

O-237-09

TRADE MARKS ACT 1994

IN THE MATTER OF A JOINT HEARING
IN RELATION TO APPLICATION No. 2496464
IN THE NAME OF UNILEVER PLC

AND

OPPOSITION NO 98946 THERETO
BY SAGA LEISURE LIMITED

TRADE MARKS ACT 1994

IN THE MATTER OF a joint hearing
in relation to application
No. 2496464 in the name of
Unilever Plc and opposition
No. 98946 thereto by
Saga Leisure Limited

Background

1. Application No. 2496464 is for the trade mark SAGA, has a filing date of 1 September 2008 and stands in the name of Unilever Plc. It was published for opposition purposes in the *Trade Marks Journal* on 9 January 2009.
2. On 6 March 2009 a notice of threatened opposition, on Form TM7a, was filed by Dechert LLP. The form had been completed so as to show Unilever Plc as both the applicant and the opponent. On 8 April 2009, Dechert filed notice of opposition on Form TM7 under cover of a letter of even date which explained that “due to an administrative error” the Form TM7a had been “erroneously incorrectly completed” and that the reference on that form to the potential opponent should have read Saga Leisure Ltd (“the opponent”) as was entered on the Form TM7.
3. By way of a letter dated 19 May 2009, Baker & McKenzie LLP on behalf of Unilever Plc (“the applicant”) submitted that the Form TM7 should not be accepted as it was filed after the period allowed on the basis that the earlier filed Form TM7a was defective to the extent that it did not allow for extension of the opposition period. An official letter dated 29 May 2009 informed the parties of the registrar’s preliminary view to accept the form but noted that Baker & McKenzie’s letter requested a hearing to argue against any such acceptance.
4. The hearing took place before me by telephone on 9 July 2009. Both parties filed skeleton arguments in advance of the hearing at which Ms Tebbutt of Dechert represented Saga Leisure Ltd and Ms Denham of Baker & McKenzie represented Unilever Plc. Later that same day I wrote to the parties in the following terms:

“After considering -[the skeleton arguments]- and the submissions made orally at the hearing, my decision is that the details given on the Form TM7a constituted an obvious error which should be corrected under the provisions of rule 74 thereby allowing the Form TM7 to be accepted. In reaching my decision I took into account a number of relevant factors, not least that pre-action correspondence between the parties had taken place, that the opponent’s attorney’s identification reference were the same on both forms and the timing of the raising of the issue by the applicant.”
5. Baker & McKenzie subsequently filed a Form TM5 requesting a statement of reasons for my decision. These I now give.

The law

6. Opposition to registration of an application is provided for by Section 38 of the Act which states:

“**38.**-(1) When an application for registration has been accepted, the registrar shall cause the application to be published in the prescribed manner.

(2) Any person may, within the prescribed time from the date of the publication of the application, give notice to the registrar of opposition the registration.

The notice shall be given in writing in the prescribed manner, and shall include a statement of the grounds of opposition.

(3) ...”

7. The relevant rule is rule 17 which states:

“**17.**-(1) Any notice to the registrar of opposition to the registration, including the statement of the grounds of opposition, shall be filed on Form TM7.

(2) Unless paragraph (3) applies, the time prescribed for the purposes of section 38(2) shall be the period of two months beginning with the date on which the application was published.

(3) This paragraph applies where a request for an extension of time for the filing of Form TM7 has been made on Form TM7A, before the expiry of the period referred to in paragraph (2) and where this paragraph applies, the time prescribed for the purposes of section 38(2) in relation to any person having filed a Form TM7A (or, in the case of a company, any subsidiary or holding company of that company or any other subsidiary of that holding company) shall be the period of three months beginning with the date on which the application was published.

(4) Where a person makes a request for an extension of time under paragraph (3), Form TM7A shall be filed electronically using the filing system provided on the Office website or by such other means as the registrar may permit.

(5)

8. Also of relevance is rule 74 which states:

“**74.**-(1) Subject to rule 77, the registrar may authorise the rectification of any irregularity in procedure (including the rectification of any document filed) connected with any proceedings or other matter before the registrar or the Office.

(2) Any rectification made under paragraph (1) shall be made-

(a) after giving the parties such notice; and

(b) Subject to such conditions,

as the registrar may direct.”

Decision

9. Following publication of an application in the *Trade Marks Journal*, a period of two months is allowed under the provisions of rule 17(2) for the filing of opposition. If, during that two month period, a request is made, on Form TM7a, to extend that period, an extension of a further month may be granted under the provisions of rule 17(3).

10. The application was published on 9 January 2009. Any opponent therefore had until 9 March 2009 to file opposition on Form TM7 or to file a Form TM7a to extend the opposition period until 9 April 2009.

11. Dechert filed the Form TM7a, seeking to extend the opposition period, on 6 March 2009, within the period allowed. The filing of the Form TM7a is, in accordance with rule 17(4), carried out electronically via the IPO website. In completing the form, Dechert entered the name and address details of the applicant in the field intended to contain those of the opponent. The form therefore showed both the applicant and the opponent to be Unilever Plc. Dechert filed the Form TM7 on 8 April 2009. That form showed the opponent to be Saga Leisure Ltd.

12. Ms Denham, for the applicant, submitted that the Form TM7a is not a complicated form to complete and that it is difficult to see how it could be incorrectly completed. Alternatively, she submitted that it is difficult to see how a reasonably attentive person would not immediately recognise that an error had been made. She went on to say that as the Form TM7a was not properly completed it should be rejected and thus the TM7 itself should be rejected as having been filed out of time. She submitted that it would not be just and reasonable to utilise the provisions of rule 74 to correct the Form TM7a and allow it to be accepted as that would result in unfairness and unduly favour the opponent.

