

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 2452608 IN THE
NAME OF JANG HUSSAIN**

**AND IN THE MATTER OF OPPOSITION NO. 95673 THERETO BY
CONSOLIDATED ARTISTS B.V.**

**APPLICANT'S APPEAL TO AN APPOINTED PERSON FROM THE
DECISION OF MR MIKE FOLEY DATED 22 SEPTEMBER 2008**

INTERIM DECISION AND DIRECTIONS

Introduction

1. On 22 September 2008, Mr Mike Foley for the Registrar issued a decision (“the Decision”) upholding an opposition by Consolidated Artists B.V. (“the Respondent”) against an application by Jang Hussain (“the Appellant”) to register a series of three trade marks comprising the words MANGO HOUSE, Mango House, mango house (application no. 2452608) for certain restaurant services in Class 43. The precise specification is set out in the Decision.
2. The opposition, filed on 19 November 2007, was based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), which provides as follows:
 - 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.
3. The Decision does not set out the details of the earlier trade mark relied on by the Respondent, though at paragraph 15 the Hearing Officer states that it “consists of the word MANGO” and at paragraph 16 it is said to be “in a sort of military-style font”. It transpires from the Notice of Opposition (Form TM7) that the earlier trade mark relied on is the Respondent’s application to register a stylised representation of the

word MANGO as a Community trade mark for a range of services in Classes 41, 43 (including restaurant services) and 44, as shown below:



4. The Respondent's application was filed on 20 April 2007, claiming a priority date (at least in respect of restaurant services) of 31 October 2006. It is recorded under number 5880935 ("the CTM Application").
5. For the purposes of this interim decision, there is no need to analyse the Hearing Officer's reasoning. It is sufficient to record the following four points:
 - (1) the opposition was based only on the CTM Application;
 - (2) the opposition was brought only under section 5(2)(b) of the Act;
 - (3) the opposition succeeded; and
 - (4) the Appellant appealed to the Appointed Person by Notice of Appeal dated 20 October 2008.

Application to Stay the Appeal

6. Paragraph 5 of the Appellant's statement of grounds of appeal reads as follows:

The Registrar failed to take into account that the Opponents (sic.) application was itself the subject of an Opposition and may not become registered and has therefore unfairly prejudiced the Applicant. The Applicant contends that it would be fair and prudent to suspend opposition by the Opponent pending the outcome of Opposition to their mark.

7. On reviewing the appeal papers, I checked the details of the CTM Application recorded on the database held by the Office for Harmonisation in the Internal Market ("OHIM") and found that it was indeed being opposed by a third party. The opposition ("the CTM Opposition") had been filed on 21 November 2007, two days after the present opposition proceedings had commenced.
8. There was no reference to the CTM Opposition in the Decision. I called for and inspected the Registry file, and could find no reference to it either in the formal documents and correspondence connected with these proceedings or in the parties' skeleton arguments or the transcript of the oral submissions made at first instance. The fact that the earlier trade mark relied on would not proceed to registration if the CTM Opposition were successful appeared to have been overlooked by everyone concerned.

9. Tribunal Practice Notice 3/2004 sets out Registry practice with regard to oppositions based on earlier trade marks that are still pending. Prior to TPN 3/2004, it had been common practice for the Registrar to proceed with the case and to issue a provisional decision, to be supplemented with a further decision that depended on whether or not the pending application proceeded to registration. But the position was reviewed in the light of the impact of this approach on time periods for appeal and to try to achieve greater fairness between parties, with the result that the following approach should now be taken:

... the Trade Marks Registry will, from 1 July 2004, standardise its practice. Instead of issuing provisional and supplementary decisions ... the Hearing Officer will, during their review of the proceedings, (paragraph (a) of Tribunal Practice Notice 5/2000 refers) consider whether the allegations are based upon pending earlier trade mark(s) which are likely to lead to the refusal/cancellation of the application/registration. In such circumstances, the Hearing Officer is likely to suggest that the proceedings are suspended to await the outcome of the pending earlier trade mark(s). The parties will of course retain their right to comment on such an approach. The Hearing Officer may allow the proceedings to continue to either a substantive hearing or a decision from the papers, if they consider it appropriate.

10. It was clear from the Form TM7 in this case that the Respondent's earlier trade mark relied on was a pending application. The Appellant did not comment on this fact in its Form TM8 filed on 18 December 2007. Nevertheless, it should have been picked up when the case was reviewed by the Registry to check that it could proceed to a decision with or without a hearing. Pursuant to TPN 3/2004, one would expect the Hearing Officer to have suggested a suspension of proceedings at that point, subject to the views of the parties. But this was not done.

11. On 8 December 2008, I wrote to the Treasury Solicitor's Department as follows:

I refer to the above case, in which the papers have been passed to me as the Appointed Person to consider the trade mark applicant's appeal against the decision of Mr Foley dated 22 September 2008.

The Appellant points out at point 5 of the statement of grounds in the Notice of Appeal that the Community trade mark relied on as the earlier trade mark in the opposition (CTM no. 5880935) is itself under opposition before OHIM. Having checked on OHIM's website, this appears to be correct: an opposition to the CTM was received on 21 November 2007 (i.e. two days after the present UK opposition was filed) from a third party with no obvious connection to this case.

