

TRADE MARKS ACT 1994

**IN THE MATTER OF
TRADE MARK APPLICATIONS Nos. 3139254, 3139258 & 3139259
IN THE NAME OF WALMART APOLLO LLC**

**AND OPPOSITIONS Nos. 406281, 406282 & 406283 THERETO
BY TAILOR & CUTTER (CAMBRIDGE) LIMITED**

**AND IN THE MATTER OF
TRADE MARK APPLICATION No. 3122696
IN THE NAME OF TAILOR & CUTTER (CAMBRIDGE) LIMITED**

**AND OPPOSITION No. 407960 THERETO
BY WALMART APOLLO LLC**

**AND IN THE MATTER OF
TRADE MARK REGISTRATIONS Nos. 3003551 & 3003552
IN THE NAME OF WALMART APOLLO LLC**

**AND INVALIDATIONS Nos. 501557 & 501558 THEREOF
BY ANDREW CAMPBELL JACKSON, TAILOR & CUTTER LIMITED AND
TAILOR & CUTTER (CAMBRIDGE) LIMITED**

**AND IN THE MATTER OF
AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANTS FOR INVALIDATION
AGAINST A DECISION OF MR MARK KING DATED 22 MAY 2018**

DECISION

Introduction

1. This appeal is in the following consolidated proceedings, listed in order of time of filing:
 - (1) Oppositions numbers 406281 – 3 filed by Tailor & Cutter (Cambridge) Limited (“T&C”) on 18 March 2016 against Applications numbers 3139254, 3139258 and 3139259 all filed on 4 December 2015 standing in the name of Walmart Apollo, LLC (“Walmart”) to register the word trade mark TAILOR & CUTTER and 2 x series of TAILOR & CUTTER figurative trade marks in Class 25. The oppositions were based under Section 5(1) – (2) of the Trade Marks Act 1994 on T&C’s earlier (then) Application number 3122696 for a series of 2 x trade marks for the words TAILOR & CUTTER and TAILOR AND CUTTER in Classes 14 and 25. They were also based on T&C’s

claimed earlier unregistered rights in TAILOR & CUTTER under Section 5(4)(a) of the Act.

- (2) Opposition number 407960 filed by Walmart on 25 November 2016 against Application number 3122696 filed on 17 August 2015 by T&C for a series of 2 x trade marks for the words TAILOR & CUTTER and TAILOR AND CUTTER in Classes 14 and 25. The opposition was based *inter alia* under Section 5(1) – (2) on Walmart’s earlier trade mark number 3003551 for the words TAILOR & CUTTER in Class 25.
 - (3) Invalidity Applications numbers 501557 and 501558 by joint applicants Andrew Campbell Jackson, Tailor & Cutter Limited and T&C (“joint T&C applicants”) filed on 8 February 2017 to invalidate Walmart’s Registrations numbers 3003551 TAILOR & CUTTER (relied on in (2) to oppose T&C’s Application number 3122696 in turn relied on in (1) to oppose Walmart’s Applications numbers 3139254, 3139258 and 3139259) and 3003552 TAILOR & CUTTER For the discerning gentleman figurative under Section 47(2) and Section 5(4)(a) of the Act on the basis of the joint T&C applicants’ claimed unregistered rights in the names and marks TAILOR & CUTTER and TAILOR AND CUTTER.
2. As will be appreciated from the above, and as was acknowledged by the Registrar and the parties, the pivotal action in these consolidated proceedings was action (3) – Applications numbers 501557 and 501558 to declare invalid Walmart’s earlier TAILOR & CUTTER trade marks numbered 3003551 and 3003552 (particularly the former) for TAILOR & CUTTER and TAILOR & CUTTER For the discerning gentleman figurative in Class 25 under Sections 47(2) and 5(4)(a) of the Act.
 3. It is against Mark King’s decision, acting for the Registrar, dated 22 May 2018, BL O/312/18, entirely to dismiss the invalidation that the joint T&C applicants now appeal.

Section 47(2) and Section 5(4)(a)

4. Section 47(2) and Section 5(4)(a) relevantly provided:

“47. –

(2) The registration of a trade mark may be declared invalid on the ground-

[...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied ...

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 ...”

