

TRADE MARKS ACT 1994 AND TRADE MARKS RULES 1994

**IN THE MATTER OF A REQUEST BY
ELI LILLEY & COMPANY
THAT THE REGISTRAR SET ASIDE HIS DECISION IN
REVOCATION PROCEEDINGS NO. 8854
AND CONSIDER PROCEDURAL IRREGULARITIES
ALLEGED TO HAVE OCCURRED PRIOR TO THE ISSUE OF THE DECISION**

AND

**IN THE MATTER OF
THE REGISTRAR'S REFUSAL OF AN EXTENSION OF THE TIME
PRESCRIBED FOR AN APPEAL TO THE APPOINTED PERSON
IN RESPECT OF THE ALLEGED IRREGULARITIES**

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20 **STATEMENT OF GROUNDS**

The Registrar's Decision on the substantive matter in Revocation action No. 8854 issued on 15 May 1997. By a letter dated 15 August 1997 Messrs Page White & Farrer, acting for Eli Lilley, the registered proprietor in the Revocation proceedings No. 8854, claim that irregularities occurred in the question of the procedure for the conduct of revocation proceedings, laid down in the Trade Marks Rules 1994. They therefore ask that the Registrar set aside his Decision dated 15 May 1997 and consider the matter of the alleged irregularities. Alternatively, they seek an extension of time under Rule 62(2) in order to appeal against the alleged procedural irregularities. After due consideration I refused to set aside the decision of the Registrar dated 15 May 1997 and as a consequence I also refused the request for an extension of time to appeal the matter of the irregularities to the Appointed Person.

I am now asked for my written grounds of decision.

35 **BACKGROUND**

Alpha Therapeutic Corporation of California, USA, applied on 2 February 1996 to revoke registration No.973636 in respect of the trade mark "ONCOVIN", standing on the register in the name of Eli Lilley and Company. The Revocation proceedings are numbered 8854.

40 The Form TM26 and Statement of Grounds were served on the Registered Proprietor in accordance with Rule 31(2) on 14 February 1996. A Form TM8 and Counterstatement denying the grounds were duly received on 14 May 1996, together with evidence of use in accordance with the provisions of Rule 31(3). The case proceeded to a formal decision from the papers filed and without recourse to a hearing. The decision, in favour of the applicant for revocation, was issued on 15 May 1997.

50 The Trade Mark Agent acting for the registered proprietor, at that time Baker & McKenzie, requested an extension of time of one month to appeal against the decision of the Registrar and this was granted, with no objection from the applicant for revocation. Trade Mark agents Page White & Farrer then filed a Form TM33 as the new agents for the registered proprietor, along with a further request for an extension of time of one month to consider filing an appeal

5 against the Registrar's decision. The reasons given in the letter dated 1 July 1997 were as follows:

10 "We are informed that an appeal is to be filed to the High Court in these proceedings and in view of the change of agent we respectfully request that a further extension of time of one month be granted to enable us to prepare our papers ie. up to 16 August 1997. A Form TM9 is duly filed. In view of the complexities involved in the appeal procedure, your early indication as to whether this extension can be granted would be appreciated".

15 This further extension of time request, to 16 August 1997, was considered justified in the circumstances and was therefore granted, again there was no objection from the applicant for revocation.

20 In the event the registered proprietor decided to appeal to the Appointed Person, not the High Court, as earlier indicated, and this was received on 15 August 1997 along with a request to adduce further evidence. Also received on 15 August 1997 was a submission in respect of alleged procedural irregularities by the Trade Marks Registry, said to have taken place prior to the issuance of the decision on 15 May 1997. The irregularities alleged are that;

