

TRADE MARKS ACT 1994

IN THE MATTER OF an Interlocutory Hearing
in relation to opposition numbers 90569 and 90819
by Halfords Limited against trade mark applications Nos
2232968A and 2260254 in the name of
EMAP Consumer Media Limited.

BACKGROUND

1. Trade mark application 2232968 was filed on 18 May 2000 by EMAP Consumer Media Limited, 1 Lincoln Court, Lincoln Road, Peterborough, Cambs., PE1 2RF. Subsequently this application was divided into two parts. As a result of this division trade mark application 2232968A was accepted and published for opposition purposes on 13 February 2002. On 13 May 2002 Halfords Limited opposed the application. Trade mark application 2260254 was filed on 05 February 2001 by EMAP Consumer Media Limited, 1 Lincoln Court, Lincoln Road, Peterborough, Cambs., PE21 2RF. It was accepted and published for opposition purposes on 08 May 2002. On 11 July 2002 Halfords Limited opposed the application. In respect of both oppositions the details of the marks themselves and the specifications of goods and services applied for are not relevant to this decision and I will not recite them. The grounds of both oppositions were under section 5(2)(b) of the Act. In both oppositions the opponents identified earlier registered trade marks, being UK registrations, of which the opponents said they were the proprietor.

2. In accordance with established practice set out in Tribunal Practice No 4/2000, the registry examined the statement of cases to ensure that they had been adequately particularised and contained no obvious errors or omissions. This examination by the registry takes place prior to formal serving on the applicant but the applicant receives copies of any correspondence.

3. As a result of these examinations the preliminary view of the registry was that both oppositions should be struck out on the basis that no ground of opposition is stated since the opponents do not believe that the earlier trade marks are likely to be confused with the marks applied for in applications 2232968A and 2260254.

4. Further correspondence was received from Wynne-Jones, Lainé & James, the opponents' trade mark attorneys, but the registry maintained its position which resulted in the opponents submitting a request to be heard in respect of both oppositions.

5. The Hearing was held on 14 August 2002. The opponents were represented by Mr Dunlop of Wynne-Jones, Lainé and James. The applicants were not represented at the hearing but Ms Lundbeck of Urquhart-Dykes & Lord, their trade mark attorneys, submitted written submissions in lieu of attendance.

6. At the hearing I gave my decision that, in respect of both oppositions, the Notices of Opposition and the Statements of Case are sufficient to allow both oppositions to proceed. I am now asked to state in writing the reasons for my decision.

THE OPPOSITION

7. In respect of each opposition the opponents submitted identically worded Statements of Case. These are set out below:

1. *“The Opponents are the Proprietors of British Trade Mark Registrations Nos. 2182199 and 2220173 MAX MATS in Class 12 and 27 respectively for mats adapted for cars and mats, matting, car mats respectively. The details of each are enclosed. Both pre-date the Application.*
2. *In an open letter of 3rd April solicitors acting for the Applicants have suggested that the Applicant’s mark and MAX MATS are so close for there to be a likelihood of confusion between identical products bearing the respective marks. The Opponents believe that this suggestion is unfounded and incorrect, but if the Applicants were correct in their contention, the Application should be refused under section 5(2)(b) of the Trade Marks Act 1994.”*

APPLICANTS’ WRITTEN SUBMISSIONS

8. In written submissions dated 12 August 2002 Ms Lundbeck referred me to the Demon Ale case [2000] RPC Mr Geoffrey Hobbs QC acting as the Appointed Person where he said:

“Considerations of justice, fairness, efficiency and economy combine to make it necessary for the pleadings of the parties in registry proceedings to provide a focussed statement of grounds upon which they intend to maintain the Tribunal should or should not do what it has been asked to do.”

9. Ms Lundbeck goes on to accept that in both Statements of Case the opponents make reference to their own registered trade marks which predate both applications. However, she also draws attention to the statement by the opponents that they *“believe that this suggestion is unfounded and incorrect”*. Her submission continues that because the opponents are of the view that they do not believe that the trade marks applied for are in conflict with the earlier rights then they have failed to provide, within the time period allowed under Rule 13(1) of the Trade Marks Rules 2000, focussed Statements of Grounds upon which they intend to maintain the Tribunal (the Trade Marks Registry) should or should not do what it has been asked to do. She submits that the oppositions have not been properly filed and they should both be struck out. Ms Lundbeck contends that it is inappropriate for opposition to be based on the views of the applicants and further submits that because the opponents have failed to provide focussed Statements of Grounds the applicants have not been made aware as to where the complaint lies and that this is contrary to *“considerations of justice, fairness, efficiency and economy”* (Demon Ale).

