

O-194-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF A JOINT HEARING HELD IN RELATION TO A REQUEST  
FOR AN EXTENSION OF TIME IN WHICH TO APPEAL A DECISION OF THE  
REGISTRAR FOLLOWING INVALIDATION ACTIONS Nos. 81656 & 81657 FILED IN  
THE NAME OF O2 LIMITED AGAINST REGISTRATION Nos. 2308256 & 2325253  
STANDING IN THE NAME OF PHILIP MAITLAND**

## TRADE MARKS ACT 1994

**IN THE MATTER OF a joint hearing held in relation to a request for an extension of time in which to appeal a decision of the registrar following invalidation actions nos. 81656 & 81657 filed in the name of O2 limited against registration nos. 2308256 & 2325253 standing in the name of Philip Maitland**

### BACKGROUND

1. Trade mark registration nos: 2308256 and 2325253 were declared invalid in May 2006. They were for the following marks:

No. 2308256



No. 2325253



I note that the marks were applied for on 16 August 2002 and 3 March 2003, and that they completed their registration procedure on 28 February 2003 and 22 August 2003 respectively. Both marks were shown on the Trade Marks Registry's database as standing in the name of Philip Maitland and had been registered for the following goods in Class 33: spirits (2308256) and flavoured vodka (2325253).

2. Rather than provide an extensive summary, the background to the hearing before me can be conveniently found in two decisions of the Registrar which, for the sake of convenience, are attached as Annexes A and B to this decision. The first, dated 11 May 2006, related to O2's original requests for invalidation (O-122-06). The second, dated 4 January 2007, related to Mr Maitland's request to have the original decision set aside and the proceedings re-opened (O-003-07).

3. In short, O2 sought to invalidate Mr Maitland's registrations on the basis of sections 5(2)(b), 5(3) and 5(4)(a) of the Act. In a decision taken from the papers on file dated 11 May 2006, the hearing officer concluded that O2's grounds based on sections 5(2)(b) and 5(4)(a) of the Act failed, but that they should succeed under section 5(3) of the Act (Annex A). A period expiring on 8 June 2006 in which to appeal the decision was allowed; no appeal was filed. Mr Maitland then sought, for the reasons explained by the Hearing Officer in her decision to have the original

decision set aside and the proceedings re-opened. At a hearing on 30 November 2006, this request was refused. At Mr Maitland's request, a statement of reasons was prepared (Annex B) and the parties allowed until 31 January 2007 to appeal the decision; this decision was not appealed.

4. On 2 February 2007, Howes Percival (hereafter HP) who were now acting as agents for Mr Maitland, wrote to the Trade Marks Registry (hereafter TMR). In their letter they sought, as a matter of urgency, complete copies of the official invalidation files for the registrations mentioned.

5. In a letter dated 20 February 2007, HP filed, *inter alia*, a Form TM9 (requesting a retrospective extension of time of 9 months to appeal the decision of 11 May 2006), a Form TM 54 (notice of giving evidence), a witness statement by Mr Maitland dated 19 February 2007 together with exhibit PM1 (to support the retrospective request for additional time in which to appeal), and a draft notice of appeal.

6. I have read this witness statement and the documents provided in exhibit PM1, but do not propose to provide a full summary of the statement here. In short, Mr Maitland explains, *inter alia*, that he was not aware of the applications for invalidity and provides information as to why this was the case. A substantial number of the points made by him are contained in the hearing officer's decision in Annex B and do not need to be repeated again here. Other points emerging from his witness statement are, in my view, as follows:

- that the property at 67 Lindsay Drive was sold and contracts exchanged on 26 September 2003;
- that on the sale of the Lindsay Drive property, he arranged with the Post Office for post to be forwarded to his new address of: Flat 1, 25 Well Walk, London NW3 1BY which he moved into in October 2003;
- that although he did receive some forwarded mail for approximately one year after he had sold the property at Lindsay Drive, not all of his post appears to have been successfully forwarded to his new address;
- that on 3 November 2003, he sent a Form TM21 to the TMR to effect a change of address. He is, he explains, certain of this date and refers to page 5 of exhibit PM1 which he says is a contemporaneous handwritten note he placed on his personal trade mark file. I note that this reads: "Memo 3/11/03 Sent PO new address at Well Walk";
- that on 4 August 2006, he received a letter from Wragge & Co (solicitors acting on behalf of O2) addressed to International English Distillers Ltd at his office address of Trafalgar House, 11-12 Waterloo Place, London, SW1Y 4AU, indicating that his trade marks had been invalidated. This is, he says, the first that he had heard of the proceedings;

- that he does not recall ever receiving Boulton Wade Tenant's (hereafter BWT) letter of 11 March 2004 sent to him at the Waterloo Place address mentioned above, a copy of which was provided to him by Wragge & Co in their letter of 7 August 2006;
- that on 11 December 2006, he contacted HP for the first time;
- that he has since discovered that his attempts to have the original decision set aside on the grounds that the letters were sent to the wrong address could not succeed;
- that he now realises that what he should have done was to appeal the original decision albeit belatedly;
- that to ascertain the correct position has been time consuming, as it required a thorough investigation of the official files, the preparation of evidence in support and the necessity to take specialist legal advice;
- that the delay between August 2006 and January 2007 was the result of him adopting an incorrect approach; the delay since resulted from the need to double check the official files for what he describes as a missing letter;
- that although the official letter of 23 February 2005 to BWT offered them a hearing, no such letter was sent to him. Consequently, the decision of 11 May 2006 should be set aside as a result of this procedural irregularity;
- that from as early as 27 August 2004, BWT were treating the matter as if he was not involved stating, *inter alia*, in a letter of that date: "on the basis that the registered proprietor has not filed TM8 and counterstatement within the period allowed and is not, in effect, any longer a party to these proceedings";
- that it would appear that BWT's failure to copy correspondence to him influenced the TMR's approach to corresponding with him, such they also stopped sending him letters and in particular the critical letter informing him of his right to a hearing or to make submissions;
- that BWT's written submissions of 9 March 2005 were factually misleading;
- that although the Vodka Rush brand has not yet been launched, the Premium Sparkling brand is in use and has been actively marketed overseas, and, that Premium Sparkling and Super Premium Sparkling are well respected within the spirit industry and were commended at the International Wine and Spirit Competition 2004, with Super Premium Sparkling receiving a bronze award at the International Wine and Spirit Competition 2005.

7. Having considered this information the TMR, in an official letter dated 13 March 2007, issued a Preliminary View. It did so in the following terms:

"The Registry's preliminary view is that the extension of time request until (sic) should be refused.

The Registry is of the opinion that the reasons given do not warrant an extension of time to file an appeal, I refer you to Tribunal Practice Notice 3/2000 regarding extensions of time in which to appeal decisions.”

I note that HP were allowed until 27 March 2007 in which to request a hearing, an offer they accepted in a letter dated 20 March 2007.

### **The joint hearing**

8. A joint hearing to consider the TMR’s preliminary view took place before me, by video conference, on 12 April 2007. At the hearing, Mr Maitland was represented by Mr Michael Edenborough of Counsel instructed by HP; O2 were represented by Mr Julius Stobbs of BWT.

### **The skeleton arguments**

9. Both parties provided skeleton arguments, the main points emerging from which were, in my view, as follows:

#### **Mr Maitland’s skeleton arguments**

- that there are two strands to the appeal;
- that the decision of 11 May 2006 was wrong in law and fact, because the conclusion did not follow from the relevant findings of fact made by the hearing officer and the correct application of the law to those findings;
- that the decision is fundamentally flawed and should not be allowed to stand, even if that means allowing a retrospective extension of time in which to challenge it;
- that in the alternative, there was a serious procedural irregularity sufficient to warrant that the decision be set aside in any event. This is because Mr Maitland was never notified that, once the evidence rounds had been completed, he had an opportunity to file written submissions or that he could request to be heard. This, in itself, would be sufficient to justify a retrospective extension of time. A serious miscarriage of justice has been perpetrated, and it cannot be ignored by committing another failure to allow Mr Maitland a hearing to defend his property rights;
- that in relation to prejudice, Mr Maitland has been, and will continue to be prejudiced, if he is not allowed a hearing to defend his property rights on the merits, whereas O2 will suffer no prejudice at all. This is evidenced by the fact that O2 did not sue Mr Maitland at the outset for trade mark infringement, and as far as is known, still has not sued him despite there being no change to Mr Maitland’s trading activities.

## O2's skeleton arguments

I note that in paragraph 1 of their skeleton argument O2 comment as follows:

“1. There appear to be two main thrusts to the request of the registered proprietor to reopen this case. The first is a request for an extension of time in relation to the original appeal period set as a deadline of 28 days running from 11 May 2006. The second is an indication that there has been a procedural irregularity on the part of the Registrar in coming to his decision and that the case should effectively be reopened because of that procedural irregularity. Whilst this procedural irregularity is given as part of the reasons for requesting an extension of time, it also appears to be argued separately, and so we shall look at these two things separately.”

O2 then go on to say:

- that rule 68 of the Trade Marks Rules 2000 does not bar an extension of time in which to appeal a decision of the Registrar, and so in theory an extension of time can be granted for this purpose;
- that there are three main reasons why, in the circumstances of this case, it would not be appropriate to grant an extension of time;
- the first reason, is that the reasons given do not warrant the extension;
- that it is well established that a registered proprietor's failure to keep their address for service up to date will not be an excuse for any delay in meeting a time limit set by the TMR. However, the address issue only explains the delay between the issue of the decision on 11 May 2006 and the receipt of the decision by Mr Maitland on 4 August 2006, and as such, the delay between 4 August 2006 and 21 February 2007 (the date the request for a retrospective extension of time was received by the TMR) needs to be explained by other means;
- that part of the delay appears to result from Mr Maitland attempt to re-open the proceedings by the wrong means; simply pursuing the wrong course of action can never be regarded as a justifiable reason for delay;
- that it then took Mr Maitland four months to seek any legal advice following receipt of the original decision, and a further two and a half months to request an extension of time; these cannot be seen as justifiable reasons for the delay in the proceedings, particularly as legal advisers will know that it is extremely difficult to justify extensions of time that are filed outside the relevant period;
- that in so far as a serious procedural irregularity was concerned, Mr Maitland was fully aware of having hearings at the TMR, and that any procedural irregularity that may have taken place cannot have had any impact on the period of delay that occurred;

- the second reason is that the registrar is *functus officio*;
- that the registrar should not be able to grant an extension of time on the basis that a decision has already been made – reference is made to the decision of Mr Simon Thorley QC acting as the Appointed Person in *Omitec* [O-018-02) in which he commented: “..once the Registrar has issued a decision revoking a trade mark she is *functus* and can thereafter not revisit her decision.” In practice the registrar has issued a decision that this procedure is closed, and so following the official letter of 27 June 2006 (the letter which implemented the decision of 11 May 2006) it must be the case that the registrar is *functus* in respect of the issue as to whether to allow an appeal can be started;
- the third reason is that it would not be “just and equitable” to grant the extension;
- that when deciding whether to allow a retrospective extension of time, the registrar needs to be satisfied that it is just and equitable to do so;
- that in this case it is not, and there is one overriding reason for this, which is the public interest. A period of 8 months has passed before the request for an extension of time to appeal the original decision was filed, during which time the registrations in question have not been on the register and third parties have been making judgements based on this information. If the extension of time was granted to appeal the decision, and the appeal was ultimately successful, the registrations would be reinstated on the register, and would constitute prior rights in respect of any new trade marks that were adopted in the interim period;
- returning to the serious procedural irregularity which may have occurred, the proceeding should not be re-opened for three reasons;
- that the first reason is that there is no evidence to suggest that there actually has been any procedural irregularity, in other words, there is no evidence to indicate that the correspondence in question discussing the possibility of a hearing was not copied to Mr Maitland. If the letter to BWT identifying the possibility of a hearing had been copied to Mr Maitland, then there would be no question at all of any procedural irregularity. There is simply no evidence that it was not copied to Mr Maitland;
- that the second reason is that even if that correspondence was not copied to Mr Maitland there has not been any procedural irregularity in any case. In accordance with rule 33(6) it is at the registrar’s discretion as to whether to treat an application for invalidity as opposed when no Form TM8 and counter-statement are filed; it is clear (if not specifically stated) in the official letter of 16 July 2004 that this is the approach the TMR have adopted. That the official letters of 16 July 2004 (both of which were sent to Mr Maitland) reminded BWT of their right to a hearing, and that given that rule 54 does not specifically state that the registrar has to remind any person of the right to be heard, at no point in the procedure was the right to be heard removed from Mr Maitland; for these two separate reasons there has been no irregularity in procedure;

- that the third reason is that even if there had been a procedural irregularity, it is clear that it would have had no material effect. It is well accepted that for the registrar to exercise discretion to re-open proceedings on the basis of a procedural irregularity, it has to be shown that the irregularity was material in its effect. In *Bat Out Of Hell* [O-077-02] the hearing officer said: “Bearing in mind the guidance from the Appointed Person I go on to consider whether the procedural irregularity was material in its effect”. In these proceedings it is accepted that none of the correspondence relating to the case was ever received by Mr Maitland. Even if it had been copied to Mr Maitland, then he could not have requested a hearing, because by his own admission he had not kept his address for service up to date and as such would not have received the correspondence in question. Even if there is deemed to be a procedural irregularity it cannot have had a material effect.

### **The decision following the hearing**

10. At the hearing I reserved my decision. I communicated my decision to the parties in a letter dated 17 April 2007. The substance of that letter was as follows:

“..... I agree with Mr Edenborough that the inter-relationship between Section 76 of the Act, and rules 63(1A), 68(3) and 68(5) of the Trade Marks Rules 2000 (as amended), provides the Registrar with the jurisdiction to consider the request for additional time and does not, as Mr Stobbs argued, render the Registrar *functus officio*. However, when considering a request for a retrospective extension of time, it was necessary for me to keep in mind the wording of rule 68(5) and in particular the words “...satisfied with the explanation...” and “...just and equitable to do so” appearing therein. Having done so, I agree with Mr Stobbs that the circumstances of these proceedings do not justify the granting of additional time. In my view, Mr Maitland’s failure to appeal the Decision of 11 May 2006 in the statutory period allowed (i.e. 11 May 2006 to 8 June 2006) resulted from his own failure to keep his address for service up-to-date. His failure to appeal the Decision in the period 4 August 2006 to December 2006 was, Mr Edenborough fairly accepted, an error on Mr Maitland’s part as to how the matter should be taken forward. Whilst I accept that as a litigant in person Mr Maitland’s approach to the proceedings at that point may have been understandable, I also agree with Mr Stobbs that as this matter was clearly of some importance to him, it is at this point that he should have sought professional advice. The final leg of the delay is between 11 December 2006 (when Mr Maitland first contacted your firm) and the filing of the request for additional time on 21 February 2007. Whilst I appreciate that to correctly advise Mr Maitland your firm needed to examine the proceedings to date, the official file indicates that your request for a copy of the official files was not made until 2 February 2007 (a little under two months after Mr Maitland’s first approach to you) and that Mr Maitland’s witness statement was not signed until 19 February 2007.