5. The Statement of Grounds of invalidity claimed goodwill and reputation in the marks TAILOR & CUTTER and TAILOR AND CUTTER through use of those marks throughout the UK since 1997: “in respect of clothing, suits, shirts, jackets, tuxedos, jewellery, fashion accessories, tailoring services and retail services related to clothing, suits, shirts, jackets, tuxedos, jewellery and fashion accessories”. By reason of that goodwill and reputation the adoption by Walmart of trade marks numbers 3003551 and 3003552 was said to constitute a misrepresentation which was causing confusion with the joint T&C applicants’ earlier unregistered rights and damage to the joint T&C applicants’ goodwill.
6. The evidence adduced by the joint T&C applicants in support of their cases was described by the Hearing Officer at paragraphs 4 – 36 of the decision.
7. It was not suggested that the Hearing Officer misdescribed or omitted from his description (as opposed to failing to take into account or giving sufficient weight to) any of the joint T&C applicants’ evidence.
8. That evidence comprised in the main a Witness Statement of Andrew Jackson dated 6 June 2017, in summary:
 - 1) stating that he was the sole director of a number of companies which together with himself as sole trader had since 1997 operated a business(es) under the mark TAILOR & CUTTER throughout the UK for: “high quality bespoke tailoring services, high quality bespoke-tailored clothing, including suits, shirts, jackets and tuxedos, jewellery, fashion accessories, and associated retail services”. A list of these companies was provided together with incorporation, change of name, dissolution details and extracts of the databases held at Companies House (Exhibit AJ1);
 - 2) giving turnover figures under the mark TAILOR & CUTTER for the years 2003 – 2014 inclusive with a total turnover for these years of £1,499,295¹. Mr Jackson asserted that he had sold over £1.75m worth of TAILOR & CUTTER branded garments to date;
 - 3) providing in support at²:
 - AJ2, a copy NatWest Bank, Peterborough Branch paying in slip in the name of Mr AC Jackson trading as Tailor & Cutter. The slip was undated but left a space for inserting the date that read “... 19”. That said the joint T&C applicants indicated that it derived from the late 1990s;

¹ Mr Jackson stated that he provided tuition services for trainee tailors for a period prior to December 2005 accounting for around 1% of the total turnover but otherwise the figures related predominantly to the sale of tailored clothing.

² The Hearing Officer reproduced in his decision representative examples of the photographs and ads exhibited by Mr. Jackson.

- AJ3, Whois reports for the domain names www.tailorandcutter.co.uk³ and www.tailorandcutter.com registered/created in 1999, noting that the registrant was T&C;
- AJ4, historic webpages (in the period 2004 – 2014) from the WayBackMachine Internet Archive for the Tailor & Cutter website. As the Hearing Officer noted the majority of the web pages included the heading TAILOR & CUTTER within or above a picture and several read:

“Bespoke Tailoring

Tailor & Cutter are pleased to offer a full range of personal tailoring services for Gentlemen. Our Bespoke Tailoring Workshop is able to create beautiful Suits, Jackets, Tuxedos and Overcoats individually tailored to your requirements.

We are also able to offer a world renown shirt making service and a large selection of gentlemen’s accessories.”

- AJ5, copy invoices from Ringhart Fabrics London addressed to “Tailor & Cutter” (1 for each of the years 1999, 2003, 2005, 2007 and 2012) for what would seem to be relatively small amounts of cotton fabrics;
- AJ6, rent invoices for premises in Cambridge made out to Andrew Jackson (2007), Andrew Jackson, Tailor & Cutter (2010) and T&C (2012);
- AJ7, tenant testimonials for Andrew Jackson Tailor & Cutter dated 2006;
- AJ8, photographs of the joint T&C applicants’ shop premises in Cambridge and Stamford with TAILOR & CUTTER and next to or below that BESPOKE TAILORS written on the shop fascia boards or windows (said to have been taken in 2009, 2010, 2012 and 2013)⁴;
- AJ9, sign writer invoices (2003, 2007, 2009) addressed to Tailor & Cutter;
- AJ10 and AJ11, Yellow Pages ads for Cambridge and Peterborough (2000 – 2015, Cambridge, 1997 – 2015, Peterborough). All but the earliest one of these were headed first line TAILOR & CUTTER, second line BESPOKE TAILORS & SHIRT MAKERS and featured a picture of 2 men in frock coats and top hats brandishing walking sticks.

³ In 2 such examples of the heading appearing within a picture, the words “BESPOKE TAILORS AND SHIRTMAKERS” appeared immediately underneath the heading.

⁴ The 2009 photograph shows TAILOR & CUTTER with BESPOKE TAILORS & SHIRT MAKERS written next to it on the fascia board above the shop front.