OPPONENTS’ SUBMISSIONS

10. At the hearing Mr Dunlop expanded on the points raised in the skeleton arguments

submitted on 13th August 2002. Mr Dunlop referred to the Statements of Case which provide details of trade marks registered in the name of the applicants and which pre-date the dates of application. Mr Dunlop states that although the opponents do not believe that the allegation made in a letter dated 3rd April 2002, that there is a likelihood of confusion between the marks, it is for the Registry to decide such an issue. Mr Dunlop criticises the preliminary decision to strike out the oppositions on the basis that no grounds of opposition are stated. It is Mr Dunlop's contention that the Statements of Case contains a specific and clearly identified ground of opposition and satisfies the requirements of Rule 13 of the Trade Marks Rules 2000. Mr Dunlop submitted that the preliminary decision of the Registry to strike out the oppositions is in breach of Article 6(1) of the Human Rights Convention because the opponent is being prevented from having a fair and public hearing by an independent and impartial tribunal established by law.

THE DECISION

11. On 4th October 2000 the Registry issued Tribunal Practice Notice (TPN 4/2000) which introduced new guidelines concerning Statements of case and counter-statements in opposition, revocation and invalidity proceedings before the Registrar of Trade Marks. For ease of reference a copy of this guidance is at Annex A.

12. The essential guidance which emanates from this Notice is that all Statements of Case will be scrutinized prior to their acceptance so as to ensure that they comply with the requirement that they are adequately particularised so that they comply with Section 38(1) and (2) of the Trade Marks Act 1994 and Rules 13(1) and 13(2) of The Trade Marks Rules 2000.

13. Sections 38(1) and (2) of the Trade Marks Act 1994 read as follows:

“38.-(1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition to the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.”

14. Rules 13(1) and (2) of the Trade Marks Rules 2000 read as follows:

“13.-(1) Notice of opposition to the registration of a trade mark shall be filed on Form TM7 within three months of the date on which the application was published under rule 12, and shall include a statement of the grounds of opposition; the registrar shall send a copy of the notice and the statement to the applicants.

(2) Where the opposition is based on an earlier trade mark there shall be included in the notice:

(a) a representation of that mark; and

(b) if registered, the classes in respect of which that mark is registered; and

- (c) the goods and services in respect of which that mark is registered, or if not registered, used; and
- (d) where the earlier mark is defined in section 6(1)(a) and (b),
 - (i) the application and/or registration number(s) of that mark, and
 - (i) except in the case of a mark the subject of an application not yet published, the number of the publication in which it was published.”

15. In respect of these particular proceedings the applicant’s submissions focus on the statement by the opponents that they do not believe that the trade marks in question are so similar that for the goods involved there is any likelihood of confusion in the eyes of the average consumer for such goods. Both oppositions are based on the opponent’s earlier trade marks under Section 5(2)(b) of the act. Furthermore it is clear that in order to comply with the requirements defined by Rules 13(1) and (2) the oppositions must include specific information. It must be determined that the Notices of Opposition and the Statements of Case are sufficient to satisfy these requirements. Having taken account of all of the papers before me and all of the submissions made by both parties I have concluded the following:

- (1) The Statements of Case both contain representations of the earlier trade marks.
- (2) The earlier trade marks are registered trade marks and the Statements of Case provide sufficient information in respect of the classes for which they are registered.
- (3) The earlier trade marks are registered trade marks and the Statements of Case provide sufficient information in respect of the goods for which they are registered.
- (4) The Statements of Case provide details of the registration numbers of the earlier trade marks.

16. In assessing the Notices of Opposition and the Statements of Case filed by the opponents it is my view that the requirements set out in Section 38(1) and (2) of the Act and Rules 13(1) and (2) of the Rules have been satisfied in full. The Notices of Opposition were filed in writing in the prescribed manner and within the prescribed time from the dates of the publication of the applications. The Notices of Opposition both contained Statements of Case and both, in my view, meet in full the requirements set out above. The opponents identified the ground of opposition as being based upon Section 5(2)(b) of the Act. It is implicit in this that the opponents were contending that there exists a likelihood of confusion between the marks of the parties. It is true that the Statements of Grounds attribute this view of the matter to the applicants and expressly distances the opponents from that view. However, there is nothing to prevent an opponent from framing its grounds of opposition in the alternative. I believe that on a fair reading of the Statements of Grounds what the opponents were saying was that:

- a) the applicants’ advisors had assented that there existed a likelihood of confusion between the trade marks of the parties,
- b) the opponents had rejected this but,

c) if they were wrong to do so the opponents' alternative position in this opposition is that the existence of a likelihood of confusion should benefit them because of their earlier trade marks. On that view of the matter the opponents have raised a proper case under Section 5(2)(b) of the Act.

Dated this 20TH day of December 2002.

**A J PIKE
For the Registrar
The Comptroller General**

Annex in paper copy only

ANNEX A