Insofar as the “..just and equitable” arm of rule 68(5) is concerned, I heard competing submissions from Mr Edenborough and Mr Stobbs on the potential prejudice (or otherwise) to O2 and to the public interest argument. In relation to the latter, I note that Tribunal Practice Notice 3 of 2000 entitled “Requests for extensions of time in which to appeal decisions” refers to the Decision of Mr Simon Thorley QC acting in his capacity as an Appointed Person in *Whiteline Windows Limited v Brugmann Frisoplast GmbH* (O-

299-00). In that Decision Mr Thorley makes it quite clear that the power to extend the period to appeal was a matter that must be approached with the greatest caution as, *inter alia*, appeals created uncertainty and ought to be disposed of in a timely manner.

In all the circumstances, I am not satisfied with either the explanation for the various delays that have occurred, or, in light of the Appointed Person's comments mentioned above, together with the desirability for the finality of litigation and the reasonable expectations of O2 that the proceedings had been concluded, that it would be appropriate for me to exercise my discretion in Mr Maitland's favour.

That of course is not an end to the matter. Mr Edenborough also argued that there had been a serious procedural irregularity in the Trade Marks Registry which justified Mr Maitland's request for additional time. This procedural irregularity is said to have occurred when the Trade Marks Registry (apparently) failed to send a copy of the official letter of 23 February 2005 to Mr Maitland and in so doing failed to offer him the opportunity to be heard or to file written submission before a decision on the merits of the applications was made. In this regard, I heard submission on the meaning of rules 33(6) and 54 and whether, if a procedural irregularity had occurred, it would have had material consequences.

In my view the position is this. The official letter of 23 February 2005 addressed to Boulton Wade Tennant informed them that certain evidence was to be admitted into the proceedings. The letter was also an indication that the filing of evidence was considered complete and that the proceedings would be passed to a hearing officer for a substantive determination to be made. The letter concluded in the following terms: "...A period of 14 days from the date of this letter is allowed for you to file any written submissions or request to be heard"; there is nothing in the letter to indicate that Mr Maitland was sent a copy. This raises two questions: (i) should he have been sent a copy? and (ii) if he should have, in light of the circumstances of these proceedings, did that omission have a material effect. Mr Stobbs argued that the official letter of 23 February 2005 was not copied to Mr Maitland because following his non filing of a Form TM8 and counterstatement, and given the wording of rule 33(6), the Trade Marks Registry was effectively treating him as not opposing the applications and that he was from that point on no longer a party to the proceedings. However, even if that was wrong, Mr Stobbs argued that the error would have had no material effect because any letter sent would not have been received by Mr Maitland in any case. For his part Mr Edenborough argued that the fact that the Trade Marks Registry were not treating Mr Maitland as opposing the applications did not mean that he was no longer a party to the proceedings. As to whether the procedural irregularity was material, he argued strongly that as I could not be absolutely certain that an official letter if sent to Mr Maitland on 23 February 2005 would not have been received by him, the failure of the Trade Marks Registry was, in his view, material and was capable of correction under rule 68(7).

In my view it is not necessary for me to determine whether the Trade Marks Registry should have sent the letter of 23 February 2005 to Mr Maitland, because I am satisfied (in so far as one can be in proceedings such as this), that even if a letter had been sent, it was,

in my view, most unlikely to have ever been received by him. I reach this conclusion because it is clear that any such letter would have been sent to Mr Maitland at his 67 Lindsay Drive address. Previous official letters of 19 May 2004 (informing him of the filing of the actions) and 16 July 2004 (noting that no defence had been filed) both of which were sent to the Lindsay Drive address were, it appears, never received by him. In his witness statement Mr Maitland explains (in paragraph 10) that contracts on the Lindsay Drive address were exchanged on 26 September 2003, and in paragraph 11 he comments that he received forwarded mail for approximately a year after he sold the property at Lindsay Drive. At the hearing, Mr Edenborough agreed that a fair reading of this paragraph suggested that a mail redirect was in operation until (probably) September 2004 or thereabouts. If Mr Maitland had not received correspondence from the Trade Marks Registry sent to the Lindsay Drive address during the period in which the mail redirect was in operation, it is, in my view, even less likely that he would have received an official letter some five months after the mail redirect ceased. In this regard, I agree with Mr Stobbs that a theoretical possibility that an official letter sent to Mr Maitland on 23 February 2005 may in some fashion have found its way to him at his new address is insufficient; it must be a realistic possibility. In the circumstances, I have concluded that even if there had been a procedural irregularity before the Trade Marks Registry (and I reach no concluded view on this point) such irregularity would have had no material effect.

Finally, I heard submissions on costs. Mr Stobbs attended the hearing to both support the Trade Marks Registry's Preliminary View and to protect his client's position. He provided a comprehensive skeleton argument running to some 7 pages and 20 numbered paragraphs and took a full part in the hearing. The hearing was lengthy and in all the circumstances, O2 are, in my view, entitled to a contribution towards the costs they have incurred; I order Mr Maitland to pay O2 the sum of £300 in this regard."

11. The parties were allowed a period of one month from the date of this letter to file Form TM5, and in so doing to request a written statement of reasons for my decisions as a precursor to launching an appeal. Mr Maitland filed Form TM5, following which I now give the reasons for my decisions below.

## **DECISION**

12. The relevant sections of the Trade Marks Act 1994 (as amended) or of the Trade Marks Rules 2000 (as amended) (or portions thereof) applicable to these proceedings are as follows:

### **Section 76 – Appeals from the registrar**

“(1) An appeal lies from any decision of the registrar under this Act, except as otherwise expressly provided by rules.

For this purpose "decision" includes any act of the registrar in exercise of a discretion vested in him by or under this Act.

(2) Any such appeal may be brought either to an appointed person or to the court.

(3)...

(4)...

(5)..."

### **Rule 33 – Application for invalidation**

“(1) An application to the registrar for a declaration of invalidity under section 47 shall be made on Form TM26(I) and be accompanied by a statement of the grounds on which the application is made.

(2)...

(3)...

(4)...

(5) The registrar shall send a copy of Form TM26(I) and the statement of the grounds on which the application is made to the proprietor.

(6) The proprietor shall, within six weeks of the date on which he was sent a copy of Form TM26(I) and the statement by the registrar, file a Form TM8, which shall include a counter-statement, otherwise the registrar may treat him as not opposing the application.

(7)... “

### **Rule 54 – Decisions of registrar to be taken after hearing**

“(1) Without prejudice to any provisions of the Act or these Rules requiring the registrar to hear any party to proceedings under the Act or these Rules, or to give such party an opportunity to be heard, the registrar shall, before taking any decision on any matter under the Act or these Rules which is or may be adverse to any party to any proceedings before her, give that party an opportunity to be heard.

(2) The registrar shall give that party at least fourteen days’ notice of the time when he may be heard unless that party consents to shorter notice.”

### **Rule 63 – Appeal to appointed person**

“(1) Notice of appeal to the person appointed under section 76 shall be filed on Form TM55 which shall include the appellant’s grounds of appeal and his case in support of the appeal.

(1A) Such notice shall be filed with the registrar within the period of 28 days beginning on the date of the registrar’s decision which is the subject of the appeal.

- (2)...
- (3)..."

**Rule 68 – Alteration of time limits (Form TM9)**

“(1) The time or periods-

(a) prescribed by these Rules, other than the times or periods prescribed by the rules mentioned in paragraph (3) below, or

(b) specified by the registrar for doing any act or taking any proceedings,

subject to paragraph (2) below, may, at the written request of the person or party concerned, or on the initiative of the registrar, be extended by the registrar as she thinks fit and upon such terms as she may direct.

(2) Where a request for the extension of a time or periods prescribed by these Rules-

(a) is sought in respect of a time or periods prescribed by rules 13 to 13C, 18, 23, 25, 31, 31A, 32, 32A, 33, 33A or 34, the party seeking the extension shall send a copy of the request to each person party to the proceedings;

(b) is filed after the application has been published under rule 12 above the request shall be on Form TM9 and shall in any other case be on that form if the registrar so directs.

(3) The rules excepted from paragraph (1) above are rule 10A(2) (failure to file address for service), rule 11 (deficiencies in application), rule 13(1) (time for filing opposition), rule 13A(1) (time for filing counter-statement), rule 23(4) (time for filing opposition), rule 25(3) (time for filing opposition), rule 29 (delayed renewal), rule 30 (restoration of registration), rule 31(3) (time for filing counter-statement and evidence of use or reasons for non-use), rule 32(3) (time for filing counterstatement), rule 33(6) (time for filing counter-statement), and rule 47 (time for filing opposition).

(4) Subject to paragraph (5) below, a request for extension under paragraph (1) above shall be made before the time or period in question has expired.

(5) Where the request for extension is made after the time or period has expired, the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.

(6) Where the period within which any party to any proceedings before the registrar may file evidence under these Rules is to begin upon the expiry of any period in which any other party may file evidence and that other party notifies the registrar that he does not wish to file any, or any further, evidence the registrar may direct that the period within which the first mentioned party may file evidence shall begin on such date as may be specified in the direction and shall notify all parties to the dispute of that date.

(7) without prejudice to the above, in the case of any irregularity or prospective irregularity in or before the Office or the registrar which-

(a) consists of a failure to comply with any limitation as to times or periods specified in the Act or these Rules or the old law as that law continues to apply and which has occurred or appears to the registrar as likely to occur in the absence of a direction under this rule, and

(b) is attributable wholly or in part to an error, default or omission on the part of the Office or the registrar and which it appears to her should be rectified, she may direct that the time or period in question shall be altered in such manner as she may specify upon such terms as she may direct.”

13. The contents of Tribunal Practice Notice (TPN) 3 of 2000 entitled: “Requests for extensions of time in which to appeal decisions” is also relevant. The relevant portion of that Notice reads:

“The prescribed periods during which appeals against decisions of the Comptroller or Registrar may be lodged may generally be extended by the Comptroller/Registrar. However, such extensions are discretionary and should not be granted lightly. In deciding whether to grant an extension the Hearing Officer needs to have full regard to the same overriding objectives as the courts, as set out in rule 1.1 of the Civil Procedure Rules 1998, one of which is to deal with cases expeditiously and fairly.

This was underlined in a recent decision, *Whiteline Windows Limited v. Brugmann Frisoplast GmbH* (unreported). Mr Simon Thorley Q.C. sitting as the Appointed Person on a trade marks appeal, commented that whilst he accepted that the Registrar had the power to extend the appeal period, it was a matter which must be approached with the greatest caution. He stated that caution was necessary to ensure that the exercise of discretion did not undermine the purpose underlying the statutory provision. He further commented that appeals create uncertainty and as such it was in the interests of everyone to ensure that appeals are disposed of timeously. Mr Thorley concluded by stating that extensions of time in which to enter notices of appeal are therefore not to be encouraged.

Thus an extension will only be granted if there is a reason which is sufficiently strong to outweigh the potential harm to other parties or the public that may be caused by further delay.....”.

14. In order to reach a conclusion in this matter, it was necessary for me to make decisions in relation to a number of issues. These were:

(1) Is the registrar functus officio?

(2) If not, and as this was a request for a retrospective extension of time, was I satisfied both with the explanation for the delay and was it, in my view, just and equitable to grant Mr Maitland’s request?

And:

(3) Had there been a serious procedural irregularity in the TMR which ought to be corrected?

I shall deal with each of these issues in turn.

15. In relation to (1) above, the functus point, at the hearing Mr Edenborough said:

“It has been alleged against me that you now are functus with respect to this application before you today. That is wholly wrong. It is wholly wrong because we are not asking you, this tribunal, the Registry, to re-visit a decision at all. No decision has been made on the application to retrospectively extend time in which to appeal. There has been a decision with respect to the first instance decision with regard to the invalidation actions. That was the 11th May 2006 decision. That decision was communicated in the letter of 27th June 2006. We are not asking you to re-visit that decision. At the moment you, sir, are acting as a gatekeeper to whether or not a different tribunal, the appellate tribunal, in this particular case, the appointed person, can re-visit that decision. Why do I say you have jurisdiction? Simply because Rule 68(5) gives you the jurisdiction and 68(7) gives you the jurisdiction. It is a nonsense to say that you are functus with respect to an application for a retrospective extension of time in which to appeal merely because the time period in which to appeal has expired. The whole purpose of Rule 68(5) is that you are given jurisdiction to consider such applications after the expiry of those time periods. It is as simple as that.”

16. Having considered the inter-relationship between Section 76 of the Act, and rules 63(1A), 68(3) and 68(5) of the Trade Marks Rules 2000 (as amended), I indicated to the parties in my letter following the hearing that the registrar had, in my view, the necessary jurisdiction to consider Mr Maitland’s request for additional time in which to appeal the decision of 11 May 2006. I note that while this view was contrary to Mr Stobbs’ submissions, BWT did not seek a written statement of reasons. As such, this aspect of my decision has not been challenged, and I need say nothing further about it in this decision.

17. In relation to (2) above, the explanation for the delay, I note that in *Genius trade mark* [1999] RPC 741, the hearing officer said, when considering a request under rule 62(5), which I note contains the same wording as the current rule 68(5):

“In the exercise of my discretion there are therefore two issues upon which I must be satisfied, if I am not satisfied on either one the request for an extension will be refused. I must be both satisfied with the explanation for the delay in the request *and* (my emphasis) consider that to grant the request would be just and equitable.”

18. I also note that in *Ministry of Sound Recordings Limited and Virgin Records Limited* [O-136/03], Mr Geoffrey Hobbs QC acting as the Appointed Person said:

“The general discretion conferred by rule 68(1) is qualified in relation to requests made after the expiry of the 28 day period by rule 68(5) which provides that “the registrar may, at her discretion, extend the period or time if she is satisfied with the explanation for the delay in requesting the extension and it appears to her to be just and equitable to do so.” **The burden of justification thus appears to be heavier in relation to a party who applies for an extension after expiry of the relevant time limit than in the case of a party who applies pre –expiry.**” (my emphasis).