- AJ12, Yell copy invoice for advertising in 2003/04 made out to “TAILOR & CUTTER BESPOKE TAIL” and advertising proof request for the above mentioned ad dated 18 January 2013;
 - AJ13, Leaflet that Mr Jackson said derived from the period of trading 1997 – 2006. A copy of the front cover of this leaflet also appeared in the historic web pages exhibited at AJ4. Mr Jackson added that: “Advertising letters, leaflets and so on were and are in the main used in direct mailouts. They are also handed out in the shops.”, but no distribution details were given;
 - AJ14, copy ad appearing in Stamford Living, October 2006. The ad is again headed TAILOR & CUTTER, Bespoke Tailors & Shirt Makers with pictures of a men’s coat surrounded by men’s jackets on dummy models. There is an accompanying copy invoice from the magazine publishers indicating that the ad was also run in the October 2006 issues of Rutland & Market Harborough Living and Nene Valley Living;
 - AJ15, undated copy compliments slips (with and without terms and conditions) and headed notepaper the former carrying the legend Tailor & Cutter, Bespoke Tailors and Shirt Makers;
 - AJ16, undated photographs of TAILOR & CUTTER labels in a jacket and shirt collars and in cufflinks boxes the latter said to pre- and postdate 2012 with different colour linings. Mr Jackson stated that: “... for jackets the labels go in the pockets. Not every customer chooses to have a pocket label, but most jackets would include one.”;
 - AJ17, undated fitting/finishing sheet to be used to take a customer’s measurements/instructions headed “Tailor & cutter”;
 - AJ18, redacted customer location list said by Mr Jackson to include representative examples from manual customer records dating back to 1997;
- 4) exhibiting at AJ19 copy Google print outs of Asda’s GEORGE Tailor & Cutter men’s garments and claiming customer/public confusion therewith as evidenced by calls logged at AJ20, and copy emails at AJ21 and 22 received by the joint T&C applicants between April – September 2015;
9. The joint T&C applicants’ evidence also included witness statements from representatives of 3 of the joint T&C applicants’ cloth/menswear accessories suppliers each stating their belief that TAILOR & CUTTER was distinctive of the joint T&C applicants.
10. On the other hand, Walmart adduced evidence *inter alia* going to the alleged descriptiveness of the terms “tailor” and “cutter” separately and conjoined including a UK Government apprenticeship standard for a “bespoke tailor and cutter” first published 21 August 2015.

Hearing Officer's decision

11. The Hearing Officer held, in brief:

- (1) The relevant date for assessing the invalidity claim under Section 47(2) and Section 5(4)(a) was the date of the filing of Registrations numbers 3003551 and 3003552, which was 25 April 2013 (para. 66).
- (2) A summary of the 5(4)(a) objection was that the joint T&C applicants claimed at the relevant date to have owned goodwill in a business operating under the term "TAILOR & CUTTER" by virtue its use throughout the UK since 1997 for clothing, suits, shirts, jackets, tuxedos, jewellery, fashion accessories, tailoring services and retail services relating to clothing, suits, shirts, jackets, tuxedos, jewellery and fashion accessories (para. 67).
- (3) The legal elements of passing off were stated in *Discount Outlet v. Feel Good UK* [2017] EWHC 1400 IPEC at paragraphs 55 – 56 and Halsbury's Laws of England, Vol. 97A (2012 reissue) paragraph 309 (paras. 63 – 64).
- (4) The Hearing Officer was prepared to accept (in the absence of formal transfers) that the joint T&C applicants were entitled jointly to rely on any goodwill owned by the joint T&C applicants individually at the relevant date (paras. 70 - 76).
- (5) The crux of the dispute was: "Is use of the term Tailor and Cutter by [the joint T&C applicants] in relation to a tailoring business capable of accruing goodwill which could give rise to deception amongst a significant number of the relevant public which could lead to damage" (para. 77).
- (6) The Hearing Officer noted the following from case law *inter alia* referred to him by the parties (paras. 78 – 82):
 - 1) difficulties inherent in establishing actionable goodwill and reputation vis à vis essentially descriptive trading names (*Diageo North America Inc. v. Intercontinental Brands* [2010] EWCA Civ 920, para. 24, *Office Cleaning Services Ltd v. Westminster Window & General Cleaners Ltd* [1946] 63 RPC 39, p. 43, *McCain International v. Country Fair Foods* [1981] RPC 69);
 - 2) small reputation and goodwill can suffice in order to succeed in an action for passing off (*MULTISYS TRADE MARK* [2012] RPC 14, *Stannard v. Reay* [1967] FSR 140, *Redwood Tree Services Ltd v. Apsey* [2011] EWPC 14);
 - 3) distinctiveness for the purposes of trade mark registration was not the same concept as descriptiveness in the present context (*Phones 4U Ltd v. Phone 4U.co.uk Internet Ltd* [2006] EWCA 244, para. 34).