13. Ms Denham referred me to the practice at OHIM regarding the incorrect identification of the opponent, submitting that the relevant Community Trade Mark rules were persuasive to the issue before me. As I am required to interpret and apply the Trade Marks Act 1994 and associated rules, I fail to see how the interpretation by OHIM of Community Trade Marks rules can be of persuasive value.

14. For her part, Ms Tebbutt accepted that the Form TM7a had been incorrectly completed but submitted that in entering the applicant's name as the opponent the error was an obvious one which was capable of correction under rule 74. She said that it was obvious an applicant would not oppose its own application and referred me to my earlier decision in *The Company Shop* (BL O-088-05) in this regard. When the error had been noticed she had contacted the registry by telephone before filing

the Form TM7 which effectively corrected the error. I have not been provided with any details of to whom this call was made nor do I know if it took the form of a specific or more general discussion. Certainly no record of any such telephone call appears in the case file. I do not consider this to be material in this case.

15. Ms Tebbutt submitted that it would be disproportionate to reject the Forms TM7a and TM7. Whilst she accepted the opponent would have recourse to e.g. invalidation proceedings should the application proceed to registration, this would only lead to delay given that any such action would be made on the same grounds as formed the opposition. Furthermore, the application was already subject to a separate opposition by a third party and it would prevent unnecessary expense for all parties for all the issues to be dealt with in tandem.

16. It is clear that in completing the Form TM7a the person doing so made an error. Despite Ms Denham's submission that it is difficult to see how the form could be incorrectly completed, the facts of this case make it perfectly clear such errors can, and do, occur. Whilst the form eventually produced by the system is relatively simple, in order to submit one a person does not complete an online facsimile of that form but instead is taken through a number of separate, and somewhat wordy, pages each requiring him to complete various fields. Some fields require direct input from the filer, e.g. the application number; others will be automatically populated from other information, e.g. the applicant's name. Although the details of the applicant and opponent appear next to each other on the form as eventually produced by the electronic system, these details are shown and/or entered on separate pages during the electronic process making any error perhaps somewhat less obvious at that time. I accept that a careful reading of the form, if and when printed, should have brought the error to Dechert's notice but mistakes happen and it is not unheard of for people, even professionals, to enter incorrect details on forms etc. or to mix up the names of parties.

17. In *The Company Shop (supra)* I stated:

"34. Whilst Section 38 and rule 13 indicate that "any person" may file an opposition, I cannot imagine of a situation where a person would wish to go to the effort and expense of opposing his own application where alternative options to amend applications or avoid registration exist. To do so would be somewhat illogical if not perverse. It seems clear to me that in completing the details in the way described in the paragraphs 5 and 33 above, Mr Palmer made an obvious error. [...]"

35. Obvious errors are capable of correction and the registrar has an inherent power to do so. In the circumstances described above it appears to me that it is appropriate to allow these errors to be corrected."

18. Although the above case was determined under previous rules and related to the filing of a Form TM7 rather than a Form TM7a, the principle here remains the same. No party is going to threaten to oppose his own application. Thus, despite it not having been identified promptly, the error on the Form TM7a is an obvious one and, being an error in a document filed, I found that it was one which should be rectified under the provisions of rule 74(1).

19. It is, in my view, a fundamental right of an applicant to know the identity of a party who seeks to challenge him. In all the circumstances of this case I found that the applicant did know this identity. That the parties had been in correspondence prior to the filing of the Form TM7a is not disputed. The opposing attorney's details, including the reference number given on both Form TM7a and TM7, were identical. The filing of the forms by the opponent would not have come as a surprise to the applicant.

20. Whilst I have been unable to find a record of any telephone conversation between Ms Tebbutt and the registry in relation to this particular case, it might be helpful for me to explain that the filing of a Form TM7a is a fully automated process. On submission of all the details by the filer, the electronic system creates a form. It then produces and issues an acknowledgement of the filing which is sent to the filer along with a copy of the form the system has produced. The system also produces a letter and copy of the form for the applicant. Despite receiving a copy of the Form TM7a from the registry immediately following its filing, the applicant either did not notice the error or chose to ignore it at that time. Instead it waited some nine weeks to raise the issue (and more than four weeks after the Form TM7 itself had been received).

21. I was not persuaded by the applicant's submissions that acceptance of the form would lead to unfairness. Both parties agreed that if the challenge to the registration by Saga Leisure Ltd was not dealt with via opposition, it would still be open to it to challenge any subsequent registration should this application achieve such status. The application itself has attracted a separate opposition from a third party. That opposition is, in the normal course of events, likely to take some time to resolve. In all the circumstances of this case, it seemed to me to be less likely to lead to delay, fairer to both parties and a better use of everyone's resources, financial and otherwise, for the challenge to the registration of the application by Saga Leisure Ltd to be dealt with conterminously with the other opposition rather than awaiting the outcome of that opposition by the third party only for it then, should the applicant successfully defend that opposition and achieve registration, to be subject to a further challenge by way of e.g. an invalidation action.

22. I made no order as to costs.

23. In my letter to the parties following the hearing I advised:

"My decision is an interim one in that it does not terminate the proceedings. I have not awarded costs. Thus, in line with Rule 70 above, an appeal against my decision can only be made independently of any appeal against the final, substantive, decision, with the leave of the registrar."

Dated this 10th day of August 2009

**Ann Corbett
For the Registrar
The Comptroller-General**