19. It is, in my view clear that to accede to Mr Maitland’s request, I needed to be satisfied with **both** the explanation for the delay that had occurred, and to consider that it would be just and equitable to allow him the additional time he sought, whilst keeping in mind that the burden of justification faced by him appeared to be heavier than if he had applied prior to the expiry of the relevant time period. I should say at this point in my decision, that in compliance with rule 68, Mr Maitland’s request was filed on Form TM9 and the appropriate fee was paid. Mr Maitland’s explanation for the delay in not appealing the decision of 11 May 2006, stemmed from: (i) him not receiving a copy of the decision, (ii) his misguided approach to what Mr Edenborough described as the set-aside application, and (iii) the time required for HP to establish the correct position before lodging the retrospective request for additional time, supporting evidence and notice of appeal.

20. In relation to (i) in my letter following the hearing I said:

“In my view, Mr Maitland’s failure to appeal the Decision of 11 May 2006 in the statutory period allowed (i.e. 11 May 2006 to 8 June 2006) resulted from his own failure to keep his address for service up-to-date.”

21. It is clear that the official letters of 19 May 2004 (serving the applications for invalidation), 16 July 2004 (indicating that no defence had been filed) and 11 May 2006 (indicating the period in which to appeal the original decision) were sent to Mr Maitland at the 67 Lindsay Drive address. I note of course the hearing officer’s comments in Annex B, the comments in Mr Maitland’s witness statement and the handwritten note shown at page 5 of exhibit PM1. However, this handwritten note does not refer to any particular trade mark or trade mark number and as such is of little assistance. In his decision in *Ms Alison June Coggins and Skjelland Group AS* [O-340-04] Mr Hobbs acting as the Appointed Person said:

“The registered proprietor contended that the decision should be set aside on the ground of serious procedural irregularity.....The appeal on behalf of the registered proprietor was put upon the footing that she had not been duly served with copies of the relevant Form TM26(N) and statement of case under Rule 31(1). It was submitted that the Registrar was under a duty in the circumstances of the present case to verify the currency of the address for service at 43 Moreton Street. In my view these submissions are misconceived. The policy considerations underlying provisions such as those found in Rule 10(4) and Section 7 of the Interpretation Act 1978 negate the existence of any such duty and entitle the Registrar to accept the address for service at face value, see the judgments of the Court of Appeal in the case of *C A Webber (Transport) Ltd v. Railtrack Plc* [2003] 16 EWCA Civ 1167 15th July 2003. The reasons for the failure on the part of the

registered proprietor to comply with the requirements of Rule 31(2) within the period of three months prescribed for that purpose do not singly or in combination permit me to hold that there was a failure on the part of the Registrar to comply with the requirements of Rule 31(1). And there is no request for relief against the consequences of Rule 31(3) under Rule 68(7).”

22. In the circumstances, it is clear that the TMR sent the letters indicated to the only address for service available to them at the time of their issue. Mr Maitland could have checked that his request for his address for service to be changed, which he said was sent to the TMR on 3 November 2003, had been received and actioned; this would in my view have been prudent. However, as far as I am aware, he did not. Consequently, in my view, Mr Maitland had only himself to blame for the fact that his address for service was not correctly recorded on the trade marks register, and as a result, for the fact that the letters indicated (including of course the letter setting the appeal period) were not received by him.

23. In relation to (ii) in my letter following the hearing I said:

“His failure to appeal the Decision in the period 4 August 2006 to December 2006 was, Mr Edenborough fairly accepted, an error on Mr Maitland’s part as to how the matter should be taken forward. Whilst I accept that as a litigant in person Mr Maitland’s approach to the proceedings at that point may have been understandable, I also agree with Mr Stobbs that as this matter was clearly of some importance to him, it is at this point that he should have sought professional advice.”

24. I have little to add to this. Mr Maitland’s trade marks were clearly of importance to him. As such, it is at that stage that it would have been prudent for him to have sought professional advice as to how best to proceed. He did not, and must therefore bear the responsibility for this misjudgement and the delay which resulted from it.

25. In relation to (iii) in my letter following the hearing I said:

“The final leg of the delay is between 11 December 2006 (when Mr Maitland first contacted your firm) and the filing of the request for additional time on 21 February 2007. Whilst I appreciate that to correctly advise Mr Maitland your firm needed to examine the proceedings to date, the official file indicates that your request for a copy of the official files was not made until 2 February 2007 (a little under two months after Mr Maitland’s first approach to you) and that Mr Maitland’s witness statement was not signed until 19 February 2007.”

26. Once again, I have little to add. Mr Maitland contacted HP on 11 December 2006 and a little under two months elapsed before HP requested copies of the official files, and a little over two months before they filed the request for additional time. Whilst I accept that HP may have wanted to await the hearing officer’s written decision in O-003-07 (issued on 4 January 2007), advice, if it was needed, could have been taken ahead of receiving the written decision, given that the hearing officer’s position was fully explained in her letter of 30 November 2006 issued the same day as the hearing.

27. In my view, HP ought to have realised (or taken advice) to confirm that the set-aside application was destined to fail, and having done so, and given the known difficulty inherent in seeking to extend a time period once the period in question had expired, sought (if they felt it appropriate), to inspect the official files, and then having done so, quickly lodged the request for additional time in which to appeal. It is of course true that the Christmas and new year break fell during this period, however given the nature of any request that was likely to have to be made, it does not in my view excuse the delay which occurred.

28. In summary, I was not satisfied (using the words of rule 68(5)) with the explanation for the delay in requesting the extension, given that the first two periods of delay were attributable to errors on Mr Maitland's part, and that the third element of delay resulted, in my view, and given the circumstances of these proceedings and the information before me, from an inappropriate level of urgency at HP.

29. Given the cumulative nature of the two arms of the test mentioned in rule 68(5), and as I was not satisfied with the explanation for the delay in requesting the extension, strictly speaking that is the end of the matter and I need not go on to consider the "just and equitable" arm of the test. However, for the sake of completeness I shall do so. In relation to this issue in my letter following the hearing I said:

Insofar as the "...just and equitable" arm of rule 68(5) is concerned, I heard competing submissions from Mr Edenborough and Mr Stobbs on the potential prejudice (or otherwise) to O2 and to the public interest argument. In relation to the latter, I note that Tribunal Practice Notice 3 of 2000 entitled "Requests for extensions of time in which to appeal decisions" refers to the Decision of Mr Simon Thorley QC acting in his capacity as an Appointed Person in *Whiteline Windows Limited v Brugmann Frisoplast GmbH* (O-299-00). In that Decision Mr Thorley makes it quite clear that the power to extend the period to appeal was a matter that must be approached with the greatest caution as, *inter alia*, appeals created uncertainty and ought to be disposed of in a timely manner.

In all the circumstances, I am not satisfied with either the explanation for the various delays that have occurred, or, in light of the Appointed Person's comments mentioned above, together with the desirability for the finality of litigation and the reasonable expectations of O2 that the proceedings had been concluded, that it would be appropriate for me to exercise my discretion in Mr Maitland's favour."

30. At the hearing, Mr Edenborough strongly argued that O2 had not identified any prejudice it would suffer should Mr Maitland's request be allowed. Mr Stobbs argued equally strongly that O2 did not have to identify any prejudice to them, and in this respect the public interest was a relevant consideration. It is I think clear from the wording of TPN 3/2000 and the comments of Mr Thorley, that requests for additional time in which to appeal decisions must be approached with the greatest caution thus ensuring that the exercise of discretion does not undermine the purpose underlying the statutory provisions. Mr Thorley added that appeals create uncertainty and as such it was in the interests of everyone to ensure that they are disposed of timeously. Those comments were of course made in the context of a request for additional time that was filed within the statutory period allowed to appeal a decision. It is, I think, reasonable to infer

that a somewhat stricter view ought to be adopted in relation to requests for additional time, to file appeals, that are themselves filed out of time.

31. In this case, the request for additional time was filed some 8 months after the statutory period for appeal expired. Given the comments in TPN 3/2000 and notwithstanding Mr Stobbs' views as to the potential impact of Mr Maitland's registrations not being shown as valid when third parties were inspecting the register, together with Mr Edenborough's comments on the impact of O2's registrations and the result of the substantive decision on this consideration, the public interest implications expressed in the TPN, O2's reasonable expectations that the invalidation proceedings had long since been settled, together with the desirability for a finality to litigation, led me to the firm conclusion that the just and equitable arm of the rule 68(5) test had not been satisfied in any case.

**32. In summary, in relation to the question I posed at paragraph 14 (2) above, I was not satisfied with either the explanation for the delay, nor did I consider it just and equitable for me to exercise my discretion in Mr Maitland's favour.**

33. Finally, I turn to the issue of the alleged serious procedural irregularity. In my letter following the hearing I said this:

“That of course is not an end to the matter. Mr Edenborough also argued that there had been a serious procedural irregularity in the Trade Marks Registry which justified Mr Maitland's request for additional time. This procedural irregularity is said to have occurred when the Trade Marks Registry (apparently) failed to send a copy of the official letter of 23 February 2005 to Mr Maitland and in so doing failed to offer him the opportunity to be heard or to file written submission before a decision on the merits of the applications was made. In this regard, I heard submission on the meaning of rules 33(6) and 54 and whether, if a procedural irregularity had occurred, it would have had material consequences.

In my view the position is this. The official letter of 23 February 2005 addressed to Boulton Tennant informed them that certain evidence was to be admitted into the proceedings. The letter was also an indication that the filing of evidence was considered complete and that the proceedings would be passed to a hearing officer for a substantive determination to be made. The letter concluded in the following terms: “..A period of 14 days from the date of this letter is allowed for you to file any written submissions or request to be heard”; there is nothing in the letter to indicate that Mr Maitland was sent a copy. This raises two questions: (i) should he have been sent a copy? and (ii) if he should have, in light of the circumstances of these proceedings, did that omission have a material effect. Mr Stobbs argued that the official letter of 23 February 2005 was not copied to Mr Maitland because following his non filing of a Form TM8 and counterstatement, and given the wording of rule 33(6), the Trade Marks Registry was effectively treating him as not opposing the applications and that he was from that point on no longer a party to the proceedings. However, even if that was wrong, Mr Stobbs argued that the error would have had no material effect because any letter sent would not have been received by Mr Maitland in any case. For his part Mr Edenborough argued that the fact that the Trade

Marks Registry were not treating Mr Maitland as opposing the applications did not mean that he was no longer a party to the proceedings. As to whether the procedural irregularity was material, he argued strongly that as I could not be absolutely certain that an official letter if sent to Mr Maitland on 23 February 2005 would not have been received by him, the failure of the Trade Marks Registry was, in his view, material and was capable of correction under rule 68(7).

In my view it is not necessary for me to determine whether the Trade Marks Registry should have sent the letter of 23 February 2005 to Mr Maitland, because I am satisfied (in so far as one can be in proceedings such as this), that even if a letter had been sent, it was, in my view, most unlikely to have ever been received by him. I reach this conclusion because it is clear that any such letter would have been sent to Mr Maitland at his 67 Lindsay Drive address. Previous official letters of 19 May 2004 (informing him of the filing of the actions) and 16 July 2004 (noting that no defence had been filed) both of which were sent to the Lindsay Drive address were, it appears, never received by him. In his witness statement Mr Maitland explains (in paragraph 10) that contracts on the Lindsay Drive address were exchanged on 26 September 2003, and in paragraph 11 he comments that he received forwarded mail for approximately a year after he sold the property at Lindsay Drive. At the hearing, Mr Edenborough agreed that a fair reading of this paragraph suggested that a mail redirect was in operation until (probably) September 2004 or thereabouts. If Mr Maitland had not received correspondence from the Trade Marks Registry sent to the Lindsay Drive address during the period in which the mail redirect was in operation, it is, in my view, even less likely that he would have received an official letter some five months after the mail redirect ceased. In this regard, I agree with Mr Stobbs that a theoretical possibility that an official letter sent to Mr Maitland on 23 February 2005 may in some fashion have found its way to him at his new address is insufficient; it must be a realistic possibility. In the circumstances, I have concluded that even if there had been a procedural irregularity before the Trade Marks Registry (and I reach no concluded view on this point) such irregularity would have had no material effect.”

34. In the *Coggins* case mentioned above, Mr Hobbs said:

“...However, that does not mean that I am satisfied that the decision issued on 9th June 2004 is free of procedural irregularity. It appears to me that a decision on the part of the Registrar under Rule 31(3) as to how matters should thereafter proceed in a case covered by that rule is a decision to which the provisions of Rule 54 apply. Rule 54 provides as follows:.....

The requirements of this rule were clearly not satisfied in the present case and I think it is readily apparent that the failure to apply the rule had adverse consequences for the registered proprietor sufficient to warrant the conclusion that the decision issued on 9th June 2004 involved a serious procedural irregularity. The decision will therefore be set aside and I will direct the Registrar to indicate to the parties within 21 days of today's date how he would propose to proceed under Rule 31(3), the indication to be given in accordance with the requirements of Rule 54.”

35. Although this was a comment in relation to rule 31(3) in revocation proceedings, given that rule 33(6) is, in so far as the use of the word “may” is concerned expressed in identical terms, it applies equally in my view to invalidation proceedings. I note that in relation to undefended revocation actions, TPN 1/2005 contains references to the decisions of Mr Justice Patten in *George Lowden v The Lowden Guitar Company Ltd* [2004] EWHC 2531 (Ch) and to Mr Hobbs, in the *Coggins* case mentioned above.

36. In *George Lowden v The Lowden Guitar Company Ltd* [2004] EWHC 2531 (Ch), Mr Justice Patten said:

“25. ...In practice this is likely to limit any continued opposition in most cases to defects in the application which are apparent from the Statement of Grounds. The Registrar’s consideration of these issues will entitle the registered proprietor to a hearing under rule 54, both in relation to the rule 31(3) decision and also in relation to the subsequent decision to be made on the application to revoke. If the proprietor is able at the first hearing to identify matters of the kind I have described, then the proper course is likely to be that the application will continue to be treated as opposed and he will be represented at any subsequent hearing at which a decision is taken whether or not to revoke registration.”

37. As a result of these decisions, the TMR’s revised practice was outlined in the TPN as follows:

“Following this decision, in the event that no defence is filed in cases of revocation on the grounds of non-use, the registrar will write to the parties giving them a period of 14 days within which to either request a hearing or to provide a submission stating why discretion should be exercised in these proceedings.”

