

O-354-03

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING IN RELATION TO  
APPLICATION NOS 2266451, 2269333, 2255933 & 2269343 BY  
EASYGROUP IP LICENSING LIMITED**

**AND**



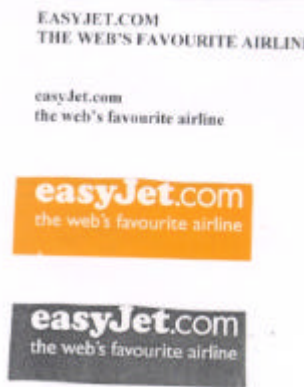

**OPPOSITIONS THERETO (NOS 80300, 90498, 90687 & 90497) BY  
ORANGE PERSONAL COMMUNICATIONS SERVICES LIMITED**

## BACKGROUND

1. On 28 August 2003 an interlocutory hearing took place before me in relation to the four sets of opposition proceedings detailed on the first page of this decision. The hearing was appointed to determine two matters; the first was the opponent's request for an extension of time to file evidence in reply under rule 13(10) of the Trade Mark Rules 2000 in respect of each set of proceedings; the second was the opponent's request for leave to amend their statement of grounds of opposition in all four cases to include Section 5(1) of the Trade Marks Act 1994. In summary, my decision at the hearing was to allow the opponent's first request but to refuse their second.

2. On 10 September 2003 the opponent filed a Form TM5 seeking written grounds for my decision to refuse leave to amend the statement of grounds of opposition.

3. All of the trade mark applications the subject of this decision have been opposed by Orange Personal Communications Services Limited. The basic details of each application are:

<p><b>2266451</b> applied for on 5/4/01 in Classes 9, 16, 25, 29, 30, 32, 33, 35, 36, 38, 39, 41 &amp; 42.</p> <p>The colour orange is claimed as an element of the mark.</p>		<p>Published for opposition purposes on:</p> <p><b>25/7/01</b></p>	<p>Opposition filed on:</p> <p><b>25/10/01</b></p>
<p><b>2269333</b> applied for on 4/5/01 in Classes 9, 16, 35, 36, 38 &amp; 42.</p> <p>The colour orange is claimed as an element of the mark.</p>		<p>Published for opposition purposes on:</p> <p><b>23/1/02</b></p>	<p>Opposition filed on:</p> <p><b>23/04/02</b></p>
<p><b>2255933</b> applied for 15/12/2000 in Classes 3, 9, 12, 14, 16, 18, 25, 28, 29, 30, 32, 33, 34, 35, 38, 39, 41 &amp; 42.</p> <p>The colour orange is claimed as an element of the third mark in the series.</p>		<p>Published for opposition purposes on:</p> <p><b>20/3/02</b></p>	<p>Opposition filed on:</p> <p><b>11/06/02</b></p>
<p><b>2269343</b> applied for on 4/5/01 in Classes 9, 16, 35, 36, 38 &amp; 42.</p> <p>The colour orange is claimed as an element of the mark.</p>		<p>Published for opposition purposes on:</p> <p><b>23/1/02</b></p>	<p>Opposition filed on:</p> <p><b>23/04/02</b></p>

4. The opponent and the applicant both filed evidence in support of their cases. The opponent was then set a period on all four cases in which to file evidence in reply.

Although the four cases are not consolidated, they all followed an almost identical timetable at this stage of the proceedings. An extension of time to file their evidence was sought by the opponent. This request was objected to by the applicant who asked to be heard on this matter.

5. On 1 August 2003 the opponent wrote to the Registrar requesting leave to amend their statements of grounds of opposition to include Section 5(1) of the Act. The request was made on the basis of two earlier marks, namely registrations 2057893A & 2057893B. The opponent had already prayed in aid these earlier marks under the provisions of Section 5(2)(b) of the Act. For information, the mark text of each registration reads:

“2057893A - The mark consists of the colour orange Pantone 151, being the predominant colour applied to the visible surface of the packaging and/or advertising and promotional materials.”

“2057893B - The mark consists of the colour orange as shown on the form of application being the predominant colour applied to the whole of the visible surface of the goods, their packaging and/or promotional and advertising materials; and being the predominant colour applied to the whole of the visible surface of materials used in the advertising and promotion of and/or performance, delivery and supply of services.”

6. The reasons given for their request are contained in the opponent’s letter of 1 August 2003. The following text is taken from the letter:

“the colour as claimed in the applicant’s mark carries no specification of or limitation to a particular shade of orange and therefore includes the particular shade of orange which is the subject of the opponent’s earlier trade mark nos. 2057893A and 2057893B whether by reference to Pantone shade (GB2057893A) or physical sample (GB2057893B),

the colour orange in the applicant’s mark is, by the applicant’s own admission in the witness statement of Mr J. Rothnie, not limited in shape to a rectangular background or indeed to any shape,

the materials supplied in the applicant’s evidence demonstrate the colour orange used as the predominant colour as applied to visible surfaces of the examples provided as exhibits at JR5 to the witness statement of Mr Rothnie,

the opponent’s earlier trade marks 2057893A and 2057893B contemplate the addition of words as well as other elements to the predominant orange colouring.”