(7) Regarding the crucial issues (paras. 83 – 93, without footnotes):

“83. In the present case, the evidence clearly shows that the words ‘TAILOR & CUTTER’ as being used descriptively of tailoring and cutting services. Mr St Quinton argues that the unusual juxtaposition of the words ‘TAILOR’ and ‘CUTTER’ result in it being distinctive for the services in question. As evidenced above, the dictionary definitions of the words ‘TAILOR’ and ‘CUTTER’ mean ‘a person who makes, repairs or alters outer garments, esp. menswear’ and ‘a person or thing that cuts esp. ‘a person who cuts cloth for clothing’ respectively. I do not accept that juxtaposing ‘TAILOR’ and ‘CUTTER’ makes the combination unusual or adds anything which could be considered fanciful. In fact, the evidence shows numerous examples of ‘TAILOR & CUTTER’ being used in combination to describe a person that is, or a business which provides, a tailor and cutter. For example, the extract from the tailoring company Davies and Son refers to one of its team members, Mr Bennett, as a ‘master tailor and cutter’. Further, the Government apprenticeship advertisement refers to ‘Bespoke Tailors and Cutters’ and the extract from the tailors Malcolm Plews describe him as a ‘veritable master tailor and cutter’. All of these are examples of TAILOR AND CUTTER being used in a descriptive manner for tailoring. It is true that some of these references postdate the relevant date. However, tailor and cutter are long established terms the meaning of which is not likely to have changed for many years.

84. At this point it is important to note that one is assessing whether ‘TAILOR & CUTTER’ was distinctive of Mr Jackson and the joint applicants business at the relevant date. Simply operating a shop under a name which describes the type of trade carried on in the shop is not enough to show the name has acquired a distinctive character. In principle, it is no different to operating a fruit and veg’ shop under the name ‘Greengrocer’. No amount of such use would make the mark distinctive. Instead, customers are likely to rely on the name of the merchant to identify the business. The fact that there are far fewer tailor and cutters than greengrocers makes no difference to this.

85. Mr St Quinton argues that since the telephone numbers have remained the same then this is an indication of a continued business. There isn’t any doubt that a business existed. Though this business is best described as being modest in scale providing a very limited number of (mainly) suits. As stated in the Oven Chips case, use of descriptive signs places a greater burden on the applicant for invalidity than that for an inherently distinctive sign.

86. Mr St Quinton argues that the instances of confusion clearly show that ‘Tailor and Cutter’ are perceived as a brand and distinctive of a business. I shall address the instances of confusion later in this decision. However, I do not agree that they support the term ‘Tailor and Cutter’ as being distinctive of Mr Jackson and the joint applicants’

tailoring services. The consumers concerned became aware of Tailor and Cutter shirts and ties only after they purchased such goods from an Asda's supermarket.

87. Mr St Quinton argues that the evidence filed by Wal-Mart, which is aimed at demonstrating 'Tailor & Cutter' is descriptive, in fact does the opposite. The premise of this argument is that Mr Brierley clearly carried out a global search of databases which include reference to the term 'tailor and cutter' but none of the hits were a) recent and b) in the UK. For example, exhibit APB4 to Mr Brierley's witness statement makes reference to the Tailor and Cutter magazine which ceased publication from 1971 and many exhibits originate from Australia and America.

88. The dictionary definitions for the word 'TAILOR' is 'a person who makes, repairs or alters outer garments, esp. menswear' and 'CUTTER' is defined as 'a person or thing that cuts esp. a person who cuts cloth for clothing'. Therefore, applying the dictionary definition of the words does make them descriptive of a person who would cut and then make clothing. The dictionary definitions of words do provide their literal meanings, however this is not the test. The test is the perception of the sign by the relevant public and whether use of such a sign has made it distinctive of the applicant, i.e. that it has developed a secondary meaning. Having considered the evidence, I find the evidence provided does not sufficiently demonstrate that it has overcome the more difficult task of establishing sufficient reputation and goodwill to show that the term TAILOR & CUTTER had become distinctive of Mr Jackson and the joint applicants' business. As stated by Mr Purvis, when you calculate the turnover to the cost of an individual suit, this is (at best) one suit per week. The advertising material submitted by Mr Jackson and T&C joint applicants is little more than Yellow pages advertisements and a limited number of brochures. The evidence does not overcome the burden placed upon Mr Jackson and T&C joint applicants, either individually or collectively, to show that TAILOR & CUTTER had become distinctive of their tailoring business. It seems to sit squarely in the scenario outlined in the *Oven Chips* decision whereby if a trader decides to use descriptive words as its trade name then some risk of confusion will occur.

89. In this instance, it appears to me that it is simply a case of a business using a name which is wholly descriptive of tailoring services and then being left in the consequential position of not being able to prevent others for using the same sign.

90. Since I have concluded that the applicant has failed to establish that TAILOR & CUTTER was distinctive of any goodwill that existed at the relevant date, the passing off case has fallen at the first hurdle and the section 5(4)(a) claim fails. Ordinarily I am not required to consider misrepresentation. However, if I am found to be wrong and

there is a protectable goodwill in TAILOR & CUTTER for tailoring services, I would have inevitably have found there to be misrepresentation which is likely to have resulted in damage to the goodwill. The section 5(4)(a) claim would then have succeeded.