38. I note that the *Coggins* and *Lowden* cases were decided in October and November 2004, respectively. As a result of these decisions it is, in my view, clear that when the TMR issued its letter of 16 July 2004 to the parties, what it was doing was in effect exercising a discretion, and in so doing treating Mr Maitland as not opposing the applications. Although the letters sent to BWT (containing the sentence: “A copy of this letter goes to Philip Maitland”) set the period for O2 to file evidence to overcome the burden placed on them by Section 72 of the Act and contained the following sentence:

“..You may also request a hearing to provide your submissions; however, I would add that a hearing is unlikely to assist the hearing officer who is content to make a decision from the papers on file”,

the letter addressed to Mr Maitland contained no such paragraph.

39. In addition, I note that while the TMR’s letter of 23 February 2005 addressed to BWT regarding the conclusion of the filing of their evidence and prior to the substantive decision being taken included the following sentence:

“The case will now be passed to the hearing officer for a substantive decision. A period of 14 days from the date of this letter is allowed for you to file any written submissions or request to be heard”,

there is no indication that this letter was copied or sent to Mr Maitland.

40. What then stems from these findings? Given the comments in *Coggins* and *Lowden* (albeit in relation to revocation proceedings), it is, in my view clear that Mr Maitland should in the TMR’s letter of 16 July 2004 have been offered a hearing in relation to the TMR’s decision to treat the applications for invalidations as proceedings unopposed. He was not, and the inclusion of the sentence in the letter to BWT of the same date and reproduced above cannot seriously be taken as such. In addition, he should also have been offered the opportunity to be heard in the TMR’s letter of 23 February 2005; this letter does not appear to have been copied or sent to him either.

41. The TMR’s approach was, I think, conditioned by the fact that because Mr Maitland did not respond to the TMR’s letters of 19 May 2004 which served the notices of invalidation on him, the provisions of rule 33(6) meant that the registrar was in effect treating him as not opposing the applications and as such, there was no necessity for letters etc to be sent to him. In the light of the decisions in *Coggins* and *Lowden* (which were decided after the TMR’s letter of 16 July 2004 but before the TMR’s letter of 23 February 2005), this approach, albeit perhaps the TMR’s practice at the time, was in my view incorrect. Put simply, Mr Maitland should have been offered the opportunity to be heard in the official letters of both 16 July 2004 and 23 February 2005. As he was not, does this mean that a serious procedural irregularity has occurred which should be corrected under rule 68(7)? While I accept that a procedural irregularity has occurred, in my view it does not, and I shall now explain why.

42. As to how to approach a procedural irregularity, I note the hearing officer’s comments in *Bat out of Hell* [O-077-02] when he said:

“12. Bearing in mind the guidance from the Appointed Person I go on to consider whether the procedural irregularity was material in its effect.”

43. In order for rule 68(7) to bite, I need to be satisfied that the procedural irregularities mentioned were material in their effect. I do not believe that they were. The TMR’s letters of 16 July 2004 and 23 February 2005 which should have expressly offered Mr Maitland the opportunity to be heard, were either sent to (the letter of the 16<sup>th</sup>) or should have been sent to (the letter of the 23<sup>rd</sup>) the Lindsay Drive address. It is clear that the letters of 19 May and 16 July 2004 were never received by Mr Maitland. In his evidence Mr Maitland explains that contracts on the Lindsay Drive property were exchanged in September 2003, and at the hearing Mr Edenborough accepted that a mail re-direct was in operation until probably September 2004. As a result of his failure to keep his address for service up to date, these letters were never received by him. Consequently, even if the letter of 16 July 2004 had contained a sentence offering him an opportunity to be heard, he would not have received it. The letter of 23 February 2005 to BWT was sent some 5 five months after the mail re-direct had ceased. In my view, even if that letter had been sent to Mr Maitland and had offered him the opportunity to be heard, it would as a result of his failure to keep his address for service up to date, have been sent to the Lindsay Drive

address and was extremely unlikely to have been received by him. If the letters of 19 May and 16 July 2004 had failed to reach him during the period of the mail redirect, I saw no reason to speculate that the letter of 23 February 2005 would have. In this respect, and despite Mr Edenborough arguing strongly that, as I could not **completely** discount the possibility that the letter may have found its way to him, I should exercise my discretion in Mr Maitland's favour, I agreed with Mr Stobbs that the possibility needed to be more than theoretical, it needed to be a realistic one. In my view it was not.

**44. In summary, while there were procedural irregularities which took place before the TMR, they were not, in my view, material in their effects, the consequence of which was that it was not appropriate for me to exercise the discretion provided by rule 68(7) in Mr Maitland's favour.**

45. In summary, in these proceedings I have concluded that:

- **the registrar was not functus officio in respect of Mr Maitland's request for additional time;**
- **I was not satisfied with either the explanation for the delay, nor did I consider it just and equitable for me to exercise my discretion in Mr Maitland's favour;**
- **while there were procedural irregularities which took place before the TMR, they were not, in my view, material in their effect, the consequence of which was that it was not appropriate for me to exercise the discretion provided by rule 68(7) in Mr Maitland's favour;**
- **as Mr Maitland's request had failed, O2 were entitled to a contribution towards their costs in the amount of £300.**

**Dated this 12th day of July 2007**

**C J BOWEN  
For the Registrar  
The Comptroller-General**

Annex A

O-122-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK REGISTRATIONS  
NOs. 2325253 AND 2308256  
IN THE NAME OF PHILIP MAITLAND**

**AND**

**IN THE MATTER OF APPLICATIONS FOR A  
DECLARATION OF INVALIDITY NOs. 81656 AND 81657  
THERE TO BY O2 LIMITED**

**IN THE MATTER OF** trade mark registrations Nos. 2325253 and 2308256  
in the name of Philip Maitland

**AND**

**IN THE MATTER OF** applications for a Declaration of Invalidity  
Nos. 81656 and 81657 thereto by O2 Limited

## **BACKGROUND**



1. The trade mark  was applied for on 16 August 2002, has been registered since 28 February 2003 under number 2308256, stands in the name of Philip Maitland and is registered in respect of:

Class 33:  
Spirits.



2. The trade mark  was applied for on 3 March 2003, has been registered since 22 August 2003 under number 2325253, stands in the name of Philip Maitland and is registered in respect of:

Class 33:  
Flavoured vodka.

3. On 11 March 2004, O2 Limited filed applications for declaration of invalidity of the registrations. The action was filed on Form TM26(I) together with the appropriate fee. The statement of case accompanying the applications set out the grounds of action, which are as follows:

- Under sections 47(2) and 5(4)(a) of the Act as the applicant claims reputation in the trade mark O2 and a wide range of “bubble” imagery used in the

telecommunications service and product field since as early as 2001 and that use of the registration would amount to passing off.

- Under sections 47(2) and 5(3) of the Act as the applicant claims reputation and goodwill in the trade mark O2 and a wide range of “bubble” imagery and that use of the registrant’s mark would be use without good cause that would take unfair advantage of or be detrimental to the reputation of the application and/or the distinctive character of the applicant’s trade marks.
- Under sections 47(2) and 5(2)(b) of the Act as the applicant claims that the registrant’s mark contains the prominent element O2 along with a get-up comprising a background of bubbles and covers similar goods to the information service relating to food and restaurants covered by the applicant’s registrations and use of the registrant’s mark is likely to cause confusion on the part of the public with the applicant’s earlier trade marks.

The applicant gave details of its earlier registered trade marks in the statement of case, these were listed as:

Registration Number	Mark	Class(es)
2198460	O2 Zone Device	3, 5, 9, 16, 41, 42
2279371	O2 Device	9, 38
2284423	O2ONLINE	9, 36, 38, 39
2284487	O2 Device and Bubbles	9, 38
2284489	O2 Device and Bubbles	9, 38
2296255	O2	9, 38
2331282	O2 and Bubbles Device	9, 38
E2109627	O2	9, 35, 36, 38, 39
2249386A	O2	26, 35, 36, 37, 39, 41, 42
2249386B	O2	26, 35, 36, 37, 39, 41, 42
2267312	O2 Device	38
2271228	O2	38, 42
E2284818	O2	38, 41
2284482	Bubbles Device	9, 38
2284483	Bubbles Device	9, 38
2284485	Bubbles Device	9, 38
2287748	Bubbles Device	9, 38
2287750	Bubbles and O2 Device	9, 38
2298339	Bubbles Device	9, 35, 36, 38, 39, 41, 42, 43, 44
2298341	Bubbles Device	9, 35, 36, 38, 39, 41, 42, 43, 44
2298342	Bubbles Device	9, 35, 36, 38, 39, 41, 42, 43, 44
2298346	Bubbles Device	9, 35, 36, 38, 39, 41, 42, 43, 44
2298347	Bubbles Device	9, 35, 36, 38, 39, 41, 42, 43, 44

The trade marks that are devices or contain device elements are reproduced as Appendix A.

4. On 19 May 2004 a copy of the application for invalidation and the statement of grounds were sent by recorded delivery to the address for service shown on the register. This was returned on 1 June 2004 marked “not called for”, and re-sent via normal mail. In the event the registered proprietor did not file a counter-statement to defend his registration. The consequences of failure to defend the registration were set out in the letter dated 19 May 2004, namely that the application for declaration of invalidity could be granted in whole or in part.

5. It does not however follow that the uncontested nature of this action will automatically mean success for the applicant for invalidity and failure for the registered proprietor. The onus in these circumstances is on the applicant for invalidity to prove why it is that the registration should be declared invalid.

6. I am mindful of the decision in the *Firetrace Case* (BL O/278/01) where the Hearing Officer stated:

“ . . . It is not sufficient to simply allege that a registration offends either section 46 or 47 of the Act without doing more to prove that the allegation has substance. That said, when an application for revocation (other than non-use) or invalidation is made and the registered proprietors choose not to respond to such a request, I do not think that it is necessary for the applicants in those circumstances to have to fully substantiate their allegations beyond providing evidence which supports a prima facie case.”

7. The reason that the Hearing Officer arrived at this view is the statutory presumption in Section 72 of the Act which states:

“In all legal proceedings.....the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.”

8. With this in mind, on 16 July 2004, the Registrar wrote to the applicant’s representative inviting him to file any evidence or make any submission which he felt would support his client’s application to, at the least, establish a prima facie case. He was also invited to state whether he wished to be heard or would accept a decision from the papers filed.

9. On 11 February 2005 the applicant for invalidity completed its evidence detailing the case against the registered proprietor. They also stated that they were content for the decision to be taken on the basis of the papers filed.

10. In each case the evidence and exhibits submitted consist of two witness statements, by Tom Sutton, Head of Advertising of O2 (UK) Limited, the first dated 25 July 2004, with twenty four exhibits, and the second dated 27 January 2005, with three exhibits. Exhibits 5, 12 and 16 of the first witness statement were submitted to proceedings in the High Court and of these 5 and 16 have been withdrawn from these proceedings, exhibit 12 has been replaced by exhibit 25 under cover of the second witness statement. Thus the total number of exhibits is twenty four.

11. The first witness statement commences by explaining the relationship between the holding company, MMO2 Plc, and O2 (UK) Limited and O2 Limited (Exhibit 1); that the applicant company was incorporated on 19 November 2001 following the de-merger of the applicant company from BT Cellnet carrying with it an existing customer base of 10 million persons; that following the de-merger on 15 January 2002 there was a £1 Billion bond issue, on 1 May 2002 the launch of the O2 brand, on 18 June 2002 the launch of the XDA phone and on 18 November 2002 the applicants business broke the then record for text messages (Exhibits 2, 3, 4 and 6); that a new web site was introduced, [www.o2.co.uk](http://www.o2.co.uk), with 500,000 customers online; that the applicant sponsored the reality television programme “Big Brother 3” in 2002 (Exhibit 7); that the applicant sponsored the television programme “Pop Stars – The Rivals” in 2002, the final of which generated 500,000 text message votes in one hour (Exhibit 8); that the applicant has, since August 2002, sponsored Arsenal FC (Exhibit 9); that the applicant has, since November 2002, sponsored the England Rugby Union team (Exhibit 10); that many press releases promoting the O2 brand were issued during the year 2002, enumerated below (Exhibit 11); that there was extensive television advertising in the UK promoting the O2 brand (Exhibits 13, 14, 15, 16, 17, 18, 19 and 20); that a large amount of money was expended on advertising the O2 brand (Exhibit 21), totalling over £93 Million in the period April 2002 to June 2004; that studies were commissioned to track “Advertising Awareness” and “Brand Awareness” (Exhibit 22); that the development and progress of the applicant companies O2 brand is detailed in its annual reports and financial statements (Exhibits 23 and 24); the witness goes on to state that he believes the O2 brand along with the blue background and bubble imagery has achieved a reputation as a leading brand in mobile phone services, has a strong association with sporting brands and youth events, and that association with an alcoholic drink will be negative to and take advantage of the O2 brand.

- Exhibit 1 – copies of pages from the Companies House web site relating to MMO2 Plc, O2 (UK) Limited and O2 Limited, also a copy of a page from the web site [www.mmo2.com](http://www.mmo2.com) listing the companies comprising the MMO2 group.
- Exhibit 2 – copies of pages from the web site [www.mmo2.com](http://www.mmo2.com) detailing “key milestones” in the development of the applicant company, as mentioned above.
- Exhibit 3 – copies of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) detailing “key milestones” in the development of the applicant company through press releases issued in 2001, as mentioned above.
- Exhibit 4 – copies of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) detailing “key milestones” in the development of the applicant company through press releases issued in 2002, as mentioned above.
- Exhibit 5 – has been withdrawn from these proceedings.
- Exhibit 6 – copy of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) being the press release issued in 2002 relating to the launch of the XDA phone, as mentioned above.