The opponent also indicated that if the Registrar was not minded to grant leave to amend then a hearing would be required in order to argue against that decision and further that any such hearing should be taken at the same time as the hearing appointed to deal with their request for an extension of time.

7. On 12 August 2003 the applicant wrote to the Registrar objecting to the proposed amendment on the basis that the respective marks could not be construed as identical. They also indicated that if the Registrar was minded to grant leave for the amendment then a hearing would be required to argue against that decision and further that any such hearing should be taken at the same time as the hearing appointed to deal with the opponent's request for an extension of time.

8. On 15 August 2003 the Registrar issued a letter to both parties advising them that her preliminary view was to refuse leave to amend; it was, however, agreed that the matter could be heard at the same hearing appointed in relation to the extension of time issues (this had by now been set down for 28 August 2003). Given that a period of less than 14 days would have elapsed between the date of the preliminary view and the date set down for the hearing, both parties gave their written agreement to waive their 14 day notice period as provided by Rule 54(2).

9. The hearing took place before me on 28 August 2003 via a video conference link. The opponent was represented by Mr Abrahams of Counsel instructed by R.G.C. Jenkins & Co.; the applicant was represented by Ms Catherine Wolfe of Page White Farrer. Both parties filed a skeleton argument prior to the hearing and both made oral submissions on the matters to be determined; I refer to these submissions, as appropriate, later in these written grounds.

## **DECISION**

### **The approach to amendment**

10. At the hearing, Mr. Abrahams suggested that the approach I should adopt in relation to the request for leave to amend the grounds of opposition should mirror the approach that the Court adopts to amendments under the Civil Procedure Rules (CPR). Part 17.3.5 of the CPR outlines the "General principles for grant of permission to amend" and quotes from Peter Gibson LJ. In *Cobbald v. London Borough of Greenwich* [August 9 1999, CA]:

"The overriding objective is that the court should deal with cases justly. That includes, so far as practicable, ensuring that each case is dealt with not only expeditiously but also fairly. Amendments in general ought to be allowed so that the real dispute between the parties can be adjudicated upon provided that any prejudice to the other party or parties caused by the amendment can be compensated for in costs, and the public interest in the efficient administration of justice is not significantly harmed"

11. The CPR does, however, go on to say (in part 17.3.6) that there is a "need to show some prospect of success". I pointed this out to Mr. Abrahams who accepted that it was necessary for him to establish that the ground to be added was properly arguable, but he urged me not to conduct a trial of the ground. The CPR also identifies that the test to be followed when looking at prospect of success is equivalent to the test in relation to summary judgement under Part 24 of the CPR which states:

### **“24.2.3. “no real prospect of succeeding/successfully defending”**

In order to defeat the application for summary judgement it is sufficient for the respondent to show some “prospect”, i.e. some chance of success. That prospect must be “real”, i.e. the court will disregard prospects which are false, fanciful or imaginary. The inclusion of the word “real” means that the respondent has to have a case which is better than merely arguable (*International Finance Corp. v. Uteaffrican srpl* [2001] L.T.L., May 15 citing *Alpine Bulk Transport Co Inc. v. Suadi Eagle Shipping Co Inc.*, [1986] 2 Lloyd’s Rep. 221, noted in para. 13.3. above). The respondent is not required to show that his case will probably succeed at trial. A case may be held to have a “real prospect” of success even if it is improbable. However, in such a case the court is likely to make a conditional order (as to which, see the commentary to r.24.6).

The hearing of application for summary judgement is not a summary trial. The court at the summary judgement application will consider the merits of the respondent’s case only to the extent necessary to determine whether it has sufficient merit to proceed to trial.”

12. The only other point that Mr Abrahams drew to my attention in respect of the approach to my decision was that I should be also conscious that if I were to refuse leave to amend the statement of grounds then the opponent would be able to launch invalidation proceedings to run the additional ground. This would consequently create a multiplicity of proceedings which Mr Abrahams had already told me (in his submissions on the extension of time issue) is an important factor because creating such a multiplicity would not be in the interests of the parties, the public or the Registry.

13. For her part, Ms. Wolfe did not accept the principle that amendments ought, in general, to be allowed. She felt that entirely new points should not be brought up at a later date, particularly, as in this case, the length of time that had elapsed between the filing of these oppositions and the date that the amendment had been requested was not insignificant. However, Ms. Wolfe did not point to any specific prejudice that the applicant would face as a result of the amendment.

14. The Registrar will often look to the CPR for guidance on a specific issue particularly if the statutory provisions giving her powers are, as is the case here, silent on that issue. This is a case where it is sensible to do so. Having done so, I agree with Mr. Abrahams that amendments should, in general, be allowed except when they would be so prejudicial to the other side that an award of costs would not compensate them for the inconvenience they may suffer.

