

**TRADE MARKS ACT 1994**

**IN THE MATTER OF :**

**OPPOSITION No. 102670**

**IN THE NAME OF THE SAUL ZAENTZ COMPANY**

**TO TRADE MARK APPLICATION No. 2588875**

**IN THE NAME OF SUCCESS STORY MANAGEMENT LTD**

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**DECISION**

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1. Opposition No. 102670 in the name of The Saul Zaentz Company ('the Opponent') to Trade Mark Application No. 2588875 for registration of the mark HENRY SPURWAY'S BILBO BAGGINS in Classes 9 and 41 in the name of Success Story Management Ltd ('the Applicant') succeeded for the reasons given in a decision issued by Mrs. Ann Corbett on behalf of the Registrar of Trade Marks under reference BL O-225-13 on 11 June 2013.

2. The Applicant appealed to an Appointed Person under Section 76 of the Trade Marks Act 1994 on the basis of the Grounds of Appeal accompanying its Form TM55 dated 8 July 2013. Paragraph 18 of the Grounds of Appeal gave notice that *'The Applicant/Appellant intends to seek leave to have this Appeal heard by the Court of Session in Scotland under Section 76(3) of the Act'*.

3. This was evidently intended to serve as a request under Rules 72(1)(b) and 72(3) of the Trade Marks Rules 2008 for the Appeal to be referred to the Court of Session under

Section 76(3)(c) of the 1994 Act, albeit that a request to that effect would normally be sent to the Registrar within the period of '28 days of the date on which the notice of appeal is sent to the respondent by the registrar' as envisaged by Rule 72(1).

4. On 14 October 2013 the following directions were given under Rules 62(1)(a) and 73(4) for the purpose of providing for the orderly determination of any request that the Applicant intended to pursue for referral of the Appeal to the Court of Session under Section 76(3)(c):

- (1) the Applicant was directed to state in writing in a letter to be sent by no later than 5:00pm on Monday 28 October 2013 whether and, if so, upon the basis of what particular considerations it maintained that the Appeal should be referred to the Court of Session under Section 76(3)(c);
- (2) if the letter sent under (1) above confirmed the request for referral, the Opponent was directed to state in writing in a letter to be sent by no later than 5:00pm on Monday 11 November 2013 whether and, if so, upon the basis of what particular considerations it maintained that the Appeal should or should not be referred to the Court of Session under Section 76(3)(c);
- (3) any representations that the Registrar might wish to make in relation to any request for referral of the Appeal to the Court of Session were to be set out in a letter to be sent by no later than 5:00pm on Monday 25 November 2013.

5. By letter dated 28 October 2013 MacRoberts LLP confirmed on behalf of the Applicant that the request for referral to the Court of Session was maintained on the basis of the following considerations:

1. The Applicant is a Scottish company based in Edinburgh and wishes the Appeal to be heard before the relevant court of its domicile.
2. The Applicant is a Scottish based company and intends to form and thereafter manage the revamped and revived 1970s pop group, Bilbo Baggins (formerly managed by Mr George Henry Spurway of the Applicant in the late 1970s) from Edinburgh and considers that the Court of Session is the most appropriate forum geographically to hear the Appeal.
3. The original 1970s pop group Bilbo Baggins was formed in Scotland at around the same time as a number of Scottish bands including The Bay City Rollers and the band was widely known and well regarded in Scotland and geographically therefore the Court of Session is the most appropriate forum for the Appeal to be heard.
4. The Applicant considers that it was prejudiced by its inability to be present at the Hearing at the Trade Mark Registry's offices in Newport on 9 April 2013 and considers the Appeal should be held in a forum where the Applicant can be personally present.
5. Mr George Henry Spurway of the applicant is a well known figure in Scotland supported by evidence filed prior to the Hearing (and referenced in the newspaper articles attached) and the Applicant considers the use of the prefix "Henry Spurway's" removes any chance of any likelihood of confusion in relation to the use of the mark Bilbo Baggins for the revived and revamped 1970s band although it is disputed that there would be any likelihood of confusion between the use of the Bilbo Baggins mark in relation to the revamped and revived 1970s pop group and the use of the mark as registered by the Opponent on 1 August 2008 and 31 July 2010.
6. Mr George Henry Spurway, the sole Director and shareholder of the Applicant also incorporated Bilbo Baggins Pop Group Limited on 9 May 2011 (a copy of Companies House details are attached hereto) to support the Applicant in the future management and operation of the revamped and revived 1970s band "Henry Spurway's Bilbo Baggins".