- Exhibit 7 – copy of an online article, from the web site [www.realitynewsonline.com](http://www.realitynewsonline.com), dated 8 January 2002 detailing the live final of the reality television programme “Big Brother 3”, there is no mention of O2 in the article.
- Exhibit 8 – copy of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) being the press release issued in 2002 relating to the record number of text messages received in the one hour final vote from the viewers of “Popstars – The Rivals”, over 200,000.
- Exhibit 9 – copy of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) being the press release issued in 2002 relating to the sponsorship of Arsenal FC, also copies from the web site [www.arsenal.com](http://www.arsenal.com) showing the O2 trade mark displayed on the official club web site.
- Exhibit 10 – copy of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) being the press release issued in 2002 relating to the sponsorship of the England Rugby Union team.
- Exhibit 11 – copies of pages from the Media Centre section of the web site [www.mmo2.com](http://www.mmo2.com) being the press release issued in 2002, first a summary of press releases for the year, also copies of press releases relating to – the roll out of the Blackberry wireless E-mail solution (2 press releases), the growth of contract customers, the partnership agreement with IT companies for a new range of mobile data services, the new policy for radio communications for the Ministry of Defence, the analysts estimate of end of year figures for financial year ending 31 March 2002, the preliminary announcement of end of year figures for financial year ending 31 March 2002, the growth of mobile data services, future developments, growth in customer numbers and mobile data (2 press releases), a report from the BBC web site about the television programme “Big Brother 3” (with no reference to O2 in the report), the release of a games service for mobile phones, the estimate of half year figures for the period ending 30 September 2002, the launch of an interactive service, the first anniversary of the business as an independent company and the announcement of the interim results for period ending 30 September 2002.
- Exhibit 12 – see Exhibit 25.
- Exhibit 13 – a copy of an advert for the XDA product including the trade mark O2 and bubble imagery, dated May 2002.
- Exhibit 14 – copies of adverts used during the Big brother 3 television programme including the trade mark O2 and bubble imagery, May to July 2002.
- Exhibit 15 – copies of eleven adverts shown during the period April to June 2002, all including the trade mark O2.
- Exhibit 16 – has been withdrawn from these proceedings.

- Exhibit 17 - a copy of an advert used for Christmas 2002, promoting the XDA product and including the trade mark O2 and bubble imagery.
- Exhibit 18 – a copy of an advert shown during the period April to June 2003, promoting “bolt-ons” and including the trade mark O2 and bubble imagery.
- Exhibit 19 – a copy of an advert shown during the period April to June 2003, promoting “O2 active” and including the trade mark O2 and bubble imagery.
- Exhibit 20 – copies of adverts detailing sponsorship of the England Rugby Union team, including the trade mark O2 and bubble imagery, dated December 2003.
- Exhibit 21 – a copy of a spreadsheet document detailing advertising expenditure on a month by month basis from April 2002 to Feb 2004:

April 2002	£ 1,716,779
May 2002	£ 6,843,705
June 2002	£ 5,389,472
July 2002	£ 2,581,523
August 2002	£ 1,488,049
September 2002	£ 1,281,495
October 2002	£ 4,003,028
November 2002	£ 4,298,307
December 2002	£ 4,600,839
January 2003	£ 1,164,269
February 2003	£ 1,405,673
March 2003	£ 1,375,612
April 2003	£ 8,457,035
May 2003	£ 3,046,843
June 2003	£ 2,844,671
July 2003	£ 3,002,537
August 2003	£ 1,443,911
September 2003	£ 5,025,196
October 2003	£ 4,656,592
November 2003	£ 3,699,455
December 2003	£ 1,708,190
January 2004	£ 886,911
February 2004	£ 4,742,188
Total	£ 75,662,280

Also a spreadsheet detailing the expenditure by media during the period April 2002 to June 2004

Cinema	£ 2,446,340
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Direct Mail	£ 5,937,379
Internet	£ 3,250,733
Outdoor	£ 16,344,967
Press	£ 22,713,474
Radio	£ 5,499,244
TV	£ 36,821,076
Total	£ 93,013,213

- Exhibit 22 – a copy of a PowerPoint display detailing the results of mobile phone user surveys relating to “Advertising Awareness”, showing that at the end of the period studied the O2 brand is second only to the ORANGE brand, and “Brand Awareness”, showing that at the end of the period studied the O2 brand is third behind the ORANGE and VODAFONE brands.
- Exhibit 23 – copies of the Annual Review 2003 and Annual Report and Financial Statement 2003, which shows that total revenue for the financial year 02/03 reached £ 3,025 Million and the customer base had risen to over 12 Million.
- Exhibit 24 – a copy of the Annual Report and Financial Statement 2002.

12. The second witness statement commences by explaining that proceedings are taking place in the High Court between the applicant company and Hutchinson 3G UK Limited and Exhibits 5, 12 and 16 have been submitted in those proceedings, as a result of the court proceedings Exhibits 5 and 16 have been withdrawn from these proceedings; that Exhibit 25, a CD-ROM containing copies of 16 television advertisements and 82 other advertisement media, includes the television advertisement previously submitted as Exhibit 12; that Exhibit 26 consists of paper copies of advertisements and other promotional material also found on the CD-ROM constituting Exhibit 25 and that Exhibit 27 contains copies of representations of nine of the trade marks used as the basis of these proceedings with a variety of representations of the bubble imagery in actual use.

- Exhibit 25 – a CD-ROM containing copies of 16 television advertisements and pictures of 82 other advertising media, including posters, billboards, point of sale displays and beer mats. The television advertisement, previously referred to as Exhibit 12, is a copy of an advert including the trade mark O2 and bubble imagery, dated May 2002.
- Exhibit 26 – hard copies of fourteen of the pictorial advertisements contained on the CD-ROM which comprises Exhibit 25, these all being used between April 2002 and November 2002 inclusive.
- Exhibit 27 – copies of the images which constitute trade marks 2284482, 2284483, 2284485, 2287748, 2298339, 2298341, 2298342, 2298346 and 2298347, the Bubble device marks, and examples of the marks in use on advertising material.

13. Acting on behalf of the Registrar and after a careful study of the papers before me I give the following decision.

## DECISION

14. The applicant claims that the registration should be declared invalid as per section 47 of the Act on the basis of the provisions of sections 3(6), 5(2)(a) and/or (b), 5(3) and 5(4)(a). The relevant parts of section 47 of the Act are as follows:

“47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) The registration of a trade mark may be declared invalid on the ground-

- (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
- (b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

15. First I will set aside registration number 2331282 as this has a filing date later than the registrations in suit. The relevant section of the Act is as follows:

“6. - (1) In this Act an “earlier trade mark” means –

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
- (b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark.

(2) . . . .

(3) . . . .”

The date of application of registration 2331282 is 6 May 2003, whilst the date of application of the marks in suit is 16 August 2002 for registration 2308256 and 3 March 2003 for registration 2325253. It is therefore a later filed mark than either of those in suit and cannot be used as the basis for action under section 5 of the Act.

16. In considering the application of the principles of law under each of the sections below I also bear in mind the written submissions filed under cover of a letter dated 9 March 2005 by Boulton Wade Tenant on behalf of the applicant.

### **Section 5(2)(b)**

17. This reads:

“5.- (2) A trade mark shall not be registered if because -

(a) .....

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

18. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

19. In essence, the test is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those differing elements, taking into account the degree of identity/similarity of the goods/services and how they are marketed. In comparing the marks I must have regard to the distinctive character of each and assume normal and fair use of the marks across the full range of the goods and services within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant.

20. The essential element of the marks in suit is the letter and numeral “O<sub>2</sub>” on a roughly rectangular background; in the first mark there are the additional elements “VODKA” in a stylised form above the rectangle and the words “Premium Sparkling Vodka” below the rectangle; in the second mark there are the additional elements “VODKA” in a stylised form above the rectangle and the word “RUSH” below the rectangle.

21. With regard to the following marks cited by the applicant, 2198460, 2279371, 2284423, 2284487, 2284489, 2296255, E2109627, 2249386A, 2249386B, 2267312, 2271228, E2284818

and 2287750, the essential element of the marks are the letter and numeral “O<sub>2</sub>”, generally represented in the form “O<sub>2</sub>”, either solus or on a dark rectangular background.

22. In the case of 2279371, 2296255, E2109627, 2249386A, 2249386B, 2271228 and E2284818 the mark is generally “O<sub>2</sub>”, or sometimes in the form “O2”, solus either in normal typescript form or stylised form. In the case of 2284487, 2284489, 2267312 and 2287750 the mark is “O<sub>2</sub>” solus either in normal typescript form or stylised form on a rectangular background, in the case of 2284487, 2284489 and 2287750 with accompanying “bubble devices”. In the case of 2198460 the mark is “O2” with the additional word “ZONE” on the bottom stroke of the numeral and in the case of 2284423 the mark is the letter and numeral combination “O2ONLINE”.

23. In the marks in suit the words “VODKA” and “Premium Sparkling Vodka” are descriptive of the goods and therefore non-distinctive. The word “RUSH” may be characterised as the effect that the drinker of the “flavoured vodka” drink might get, but is represented in a smaller typescript below the “O<sub>2</sub>” forming the body of the mark, whilst it cannot be regarded as non-distinctive it does not detract from the essential nature of the mark as an “O<sub>2</sub>” mark.

24. In chemical notation “O” is oxygen, “H<sub>2</sub>O” is Hydrogen Oxide, or water, and the association with oxygen and water is made by the applicants marks 2284487, 2284489 and 2287750 which associate the mark “O<sub>2</sub>” with gas, air or oxygen bubbles in water. The use of the marks in the form “O<sub>2</sub>” will suggest to the public a chemical notation for a form of oxygen, and there is therefore a conceptual similarity.

25. Essentially the marks in suit and the marks cited above are all “O<sub>2</sub>” marks and as such are visually, orally and conceptually similar.

26. However, the following cited marks raised by the applicant are purely device marks consisting of “bubble” arrangements, gas, air or oxygen in water, the relevant marks are 2284482, 2284483, 2284485, 2287748, 2298339, 2298341, 2298342, 2298346 and 2298347. The marks in suit appear to be on plain rectangular backgrounds with no similar representation of bubbles. In their submission the applicants assert that there are bubbles in the background to the marks in suit, I cannot identify these bubbles and as such there cannot be any similarity between the marks.

27. There is therefore a similarity between the marks in suit and the applicants cited marks 2198460, 2279371, 2284423, 2284487, 2284489, 2296255, E2109627, 2249386A, 2249386B, 2267312, 2271228, E2284818 and 2287750.

28. I must now go on to consider the goods and services of the specifications. The specification of the marks in suit are “Spirits”, in the case of 2308256, and “Flavoured vodka”, in the case of 2325253, both being in Class 33 of the International Classification system. No Class 33 goods appear in any of the specifications of the earlier trade marks. The specifications of the earlier marks claimed by the applicant are displayed at Appendix B.

29. I therefore have to consider if any of the elements of the specifications are similar to the goods “Spirits” and “Flavoured vodka” despite being in different classes in the International

Classification system. If there are no similar goods and/or services I cannot consider the ground in relation to Section 5(2).

30. In their submissions the applicant argues that the services “Information and advisory services in respect of food and restaurants” contained within the Class 43 specification of registrations 2298339, 2298341, 2298342, 2298346 and 2298347 are similar to the goods “Spirits” and “Flavoured vodka”. They submit that the terms “food” and “restaurants” must be similar to the nature of goods such as “alcohol”. However, in this comparison we are considering “goods” against an “information and advisory service” and the similarity between the two. I also take into account that there is no similarity between the marks in suit and the cited marks which have this specification, see paragraph 26 above.

31. In *Daimlerchrysler AG v Office for Harmonization In the Internal Market (Trade Marks and Designs)* [2003] E.T.M.R. 61 the Court of First Instance (CFI) stated:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

In *Devinlec Développement Innovation Leclerc SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 147/03 the CFI held:

“104 Consideration of the objective circumstances in which the goods covered by the marks are marketed is fully justified. The examination of the likelihood of confusion which the OHIM authorities are called on to carry out is a prospective examination. Since the particular circumstances in which the goods covered by the marks are marketed may vary in time and depending on the wishes of the proprietors of the trade marks, the prospective analysis of the likelihood of confusion between two marks, which pursues an aim in the general interest, that is, the aim that the relevant public may not be exposed to the risk of being misled as to the commercial origin of the goods in question, cannot be dependent on the commercial intentions, whether carried out or not, and naturally subjective, of the trade mark proprietors.....

107 It follows that by taking into consideration in the assessment of the likelihood of confusion between the marks the particular circumstances in which the goods covered by the earlier mark are marketed, the temporal effect of which is bound to be limited and

necessarily dependent solely on the business strategy of the proprietor of the mark, the Board of Appeal erred in law.”

Geoffrey Hobbs QC, sitting as the appointed person, in *Croom’s Trade Mark Application* [2005] R.P.C. 2, stated:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account. However, the protection claimed by the opponent independently of registration ( *i.e.* under s.5(4)(a) of the Act) must relate to the actual and anticipated use of the rival marks.”

The effect of the above authorities is that in considering goods or services in specifications it is necessary to consider them across the entire gamut of normal and fair use. In their submission the applicant invites me to consider a variety of potentially hypothetical scenarios which might lead the public to confusion, e.g. where the applicants’ web site, clearly displaying the “O<sub>2</sub>” and bubble brand, links to a sponsorship web site that endorses vodka drinks or has cocktail recipes. I have no evidence that the public could, or would, make that connection and it is outwith anything in my experience. I cannot accept this therefore as an extension of normal and fair use of the cited marks for the goods and services for which they are registered.

32. Taking all these factors into account I have come to the view that the similarities between the marks are offset by the complete lack of similarity between the goods and services for there to be a likelihood of confusion. The opposition fails under Section 5(2)(b).

### **Section 5(3)**

33. I go on to consider the ground under Section 5(3). As a result of regulation 7 of The Trade Marks (Proof of Use etc) Regulation 2004 Section 5(3) now reads:

“5.(3) A trade mark which -

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

34. The scope of the Section has been considered in a number of cases notably *General Motors Corp v Yplon SA (Chevy)* [1999] E.T.M.R. 122 and [2000] R.P.C. 572, *Premier Brands UK Limited v Typhoon Europe Limited (Typhoon)* [2000] R.P.C. 767, *Daimler Chrysler v Alavi (Merc)* [2001] R.P.C. 42, *C A Sheimer (M) Sdn Bhd’s Trade Mark Application (Visa)* [2000]

R.P.C. 484, *Mastercard International Inc and Hitachi Credit (UK) Plc* [2004] E.W.H.C. 1623 (Ch) and *Electrocoin Automatics Limited and Coinworld Limited & others* [2004] E.W.H.C. 1498 (Ch).

35. The Section was also considered in a recent case for opposition, *Intel Corp Inc v Sihra* [2003] R.P.C. 44, at paragraph 19:

“I consider that a fair view of the evidence is that by July 1995 the INTEL mark was widely known and recognised as a mark distinctive in its own right, with an established reputation in the eyes of the consumer in relation to computers and computer-linked products. . . .”

