proceed by treating everything the Hearing Officer said on the 589 mark as if it applied to the 108 mark. The only logical options left which would enable me to decide the appeal on the 108 mark would therefore be:
 - (i) to make assumptions, based on the Hearing Officer's reasoning on the 589 mark, as to what he would have concluded about the similarities and differences between the mark applied for and the 108 mark, and then decide whether that conclusion would have comprised an error of principle or have been plainly wrong.
 - (ii) to decide the case *de novo* as if I were the Hearing Officer.
19. I do not consider that either of these options is remotely acceptable. I therefore must conclude that the only appropriate course in this case on the second ground of appeal is to hold that the Hearing Officer has erred in principle by not carrying out the global

assessment in relation to the 108 mark, and to remit the matter back to the Hearing Officer to provide a reasoned Decision.

20. That leaves the third and fourth grounds of Appeal which relate to the opposition based on the 589 mark. It would be open to me to decide those grounds of Appeal now, but I believe this would be an unsatisfactory course to take. It is better to have the entire decision of the Hearing Officer all before a single Appointed Person at the same time, to ensure consistency in the decision-making process. I will therefore stay the determination of the third and fourth grounds of Appeal pending the Decision of the Hearing Officer on the opposition based on the 108 mark, and the expiry of any period for filing an Appeal against that Decision. If an Appeal is filed by either party against that Decision, then it should be heard together with the third and fourth grounds of appeal preferably by me. If no Appeal is filed, then I should be notified and will then decide the third and fourth grounds of Appeal and all issues of costs without a further hearing.

21. I shall reserve all questions of costs pending final resolution of this Appeal.

IAIN PURVIS QC
The Appointed Person
8 June 2019