

O-224-03

TRADE MARKS ACT 1994

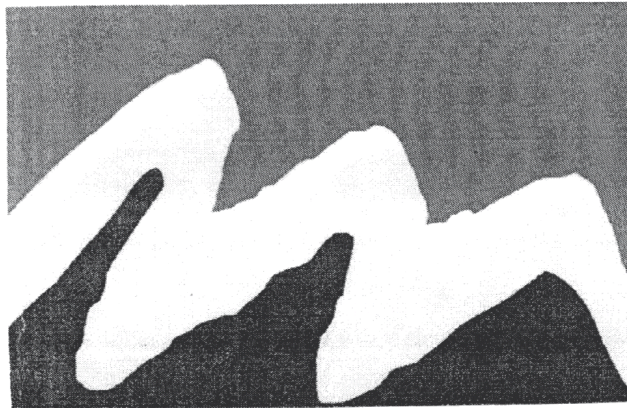
**IN THE MATTER OF AN INTERLOCUTORY HEARING HELD IN RELATION TO
OPPOSITION NO: 70319 BY BOEHRINGER INGELHEIM PHARMA KG TO A
REQUEST TO EXTEND PROTECTION OF INTERNATIONAL TRADE MARK
REGISTRATION No. 694819 IN THE NAME OF DECATHLON TO THE UNITED
KINGDOM**

TRADE MARKS ACT 1994

IN THE MATTER OF an Interlocutory Hearing
held in relation to Opposition No: 70319 by
Boehringer Ingelheim Pharma KG to extend protection of
International trade mark registration No. 694819 in the
name of Decathlon to the United Kingdom

BACKGROUND

1. On 6 March 1998, Decathlon of 4 Boulevard de Mons, Villeneuve, D'Ascq, France, on the basis of a French registration and claiming an international priority date of 22 September 1997, requested protection in the United Kingdom of the following trade mark:



for a range of goods and services in Classes, 1, 3, 5, 8, 9, 11, 16, 18, 20, 21, 22, 25, 27, 28, 29, 30, 32, 36, 38, 39 and 41. For the purposes of this decision a complete list of the goods and services for which protection was sought is not strictly necessary. However, for the sake of completeness a full “case details” appears as an Annex to this decision.

2. The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

3. On 23 June 2000, Boehringer Ingelheim Pharma KG filed notice of opposition to the conferring of protection on this international registration. The opposition is based on Sections 3(6), 5(2)(b) and 5(4)(b) of the Trade Marks Act 1994. I note that in so far as it is relevant, the applicants deny the grounds of opposition. The ground based on Section 5(2)(b) of the Act turns on the similarity or otherwise of the opponents' Community trade mark registration No.

446989 which is registered with effect from 20 January 1997 in respect of a range of goods and services in Classes 5, 9, 16, 41 and 42.

4. I note that these proceedings were subject to an initial cooling off period of three months and that the specification of the United Kingdom designation of the international registration has been amended on two occasions.

5. The parties evidence in these proceedings is as follows:

Evidence in chief:

- a statutory declaration dated 17 September 2001 together with exhibit AJC1 thereto by Alison Jane Cole of Urquhart Dykes & Lord who are the opponents' professional representatives;
- two witness statements from Peter Laurence Barnes of Barlin Associates who are the applicants' professional representatives. For the purposes of this decision, only the first witness statement and exhibit is relevant. The first witness statement is dated 25 June 2002 and attached to it are two exhibits. Exhibit PLB/1 is a copy of a decision of the Danish Patent and Trade Mark Office dated 12 April 2000 together with a copy of the Board of Appeal's decision in the same proceedings dated 23 May 2002; both are accompanied by translations.

6. I note that the dispute which arose in Denmark was between the same parties as the instant opposition, and that the revocation in Denmark was in respect of the same Community trade mark on which the opponents' base their Section 5(2)(b) ground in these proceedings. For the sake of completeness, I note that exhibit PLB2 consists of a copy of the opponents' website (dated 22 May 02) and the second witness statement dated 5 July 2002 is accompanied by exhibit PLB/3 which consists of a copy of the international registration as it appears in colour on the form of application for registration.

7. In response to this evidence, the opponents' filed evidence in reply under the provisions of rule 13(10) of the Trade Marks Rules 2000. This consisted of a witness statement dated 8 October 2002 by the same Alison Jane Cole mentioned above. The relevant parts of the witness statement are reproduced verbatim below:

“1. In his witness statement of 25 June 2002 Peter Laurence Barnes submitted a copy of a decision of the Danish Trade Mark Office concerning the marks in question. The Danish officials decided that the marks in that case were not similar. It is submitted that the marks compared in that case differ to those in question. The applicants' mark was considered in colour and much of the decision focussed on and analysed the relevance of the colours in the mark and in relation to the comparison of the two marks. These are irrelevant considerations to the current case. There is no colour claim

on the applicants' mark in the UK and no evidence of any use other than in the form advertised. As such, the marks are to be compared in black and white. In this respect, I reiterate comments made before, which is that the applicants' mark is simply an extended version of the opponents' mark, akin to a pattern being repeated one and a half times. It should be further noted that the Danish decision made no reference to EU legislation, ECJ or OHIM decisions in comparing marks and as such its applicability to UK matters must be doubted.