36. There are parallels with this case in as far as within a short space of time the applicant has established a reputation for its mobile phone and telecommunications service, and I think this is well established by the evidence enumerated above. However, the reputation is only within that narrow sphere and in my view the issue is whether it is strong enough to support a ‘Chevy reputation’ in relation to a wider range of goods.

37. Following the ECJ’s judgments in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd*, Case C-292/00, and *Adidas-Salomon AG and Adidas Benelux BV v Fitness World Trading Ltd*, Case C-408/01, it is clear that Section 5(3) also applies to goods or services which are similar or identical as well as those which are not similar. Hence the amended version of Section 5(3) set out above. Dissimilarity, like similarity, is a matter of degree and the relative proximity or distance between parties’ goods and services is a factor that is likely to bear firstly on whether consumers will make an association between them in the light of the reputation attaching to an applicant for invalidity’s earlier trade mark and secondly on whether one of the adverse consequences envisaged by Section 5(3) is made out.

38. It will be convenient at this point to set out the nature of the test to be applied in determining whether there is unfair advantage or detriment and the standard of proof that is called for.

39. In the *Chevy* case, the Advocate General said:

“43. It is to be noted in particular that Article 5(2), in contrast to Article 5(1)(b), does not refer to a mere risk or likelihood of its conditions being fulfilled. The wording is more positive: “takes unfair advantage of, or is detrimental to” (emphasis added). Moreover, the taking of unfair advantage or the suffering of detriment must be properly substantiated, that is to say, properly established to the satisfaction of the national court: the national court must be satisfied by evidence of actual detriment, or of unfair advantage. The precise method of adducing such proof should in my view be a matter for national rules of evidence and procedure, as in the case of establishing likelihood of confusion see the tenth recital of the preamble.”

40. More recently in *Mastercard International Incorporated and Hitachi Credit (UK) Plc* Mr Justice Smith dealt with a submission by Counsel for the Appellant (on appeal from a Registry opposition decision) that Section 5(3) was concerned with possibilities rather than actualities.

Commencing with the above passage from *Chevy*, the judge reviewed the leading cases dealing with the point including observations by Pumfrey J in the *Merc* case and Patten J in *Sihra*. He concluded that the Registry Hearing Officer had been right to conclude that there must be “real, as opposed to theoretical, evidence” that detriment will occur and that the Registry Hearing Officer was “right to conclude that there must be real possibilities as opposed to theoretical possibilities”.

41. I should just add that, whilst the above extract refers to real evidence of the claimed form of damage, this cannot mean that there must be actual evidence of damage having occurred. In many cases that come before the Trade Marks Registry, the mark under attack is either unused or there has been only small scale and recent use. No evidence of actual damage is possible in such circumstances. I, therefore, interpret the above reference to mean that the tribunal must be possessed of sufficient evidence about the use of the earlier trade mark, the qualities and values associated with it and the characteristics of the trade etc that it is a reasonably foreseeable consequence that use of the other side’s mark will have the claimed adverse consequence(s).

42. On the other hand, even if it is accepted that there will be damage, it must be more than simply of trivial extent as is evident from the following passage from *Oasis Stores Ltd’s Trade Mark Application* [1998] R.P.C. 631:

“It appears to me that where an earlier trade mark enjoys a reputation, and another trader proposes to use the same or similar mark on dissimilar goods or services with the result that the reputation of the earlier mark is likely to be damaged or tarnished in some significant way, the registration of the later mark is liable to be prohibited under section 5(3) of the Act. By ‘damaged or tarnished’ I mean affected in such a way so that the value added to the goods sold under the earlier trade mark because of its repute is, or is likely to be, reduced on scale that is more than *de minimis*”.

43. I note too the following from Mr Geoffrey Hobbs QC (sitting as a Deputy Judge) in *Electrocoin Automatics and Coinworld*:

“102. I think it is clear that in order to be productive of advantage or detriment of the kind prescribed, ‘the link’ established in the minds of people in the market place needs to have an effect on their economic behaviour. The presence in the market place of marks and signs which call each other to mind is not, of itself, sufficient for that purpose.” (footnotes omitted).

44. I now turn to the applicant’s case on unfair advantage or detriment. The evidence provided only went as far as establishing the scale of use and reputation of the registered marks. In the applicant’s submission they refer to the marks in suit as having a bubble imagery, which is not apparent from the marks as held on the Trade Marks Registry image database and reproduced at paragraphs 1 and 2 above, and the similarity is, in my view, purely between the dominant element “O<sub>2</sub>”. The submission asserts that there is likely to be negative connotations from association with alcoholic drinks and the drinks industry in general; that the use of the similar “O<sub>2</sub>” mark will cause the public to believe that there is a connection with the applicant; that with the public knowledge of the sponsorship agreements of the applicant, with sports clubs and

sporting organisations, they will draw the conclusion that the use is licensed by the applicant; that the applicant's reputation could be damaged by the use of the marks in suit on poor quality goods over which the applicant has no control; that the marks in suit have been selected specifically to trade off the brand values that the applicant seeks to establish for their own products and services, stated as "bold, clear, open and trusted"; that the brand values of the applicant are not those one would associate with alcoholic products, citing existing advertisements for another alcoholic product as emphasising "wickedness", encouragement to "lie" and appearing "seedy".

45. The first matter to be considered is whether the link referred to in these submissions exists or is reasonably likely to exist.

46. In the *Sihra* case Mr Justice Patten accepted:

"22 . . . . the general proposition that s.5(3) is not intended to prevent the registration of any mark whatsoever which is similar to a trade mark with the necessary character and reputation, even if the use of the similar mark will lead to an association in the mind of the consumer between the two marks."

But without that link or association one does not get to a consideration of unfair advantage or detriment.

47. The link or association does not have to be one that establishes confusion (*Premier Brands UK Ltd v Typhoon Europe Ltd*) and, as also noted in that case, it will generally be less hard to establish a link or association between a sign and a mark than to establish confusion. Unlike the *Sihra* case, where survey evidence was filed showing the public's reaction to the mark in issue when presented in the context of toy construction blocks, I have no survey or other independent evidence before me in this case dealing with whether association exists or, if established, the degree, strength and nature of the association. I must, therefore, make up my own mind on the matter having regard to the marks themselves, the extent of the applicant's reputation and the scope of the registered proprietor's specification.

48. There is simply no information on the companies involved in this dispute to say whether their existence and trading activities has had any discernible impact on the relevant public's perception of and approach to the mark "O2", although the applicant has provided evidence relating to their position within the mobile telecommunications market.

49. The issue before me is the degree of connection or association, if any, in the minds of the public between the "O<sub>2</sub>" signs used in relation to mobile and data telecommunications related products and services on the one hand and as used in relation to spirits and flavoured vodka products on the other. The applicant's case, as laid out in paragraph 44 above, is that the public perspective would be affected through negative connotations, primarily, from the association with alcoholic drinks. Thereby the applicant's marks being adversely affected as this association will take unfair advantage of their reputation and be detrimental to their goodwill and reputation in the UK.

50. I have not, therefore, found the issue of connection or association to be a straightforward one to decide. The marks in these proceedings are essentially “O<sub>2</sub>” marks and I am prepared to accept that customers for the services offered by the applicant would be reminded of their brand because of the widespread knowledge and repute of that brand. However, I also have to conclude whether that association would be other than a fleeting and shallow one because of the separation of the products and services.

51. The applicant claims in their submission that both unfair advantage and detriment will flow from any association that is made. The Act clearly places the onus on the applicant for invalidity to establish an association leading to one or more of the adverse consequences of unfair advantage or detriment.

52. Considering unfair advantage first, there have been a number of cases that have pointed to the need for an applicant for invalidity or opponent to establish his case to a more than trivial extent. Thus in the *Visa* case, the Appointed Person held that:

“I think it is clear that Sheimer [the applicant for registration] would gain attention for its products by feeding on the fame of the earlier trade mark. Whether it would gain anything more by way of a marketing advantage than that is a matter for conjecture on the basis of the evidence before me. Since I regard it as quite likely that the distinctive character or reputation of Visa International’s earlier trade mark would need to increase the marketability of Sheimer’s products more substantially than that in order to provide Sheimer with an unfair advantage of the kind contemplated by section 5(3) I am not prepared to say that requirement (iv) is satisfied.”

53. In the *Sihra* case Intel had based its case partly on unfair advantage but Mr Justice Patten in finding in favour of Intel on Section 5(3) grounds expressed himself in cautious terms in relation to unfair advantage:

“24 It seems to me very likely that the use of the mark INTEL-PLAY will feed on the earlier mark and lead to greater sales of the applicant’s products than could be achieved using the existing LOXOL mark. But there is understandably no evidence of likely scale. I am therefore content to base my decision on the detriment .....

54. In accepting an association based on the presence of the element “O<sub>2</sub>”, I have to decide whether the marks in suit would gain any marketing or other advantage in their favour. The fact that the applicant’s brand brings with it a very strong reputation for high quality and technologically advanced products and services does not, on its own, mean that consumers will respond more favourably upon seeing a bottle of alcoholic drink bearing the same brand. However, the extension of that reputation through sponsorship with sports clubs and sporting organisations brings the “O<sub>2</sub>” brand squarely into popular culture where alcoholic drinks seem to be an essential part of a lifestyle associated with those clubs and organisations. Thus the marks in suit may gain a marketing advantage, with higher levels of sales, through the association of their marks with the brand of the applicant. I, therefore, find that the applicant succeeds under the unfair advantage head.

55. Detriment to distinctive character or repute can take the form of blurring or tarnishing – see *Premier Brands* for a discussion of the circumstances in which these forms of damage can arise. The applicant has largely pleaded its case in terms of generalised assertions. However, it is possible to discern two strands of thinking in the way it has presented its case. Firstly, that the distinctiveness will be damaged as a result of use of “O<sub>2</sub>” for the goods in respect of which it is registered through a lack of quality of those goods; and secondly, that there are negative connotations associated with those products that would adversely affect their brand.

56. With regard to these submissions the applicant cannot provide evidence as to the quality of the alcoholic products which may have been traded under the marks in suit and they also cannot provide evidence upon which to base the conclusion that there will be any material damage to the applicant’s marks as a result of adverse association with use of a similar mark for alcoholic products.

57. Nevertheless, considerable care is needed where marks enjoy the sizeable reputation that the applicant’s do, that reputation has strength in depth rather than breadth. It is not, in my view, comparable to, say, the Virgin brand which has been deployed across a very wide range of unconnected goods and services. I am not prepared to say that “O<sub>2</sub>” cannot bridge any gap but there is considerable distance between the respective areas of business.

58. In *Oasis Stores Ltd’s Trade Mark Application* [1998] R.P.C. 631 the Hearing Officer said:

“Any use of the same or a similar mark for dissimilar goods or services is liable, to some extent, to dilute the distinctiveness of the earlier mark. The provision is clearly not intended to have the sweeping effect of preventing the registration of any mark which is the same as, or similar to, a trade mark with a reputation. It therefore appears to be a matter of degree.”

That decision was referred to with approval in *Premier Brands*.

59. As already stated above, at paragraph 54, through the sponsorship of sports clubs and sporting organisations the applicant will gain an association with the alcohol drinking sporting culture and any alcoholic product carrying a similar, almost identical, mark may act to be detrimental to their reputation and character. Whilst they will wish to be associated with sporting excellence of the clubs and organisations they sponsor, on the sports field, they will want to avoid association with the negative aspects of the surrounding culture, and this will include the drinking of alcohol.

60. Weighing the above factors in the balance I come to the conclusion that there is a likelihood that there could be material damage to the distinctiveness or singularity of the applicant’s brand if the marks in suit are used in a normal and fair manner in relation to the goods in question. The application for a declaration of invalidity succeeds under the detriment to distinctive character or repute head.

61. I go on to consider if there is a ‘due cause’ defence. Guidance on this aspect of Section 5(3) can be found in *Premier Brands* (page 1096 et seq) which in turn referred with approval to the views of the Benelux Court on comparable wording in *Lucas Bols* [1976] I.I.C. 420 at 425:

“What this requires, as a rule, is that the user (of the mark) is under such a compulsion to use this very mark that he cannot honestly be asked to refrain from doing so regardless of the damages the owner of the mark would suffer from such use, or that the user is entitled to the use of the mark in his own right and does not have to yield this right to that of the owner of the mark ...”.

On the same page, the court went on to suggest that a “justifiable reason” may be “if the user can assert an older right than that of the [registered proprietor]” but went on to emphasise that whether the alleged infringer can establish a “justifiable reason” must be “resolved by the trial judge according to the particular facts of each case”.

62. The example quoted above relates to the position where a party has an ‘older right’ but taken in context does not appear to rule out the possibility of due cause being considered where a junior but concurrent right of sufficient extent and duration has been established.

63. I have no evidence from the registered proprietor to establish whether his marks are in use and if so from what date and what reputation they may have established. There is also no evidence from the registered proprietor to establish why he chose such a similar mark if not to trade off the reputation of the applicant. I am therefore not persuaded that, in all the circumstances, the registered proprietor should be entitled to claim the benefit of a ‘due cause’ defence in relation to the subject marks.

64. The application for a declaration of invalidity on the basis of section 5(3), therefore, succeeds.

#### **Section 5(4)(a)**

65. Finally I consider the ground under Section 5(4)(a), which reads:

(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) . . . . .

66. The requirements for this ground of action have been restated many times and can be found in the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Wild Child* trade mark [1998] R.P.C. 455. Adapted to these proceedings, the three elements that must be present can be summarised as follows:

- (1) that the applicant's goods and services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the registered proprietor (whether or not intentional) leading or likely to lead the public to believe that goods offered by the registered proprietor are goods of the applicant, and
- (3) that the applicant has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the registered proprietor's misrepresentation.

67. In their submissions the applicant accepts that there is no common field of activity between the parties but nevertheless reassert the arguments already raised under section 5(3) above. Additionally they assert that “. . . the applicant is likely to suffer damage by the injury which is inherently likely to be suffered by it when on the frequent occasions it is confused by customers or potential customers with a business owned by another proprietor, or is wrongly regarded as being connected with the business. We submit that this will potentially injure the trade reputation of the applicant if there were any failings in the products offered for sale by the registered proprietor.” This appears to be a general assertion that could be made in virtually all cases and requires an element of evidential substantiation.