Is there anything in the get up that would make it distinguishable to the applicant or that it has developed a secondary meaning?

91. Mr St Quinton argued that the term cutter may be known amongst aficionados of very high-end Saville Row tailoring, but generally it is not a well known term and therefore the unusual juxtaposition of Tailor and Cutter has distinguishing capabilities. I do not accept this argument. Whilst many consumers may not know the precise role of a cutter it is clear that when used alongside tailor, its ordinary meaning would be that they also cut the cloth, i.e. the cutter.

Instances of confusion

92. Exhibits AJ21 and AJ22 to Mr Jackson's witness statement are examples of what he claims to be instances of deception. Further, he provides a log of incidents whereby members of the public have mistakenly believed that there was a connection between his companies and Asda.

93. With regard to the email instances of confusion, I do not consider these to be of assistance. Whilst I accept the veracity of the emails, I am not persuaded that even if goodwill had existed, a substantial number of the relevant class of consumers would be deceived. I consider the first email from Mr Wilson to be an instance of confusion which will occur only amongst a very few consumers. With regard to the second email, since Mr Edwards was observing that 'Asda have a brand of Tailor & Cutter...this is not good for you or your brand', he was not deceived that they originate from the same undertaking. The same rationale can be applied to many of the 'incidents' that Mr Jackson refers to at exhibit AJ20 since many are sarcastic remarks.

OUTCOME

94. The opposition under Section 5(4)(a) claim fails."

12. I will mention the Hearing Officer's other findings in relation to the consolidated proceedings shortly:
 - (i) Had the joint T&C applicants succeeded in their objection under Section 5(4)(a), any protectable goodwill would have been limited to bespoke tailoring services. The Hearing Officer would have accepted Walmart's fall-back position to amend their specification in Class 25 to exclude bespoke clothing in order to overcome the invalidations (paras. 95 – 96).

- (ii) Walmart's opposition number 40760 against T&C's Application number 3122696 for the series TAILOR & CUTTER and TAILOR AND CUTTER (proceeding 2) succeeded under Section 5(1) in respect of T&C's goods in Class 25, and partly under Section 5(2)(a) in respect of T&C's goods in Class 14 except for: *Jewellery; bracelets, chains, pendants, brooches; buckles; watches, clocks, parts and fittings for watches and clocks including watchstraps; key rings, key holders made of precious metals*. Walmart's Section 3(1)(b), (c) and (d) objections failed in respect of those remaining goods (paras. 97 – 122).
- (iii) T&C's oppositions numbers 406281 – 3 against Walmart's Applications numbers 3139254, 3139258 and 3139259 for TAILOR & CUTTER and 2 x series of TAILOR & CUTTER figurative trade marks in Class 25 (proceeding 1) failed: under Section 5(2)(b) because the remaining goods in T&C's Registration number 3122696 were dissimilar; under Section 5(4)(a) because T&C had failed to prove the necessary goodwill.
- (iv) Costs in the sum of £700 would be awarded to Walmart which had enjoyed a larger degree of success overall.

The appeal

13. On 19 June 2018, the joint T&C applicants filed Notice of appeal to the Appointed Person under Section 76 of the Act against the Hearing Officer's decision. As indicated, the bulk of the appeal was directed at the Hearing Officer's rejection of the joint T&C applicants' invalidation actions under Section 47(2) and Section 5(4)(a) (proceeding 3). It is said that the Hearing Officer mis-evaluated the evidence in several respects in particular in relation to clothing and should have held that the joint T&C applicants had established sufficient reputation and goodwill in order to support their Section 5(4)(a) objections. The joint T&C applicants further challenged the Hearing Officer's default decision on Walmart's fall-back position. In the appeal order sought the joint T&C applicants requested that: (1) Walmart's Applications numbers 3139254, 3139258 and 3139259 be refused (proceeding 1); (2) Walmart's Registrations numbers 3003551 and 3003552 be declared invalid (proceeding 3); (3) T&C's Application number 3122696 be allowed to proceed to registration for all the goods specified (proceeding 2); (4) the joint T&C applicants be awarded costs.
14. On 18 July 2018, Walmart filed a Respondent's notice stating that the Hearing Officer's decision should be upheld and/or alternatively that: (i) in the absence of relevant assignments the Hearing Officer should solely have considered T&C's trade; (ii) T&C's Application number 3122696 should have been refused registration in Class 25 under Section 3 in any event.
15. At the appeal hearing, the joint T&C applicants were represented by Mr Thomas St Quintin of Counsel. Mr Michael Silverleaf of Queen's Counsel appeared on behalf of Walmart.

