

O-235-17

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND IN THE MATTER OF TRADE MARK APPLICATION NO 31084515
BY YOURS CLOTHING LTD

AND IN THE MATTER OF OPPOSITION NO 405200 BY
RHINO RUGBY LTD

ON APPEAL FROM THE DECISIONS OF
MR OLIVER MORRIS DATED 12 AUGUST 2016
AND 9 NOVEMBER 2016

DECISION


1. This is an appeal from two decisions of Mr Oliver Morris, the Hearing Officer for the Registrar. In the first, he upheld in part an opposition by Rhino Rugby Ltd ("the Opponent") to a trade mark application for a series of marks consisting of the words **BADRHINO** and **badrhino**, and in his supplemental decision he upheld the opposition for part of an amended specification for the trade mark. Yours Clothing Ltd, the applicant for the BADRHINO marks ("the Applicant") appeals against both of those decisions.

Background

2. AK Retail Holdings Ltd filed the trade mark application in issue on 13 May 2015. The application was later assigned to the current Applicant. The application was published on 3 July 2015. The specification of goods for which registration was sought was amended soon after the opposition was filed and so the specification considered by the Hearing Officer was:

Class 25: Articles of clothing and headgear; articles of outer clothing; articles of under clothing; nightwear; leisurewear; sportswear; bathing costumes; swimwear; neck ties, scarves; leisure clothing; tee shirts, sweat tops, hooded tops, shorts, jogging bottoms, track suits, jackets, sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.
3. The opposition brought by the Opponent was pursued on the basis of three earlier trade mark rights, all of which were relied upon for an objection pursuant to sub-

section 5(2)(b) of the 1994 Act. The Opponent's UK trade mark No 2535347 was also relied upon for an objection pursuant to sub-section 5(3). The earlier marks were:

<p>UK trade mark No 2471901 RHINO PURE RUGBY</p>	<p>Filed 9 Nov 2007 Registered 30 Sept 2011</p>	<p>Class 18: Rugby products comprising goods of leather and imitation leather, luggage, bags, umbrellas, sports bags, kit bags, ball bags, wallets and purses intended to be sold or purchased for use in connection with the game of rugby Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased for use in connection with the game of rugby. Class 28: Sporting articles and equipment; physical training equipment and apparatus; rugby training equipment including scrummage training machines, tackle bags, contact pads, body pads, rucking nets, training poles, grid markers, protective pads and body supports; rugby ground equipment including goal posts, post padding, flags and poles; kicking tees and rugby balls.</p>
<p>UK trade mark No 2535347 RHINO</p>	<p>Filed 24 Dec 2009 Registered 27 July 2012</p>	<p>Class 25: Rugby clothing (but not including footwear) and rugby headgear intended to be sold or purchased in connection with the game of rugby; none of the aforementioned relating to the rugby league football team known as Leeds Rhinos</p>
<p>EUTM No 4622155 </p>	<p>Filed 11 Oct 2005 Registered 14 June 2012</p>	<p>Class 18: Goods of leather and imitation leather; luggage; bags; umbrellas; sports bags; kit bags; ball bags; wallets and purses; all these goods being rugby products. Class 25: Clothing and headgear; all these goods being rugby products.</p>

4. None of the earlier marks was subject to proof of use at the relevant date. However, both sides filed evidence, and the Opponent provided evidence of the use which it had made of its marks in relation to a variety of goods within its specification, especially clothing, as well as prints from the Applicant's website offering clothing and footwear for sale.
5. Both sides were professionally represented throughout the proceedings. A hearing took place before the Hearing Officer. The Applicant was represented by Mr Tim

Austen, who also appeared for it on the appeal. The Opponent was represented by its managing director, Mr Clark, before the hearing officer, but by its trade mark attorney, Mr James Sanderson, on the appeal.

6. In his initial decision, dated 12 August 2016, the Hearing Officer concentrated upon the opposition based upon UK trade mark No 2535347 RHINO (“the ‘347 Mark”), as representing the Opponent’s best case. He found, first of all, that the Opponent had not proved that the ‘347 Mark had a reputation, so its section 5(3) objection failed. His findings in relation to s 5(2)(b) were, in summary, that :
 - a. the use of the word rugby before the words clothing/headgear included in the ‘347 specification must be taken to have some impact upon the specification, but would nevertheless cover a variety of types of goods for playing rugby or rugby training;
 - b. limiting the specification to rugby clothing/headgear did not amount either to a disclaimer or to a limitation of the specification in terms of section 13 of the 1994 Act;
 - c. some but not all of the goods in the Applicant's specification were similar to the goods in the ‘347 specification, to a greater or lesser extent;
 - d. the average consumer was a member of the general public;
 - e. there was some similarity between the parties’ marks: conceptual similarity was reasonably high, and there was a medium degree of aural and visual similarity;
 - f. the ‘347 Mark had a medium degree of inherent distinctive character; so
 - g. there was a likelihood of confusion in relation to some but not all of the Applicant's goods, depending on how similar they were to the Opponent's goods.
7. The Hearing Officer therefore found that the opposition succeeded in part and set out a list of goods for which the application might proceed to registration and a further list for which it was to be refused. See Annex A below. He also invited the Applicant to put forward a revised specification, to identify any specific goods falling within the ambit of the original specification which it would wish to maintain in the specification, based upon the findings which he had made.
8. The Applicant did file a revised specification (see Annex B below) and after taking into account some further submissions by the parties the Hearing Officer issued his supplemental decision dealing with that revised specification, part of which he found to be unobjectionable, and part of which he rejected (see Annex C below).
9. The Applicant appealed both decisions, and I consider that I can summarise the main grounds of appeal thus:

- a. The Hearing Officer was wrong to construe the specification of the '347 Mark as including clothing which was not "by its nature specifically for rugby;"
 - b. The Opponent had voluntarily limited the scope of its mark to rugby clothing (etc) in order to achieve registration of it, and the Hearing Officer ought to have held that the mark was subject to a limitation falling within section 13 of the Act;
 - c. The Hearing Officer wrongly assessed the similarity of some of the parties' goods in both the main and supplemental decisions, so went wrong in assessing the likelihood of confusion, and should have allowed the application to proceed for all (or some) of the goods rejected in both decisions.
10. The Opponent filed a Respondent's notice but did not claim that the Hearing Officer had erred in any way nor, in the event, did it rely upon any grounds for maintaining the decision other than those given by the Hearing Officer in the two decisions under appeal.

Standard of review

11. This appeal is by way of review. The principles applicable on an appeal of this kind were recently considered in detail by Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd* (BL O/017/17) at [14]-[52] and his conclusions were approved by Arnold J in *Apple Inc V Arcadia Trading Limited* [2017] EWHC 440 (Ch).

“(i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR 52.11). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong (Patents Act 1977, CPR 52.11).

(ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar's determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).

(iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B* and others).

(iv) 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).

(v) Situations where the Registrar's decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be 'clearly' or 'plainly' wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar's decision was wrong, should the appeal be allowed (*Re: B*).

(vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson* and others)."

12. Further comments on the nature of an appeal to the Appointed Person were made by Mr Iain Purvis QC in *Rochester* BL O/049/17, and he said at [33]:

"... the reluctance of the Appointed Person to interfere with a decision of a Hearing Officer on likelihood of confusion is quite high for at least the following reasons:

(i) The decision involves the consideration of a large number of factors, whose relative weight is not laid down by law but is a matter of judgment for the tribunal on the particular facts of each case

(ii) The legal test 'likely to cause confusion amongst the average consumer' is inherently imprecise, not least because the average consumer is not a real person.

(iii) The Hearing Officer is an experienced and well-trained tribunal, who deals with far more cases on a day-to-day basis than the Appellate tribunal.

(iv) The legal test involves a prediction as to how the public might react to the presence of two trade marks in ordinary use in trade. Any wise person who has practised in this field will have come to recognize that it is often very difficult to make such a prediction with confidence. ... Any sensible Appellate tribunal will therefore apply a healthy degree of self-doubt to its own opinion on the result of the legal test in any particular case."

13. I have borne these principles in mind on this appeal.

Merits of the appeal

Ground 1: The Hearing Officer was wrong to construe the '347 Mark specification as including clothing which was not "by its nature specifically for rugby."

14. The Applicant's first point was that the specification of "rugby clothing (but not including footwear) and rugby headgear" could only be a valid specification if it referred to types of clothing and headgear specifically designed or adapted for use "in rugby," by which I understood the Applicant to mean "use in playing rugby." It should be confined to the substance of that phrase and would comprise only items identifiable to a specialist consumer as rugby clothing/headgear. Any wider construction of the Opponent's specification would, the Applicant contended, breach the principles laid down in *IP Translator* (set out below). Indeed, the Applicant contended that if there is no category of goods properly identifiable as rugby clothing/headgear, the registration is not valid. However, there had been no challenge to the validity of the Opponent's '347 trade mark, and so it does not seem to me that the Applicant is in a position to suggest that it was not validly registered because the specification is not sufficiently clear. The Hearing Officer had to do his best to construe the specification as it stood and the only question for me is whether the Hearing Officer went wrong in his construction of the specification.

15. In the *IP Translator* case (Case C-307/10, *Chartered Institute of Patent Attorneys v Registrar of Trade Marks*, [2013] R.P.C. 11), the CJEU explained the requirement for a trade mark specification to be clear and precise:

"46 In that connection, it must be recalled that the entry of the mark in a public register has the aim of making it accessible to the competent authorities and to the public, particularly to economic operators (*Sieckmann*, at [49], and Case C-49/02, *Heidelberger Bauchemie GmbH's Trade Mark Application* [2004] E.C.R. I-6129, [2004] E.T.M.R. 99, at [28]).