68. I believe that there is sufficient evidence to justify the applicant's claim to a reputation under this head. However, in this instance no evidence has been directed to any of the other elements which must be present, only assertions by the applicant, and there is therefore nothing to substantiate this ground of action. Therefore, I dismiss the application in so far as it is based upon section 5(4)(a) of the Act.

## **Result**

69. I find that the respective trade marks are similar but are not registered for goods or services which will result in confusion on the part of the public, which includes association with the earlier trade marks, therefore this action has failed on the Section 5(2)(b) ground. There is insufficient evidence to establish the applicant's claim under the Section 5(4)(a) ground and that fails also.

70. However, the applicant has succeeded under the Section 5(3) ground and the registered proprietor's trade marks should be removed from the register.

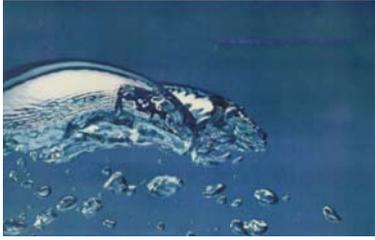
**Costs**

71. The applicant has been successful and is entitled to a contribution towards its costs. In all the circumstances I order the registered proprietor to pay the applicant the sum of £800. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11<sup>th</sup> day of May 2006**

**Graham Attfield  
For the Registrar  
the Comptroller General**

Appendix A

		
<p>2198460</p>	<p>2279371</p>	<p>2284487</p>
		
<p>2284489</p>	<p>2296255</p>	<p>2331282</p>
		
<p>2249386A</p>	<p>2267312</p>	<p>2284482</p>
		
<p>2284483</p>	<p>2284485</p>	<p>2287748</p>

					
<b>2287750</b>		<b>2298339</b>		<b>2298341</b>	
					
<b>2298342</b>		<b>2298346</b>		<b>2298347</b>	

**Appendix B**

Registration Number	Mark	Class(es) and Specification(s)
2198460	O2 Zone Device	<p>Class 03: Soaps, perfumery, essential oils, cosmetics, hair lotions, dentifrices, plant and flower remedies.</p> <p>Class 05: Pharmaceutical and plant-based preparations and dietetic substances adapted for medical use, plasters, materials for dressings, first-aid preparations, dental preparations, disinfectants, fungicides and herbicides, homeopathic preparations, plant-based healing creams and ointments, first-aid preparations.</p> <p>Class 09: Photographic, cinematographic and teaching apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; recording discs; downloadable electronic publications.</p> <p>Class 16: Paper, cardboard and goods made from cardboard; magazines, newspapers and periodicals; stationery; photographs; adhesives for stationery; plastic materials and natural fibres for packaging; printers' type, printing blocks.</p> <p>Class 41: Education, providing of training, entertainment; all relating to alternative medicine and/or health; sporting and cultural activities; providing on-line electronic publications.</p> <p>Class 42: Providing information on health; medical, hygienic and beauty care; scientific research; computer programming, veterinary and agricultural services; provision of information relating to alternative medicine.</p>

2279371	O2 Device	Class 09: Mobile telecommunications apparatus; mobile telecommunications headsets. Class 38: Mobile telecommunications services; telecommunications portal services; Internet portal services; mobile telecommunications network services; Internet access services; applications services provision.
2284423	O2ONLINE	Class 09: Mobile communications apparatus and instruments. Class 36: Information services in respect of finance; financial sponsorship services. Class 38: Telecommunications services; telecommunications portal services; Internet portal services; Internet access services. Class 39: Information services in respect of travel.
2284487	O2 Device and Bubbles	Class 09: Mobile communications goods and parts and fittings therefor. Class 38: Mobile communications services; Internet portal services.
2284489	O2 Device and Bubbles	Classes 09 and 38 as 2284487 above.
2296255	O2	Class 09: Mobile communications apparatus; mobile communications handsets; mobile communications headsets; parts and fittings for the aforesaid goods. Class 38: Telecommunication and data communication services provided by a mobile telephone company; operation

		of a digitalized media platform for the exchange of messages and information; WAP (wireless application protocol) services; electronic postal services, namely transmission and forwarding of electronic mail, SMS (short message services), facsimiles, WAP (wireless application protocol) services; collection and delivery of news and general information; transmission of information in the field of entertainment, general information, economy and finance, sport and cultural activities in digital networks; monitoring, processing, sending and receiving data, sounds, images and/or signals and information processed by computers or by telecommunication apparatus and instruments.
2331282	O2 and Bubbles Device	Class 09: Mobile communication apparatus and parts and fittings therefor. Class 38: Mobile communications services; telecommunications network services; telecommunications payment plans and tariffs.
E2109627	O2	Class 09: Telecommunications apparatus and instruments. Class 35: Provision of advertising services to enable others to view and purchase goods over a global computer network. Class 36: Information services relating to finance. Class 38: Telecommunications services; telecommunication of information; provision of telecommunications access and links to computer databases and to the global computer network; electronic transmission services. Class 39:

		Provision of information relating to transport and travel
2249386A	O2	<p>Class 25: Clothing, footwear, headgear.</p> <p>Class 35: Direct mail advertising; dissemination of advertising and promotional materials; compilation of mailing lists; manufacturers' representative services; preparation and issuing of publicity materials; market research; distribution and demonstration of goods and samples; business management advisory and consulting services, business services relating to the operation and management of business premises, stores, shops, stalls and markets; the bringing together for the benefit of others, of a variety of retail outlets, entertainment venues, shopping mall and shopping centre facilities and restaurants, enabling customers to conveniently view and purchase goods and make use of the services provided in a shopping centre or shopping mall.</p> <p>Class 36: Real estate agency services; real estate management and brokerage services; rental of commercial premises; property leasing services.</p> <p>Class 37: Real estate development services; shop fitting services; property maintenance services; interior refurbishment of buildings; maintenance, repair and renovation of buildings, facilities and parts and fittings thereof; cleaning of buildings (interior and exterior services) and facilities; consultancy and advisory services relating to the aforesaid.</p> <p>Class 39: Rental of garage and of parking places; provision of vehicle parking facilities; vehicle park services; delivery of goods by road; arranging the delivery of</p>

		<p>goods by road, air and by rail.</p> <p>Class 41: Education and training services in respect of staff recruitment and replacement, catering, estate agency, advertising, business management and interior design services; sporting and cultural activities; cinema, night club; amusement arcade services, but not including computer games; entertainment production and management services; theatre services; organisation of games, competitions and quizzes; bingo hall, snooker hall, night club, discotheque, dance hall and concert services.</p> <p>Class 42: Advisory and consultancy services in relation to the operation of retail outlets; kitchen, bedroom, bathroom, garden, conservatory and home design services; interior design services.</p>
2249386B	O2	Classes 25, 35, 36, 37, 39, 41 and 42 as 2249386A above.
2267312	O2 Device	Class 38: Telecommunications services; telecommunication of information (including web pages).
2271228	O2	Class 38: Internet portal services and telecommunications portal services. Class 41: News and current affairs information services. Class 42: Weather forecasting. Class 45: Fashion information services; horoscope forecasting.

E2284818	O2	<p>Class 38: Internet portal services; telecommunications portal services; provision of telecommunications access and links to computer databases and to the Internet; electronic mail services; telecommunication of information; delivery of multimedia content over electronic communications networks.</p> <p>Class 41: Information services relating to entertainment and sport.</p>
2284482	Bubbles Device	<p>Class 09: Mobile communications apparatus and instruments and parts and fittings therefor.</p> <p>Class 38: Mobile communications services; Internet portal services.</p>
2284483	Bubbles Device	Classes 09 and 38 as 2284482 above.
2284485	Bubbles Device	Classes 09 and 38 as 2284482 above.
2287748	Bubbles Device	Classes 09 and 38 as 2284482 above.
2287750	Bubbles and O2 Device	Classes 09 and 38 as 2284482 above.
2298339	Bubbles Device	<p>Class 09: Telecommunications apparatus and instruments; mobile communications apparatus and instruments and parts and fittings therefor; headsets; earpieces.</p> <p>Class 35: Marketing, promotional and advertising services; business advisory, consultancy and information services.</p> <p>Class 36: Information services and interactive database information services all relating to finance, insurance, shares and share dealing.</p> <p>Class 38: Telecommunications services; Internet access services; Internet portal services;</p>

		<p>telecommunications portal services.</p> <p>Class 39: Information services relating to travel and transport; booking and ticketing services relating to travel and transport.</p> <p>Class 41: Information and advisory services relating to education, training, entertainment, sport, recreation, theatre, television, music, news and publishing; electronic game services and competitions provided by means of telecommunication and the Internet; entertainment services provided online via the Internet.</p> <p>Class 42: Information and advisory services relating to the weather.</p> <p>Class 43: Information and advisory services in respect of food and restaurants; booking and reservation services for restaurants.</p> <p>Class 44: Information and advisory services in respect of hygiene, beauty care and health care.</p>
2298341	Bubbles Device	Classes 09, 35, 36, 38, 39, 41, 42, 43 and 44 as 2298339 above.
2298342	Bubbles Device	Classes 09, 35, 36, 38, 39, 41, 42, 43 and 44 as 2298339 above.
2298346	Bubbles Device	Classes 09, 35, 36, 38, 39, 41, 42, 43 and 44 as 2298339 above.
2298347	Bubbles Device	Classes 09, 35, 36, 38, 39, 41, 42, 43 and 44 as 2298339 above.

Annex B

O-003-07

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN INTERLOCUTORY HEARING  
IN RESPECT OF REGISTRATION NOS. 2325253 AND 2308256  
IN THE NAME OF PHILIP MAITLAND**

**AND**

**IN THE MATTER OF APPLICATIONS FOR DECLARATIONS OF INVALIDITY  
THERE TO BY O2 LIMITED UNDER NOS. 81656 and 81657**

## **RADE MARKS ACT 1994**

**IN THE MATTER OF an Interlocutory  
Hearing in respect of registration Nos.  
2325253 and 2308256 in the name of  
Philip Maitland**

**and**

**in the matter of applications for  
declarations of invalidity thereto  
by O2 Limited under Nos. 81656 and 81657.**

### **Background**

1. Trade Mark No. 2308256 was applied for on 16 August 2002 by Large Distilleries of Manchester. On 29 January 2003, a Form TM16 was filed seeking to record a change of proprietor to Philip Maitland who gave his address as Rue Jacob, Paris. The registry issued a letter dated 4 February 2003 to Mr Maitland at his Paris address asking him to contact the writer to provide an address for service in the UK. Although the letter gave no indication of this, an address for service in the UK was required under the provisions of Rule 10 of the Trade Marks Rules 2000.

2. I presume Mr Maitland telephoned the registry shortly after receiving the letter giving an address at Lindsay Drive, Harrow as on 14 February 2003, the registry issued a letter to that address, confirming the recordal of the assignment of the registration to Mr Maitland. Thus the applicant's address was recorded as Rue Jacob, Paris, with an address for service at Lindsay Drive, Harrow. The application subsequently proceeded to registration and no further changes to the address details have been made.

3. Trade Mark No. 2325253 was applied for on 3 March 2003 by Philip Maitland with an address at Lindsay Drive, Harrow. No agent was appointed so this address was also recorded as the address for service. Again the application subsequently proceeded to registration and no changes to the address details have been made.

4. Separate applications to invalidate both registrations were filed on 11 March 2004 on behalf of O2 Limited. The Registrar later sent the applications, separately, by recorded delivery to the registered proprietor at the recorded address for service at Lindsay Drive, Harrow. Both sets of documentation were subsequently returned by the Royal Mail marked "not called for". It appears from the papers on file that further copies were sent by ordinary post to the same address. The registered proprietor did not file counter-statements within the period allowed to him under the provisions of Rule 33. Both sets of proceedings continued, however, with the applicant filing evidence.

5. Nothing was heard or received from the registered proprietor and no request for a hearing was made by either party. On 11 May 2006 a decision from the papers was issued in relation to

applications for invalidation of the two registrations and was sent to both parties by recorded delivery. I should perhaps point out at this stage that whilst it is clear now that the registered proprietor for both registrations are one and the same, for reasons which are unknown to me and despite the address of the registered proprietor differing in both cases, a single decision was issued in relation to the two applications.

6. No appeal against that decision was received within the period allowed and the two registrations were subsequently recorded as having been invalidated.

7. On 7 August 2006, a letter was received from Mr Maitland, indicating that he had had no knowledge of the proceedings and seeking to re-open them. The letter also indicated that in November 2003 he had filed a Form TM21 to record a change of address and suggested the request had been overlooked by the Trade Marks Registry. A Form TM21 dated 3 November 2003 and marked "copy" was enclosed with the letter, indicating a change of address in relation to registration No. 2308256. The form made no mention of registration No. 2325253.

8. The letter and copy Form TM21 was considered by registry and, on 17 August 2006, a letter was issued which confirmed that there was no record on file of the prior receipt of any such request for a change of address. The letter also indicated that the copy form supplied could not have been filed in November 2003 as the registered proprietor suggested it had, as that particular version of the form did not come into use until October 2004 as was indicated on it.

9. Mr Maitland responded by way of a letter dated 22 August 2006 confirming he did file the change of address form on 3 November 2003 but did not keep a copy of it. He maintained his request for the proceedings to be re-opened.

### **The hearing**

10. Prior to the hearing I asked that the Appointed Person's decision O-340-04 *Ms A J Coggins v Skjelland Group AS* be brought to the parties' attention.

11. The hearing took place before me on 30 November 2006 by telephone. Mr Maitland represented himself whilst Mr Stobbs, of Boulton Wade Tennant represented the applicant. In line with having issued a single decision, a single hearing in respect of both invalidated registrations took place. Neither party raised any objections regarding the single decision and therefore I proceeded on this basis.

12. Following the hearing, I issued my decision in a letter later the same day. The letter to Mr Maitland, copied to Boulton Wade Tennant, stated:

"The issue before me was the registrar's preliminary view to refuse your request to re-open the above proceedings. I received some papers from you in advance of the hearing along with a very brief skeleton argument from the applicant.

In response to my questions, you indicated that you were not familiar with the hearing process. I explained to you the procedure that would be followed. I also asked you to

clarify the remedy you sought. You confirmed that you were seeking to re-open these cases by having the decisions set aside.

After considering all the submissions made, my decision is to uphold the preliminary view and refuse to set aside the decisions and re-open these proceedings. As I explained, the registrar has very limited powers to set a decision aside. He may do so where a decision contains a clerical error or other error arising from an accidental slip or omission. You submitted that there had been a procedural irregularity in these proceedings because of the failure to update the address for service details.