Application to adduce fresh evidence on appeal

16. The Reasons for appeal had contained a bare request to adduce further evidence on appeal: "... to address matters raised for the first time by the Hearing Officer in the Decision, including his assumptions regarding the Appellants' business and tailoring business, and regarding instances of actual confusion".
17. Following my Directions⁵, on 14 January 2019, the joint T&C applicants made a formal application to adduce fresh evidence on appeal comprising a Witness Statement of Andrew Jackson dated 14 January 2019 and Exhibits AJ1 and AJ2. Walmart filed written submissions against the admission of such evidence on 21 January 2019.
18. The applicable general principles governing the admission of fresh evidence on appeal were summarised by Henry Carr J in *Consolidated Developments Limited v. Andrew Alexander Cooper* [2018] EWHC 1727 at paragraph 33:
 - i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;
 - ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;
 - iii) it is useful to have regard to the *Hunt-Wesson* factors;
 - iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;
 - v) the admission of fresh evidence on appeal is the exception and not the rule;
 - vi) the *Gucci* decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and
 - vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence."
19. I refused to allow in the fresh evidence because in my judgment the basic test in *Ladd v. Marshall* [1954] 1 WLR 1489, Denning LJ at paragraph 1491 was not satisfied.
20. First, it was not shown that the evidence could not have been obtained with reasonable diligence for use before the Hearing Officer. The fresh evidence sought to be introduced essentially contained Mr Jackson's ripostes to the Hearing Officer's

⁵ Issued through the Treasury Solicitor's Office on 3 January 2019.

observations and findings and to arguments put forward by Walmart at the hearing. These points could and should have been made by or on behalf of the joint T&C applicants before and/or at the hearing. As Lewison LJ commented in *Fage UK Ltd v. Chobani UK Ltd* [2014] EWCA Civ 5, at paragraph 114: “The trial is not a dress rehearsal. It is the first and last night of the show”. The only “new” evidence put forward was an undated Google print-out showing Asda’s products being offered for sale on eBay and an Advertising Standards Authority decision dated 2008 concerning cutting patterns, the latter clearly being available to put to the Hearing Officer at the correct time.

21. Furthermore, none of this evidence would in my view have an important influence (recognising that this need not be decisive) on the result of the case within the meaning of the second condition of the test in *Ladd v. Marshall*.
22. For the sake of completeness, I accept that the fresh evidence was apparently credible though not incontrovertible as per the third *Ladd v. Marshall* criterion.
23. To conclude on this preliminary issue, the joint T&C applicants’ request to introduce fresh evidence was rejected.

Standard of review

24. The principles applicable on an appeal from the Registrar were summarised by Mr Daniel Alexander QC sitting as the Appointed Person in *TT Education Ltd v Pie Corbett Consultancy Ltd*, BL O/017/17 at paragraph 52:

“(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)."

25. In *Abanka DD v. Abanca Corporación Bancaria SA* [2017] EWHC 2428 (Ch), Mr Alexander sitting as a Deputy High Court Judge added at paragraph 24:

“... the real question, as all the cases say, is whether the decision in question was wrong in principle or was outside the range of views which could reasonably be taken on the facts ...”

26. I have borne the above in mind.

Grounds of appeal

27. The first ground of appeal was that the Hearing Officer allegedly ignored or misrepresented the nature of the joint T&C applicants' trade. The argument ran (para. 23, Appellants' Skeleton Argument):

“Just as a consumer does not go to a premium restaurant to receive chef's services or sommelier services, but instead goes to buy prepared meals and wine, they do not go to the Appellants' business to obtain “tailoring services”. They go instead to buy clothes and accessories. With every transaction, the customer concludes their interaction with the Appellants by taking possession of new goods that they previously did not possess.”

28. The point of this argument insofar as I understood it, was that TAILOR & CUTTER was claimed not to be descriptive of clothes and accessories (in contrast to tailoring services) and therefore the authorities cited by the Hearing Officer as establishing that a heavier burden exists in passing off on those seeking to protect descriptive trading names was not pertinent.