The usual approach in such a case at first instance is for the hearing officer to suggest that the opposition proceedings are suspended to await the outcome of the pending earlier trade mark, subject to considering comments from the parties on this approach (see TPN 3/2004). I have reviewed the Registry file, and it does not appear that this was done; nor was it mentioned in the decision that the earlier trade mark was a pending application. I also have not seen anything to indicate that either party raised the possibility of a stay either in correspondence or in the skeleton arguments submitted prior to the hearing.

The Appellant states in its grounds that “it would be fair and prudent to suspend opposition by the Opponent pending the outcome of Opposition to their mark”. I interpret this as a request to suspend the appeal proceedings, which I believe I should deal with as a preliminary issue.

If the Opponent (now the Respondent) were willing to agree to the appeal being suspended, I would be minded to grant the suspension by consent, pending the outcome of the CTM opposition, because of the possibility that the success of the CTM opposition would undermine the basis of Mr Foley’s decision. However, if the Respondent opposes a suspension, I must consider the arguments of the parties and issue a decision on the point. In view of the circumstances, it seems to me that the best approach is as follows:

- The Respondent should write to me by 5pm on **Tuesday, 23 December 2008**, informing me whether it will agree to the suspension or, alternatively, wishes to oppose it. If it wishes to oppose, it should explain its reasons for this and should also provide me with details of the status of the CTM opposition proceedings including, in particular, when it is estimated that these will be determined. This letter should be copied to the Appellant and to Treasury Solicitors.
- If the Respondent opposes the suspension, the Appellant should write to me **within ten business days** after receiving the Respondent’s reasons, responding to the points raised by the Respondent. This letter should be copied to the Respondent and to Treasury Solicitors.
- I shall then consider what action to take in the light of the submissions that I receive.

I appreciate that we will soon be entering the holiday season. If either party has any difficulty with the time limits that I have imposed, they should write to me. However, I hope that these will not cause a problem and I am keen that the uncertainty caused by this issue should not continue for too long. In the meantime, the fixing of the date for the hearing of the appeal will be deferred

I should be grateful if you would forward this letter to the parties without delay.

12. Following a slight delay over the Christmas period, Mr C.P. Pett of the Respondent’s representatives, Frank B. Dehn & Co., wrote to me on 14 January 2009, stating that the Respondent was “willing to agree to the suspension of the appeal pending resolution of the opposition against his earlier right”.

Interim Decision

13. If the CTM Opposition succeeds, then the Respondent’s earlier trade mark will cease to exist *ab initio*, thus undermining the whole basis for the Decision. As a consequence, if this appeal were to go ahead, and if I were to find in favour of the Respondent, my own decision would have to be issued on a provisional basis, pending the outcome of the CTM Opposition. On the other hand, if the appeal were to go ahead, and I were to find in favour of the Appellant, I could issue a final decision that would be unaffected by the outcome of the CTM Opposition.

14. Although some parties in the position of the Appellant might wish to proceed with the appeal in the hope of achieving either complete success or a decision against it that would be provisional until the outcome of the CTM Opposition was known, the Appellant has made it clear that it would prefer to stay the proceedings until the status of the Respondent's earlier trade mark has been determined. That is a reasonable position, which will postpone any further costs being incurred in these proceedings and could avoid them altogether.
15. Similarly, some parties in the position of the Respondent might argue against a stay of proceedings on the basis that a decision on the appeal would effectively bring the current opposition to an end, subject only (in the event that I uphold the Decision) to the outcome of the CTM Opposition. This would conveniently wrap up the case at a time when it is fresh in the parties' minds, and may help with making commercial decisions. However, this Respondent has indicated its willingness to accept a stay.
16. In the circumstances set out above, and in the light of the parties' agreed position, I intend to grant a stay of the appeal before me. In the first instance, the stay will last until two months after OHIM notifies the Respondent of the first instance decision in the CTM Opposition, or until two months after the CTM Opposition otherwise comes to an end, whichever is the earlier. (I choose two months because this is the period within which an appeal must be made before OHIM, pursuant to Article 59 of Council Regulation 40/94/EEC on the Community trade mark.)
17. In the event of an appeal in the CTM Opposition, it will be open to the parties to apply to extend the stay or alternatively to ask for this appeal to proceed, and I shall review the matter in the light of the then current circumstances.
18. Since the Appellant has no involvement in the CTM Opposition, and since OHIM's decisions are not always published straight away, it will be necessary for the Respondent to notify both the Appellant and me when the decision is issued by OHIM. I make an appropriate direction below.

Directions

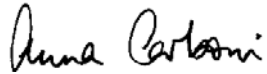
19. Pursuant to my decision set out above, I make the following directions in this appeal:
 - (1) Within one month of receiving notification from OHIM of the first instance decision in the CTM Opposition, or of termination of the CTM Opposition for any other reason, the Respondent shall inform the Appellant and the Appointed Person in writing (with a copy to the Treasury Solicitor's Department) of the decision (attaching a copy) or other termination event, as appropriate.
 - (2) Within two months of either event referred to under (1) above, the parties shall seek to agree whether a further stay of this appeal is desirable and shall notify

the Appointed Person (with a copy to the Treasury Solicitor's Department) of their agreed position or, in the absence of agreement, shall each make written submissions explaining their respective positions in relation to the ongoing conduct of this appeal.

- (3) This appeal shall be stayed until the expiry of two months following either event under (1) above.

Costs

20. Any claim for costs in relation to the Appellant's request for a stay should be dealt with at the same time as the costs in the main appeal.



ANNA CARBONI

19th January 2009