47 On the one hand, the competent authorities must know with clarity and precision the nature of the signs of which a mark consists in order to be able to fulfil their obligations in relation to the prior examination of applications for registration and the publication and maintenance of an appropriate and precise

register of trade marks (see, by analogy, *Sieckmann*, at [50], and *Heidelberger Bauchemie*, at [29]).

48 On the other hand, economic operators must be able to acquaint themselves, with clarity and precision, with registrations or applications for registration made by their actual or potential competitors, and thus to obtain relevant information about the rights of third parties (*Sieckmann*, at [51], and *Heidelberger Bauchemie* at [30]).

49 Accordingly, Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”

16. In *Youview TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) [2013] E.C.C. 17 Floyd J said:
“12 ... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in *The Chartered Institute of Patent Attorneys (Trade Marks) (IPTRANSLATOR)* (C-307/10) [2012] E.T.M.R 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of “dessert sauce” did not include jam, or because the ordinary and natural description of jam was not “a dessert sauce”. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”
17. In the infringement proceedings which followed Floyd J’s ruling, reported as *Total Ltd v YouView TV Ltd* [2014] EWHC 1963 (Ch), [2015] F.S.R. 7, Sales J commented:
“49 In *IP Translator* the CJEU held that it is implied within the Directive that excessive uncertainty in the specification of goods and services to be covered by a trade mark is a basis on which registration of a trade mark should be refused. Such uncertainty would leave potential competitors unclear what activities they could and could not embark upon, and would produce an unfair anti-competitive “chill” effect in relation to their activities. The CJEU also held that it could not simply be assumed that specification of goods and services using the terminology employed in the Nice classification categories would be sufficiently certain to meet the implied standard.”

On the other hand, Sales J held that the requirement for clarity could not be taken too far:

“57 ... It is to be expected (indeed, is practically inevitable) that most if not all specifications of goods and services will have some element of uncertainty at their

margins, since one is using concepts expressed in short words or formulations to apply to fields of often complex and variable activities.”

18. The Hearing Officer said at paragraphs 26-28 of the main decision:

“26. The opponent’s specification covers rugby clothing and rugby headwear which is intended to be sold or purchased in connection with the game of rugby. I am not sure that the (“in connection with”) qualification adds a terrific amount. More focus should be placed on what is meant by rugby clothing as a term in its own right. Although, what it does not do is to expressly limit the rugby clothing/headgear to goods for playing rugby. Much depends, therefore, on the term itself, rugby clothing/headgear.

27. Simply because the term clothing is used as part of the specification does not mean that the term is a broad one covering all items of clothing. The use of the word rugby before the words clothing/headgear must be taken to have some form of impact. By way of example, denim jeans would not fall within the specification because such garments have nothing to do with rugby. That is so regardless of the opponent’s evidence that it now sells leisure clothing (including items such as chinos). It matters not that what the opponent may have actually sold, what matters is what the specification as registered covers.

28. In terms of what the specification does cover, it would, for obvious reasons, cover rugby shirts and (despite Mr Austin’s reluctance) rugby shorts. It should also be noted that rugby shirts would include both professional items that a rugby player may wear whilst playing the game, but also more casual types of rugby shirt and replica fan shirts. I also consider that the specification would cover items which one may wear whilst rugby training such as tracksuits, hoodies/fleeces and even jackets for cold weather training. Other items would include training t-shirts and even undergarments such as compression/support trunks. In terms of headgear, this would not include items such as scrum caps because such items fall in class 9 not in class 25. However, the terms would cover items that might be used for training, such as beanie style hats. The above may be significantly wider than Mr Austin submitted, but having regard to the case-law, including the comments of Mr Justice Floyd (as he then was) as to fuzziness and imprecision, I consider that this represents a reasonable scope of goods that would be taken by the average consumer encountering such a term. I add that the comments made in the opponent’s letter to the EUIPO does not make me doubt this view. That it considered rugby products to be clear and unambiguous does not equate to an acceptance that the goods are as limited as Mr Austin submitted.” (my emphasis)

19. The Applicant did not contend on the appeal that the Hearing Officer was wrong to include all of those sorts of rugby shirts within the specification, nor did it dispute that rugby shorts are included within the specification. However, it submitted that the Hearing Officer construed the specification in too broad and non-specific a manner,

which led him to reach incorrect conclusions as to the likelihood of confusion. The Applicant contended that the only appropriate construction of the specification was to limit it to clothing/headgear specifically designed or adapted for playing rugby, as otherwise the restriction of the specification to rugby clothing/headgear was meaningless. The Applicant therefore criticised the comment in paragraph 26 that the specification did not *“expressly limit the rugby clothing/headgear to goods for playing rugby,”* suggesting that this was “an extraordinary approach.” The Applicant also criticised the finding that *“the specification would cover items which one may wear whilst rugby training such as tracksuits, hoodies/fleeces and even jackets for cold weather training”* and the Hearing Officer’s view that *“rugby headgear”* would cover headgear that *“might be used for training, such as beanie style hats.”* It submitted that there was no proper line to be drawn between garments which might be worn for rugby training and those which might be worn for football training or for any other sport, and so the Hearing Officer had gone wrong in principle, and construed the specification in an impermissibly wide and “fuzzy” manner.