29. I do not accept these arguments. The motivation of customers in seeking out restaurant services on the one hand and tailoring/cutting services on the other hand is a holistic experience of the services and the products (restaurant meal/bespoke clothing) concerned.
30. The Hearing Officer concluded from the evidence, and I agree, that the joint T&C applicants ran a bespoke tailoring business. Of course he accepted that this would result in bespoke clothing including shirts. However, in the absence of a breakdown of the turnover figures, customer invoices etc. the Hearing Officer agreed with Walmart's counsel (not challenged on appeal) that when one calculated the joint T&C applicants' turnover to the cost of a suit stated by Mr Jackson in his evidence that was at best 1 suit per week (decision, para. 88).
31. Regarding the joint T&C applicants' assertion to have sold accessories under the name TAILOR & CUTTER the only evidence provided in support was an undated photograph of cufflink boxes bearing the name TAILOR & CUTTER. Again there were no customer invoices, and no breakdown of sales was given. The only information provided by Mr Jackson was that: "the ones [cufflink boxes] with the purple material were used up until 2012, and the black-and-white ones have been used subsequently".
32. Mr St Quintin sought to argue that in respect of the cufflinks and other items of clothing, jewellery and fashion accessories, the Hearing Officer should have accepted the unchallenged statements by Mr Jackson in his evidence. However, as observed by Mr Daniel Alexander QC sitting as the Appointed Person in *MULTISYS Trade Mark*, BL O/410/11:

"20 ... The Registrar is not obliged to accept - and in some circumstances may be obliged to reject - a conclusory assertion by a witness that it has a given goodwill at the relevant date or that the use by a third party of a similar mark would amount to misrepresentation, when the material relied upon in support does not bear that out.

21. That point was also made by Laddie J in *DIXY FRIED CHICKEN TM* [2003] EWHC 2902 (Ch) and, more recently, in *Williams and Williams v. Canaries Seaschool SLU (CLUB SAIL)* [2010] RPC 32, Geoffrey Hobbs QC, Appointed Person, said at [38]:

"...it is not obligatory to regard the written evidence of any particular witness as sufficient, in the absence of cross-examination, to establish the fact or matter (s)he was seeking to establish."

22. Overall, the adequacy of evidence falls to be assessed by reference to the Lord Mansfield's aphorism from *Blatch v. Archer* (1774) 1 Cowp 63 at 65, cited, inter alia by Lord Bingham in *Fairchild v. Glenhaven Financial Services Ltd* [2002] UKHL 22 [2203] 1 AC 32 and in *CLUB SAIL*: "...all evidence is to be weighed according to the proof which it was in the power of one side to have produced, and in the power of the other to have contradicted."

33. In my judgment, the first ground of appeal is without any substance.

34. The second ground of appeal was that the Hearing Officer erred in ignoring the evidence of consumer contact with the joint T&C applicants. This complaint went to the Hearing Officer's treatment of the joint T&C applicants' evidence of alleged confusion and in particular his rejection of (or failure to accept) the joint T&C applicants' contention that this evidence showed that consumers recognised TAILOR & CUTTER as distinctive *per se*.
35. It seemed to me that the second ground of appeal was merely an extension of the first, in that substantially it represented a further challenge to the Hearing Officer's finding, well justified in my view, that TAILOR & CUTTER was *prima facie* descriptive of bespoke tailoring services.
36. As the Hearing Officer recorded at paragraphs 22 – 28 of his decision, the evidence so relied on consisted of:
- (1) statements by Mr Jackson that on 4 April 2015 he received 3 telephone calls with various requests about Asda clothing sold under the name "Tailor & Cutter", and: "Typically these calls were along the lines of "did we hold a particular stock item?"";
 - (2) exhibited at AJ20, a "log" of incidents occurring between 4 April 2015 and 15 September 2015. Only the bare bones were logged against the days: 9 x stock enquiries, 3 x alterations enquiries, 2 x sarcasms, and 4 x miscellaneous – "Asda sell these", "should he make the cheque out to Asda", "comment about Asda selling Tailor and Cutter", "asked if we were connected to Asda". As Mr Silverleaf observed no record had been made/supplied of what the enquirer/customer had said and in what context;
 - (3) 2 x emails received by the joint T&C applicants. The first (AJ21) from a C. Wilson dated 30 April 2015 concerned purple ties:

"I recently purchased a quantity of purple ties with white spots through George on Asda's on-line. I am trying to purchase some more but cannot find the product on their website. Are you still supplying this item to Asda or can I purchase them directly from you if you are still manufacturing them."
- The Hearing Officer considered this to be an instance of confusion that would only occur amongst a very few customers. Regarding the second email (AJ22) from a P. Edwards dated 29 July 2015 that read: "... Asda have a brand of Tailor & Cutter ... This is not good for you or your brand", the Hearing Officer held that there was no origin confusion, which must be right.
37. Mr St Quintin's criticism was not that the Hearing Officer found this evidence of no assistance to him on the issue of misrepresentation, but that the Hearing Officer failed to accept that these instances of consumer contact showed that the name TAILOR & CUTTER was distinctive *per se*.
38. Linked or tied into that argument were: (a) an attempt by Mr St Quintin to resurrect the joint T&C applicants' assertion, rejected by the Hearing Officer particularly in the

light of Walmart's evidence, that the words TAILOR & CUTTER were an unusual combination, which was not descriptive of tailoring services; and (b) a criticism of the Hearing Officer's analogous reference to operating a fruit and vegetable shop under the sign GREENGROCER.