Whether or not third parties were aware of your change of address, the responsibility rested with you to keep the records up to date and advise the registry of any changes. You insisted that you had sent the appropriate documents but conceded that you did not check to see that they had been actioned. I confirmed that there is no record on any of the relevant files of you having notified the registrar of your change of address at any time before the issue of the decisions.

Once the registrar has issued a decision he is *functus officio*. This means that he has discharged his duty and cannot revisit his decision. The proper avenue is for the party seeking to challenge the decision to appeal it. Further details on the appeal process are available on our website; [www.patent.gov.uk](http://www.patent.gov.uk).

This letter does not contain a full statement of reasons for my decision. As I explained at the hearing, if either party wishes to appeal this decision, they should file a Form TM5 together with the required fee (£100) requesting a statement of reasons within one month of the date of this letter. A copy of this letter has been sent to Boulton Wade Tennant.”

13. Mr Maitland subsequently filed a Form TM5 (with fee) within the period allowed, seeking a full statement of the reasons for my decision. These I now give.

## **Submissions**

### **Registered proprietor**

14. Mr Maitland submitted that “the logos” the subject of the registrations were first used on 21 February 2002 and have been used since then. They have, he said, actively featured in the press and on a website. The registrations were, he said, important to him. He submitted the applicants knew both that the marks were being used and that he would want to defend the registrations.

15. Mr Maitland explained the address at Lindsay Drive was that of his mother. He had used this address as his address for service because at the time he was resident in Paris. Unfortunately, in June 2003, Mr Maitland’s mother died and, on 11 August the same year, Mr Maitland moved to Hampstead.

16. Mr Maitland said that he had not been sent any letters regarding these two registrations. If letters had been sent to him by the registry to the Lindsay Drive address then he had not received

them. If letters had been sent there he would not have seen them as he had moved. He had not signed for anything received at that address.

17. Mr Maitland said he was aware that the onus was on him to update the Trade Marks Registry's records and thought he had done so. But with the complications caused by his mother's death he did not check whether anything had "gone astray". Mr Maitland is an officer of a company called English Distillers Ltd. He submitted that the applicant's agent was well aware of this and of the address of that company as a letter of complaint had been sent by them to that address. Knowing of his office address, Mr Maitland said that Boulton Wade Tennant could have offered it up to the Trade Marks Registry. The only contacts from them made concerning these applications for invalidation, were those received after the decision to invalidate the registrations had been issued and after the expiry of the period for lodging appeal against that decision.

18. In response to Mr Stobbs' comment, Mr Maitland denied that he had buried his head. The applicant, he reiterated, knew the mark was being used and that he would want to defend the registrations.

19. Mr Maitland concluded by saying that he might have been at fault in not checking that the form seeking a change of address had been received and actioned by the registrar but that the onus on ensuring an address was correct should not only be on him or the registrar.

### **Applicant's submissions**

20. It is, I think, appropriate to mention at this point that when invited to begin his submission Mr Stobbs indicated that he was "mainly attending the hearing as an observer". I challenged him on this as I was uncertain exactly what this was intended to mean taking into account that he had filed written submissions and had made no mention of this prior to the commencement of the hearing. Mr Stobbs then indicated that he would take a full part in the hearing.

21. Mr Stobbs said that he agreed with the registrar's preliminary view; there was no case to answer. The onus was on the registered proprietor to keep his address for service up to date and he had failed to do so. In terms of deciding whether there had been any procedural irregularity, what was within the knowledge of Boulton Wade Tennant was not the issue as they held no responsibility to inform the Trade Marks Registry of a third party's address. Procedural irregularity meant it was the procedures carried out by the Trade Marks Registry that were important.

22. Mr Stobbs accepted that a letter had been sent by his firm to Mr Maitland's company's office address. This was, he said, a cease and desist letter. He submitted that many such letters are sent out and it was not unusual to receive no response to them. His company had sent letters to both Mr Maitland's home address, as recorded at the Trade Marks Registry, and to his company's office address. There was no obligation to copy cease and desist letters to the Trade Marks Registry.

23. Whilst Mr Stobbs expressed his sympathy for Mr Maitland's bereavement, he countered that this was not relevant. The onus was on the registered proprietor to keep his address for service up to date and he had failed to do so.

### **Decision**

24. The applications which subsequently became registration Nos. 2308256 and 2325253 were applied for some seven months or so apart in August 2002 and March 2003. Applications for declarations of invalidity of both registrations were filed on 11 March 2004. At all relevant times the registrations and the applications for declarations of invalidity have been subject to the requirements of the Trade Marks Rules 2000.

25. Rule 10 of these rules state:

**"10.-**(1) For the purposes of any proceedings before the registrar under these Rules or any appeal from a decision of the registrar under the Act or these Rules, an address for service in the United Kingdom shall be filed by-

- (a) every applicant for the registration of a trade mark;
- (b) every person opposing an application for registration of a trade mark;
- (c) every applicant applying to the registrar under section 46 for the revocation of the registration of a trade mark, under section 47 for the invalidation of the registration of a trade mark, or under section 64 for the rectification of the register;
- (d) every person granted leave to intervene under rule 35 (the intervener); and
- (e) every proprietor of a registered trade mark which is the subject of an application to the registrar for the revocation, invalidation or rectification of the registration of the mark.

(2) The address for service of an applicant for registration of a trade mark shall upon registration of the mark be deemed to be the address for service of the registered proprietor, subject to any filing to the contrary under paragraph (1) above or rule 44(2) below.

(3) In any case in which an address for service is filed at the same time as the filing of a form required by the registrar under rule 3 which requires the furnishing of an address for service, the address shall be filed on that form and in any other case it shall be filed on Form TM33.

(4) Anything sent to any applicant, opponent, intervener or registered proprietor at his address for service shall be deemed to be properly sent; and the registrar may, where no

address for service is filed, treat as the address for service of the person concerned his trade or business address in the United Kingdom, if any.

(5) An address for service in the United Kingdom may be filed at any time by the proprietor of a registered trade mark and by any person having an interest in or charge on a registered trade mark which has been registered under Rule 40.

(6) Where an address for service is not filed as required by paragraph (1) above, the registrar shall send the person concerned notice to file an address for service within two months of the date of the notice and if that person fails to do so-

(a) in the case of an applicant as is referred to in sub-paragraph (a) or (c), the application shall be treated as abandoned;

(b) in the case of a person as is referred to in sub-paragraph (b) or (d), he shall be deemed to have withdrawn from the proceedings; and

(c) in the case of the proprietor referred to in sub-paragraph (e), he shall not be permitted to take part in any proceedings.”

26. As stated above, at the time the two trade mark applications achieved registration, they both stood in the name of Philip Maitland. In the case of No. 2308256 the form Mr Maitland filed to record himself as the proprietor (Form TM16) gave details of his address in Paris but, after challenge, Lindsay Drive was given as an address for service within the UK. This complied with the requirements of Rule 10(1) taking into account Rules 10(3) and 10(6). In respect of No. 2325253, the application form (Form TM3) gave the Lindsay Drive address as Mr Maitland’s address. As no separate address was provided, Lindsay Drive was also taken to be his address for service. In respect of both trade mark applications, the address for service remained as Lindsay Drive upon registration, in accordance with Rule 10(2).

27. On 11 March 2004 separate applications for a declaration of invalidity of each of the two registered marks were filed at the Trade Marks Registry by Boulton Wade Tennant on behalf of O2 Limited. Invalidity of a registration is provided for by Section 47 of the Act. The procedure to be followed on application for invalidity of a registration can be found under Rule 33 which states:

“**33.** (1) An application to the registrar for a declaration of invalidity under section 47(1) or (2) of the registration of a trade marks shall be made on Form TM26(I) together with a statement of the grounds on which the application is made; the registrar shall send a copy of the application and the statement to the proprietor.

(2) Within six weeks of the date on which a copy of the application and statement is sent by the registrar to the proprietor, the proprietor may file a counter-statement, in conjunction with notice of the same on Form TM8; where such a notice and counter-statement are filed within the prescribed period, the registrar shall send a copy of the Form TM8 and the counter-statement to the applicant.

(3) Where a notice and counter-statement are not filed by the proprietor within the period prescribed by paragraphs (2), the registrar may treat his opposition to the application as having been withdrawn.

(4) Within six weeks of the date upon which a copy of the counter-statement is sent by the registrar to the applicant, the applicant may file such evidence as he may consider necessary to adduce in support of the grounds stated in his application and shall send a copy thereof to the proprietor.

(5) If the applicant files no evidence under paragraph (4) above in support of his application, he shall, unless the registrar otherwise directs, be deemed to have withdrawn his application.

(6) If the applicant files no evidence under paragraph (4) above or the registrar otherwise directs under paragraph (5) above, the proprietor who has filed a notice and counter-statement under paragraph (2) above may, within six weeks of the date on which either a copy of the evidence or a copy of the direction is sent to him, file such evidence as he may consider necessary to adduce in support of the reasons stated in the counter-statement and shall send a copy thereof to the applicant.

(7) Within six weeks of the date upon which a copy of the proprietor's evidence is sent to him under paragraph (6) above, the applicant may file evidence in reply which shall be confined to matters strictly in reply to the proprietor's evidence, and shall send a copy thereof to the proprietor.

(8) 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.

(9) Upon completion of the evidence the registrar shall request the parties to state by notice to her in writing whether they wish to be heard; if any party requests to be heard the registrar shall send to the parties notice of a date for the hearing.

(10) When the registrar has made a decision on the application she shall send the parties to the proceedings written notice of it, stating the reasons for her decision; and for the purposes of any appeal against the registrar's decision the date when the notice of the decision is sent shall be taken to be the date of the decision."

28. The applications for declarations of invalidity of the registrations were made on Form TM26(I) as required by Rule 33(1). The statement of case in support of the application was revised at the request of the registrar in order to clarify the basis on which the applications were made. In accordance with the requirements of Rule 33(1) the registrar sent copies of the applications for declaration of invalidity of the registrations and the revised statement to the registered proprietor. The copies were sent to him, by recorded delivery, on 19 May 2004 and to the address for service which he had provided.

29. Both of the envelopes and their contents were returned to the registrar by the Royal Mail on 1<sup>st</sup> June 2004 endorsed “not called for”. The returned envelopes bear an indication that the registrar sent further copies of the documents by ordinary post. I am unable to tell from the papers before me on which date these further copies may have been sent but I have no reason to doubt that it was done on receipt of the returned letter as is usual practice. These further copies were not returned by the Royal Mail.

30. Section 7 of the Interpretation Act 1978 provides that:

“Where an Act authorises or requires any document to be served by post (whether the expression “serve” or the expression “give” or “send” or any other expression is used) then, unless the contrary intention appears, the service is deemed to be effected by properly addressing, pre-paying and posting a letter containing the document and, unless the contrary is proved, to have been effected at the time at which the letter would be delivered in the ordinary course of the post”.

31. Referring to the service of documents under Rule 31 in the case of *Ms AJ Coggins and Skjelland Group AS* (O-340-04), Mr Geoffrey Hobbs QC sitting as the Appointed Person said that service of documents:

“is deemed to have been effected when they were sent, i.e. despatched, to her address for service by pre-paid post under cover of the unreturned letter of 23 January 2004.”

32. In any event Mr Maitland claims not to have received any such letters because, essentially: (1) the address to which the letter was sent was not his address but his mother’s; (2) his mother died in June of 2003; (3) he moved to a new address in August 2003; (4) he filed notification of his new address with the registrar in November 2003; (5) the registrar took no action on the notification; and (6) the applicant was aware of the registered proprietor’s business address and should have informed the registrar.

33. Whilst I accept the first three of Mr Maitland’s claims, I am unable to accept the remaining three.

34. In respect of the fourth claim outlined above, despite a thorough search of all the relevant papers, including the application files, I can find no indication that a Form TM21 or any other documentation seeking a change of address was ever filed in respect of either of these two registrations. Mr Maitland did file what he says was a copy of the form he had filed on 3 November 2003. This “copy” was filed in August 2006 and referred only to Registration No. 2308256. As with many official forms the Form TM21 has been subject to a number of reviews over the years. As set out in paragraph 8 above, he could not have filed this form in November 2003 as this particular version was not introduced or available for use until October 2004. Following a challenge on this point, Mr Maitland said, in a letter dated 22 August 2006, that whilst he did not keep a copy of it, he did file a form requesting a change of address on 3 November 2003. He gave no details to explain how he could be so specific about the date he says the original form was filed when he had not kept a copy of it.

35. In respect of claim five outlined above, the registrar cannot action a request which he has not received.

36. In respect of the sixth claim outlined above, I accept, and indeed it is not disputed, that the applicants knew of Mr Maitland's company's office address. But I fail to see the relevance of this. The registrations were and remained recorded in Mr Maitland's personal name. As he was required to do, he provided an address for service within the UK. It was up to Mr Maitland to specify which address he wanted recorded. He chose the Lindsay Drive address. It is well established that the registrar is entitled to accept the address for service provided at face value. The onus to notify the registrar of any change of a registered proprietor's address or a change of his address for service, rests solely with that registered proprietor.

37. The registered proprietor not having not filed a Form TM8 and counter-statement under Rule 33(2), proceedings continued and led to the issue of the single decision on 11 May 2006. A copy of the decision was sent to Mr Maitland at his recorded address for service but was returned marked "person not known at this address".

38. Despite his claims that the applicant could have told the registrar of his current contact address, in his submissions at the hearing Mr Maitland accepted that the onus was on him. In these cases, there is no evidence that he discharged that onus. I am unable to find that there was any failure on the part of the registrar in this regard.

39. That being the case, I did not consider that the relief Mr Maitland sought was within my powers. I also bear in mind the comments of Mr Simon Thorley QC sitting as the Appointed Person in *OMI International PLC v EMITEC Gesellschaft Fur Emissionstechnologie MBH* (BL O-018-02), where he said:

"Once the Registrar has issued a decision revoking a trade mark she is functus and can thereafter not revisit her decision."

40. Whilst Mr Thorley's decision was in relation to an application to revoke a trade mark registration, I believe the same applies to all decisions of the registrar including decisions regarding the invalidation of a registration.

41. I therefore upheld the registrar's preliminary view, refusing to set aside the decision and re-open proceedings.

42. For completeness, and for the benefit of any appellant tribunal, I would add that neither party sought an award of costs and therefore I made no such award.

**Dated this 4th day of January 2007**

**ANN CORBETT  
For the Registrar  
The Comptroller-General**