20. It seems to me that paragraph 26 must be considered in conjunction with paragraphs 27 and 28. In paragraph 27, the Hearing Officer made it clear that he considered that the word “rugby” qualified “clothing/headgear” and must be construed accordingly. He therefore drew a distinction between rugby clothing and casual clothing in general, taking denim jeans as an example of goods falling outside the specification. Then in paragraph 28 he decided that the specification covered clothing/headgear appropriate not just to playing rugby, but also to rugby training. He also decided that the specification would include rugby shirts of all kinds, not only those for playing rugby, but casual rugby shirts and replica shirts, a finding which was not criticised by the Applicant. The uncontested inclusion of casual rugby shirts seems to me to have taken the specification outside the narrow scope suggested by the Applicant, namely clothing/headgear specifically designed or adapted for playing rugby.
21. The Applicant submitted that the Hearing Officer had approached the construction of the specification back to front, by looking at the goods to which it had to be compared in the Applicant’s own specification. In particular, it suggested that the Hearing Officer would not have suggested that the Opponent's specification included jackets save for the fact that the Applicant's specification also included jackets. It also complained that the Hearing Officer took a subjective a view of rugby clothing, based on his own experience.
22. I can see no justification for these criticisms of the decision. It appears from the decision itself that the Hearing Officer kept in mind the need to construe the specification as precisely as possible, without unnaturally straining its language. He had cited the appropriate case-law and its impact specifically in paragraph 28. It seems

to me that there was no error of principle in his approach. In my judgment the Hearing Officer was taking permissible judicial notice of the sorts of clothing which might be worn whilst playing or training for rugby, and in my view he was entitled to find that both sorts of clothing (if there is any real difference between them) fell within the specification. He plainly thought that this could include garments properly described as jackets, as well as more casual tops, such as tracksuit tops, and I do not consider that this can be said to be incorrect. In addition, nothing in the decision suggests to me that he made that finding because (and only because) the Applicant's specification also included jackets.

23. The Applicant submitted that the Hearing Officer's error was demonstrated by the comments he made at paragraph 37 of the main decision about ties:

"37. A neck tie has little connection with rugby other than that they can be embroidered with a rugby club logo for the purpose of, for example, wearing at club events. Ties are, instead, generally sold as an item of formalwear and, thus, are quite different in nature and purpose to rugby clothing/headgear."

The Applicant submitted that this showed an inconsistent approach by the Hearing Officer, because neckties would frequently be worn by rugby players at, for example, a club dinner. It seems to me, on the contrary, that this finding was wholly consistent with construing the specification as including clothing/headgear designed to be worn when playing or training to play rugby. The possibility that a tie might bear a rugby club's insignia or colours would not bring it within the specification, because it would not be worn when playing or training for rugby.

24. For all these reasons, I dismiss this ground of appeal.

Ground 2 The Opponent had voluntarily limited the scope of its mark to rugby clothing (etc) in order to achieve registration of it, and the Hearing Officer ought to have held that the mark was subject to a limitation falling within section 13 of the Act

25. Mr Austen submitted that two Court of Appeal decision which I discuss below, *Nestlé* and *Phones4U*, show that a limitation restricts the protection offered to a mark, so that if the Opponent's mark was subject to a limitation, the opposition would fail. The specification of the Opponent's mark was changed prior to its registration from the specification originally sought, for clothing in general, to "rugby clothing" and it was submitted that this amounted to a limitation within the meaning of s 13.

26. The Applicant had raised the same point at the hearing below. The Hearing Officer considered it at paragraphs 31-32 of the main decision, saying:

"31. The reason why Mr Austin submits that all things are not equal relates to the limitation the opponent made to its specification in order to dispose of the oppositions that had been lodged against it. He submitted that i) that action

results in the opponent having limited the rights conferred by the registration and, ii) the applicant having limited its specification away from rugby products means that the opponent is estopped from opposing its application. I firstly observe that these arguments were made for the first time at the hearing before me (albeit foreshadowed in Mr Austin's skeleton argument). A defence on such a basis should have been pleaded upfront as opposed to ambushing the opponent at the hearing. This is reason enough to dismiss the submission. However, even if it were considered, there are further problems.

Section 13 of the Act reads:

"13. - (1) An applicant for registration of a trade mark, or the proprietor of a registered trade mark, may;

(a) disclaim any right to the exclusive use of any specified element of the trade mark, or

(b) agree that the rights conferred by the registration shall be subject to a specified territorial or other limitation;

and where the registration of a trade mark is subject to a disclaimer or limitation, the rights conferred by section 9 (rights conferred by registered trade mark) are restricted accordingly.

(2) Provision shall be made by rules as to the publication and entry in the register of a disclaimer or limitation."