2. I submit herewith marked Exhibit AJC2 a copy of a decision of the Portuguese Commercial Court of Lisbon, together with an English translation thereof in which it is confirmed that the mark subject of the international registration "constitutes imitation of the registered trade mark". It would serve no great purpose for the parties to exchange opposing decisions from other EU jurisdictions, especially considering that these are not binding on UK proceedings. However, I would point out that the decision in the Portuguese makes direct reference to Council Directive 89/04 and Council Regulation (EC) No. 40/94 and the reasoning follows directly from ECJ case decisions, all of which are equally applied in the UK. It is submitted that the Danish decision overly dissected the marks view and failed to look at the matter globally. For all of the reasons given above, the Portuguese decision should be followed here, rather than the Danish."

8. In a letter dated 28 October 2002 Barlin Associates commented (*inter alia*) that:

"...There appears to be a preliminary matter to decide with regard to the witness statement aforesaid as the inclusion of exhibit AJC2 is not strictly in reply to the applicants' evidence in these proceedings. The inclusion of the exhibit would appear an attempt to introduce new matter into the proceedings without the applicants being given a proper opportunity to address such matter. We ask that exhibit AJC2 be struck from the witness statement of Alison Jane Cole."

The letter goes on to explain that neither the applicants nor their professional advisers were notified of the Portuguese decision and were not given the opportunity to address the matter before the court. Such an approach is, they say, a violation of Articles 5 and 6 of the Madrid Agreement.

9. In their letter of 9 December 2002, Urquhart Dykes & Lord commented (*inter alia*) that:

"...The inclusion of the decision of the Commercial Court of Lisbon in the exhibit of Alison Jane Cole of 8 October 2002 was in response to the submission of the Danish decision...."

In response to the applicants' claim that they were not notified of the Portuguese decision, the opponents take the view that this is not relevant to the issue in these proceedings.

10. In an official letter dated 24 January 2003, the Trade Marks Registry took the preliminary view that the evidence filed by the opponents was indeed evidence in reply. In particular exhibit AJC2 appeared in their view to be in reply to the witness statement of Mr Barnes and specifically exhibit PLB/1. Having reviewed their position following a further letter from Barlin Associates' dated 28 January 2003, the Trade Marks Registry in an official letter dated 25 February 2003 commented as follows:

“I refer to Messrs Barlin Associates' letter of 28 January 2003, a copy of which I understand you have received. In light of the comments therein the opponents' evidence in reply has been reconsidered and the registrar has now reached the preliminary view that paragraph 2 of the witness statement of Alison Jane Cole and exhibit AJC2 does not constitute evidence in reply and therefore this part of the evidence cannot be admitted. This is because the aforementioned paragraph and exhibit contains new and additional material which does not appear to the registrar to be in reply to the evidence filed by the applicants. It appears that the paragraph and exhibit contain material which could have been introduced when evidence in support of the opposition was submitted.”

11. In a letter dated 5 March 2003 Urquhart Dykes & Lord requested a hearing.

THE INTERLOCUTORY HEARING

12. On 10 April 2003 an interlocutory hearing took place before me to consider the opponents' request mentioned above. At the hearing Ms Alison Cole represented the opponents; the international registration holders were represented by Mr Peter Barnes.

THE SKELETON ARGUMENTS

The opponents' submissions

13. In summary the opponents submissions were:

- that the opponents' evidence i.e. paragraph 2 of the witness statement and exhibit AJC2 thereto were in reply to the Danish decision submitted in the applicants' evidence in chief;
- the evidence was not submitted earlier as the opponents were not and could not have been aware that the applicants would seek to reply on decisions from outside the United Kingdom;
- that it is well known that the United Kingdom Trade Marks Registry are not bound by decision from other legal systems;

- that the registrar may give leave for any party to file further evidence and that it was possible for the registrar to grant the applicants such a period if she felt it was appropriate;
- that the Portuguese decision was a matter of public record and as such could be included in their submissions at a substantive hearing in any event.

The applicants' submissions

14. In summary the applicants' submissions were:

- the document comprising exhibit AJC2 has no bearing on the applicants' evidence and clearly does not constitute matter strictly in reply to the applicants' evidence;
- that the decision of the Portuguese Commercial Court of Lisbon is dated 13 July 2001 and therefore the decision was known to the opponents prior to the filing of their main evidence in these proceedings on 17 September 2001.

THE DECISION FOLLOWING THE INTERLOCUTORY HEARING

15. I communicated my decision in the matter to the parties in a letter dated 11 April 2003, the relevant portion of which is reproduced below:

“Having considered the parties skeleton arguments and having had the benefit of the oral submissions at the Hearing, my decision was that paragraph 2 and exhibit AJC2 of your witness statement dated 8 October 2002 should be struck out as not constituting evidence strictly in reply. As I explained at the Hearing, I reached this decision having applied the established criteria for deciding if evidence is strictly in reply contained in Peckitt's Application [1999] RPC 337 at head note 12 and paragraphs 57-64 and 66.