- 25 (i) the Registrar failed to find that the application for revocation had been deemed abandoned pursuant to Rule 13(4), because of the applicant's failure to file evidence under the Trade Mark Rule 13(3); in the alternative
- 30 (ii) the Registrar failed to direct that the application for revocation was not deemed to be abandoned pursuant to Rule 13(4) so as to give Eli Lilley the right to file evidence under Rule 13(5); in the alternative
- 35 (iii) the Registrar implicitly made a direction that the application for revocation was not deemed to be abandoned in its letter dated 29 November 1996 to Baker & McKenzie, the agents for Eli Lilley, yet failed to give the latter the opportunity to file evidence under Rule 13(5); in the alternative
- 40 (iv) the Registrar failed to give Eli Lilley the opportunity to file evidence under Rule 13(5) but instead treated its application to file evidence comprising the Statutory Declarations of James Malpas, Alexander Simpson and Margaret Nicolson as an application to file evidence pursuant to Rule 13(7). Such constituted a procedural irregularity of the Registry which deprived Eli Lilley of an opportunity to provide proper evidence about use of the trade mark and, in particular, evidence supporting its denial that there were not proper reasons
- 45 for non-use of the registered mark for all types of pharmaceutical and veterinary drugs.

Alternatively, a further extension of time was sought for leave to appeal against these alleged procedural irregularities to the Appointed Person. In any event, the Registrar was requested

50 to set aside his decision dated 15 May 1997.

5 **DECISION**

I first of all turn to the request to revisit alleged procedural irregularities.

10 These alleged irregularities occurred during the prescribed stages leading up to a decision on the substantive issues involved in the revocation proceedings. At all the material times the registered proprietor was professionally represented but there was no challenge by them or the registered proprietor about the handling of the case.

15 Further, the registered proprietor, through its professional representatives, did file evidence in the revocation proceedings under the provisions of Rule 31(3). The applicant for revocation filed no evidence in support of their application and though the registered proprietor did through their representative seek leave to file evidence under the provisions of Rule 13(7) this was refused by the Trade Marks Registry because the evidence they sought to file was not considered relevant to the proceedings. In informing their representatives of the Trade Marks
20 Registry's decision, the Registry's officers reminded the registered proprietor's representatives that they had the right to be heard in the matter if they so wished. After a period of one month had elapsed the Trade Marks Registry wrote to the professional representatives saying that in the absence of a response to the earlier letter, and in the absence of a request for a Hearing on that matter, the case would be passed to a Hearing Officer for a decision from the papers, unless a Hearing was sought by them on the substantive issues (the applicant for revocation
25 having already indicated that they would be content to have a decision taken from the papers filed.) Hence the decision of the Registrar's hearing officer, Mr M J Tuck, dated 15 May 1997, was issued.

30 In my view there was ample opportunity for the registered proprietor and their then legal representatives to consider their positions vis à vis the filing of evidence in support of the registration of the trade mark ONCOVIN between the application for revocation (dated 2 February 1996) and the issue of Mr Tuck's decision on 15 May 1997. They had sought leave to file additional evidence, but when this was refused they chose not to pursue the matter. To
35 seek to re-open matters some months after the decision on the substantive matter between the parties has been issued is impractical and may be unfair to the other side in these proceedings. The time for pursuing alleged irregularities is when they occur or within a reasonable timescale thereafter not once the substantive issue has been determined. Therefore, the request to re-open matters in relation to the alleged irregularities was refused.

40 I turn therefore to the request to have the Registrar's decision on the substantive issues set aside. I consider that the Registrar has no powers to set aside his own decision once it has been issued in order to allow consideration of further matter. The Registrar, once he has issued a decision, considers himself to be 'functus officio' and thus any decision issued or
45 order made may be amended only where there appears in the decision a clerical error arising from an accidental slip or omission. This is not such a case. The registered proprietor is seeking not a correction to the decision but to have it set aside. That is not possible, in my view, and Messrs Page White & Farrer, acting for Eli Lilly have not presented any arguments to the contrary.

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5 Therefore, in all the circumstances of this case, the requests by the registered proprietor for;

i) a request that the Registrar's decision in the substantive matter be set aside

ii) consideration of alleged irregularities

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iii) a request for an extension of time to appeal against these alleged irregularities

were refused because the Registrar does not consider he has the power to re-open a decision of his own on appeal from a party concerned, unless directed to do so by a superior tribunal.

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Notice of appeal to the Appointed Person against this decision has already been filed, and all papers will now be brought to the attention of the Treasury Solicitor for consideration by the Appointed Person.

20 **Dated this 26th day of February 1998**

M KNIGHT

For the Registrar

25 **The Comptroller General**