32. The opponent has clearly not entered a disclaimer in relation to its earlier mark. In relation to whether it has "agree[d] that the rights conferred by [its] registration shall be subject to a specified territorial or other limitation", it has clearly not. Put simply, the opponent has simply narrowed the scope of its goods in negotiation with a third party in order to amicably settle an opposition. It has in no way agreed to limited the rights that are conferred upon its now registered mark, rights which include the ability to take action against marks with similar (as opposed to identical) goods. Neither can this create any form of estoppel with the world as whole. Whether any form of estoppel arises with the third party with whom an agreement was reached is not a matter for these proceedings. The submissions made by Mr Austin in this regard are rejected."

27. I agree with the Hearing Officer that this is not the sort of point properly raised only in a skeleton argument or at the hearing. Parties to proceedings in the IPO are obliged to set out their position in their statements of case in sufficient detail to enable the opposing party to know the case they have to meet (see e.g. *Coffeemix* [1998] RPC 717). A party ought not to be taken by surprise by a potentially significant point of this kind. Nevertheless, I too will consider the merits of the argument.
28. The Applicant relied upon the decision of the Court of Appeal in *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2006] EWCA Civ 244; [2007] R.P.C. 5, which it said showed

that a trade mark registered with a limitation of this kind provided its proprietor with commensurately restricted protection. In that case, Jacob LJ was considering the impact of a mark being described as limited to 3 particular colours. He said:

“62 So what does the language of the limitation mean? As I have said [the Claimant] contends it is part of the description of the mark, that what it means is merely that the mark is registered in the colours shown. Miss Lane [for the Defendant] submits that the language positively restricts the rights given by registration.

...

66 Miss Lane submitted that the words “the mark is limited” are hardly those of description. More apt would be “the mark is red white and blue.” But one does not need to say that: it is self-evident. ...

67 Finally Miss Lane submits that it is permissible to have regard to the pre-registration correspondence, not to raise an estoppel but merely to confirm that there was an agreement within the meaning of s.13(1) with the result that the proprietor's rights “are restricted accordingly.”

68 I have concluded that Miss Lane is right. My first reason is simply conventional—one does not normally hold that language (here the whole sentence) is redundant if there is a permissible alternative meaning. And there is another, Miss Lane's.

69 Secondly, the word “limitation” or its verb “limit” is found in the Act in the context of s.13. It is also in Art.6 of the Directive and s.11. In these contexts it means a restriction on rights or effects. There is no statutory context of use of “limit” or “limitation” as defining a mark. So it is likely that in a post-1994 registration the words have the same meaning in an actual registration as they do in the governing legislation.

70 Thirdly, the informed reader would know the context provided by the Act and Rules. So he would know that the register is to contain any particulars of a limitation of rights. On seeing the word “limited” he would be alert for a limitation of rights. If he had any doubt as to whether there was one he would have cause to go to the pre-registration correspondence—was there, he would ask, a s.13(1) agreement? If he went, he would find that the mark was applied for (without evidence of distinctiveness through use) as a series of two marks, the logo in colour, and in black and white (meaning all colours). The Office objected to the black and white version saying it was “insufficiently distinctive” but in a telephone conversation confirmed by letter (April 15, 1999) offered acceptance on the basis of a colour limitation. In a letter of confirmation agents said the decision was accepted with reluctance and asked for the colour version to proceed. In the circumstances it is clear that Caudwell were accepting a limitation within the meaning of s.13. This is perhaps emphasised by the fact that in relation to another

mark referred to in the same Office letter, the Office clearly drew a contrast between “a colour claim (as opposed to a colour limitation).”

71 As to the permissibility of using the correspondence with the Office, it is the general rule that one does not go to the prosecution history of a monopoly to determine its extent. Thus in the context of patents Lord Hoffmann in *Kirin-Amgen Inc v Hoechst Marion Roussel Ltd* [2005] R.P.C. 9 at [35] said:

“The courts of the UK, the Netherlands and Germany certainly discourage, if they do not actually prohibit, use of the patent office file in aid of construction. There are good reasons: the meaning of the patent should not change according to whether or not the person skilled in the art has access to the file and in any case life is too short for the limited assistance which it can provide.”

72 But the position is different in the case of a limitation under s.13. For there one asks whether the trade mark owner has agreed to a limitation. Clearly what is contemplated is some sort of agreement with the Office—which I think could result either from an original agreement in the application at the outset or as the result of a limitation proposed during prosecution. So in that narrow context one can reasonably expect to look at the prosecution history to see whether there was an agreement.”