Having heard submissions on costs, I awarded £200 to the Applicants as a contribution towards their cost in preparing for and attending this Interlocutory Hearing.

At the expiry of this period (and assuming neither party requests written grounds), I will arrange for the Trade Marks Registry to issue an Order for costs on the basis outlined in paragraph 14 of Tribunal Practice Notice 2 of 2000 and to strike out the offending paragraph/exhibit.”

16. On 13 May 2003, Urquhart Dykes & Lord filed Form TM5 requesting a written statement of the grounds of my decision; I give this decision below.

GROUNDS OF DECISION

17. Rule 13 of the Trade Marks Rules 2000 governs the manner in which the Trade Marks Registry handles oppositions under the Trade Marks Act 1994. Rule 13(10) deals with evidence in reply. It reads as follows:

“13(10) Within three months of the date upon which a copy of the applicant’s evidence is sent to him under paragraph (9) above, the person opposing the application may file evidence in reply which shall be confined to matters strictly in reply to the applicant’s evidence, and shall send a copy thereof to the applicant.”

18. Rule 13(11) is also relevant. This reads as follows:

“13(11) No further evidence may be filed, except that, in relation to any proceedings before her, the registrar may at any time if she thinks fit give leave to either party to file such evidence upon such terms as she may think fit.”

19. It is, I think, well established that the most recent authority on what does and does not constitute evidence in reply is that of the Hearing Officer in *Peckitt’s Application* [1999] RPC 337. Head note (12) of that case reads as follows:

“(12) Evidence "strictly in reply" must not be evidence of a sort which would give cause for the other party to put in further evidence on a substantive issue and must not involve a departure from a case put in chief. It might, however, comment upon the other party's evidence with the aim of finality and the fixing of a hearing at an early stage. If it neither altered nor strengthened the party's case and was not such as to prolong the pre-hearing procedure by justifying another round of evidence from the other party, it should be allowed to stand. (paras 57-64, 66) *Ford Motor Co. Ltd (Nastas's Application* [1968] R.P.C. 220 at 225 line 37 (Lloyd-Jacob J.) , and *Ernest Scragg & Sons Ltd's Application* [1972] R.P.C. 679 at 682 (Graham J.), applied.”

20. With these principles in mind, I turn to consider the opponents’ evidence in reply. Paragraphs (1), (3) and (4) of the witness statement of Alison Jane Cole dated 8 October 2002 are unobjectionable and as such I need say no more about them. What then of paragraph 2 and exhibit AJC2 which accompanies it?

21. I note that the statutory declaration of Ms Cole which constituted the opponents’ evidence in chief was dated 17 September 2001, whereas the decision of the Commercial Court of Lisbon was dated 13 July 2001; clearly the decision was available when the original statutory declaration was filed. It was, says Ms Cole, not filed at that time because the opponents were not and could not have been aware that the applicants would rely on a decision from outside the United Kingdom; she adds that the United Kingdom Trade Marks Registry are not bound

by decisions from other legal systems in any case. I accept both of these statements. Is then the paragraph and exhibit mentioned **strictly** (my emphasis) in reply bearing in mind the criteria outlined in *Peckitt's Application*? In my view it is clearly not.

22. To begin with it is evidence which the applicants would (given the circumstances surrounding the manner in which the decision was issued) wish to file further evidence in response to, if only, to place the decision in context; consequently it will inevitably prolong the pre-hearing procedure. It represents a clear departure from the opponents' case put in chief and it is evidence which (arguably) strengthens the opponents' case. Finally it is evidence which was clearly available when the opponents' evidence in chief was filed. Had the opponents felt it was important evidence, it is at that stage that it should have been filed. At the hearing I asked Ms Cole whether if I was against her in so far as the request under rule 13(10) was concerned, she sought refuge under rule 13(11); she confirmed that she did not.

23. In practice of course the paragraph and associated exhibit is likely to be of little or no evidential value to the Hearing Officer determining the substantive issues. This is because it is well established that decisions from other jurisdictions are (at best) of marginal assistance and at worst of no assistance at all (a point I note Ms Cole concedes).

CONCLUSION

24. In these proceedings I have concluded that:

- applying the criteria established in *Peckitt's Application*, paragraph 2 and exhibit AJC2 to the witness statement of Alison Jane Cole dated 8 October 2002 do not constitute evidence strictly in reply to the applicants evidence in chief for the reasons indicated above;
- the information now sought to be adduced as evidence in reply was available and could have been adduced at the time the opponents' evidence in chief was filed;
- no request was made by the opponents for the evidence disallowed as evidence in reply to be admitted into the proceedings as additional evidence under the provisions of rule 13(11) of the Trade Marks Rules 2000.

25. The consequence of my decision is that paragraph 2 and exhibit AJC2 of the witness statement of Alison Jane Cole dated 8 October 2002 will not be admitted into the proceedings.

Dated this 11th Day of August 2003

C J BOWEN

For the Registrar

The Comptroller-General

Annex available in a paper copy.