

O-157-03

THE PATENT OFFICE

Room 2
Harmsworth House,
13-15 Bouverie Street,
London EC4Y 8DP.

Friday 4th April 2003

Before:

THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(Mr. M. Knight
(Sitting for the Comptroller-General of Patents etc.))

In the Matter of the Trade Marks Act 1994

and

In the Matter of an Application No. 2277637
in the name of EIDOS INTERACTIVE LTD

and

In the Matter of an Opposition thereto by
MAGNUS FAHLEN under Opposition
No. 80513

(Transcript of the shorthand notes of Marten Walsh Cherer
Ltd., Midway House, 27/29 Cursitor Street, London EC4A 1LT.
Telephone No: 020-7405-5010. Fax No: 020-7405-5026).

MR. J. REDDINGTON (Gouldens) appeared on behalf of the
Applicant.

MR. C. MORCOM QC (instructed by Venner Shipley & Co.)
appeared as counsel on behalf of the Opponent.

DECISION (AS APPROVED)

THE HEARING OFFICER: I have before me a request by the opponents in
opposition number 80513 to amend the pleadings to include section 5(2)(b) in
relation to this opposition, which was filed some time ago. The request to
amend being received less than 24 hours ago.

The applicants for registration resist the amendment. Although there
may not be a need for either side to file evidence in support or defence of this
new ground, there is a reluctance on the part of the opponents to indicate that
they would not be filing evidence, or indeed that they would not be seeking yet
a further amendment to the pleadings by the addition perhaps of a section 3(6)
ground on the basis of bad faith by virtue of a wide specification of goods.

I do not ignore the fact that there is another set of proceedings involving
the parties where the respective positions are reversed which is dependent
upon the outcome of the case here. However, I note from what the parties tell
me today that that opposition seems to be fairly all-embracing and there is a
comprehensive range of grounds of opposition. That being so, it at least gave
the opponent in this case a very clear idea of the way in which the applicants
viewed matters in relation to these particular applications for registration. There
was therefore ample time before yesterday for the opponents to submit any

amendments that they might have wished to make in relation to this opposition.

Mr. Morcom on behalf of the opponents here has drawn my attention to a recent decision of the European Court of Justice which perhaps clarifies the position over the identity of trade marks, although in terms of his submissions he used the words "provides more grey areas." It could be argued therefore that the matter of identity of trade marks is one which, following clarification, requires the opponent to make a request for an amendment. However, that judgment was handed down on 20th March, as was admitted by Mr. Morcom, and again the opponent has had ample time between then and now to make the request for the amendment.

Mr. Morcom said that I did not need evidence to determine matters under section 5(2)(b); it was a jury question and, as has been pointed out, there is ample jurisprudence. Therefore the addition of this additional ground was in some respects a technicality.

Taking account of the submissions made to me, I have decided that I am going to refuse the request to amend the grounds of opposition by the inclusion of a ground based upon section 5(2)(b). It seems to me that it has come very late in the day and does not give the applicants in this case full opportunity to consider their position in relation to the opposition here, and perhaps the related but suspended opposition.

I do not regard the proposed amendment as simply a technical amendment. The position under section 5(1) of the Act is absolute: confusion does not have to be shown. Once one moves into the territory of section 5(2), then there is the possibility of filing evidence in relation, in particular, to the way in which the trade mark has been used, or may be used, in relation to the particular goods and services covered by the application or, in this case, the

applications.

Therefore it seems to me that an adjournment, whilst it may have been possible, was not something that should be entertained in this particular case because of the disadvantage and prejudice to the applicants. Having said that, I believe that we should seek to continue to deal with this opposition on the basis of the grounds already pleaded and move on to the next preliminary point.

(For discussion and decision on the second preliminary point, please see separate transcript)