29. Jacob LJ referred to new guidance which was to be adopted by the UKIPO in relation to disclaimers and limitations in the light of the *Nestlé* case (reported at [2005] RPC 5) which had also raised issues about s 13. Nestlé had applied to register a mark which was graphically represented in a black and white photograph with the description “This mark consists of the three-dimensional shape represented above.” The shape was that of a POLO mint, but without the word “POLO” embossed on it. No particular colour or size was claimed in the application. The appeal turned on the construction and application of sections 13 and 39, which provides “The applicant may at any time withdraw his application or restrict the goods or services covered by the application.” The issue identified by Mummery LJ was whether it was legitimate to allow Nestlé to amend its application by adding detailed limitations as to colour (white) and size, and so to register a mark which differed from the sign visually represented and verbally described in its initial application. The short answer was that it was not. Mummery LJ said of section 13:

“32 A requirement that the elements of colour and size should be included in the mark in order to make it distinctive and therefore registrable, does not, in our judgment, fall within the provisions of s.13(1) that the applicant “may agree that the rights conferred by the registration shall be subject to a specified limitation.” The required inclusion of the colour and size elements is not a specified limitation on “the rights conferred by the registration” of the mark identified in the application. The requirements of colour and size do not limit “the rights”, which could have been acquired on registration without including them. The

requirements relate to the inclusion of essential ingredients in the content of the mark in order to make it distinctive, thus satisfying the requirements for registration of the mark and thereby obtaining the rights conferred by it.

33 It is important to keep in mind that the “rights conferred by the registration”—which, under s.13(1)(b), an applicant may agree shall “be subject to a specified territorial or other limitation”—are rights conferred by s.9(1) and which would otherwise be infringed by use within s.10 of the Act. An applicant who agrees that the rights conferred by registration shall be subject to a limitation is agreeing, in effect, that the use of the mark outside the limitation is not to be treated as an infringement of the mark notwithstanding that such use would, otherwise, fall within s.10 of the Act. That is not at all the same thing as incorporating limitations in the description of the mark itself.”

The Court of Appeal concluded that Nestlé was seeking to achieve an amendment to the description of the mark which it had applied to register. If that was permitted by s.39 of the Act, it would be unnecessary to rely on s.13; if the amendment was not permitted by s.39, that section could not be circumvented by recourse to s.13.

30. Mr Austen also took me to the decision of Mr Richard Arnold QC (as he then was) sitting as the Appointed Person in BL O/435/05 *Merlin*, because he described the words in a specification “but not including the provision of venture capital” as “a disclaimer.” *Merlin* was decided between *Nestlé* and *Phones4U*. The case did not turn upon section 13, but related to the issue of how to apply the ruling in *Postkantoor* that “the Directive prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic.” Describing goods as “rugby clothing” would not infringe that requirement as it attributes a positive characteristic to the goods. I do not consider that this helps in terms of deciding whether or not the Opponent's specification should be construed as being subject to a limitation within the meaning of section 13.

31. Following *Nestlé*, guidance as to the use of section 13 was issued on 25 May 2006 as PAN 13/06. The terms of the Notice have since been incorporated into the UKIPO's Manual of Trade Mark Practice and provide:

“Disclaimers and Limitations (Wording of)

It is clear from the wording of section 13 of the Act that the entry of a disclaimer or limitation is voluntary and may be made prior to, or post, registration. However, there are two conditions which must be met.

Firstly, the volunteered disclaimer or limitation must either disclaim any right to the exclusive use of a specified element of the trade mark, or it must limit the rights conferred by registration. The use of a limitation to add in elements of the trade mark that were absent at the outset is not a limitation of the rights conferred

by registration, and is not therefore permissible. See *Nestlé SA Trade Mark Application* [2004] EWCA Civ 1008.

Secondly, the disclaimer or limitation should be worded in such a way as to make it tolerably clear to third parties what its effect is. Accordingly, whilst the registrar cannot and will not insist on standard wording for disclaimers and limitations, he has an inherent power to require clarification of the wording of a proposed disclaimer or Trade Marks Manual limitation which leaves room for serious doubt as to the effect of the voluntary disclaimer or limitation of rights.

It is suggested that limitations take the form “The rights conferred by the registration of this mark are limited [description of limitation].” And that disclaimers take the form “Registration of this mark shall give no right to the exclusive use of [description of element(s) of trade mark to be disclaimed].”

32. The Opponent's specification plainly does not include a limitation in the form anticipated by the Notice, even though the Notice had been issued well over a year before it filed its trade mark application in November 2007, and several years before its mark was eventually registered in September 2011. Should it nevertheless be regarded as a limitation within the meaning of section 13? Mr Austen contended that it could and that the fact that a limitation was not in the form suggested by the Registry would not make it any less a limitation for the purposes of section 13.
33. I do not accept Mr Austen's submissions on this point. First, it seems to me that the common process of narrowing down the specification of a trade mark application in order to avoid a clash with third party rights is very different from the process described by Jacob LJ in *Phones4U* as “some sort of agreement with the Office,” made during the “prosecution” of the application. To my mind, what Jacob LJ had in mind was that any section 13 limitation would be made prior to the acceptance of an application for publication, rather than in the course of opposition proceedings. That seems to me to be reflected in the terms of the Notice/Manual. Whether or not my analysis is correct (Mr Austen contended that “prosecution” of a trade mark application continued through to the end of opposition proceedings) it seems to me that the Opponent's specification is not expressed in terms which can properly be construed as or, most importantly, would be seen as, a limitation. Nothing in the specification amounts to the “alert” mentioned by Jacob LJ which is reflected in the IPO's guidance above.
34. If the Opponent's trade mark application had been made from the outset just for “rugby clothing,” Mr Austen accepted that the specification would not have been subject to the limitation which he submitted applies to the Opponent's specification. This would lead to the difficulty that two identical specifications for “rugby clothing” would not have an identical scope of protection. The difference would not be apparent