39. I do not find that there is any substance in the second ground of appeal. First, the Hearing Officer did entertain but did not accept the joint T&C applicants' contention that the evidence described at paragraph 36 above showed that consumers considered that TAILOR & CUTTER was distinctive *per se*. Instead, the Hearing Officer remarked that the consumers concerned became aware of Tailor and Cutter goods only after they purchased the same from Asda. The pertinent assessment as he had previously noted was whether TAILOR & CUTTER had acquired secondary meaning *for the joint T&C applicants' tailoring business* at the relevant date. Second, in my view, the joint T&C applicants were simply asking me to re-evaluate the Hearing Officer's assessment of the intrinsic qualities of TAILOR & CUTTER, which the Hearing Officer had undertaken after a detailed consideration of the evidence before him. Third, I consider the Hearing Officer's "greengrocer" analogy one that was apt and within his entitlement to bring.
40. For the sake of completeness, I accept that there was a mistake in the last sentence of paragraph 93 of the decision in that the Hearing Officer refers to "many" of the logged "incidents" in AJ20 being sarcastic remarks when only 2 were described as sarcasms. However, I think that was likely a misprint, and in any event did not constitute a material error on his part.
41. The third ground of appeal was that the Hearing Officer failed to assess the consumer's perception of the name. That ground again went back to the contention that TAILOR & CUTTER was an unusual combination, was partially dependent on evidence newly sought to be introduced, which I disallowed, and invited me to re-consider the Hearing Officer's evaluation of that term by reference to the evidence which was not my role to do.
42. The fourth ground of appeal was that the Hearing Officer ignored the nature of the joint T&C applicants' actual use. Under this head the joint T&C applicants contended that the Hearing Officer failed critically to analyse the evidence of the joint T&C applicants' uses of TAILOR & CUTTER on: shop fronts and signage; clothes labels; cufflinks boxes; Yellow Pages listings, web pages and leaflets; customer measure sheets and other customer facing materials as described by Mr Jackson in his witness statement (but not evidenced in supporting documentation) which it was said were and would have been understood by customers in a trade mark sense.
43. In my judgment, the joint T&C applicants were once again asking me to rehear the case. After a careful review, I am satisfied that the Hearing Officer's multifactorial assessment of the joint T&C applicants' evidence of use was appropriately critical and, moreover, conducted without error.
44. The fifth ground of appeal was that the Hearing Officer ignored the evidence of the joint T&C applicants' suppliers, who had stated that they believed TAILOR & CUTTER to be distinctive of the joint T&C applicants' business. It is clear that the Hearing Officer had this evidence in mind because he recorded it at paragraphs 30 –

36 of his decision. He did not, however, revisit this evidence in connection with his substantive determination of the Section 5(4)(a) case. That said, it is not necessary for a Hearing Officer expressly to deal with every point that figures in his decision (*REEF Trade Mark* [2002] EWCA Civ para. 29). Moreover, it is well established that the opinion evidence of trade witnesses as to consumer perception carries little, if any, weight (*esure Insurance Limited v. Direct Line Insurance Limited* [[2008] EWCA Civ 842, para. 62).

45. Mr St Quintin made some remaining points that had been covered in the above grounds of appeal. These points related to the incidents of alleged confusion, the Yellow Pages ads and the evidence of customer facing materials, which I saw no need to re-explore.
46. In sum, I consider that the Hearing Officer was within his entitlement to judge that the joint T&C applicants had failed on the evidence to establish sufficient reputation and goodwill in the essentially descriptive term TAILOR & CUTTER to support their Section 47(2)/Section 5(4)(a) invalidity cases. In those circumstances, I find it unnecessary to deal with: (a) the joint T&C applicants' appeal against the Hearing Officer's decision on Walmart's fall-back positions; and/or (b) Walmart's Respondent's notice.

Conclusion and costs

47. For the above reasons, the appeal has not been successful.
48. I will order the joint T&C applicants to pay to Walmart the sum of £1,000 as a contribution towards Walmart's costs of the unsuccessful appeal and application to introduce fresh evidence. This is in addition to the costs in the sum of £700 ordered by the Hearing Officer to be paid by the joint T&C applicants to Walmart in respect of the consolidated proceedings. The total sum of £1,700 is to be paid by the joint T&C applicants to Walmart within 28 days of the date of this decision.

Professor Ruth Annand, 7 May 2019

Mr Thomas St Quintin of Counsel instructed by Maguire Boss appeared for the joint T&C applicants/Appellants

Mr Michael Silverleaf of Queen's Counsel instructed by Appleyard Lees IP LLP appeared for Walmart/Respondent