15. As I have indicated earlier, Ms. Wolfe did not point to any specific prejudice that the applicant would suffer if the amendment were allowed. I therefore conclude that any inconvenience they may face, if I was minded to grant leave to amend, could be compensated for by an appropriate award of costs in their favour. Consequently, my decision on whether to allow leave to amend rests on the merit of the ground sought. Whilst I acknowledge that the opponent does not have to convince me that they are likely to or will probably succeed under the ground, there must still be some prospect

of success. I accept Mr Abrahams' point that I must not conduct a full trial, but nevertheless I must still look to the substantive ground in order to deal with the question before me, but I do so only insofar as is necessary to determine whether sufficient merit exists.

### **Real prospect of success**

16. The ground the opponent wishes to add to their statements of grounds are based upon Section 5(1) of the Act which states:

“5.-(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods and services for which the trade mark is applied for are identical with the goods and services for which the earlier trade mark is protected.”

For a successful finding under this ground the earlier mark relied upon by the opponent must be identical to the mark applied for by the applicant. In view of this, the Registry wrote to the parties prior to the hearing to bring to their attention the decision of the European Court of Justice (ECJ) in *LTJ Diffusion SA v. Sadas Vertbaudet SA* [291/00]. This case gives the ECJ's interpretation of the meaning of the word “identical” and therefore has a bearing on this matter. The decision states:

“50. The criterion of identity of the sign and the trade mark must be interpreted strictly. The very definition of identity implies that the two elements compared should be the same in all respects. Indeed, the absolute protection in the case of a sign which is identical with the trade mark in relation to goods or services which are identical with those for which the trade mark is registered, which is guaranteed by Article 5(1)(a) of the directive, cannot be extended beyond the situations for which it was envisaged, in particular, to those situations which are more specifically protected by Article 5(1)(b) of the directive.

51. There is therefore identity between the sign and the trade mark where the former reproduces, without any modification or addition, all the elements constituting the latter.”

17. The above case clearly sets out a strict interpretation of the word “identical”. The basis of Mr Abrahams' argument was that the earlier marks relied upon by the opponent consisted of the colour orange being the predominant colour applied to the packaging or promotional material for the goods in question. Mr Abrahams considered it implicit from the monopoly granted (through the use of the word predominantly) that other matter may be added to the surface of the materials. This was compared to the applicant's marks which although consisting of an “EASY” prefixed word on an orange rectangular mark, that through notional and fair use of the mark (as shown in the applicant's own evidence) the colour orange may not be limited to a rectangular background and could become the predominant colour applied to the visible surface of the item.

18. I asked Mr Abrahams if, as per the *Sadas* case, the word “EASY” would be seen as an addition or modification between the marks. Mr Abrahams answered in the

negative. His view was that it is not an addition to a mark where the definition of the trade mark already encompasses or envisages such additions. This is based on the use of the word “predominant” which I was told does not mean entire.

19. Ms Wolfe argued that the ground was not appropriate due to the nature of the respective marks. She pointed to the fact that the marks sought by the applicant consisted of the words “EASY” on an orange rectangle and that this could not be considered identical to the opponent’s mark which consisted of the colour orange applied predominantly to packaging.

20. I do not wish to make a formal finding on whether notional and fair use of the applicant’s mark would extend the orange rectangle behind the word “EASY” to become the background colour when used on packaging and other materials. However, for the purposes of this decision, I am content to say that this may be the case. I am after all only seeking to establish whether the opponent’s case has some prospect of success.

21. The applicant’s marks all contain an “EASY” prefixed word; no words at all are contained in the definition of the opponent’s earlier marks. I do not agree with Mr. Abrahams' opinion that through the use of the word “predominant” (as contained in the wording of the opponent’s marks), that their resultant monopoly could envisage the addition of an “EASY” prefixed word. The opponent may, in use, choose to use a specific word in conjunction with their marks, but this does not mean that such a word can be taken to form part of their monopoly. The requirements for filing a trade mark application require a fixed point of reference with which comparison with later marks can be made. This comparison necessarily includes an assessment of whether there exists an identical mark. I consider that for a trade mark to be construed as identical to the applicant’s marks then such a mark must contain the respective “EASY” prefix; the opponent’s marks do not.

22. Mr. Abrahams did not consider that the “EASY” prefixed words would be an addition or modification to the opponent’s mark. I take the opposite view. I feel it would take quite a stretch of the imagination to come to the view held by Mr. Abrahams. The mere fact that the ground has been argued does not make it an arguable ground.

## **Conclusion**

23. In view of the current state of the jurisprudence and having made a basic comparison of the marks in question, I feel that the ground that the opponent seeks to add can not be won. I indicated at the hearing that I had no doubt that this was the case. If I had any doubt at all (and consequently felt that the ground was arguable) then I would have allowed the amendment. The ground does not, in my view, stand any real prospect of success and I therefore refused leave to amend.

## **Costs**

24. Although the opponent did not succeed in their request for leave to amend, they did succeed in relation to their request for an extension of time. Consequently, I

determined that the issues cancelled each other out and I made no award of costs to either party.

**Dated this 17<sup>th</sup> day of November 2003**

**Oliver J Morris  
For the registrar  
the Comptroller-General**