on the face of the Register; someone consulting the Register would not see any limitation or “alert” on the face of either registration. The significant difference between them would become apparent only by working through the history of both trade mark applications, but there would be no reason to look behind the registration to see if there was any such hidden limitation. In my judgment, that cannot be right. I consider that it would be contrary to principle for a specification to have some hidden meaning or limitation. That is why the UKIPO requires a disclaimer or limitation to be apparent on the face of the Register.

35. All that happened in this case was that the Opponent's specification of goods was narrowed from that applied for at the outset. I do not consider that changing the specification from "clothing and headgear" to "rugby clothing" and "rugby headgear" means that the mark was subject to a limitation within the meaning of section 13.
36. For these reasons, I reject the submission that the Opponent's specification contains a limitation and I reject this Ground of Appeal.

Ground 3: The Hearing Officer wrongly assessed the similarity of some of the parties' goods in both the main and supplemental decisions, so went wrong in assessing the likelihood of confusion, and should have allowed the application to proceed for all of the goods rejected in both decisions.

37. The Applicant's submissions as to the scope of the specification were tied in with its submissions as to the relevant average consumer of the Opponent's goods, and the trade channels through which the goods would be sold. It submitted that the Hearing Officer had erred in finding that there was some similarity between the parties' respective goods in terms of their average consumers and in an overlap of trade channels.
38. The Hearing Officer considered the question of the similarity between the parties' goods in paragraphs 34-49 of the main decision. He considered, in particular, how likely it was that particular groups of goods might be sold in the same shops, whether specialist rugby shops or sports retailers, or in the same areas of a general clothing retailer or department store. Mr Austen submitted that the specialist goods in the Opponent's specification would be sold to specialist, well-informed consumers, purchasing goods in specialist rugby shops. That submission depended to a large extent upon the success of Ground 1 of the appeal, as to the proper scope of the specification. However, even if I had accepted that the specification should have been restricted to goods designed for playing rugby, I would not have accepted those additional submissions. I do not accept that the Opponent's goods (even if construed in the narrowest way) would only be sold in specialist shops nor do I consider that the

exclusion from the Applicant's specification of "rugby" goods means that at most there would be a low level of similarity between them. In my judgment, the Hearing Officer approached the analysis of the average consumer and relevant channels of trade in a satisfactory manner. Bearing in mind the considerations articulated by Mr Purvis QC in *Rochester* (see above) I do not consider that there is any error here which is susceptible to an appeal.

39. The Applicant's final and relatively subsidiary point was to submit that even if all other Grounds of Appeal failed, the Hearing Officer had gone wrong in his analysis of the likelihood of confusion in relation to certain goods ("the Remaining Goods") within the Applicant's specification. In particular, it disputed the Hearing Officer's conclusions as to jackets, knitted button front cardigans, leather jackets, denim jackets, chino shorts, sun hats, beach hats, rain hats, and fashion hats. The Applicant submitted that the categories of goods found acceptable (that is, those as to which the Hearing Officer found no likelihood of confusion) could not properly be distinguished from the Remaining Goods, and that the level of similarity of the Remaining Goods to the Opponent's goods was far too low to lead to a likelihood of confusion.
40. Jackets were dealt with in paragraph 44 of the main decision. The Hearing Officer considered that jackets could share many of the characteristics of a jacket worn for "rugby or other sporting purposes" so that the goods would be similar to a reasonably high degree, despite the channels of trade being less similar. I think it a matter of some concern given the restricted scope of the Opponent's specification that the Hearing Officer referred to a jacket worn for "other sporting purposes" but on balance I do not consider that there is an error in the Hearing Officer's conclusion such that I should set it aside on appeal. The Applicant applied in its amended specification to register the mark for leather jackets and denim jackets. The Hearing Officer dealt with this in paragraph 16 of the supplementary decision. He accepted that such goods would be unlikely to be worn for sporting purposes but thought that they were sufficiently similar to jackets which might be worn for "cold weather training" (by which I assume he means rugby training in weather cold enough to require a jacket) for the same conclusion to apply. Again, on balance I do not consider that there is an error in the Hearing Officer's conclusion such that I should set it aside on appeal.
41. "Knitted button front cardigans" which were included in the amended specification were dealt with by the Hearing Officer at paragraph 12 of the supplementary decision. He thought that they had a medium degree of similarity to hoodies or sweatshirts which would fall within the Opponent's specification, so found a likelihood of confusion. I do not think this conclusion is based on an error making it susceptible to appeal.

42. In paragraph 79 of the main decision, where the Hearing Officer indicated that he would permit the Applicant to put forward an amended specification, he said "For the record, I would place chinos, denim jeans and trousers in the same camp as the goods for which I found no likelihood of confusion." The amended specification therefore listed trousers, chinos, trousers for formal wear, denim jeans, trouser shorts, chino shorts and denim shorts. The Hearing Officer held at paragraph 13 of the supplementary decision that trousers, chinos, trousers for formal wear and denim jeans would be acceptable, but at paragraph 40 held that there was a likelihood of confusion in relation to trouser shorts, chino shorts and denim shorts. That was because in paragraph 39 of the main decision he had held that there was a likelihood of confusion between "shorts" within the Applicant's original specification and the rugby shorts which would be included within the Opponent's specification, partly because he thought that the goods were similar in nature, but also because of the likelihood that the channels of trade would overlap. The Applicant said on the appeal that there was no real distinction between chino trousers and chino shorts, and it was illogical for the Hearing Officer to find one. I have some sympathy for that submission. However, the Hearing Officer explained the distinction which he drew between the trousers and these shorts and his conclusions were in line with his view, expressed at various points in the main decision, that there would be a likelihood of confusion in relation to goods which could be properly be described as casual clothing. It seems that he took the view that more formal trousers could be distinguished from the intrinsically casual shorts. In those circumstances, I reject the appeal in relation to these goods too.
43. The last category of the Remaining Goods consists of sun hats, beach hats and rain hats. Here, too, the Applicant suggested that the Hearing Officer had drawn illogical distinctions between different kinds of headwear. In paragraph 17 of the supplementary decision he had permitted the registration of flat caps, top hats, fedoras, pork pie hats, trilbies, and fur hats yet he refused registration of sun hats, beach hats, rain hats, and fashion hats. It does seem to me that there is a lack of reasoning in paragraph 18 of the supplementary decision, where the Hearing Officer deals with sun hats, beach hats, and rain hats. It seems that he accepted a submission made on behalf of the Opponent, but he does not explain what it was or why it was correct. Nevertheless, it seems to me that his conclusion about sun hats, beach hats and rain hats follows his overall approach of excluding goods which could be properly be described as casual clothing. All of these sorts of headwear are likely to be casual and whilst the level of similarity to rugby headgear appears to me to be low, on balance I do not feel that there is so clear an error that I should overturn the Hearing Officer's conclusion.

44. The Hearing Officer's objection to fashion hats was that he found the term inherently vague - he thought that the word "fashion" added nothing to hats. I agree. In the circumstances, I am not minded to revisit the Hearing Officer's conclusion on this term.
45. In circumstances, the appeal fails. It is appropriate for the Applicant to make a contribution towards the Opponent's costs. I will order the Applicant to pay the Opponent the sum of £1000 in respect of the appeal, such sum to be paid together with the sum of £250 ordered to be paid by the Hearing Officer by 5 pm on Tuesday 30th May 2017.

Amanda Michaels
The Appointed Person
15th May 2017

MR. TIMOTHY AUSTEN of counsel instructed by Urquhart-Dykes & Lord appeared for the Appellant

MR. JAMES SANDERSON of Sanderson & Co. appeared for the Respondent

ANNEX A

Main decision

Goods for which opposition succeeded:

Articles of clothing and headgear; articles of outer clothing; articles of under clothing; leisurewear; sportswear; leisure clothing; tee shirts, sweat tops, hooded tops, shorts, jogging bottoms, track suits, jackets, sports tops; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

Goods which could proceed to registration:

Nightwear; bathing costumes; swimwear; neck ties, scarves; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby

ANNEX B

Applicant's revised specification

Long sleeved button front shirts; short sleeved button front shirts; formal shirts; formal long sleeve button front shirts; formal short sleeved button front shirts; button front aloha shirts; denim button front shirts; shirts for suits; knitted button front cardigans; trousers; trouser shorts; chinos; chino shorts; trousers for formal wear; denim jeans; denim shorts; swim shorts; leather jackets; denim jackets; nightwear; bathing costumes; swimwear; neck ties, scarves; flat caps; top hats; fedoras, porkpie hats, trilbies, sun hats, beach hats, rain hats, fur hats, fashion hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby

ANNEX C

Supplemental decision

Goods for which opposition succeeded:

Long sleeved button front shirts; short sleeved button front shirts; button front aloha shirts; denim button front shirts; shirts for suits; knitted button front cardigans; trouser shorts; chino shorts; denim shorts; leather jackets; denim jackets; sun hats, beach hats, rain hats, fashion hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby.

Goods which could proceed to registration:

Formal shirts; formal long sleeve button front shirts; formal short sleeved button front shirts; trousers; chinos; trousers for formal wear; denim jeans; swim shorts; nightwear; bathing costumes; swimwear; neck ties, scarves; flat caps; top hats; fedoras, porkpie hats, trilbies, fur hats; none of the aforesaid being rugby products nor intended to be sold or purchased in connection with the game of rugby