7. Bilbo Baggins Pop Group Limited is also domiciled in Scotland. It is clear from the reference to “Pop Group” and the purported use of the “Henry Spurway’s” prefix by the Applicant that there is and was no intention to create any misrepresentation and confusion and the Applicant considers that as both companies are domiciled in Scotland the Court of Session is the most appropriate forum to hear the Appeal.
8. The Applicant considers that it is more appropriate that the Appeal be heard before the Court of Session which will have local knowledge of at least one of the revived and revamped pop bands of latter years where a prefix has been used to identify the specific entity in the same way as is proposed by the Applicant with the mark Henry Spurway’s Bilbo Baggins, namely “Les McKeown’s Bay City Rollers”. As had been clearly identified in the submissions and evidence available at the Hearing there are a number of revived and/or revamped pop bands where a prefix has been used including, *inter alia*, Roddy Doyle’s The commitments and Faye Treadwell’s The Drifters. The Applicant does not consider that the issue of the prefix was properly considered at the Hearing and requests that this is considered in more detail before the Court of Session.
9. The Applicant does not consider that the Hearing Officer fully considered the evidence relating to the previous and continuing renown and reputation of the 1970s band Bilbo Baggins. With reference to the clear distinction that is made by the inclusion of the prefix “Henry Spurway’s” and the fact that there was no evidence of actual or potential confusion at any point now or previously between the 1970s pop group Bilbo Baggins and the character from Tolkien’s books the Applicant requests that these issues are able to be heard and considered by the Court of Session in relation to the Appeal when Mr George Henry Spurway of the Applicant can personally be present.
10. As note in the Appeal the Hearing Officer erred in her decision by not taking sufficient account of the significant reputation of the 1970s pop group Bilbo Baggins (as well as the total lack of any confusion (actual or potential) between the 1970s pop group and the character from Tolkien’s books) as recently highlighted in the press and media following the

decision of the Hearing Officer and the appearance of one of the original band members of the 1970s pop group on BBC's The Voice earlier this year. Copies of various Scottish (and national) newspaper articles are attached. The BBC broadcast, in conjunction with the TV programme The Voice this year, video footage of the Bilbo Baggins pop group from the 1970s. This media coverage further demonstrates the renown and reputation of the 1970s pop group Bilbo Baggins then and now. The popularity and appeal of the 1970s pop group Bilbo Baggins then and now, wholly distinct from the Tolkien character, is clear in relation to which it is stated by the Applicant that there is no likelihood of confusion. The Edinburgh Evening News front page shows that the Bilbo Baggins pop group headlined the 1976 Leith Festival. Leith is in Edinburgh (as is the Court of Session), highlighting the connection with Scotland and further enforcing the equitable need for the appeal to be heard before the Court of Session.

11. The Hearing Officer held that the distinctive character of the Opponent's mark had not been enhanced to any material degree by the evidence produced by the Opponent and if this is the case, which is supported by the Applicant, then there will be no greater likelihood of confusion now than there was in the 1970s when it is accepted that there was no evidence of actual or potential confusion between the 1970s band Bilbo Baggins and the character from Tolkien's books. There is and was no likelihood of confusion which likelihood is further reduced by the use of the aforesaid prefix "Henry Spurway's".
12. The Applicant considers that it is wholly equitable that these matters and those set out in the Appeal should be considered and decided upon in the Appeal by the Court of Session.

6. It was stated, in summary, that the request for referral was: *based wholly upon (i) the prejudice the Applicant considered it faced by being unable to appear personally at the Hearing; and (ii) the belief by the Applicant that it is entirely equitable that the Appeal be heard before the Court of Session based in the domicile of the Applicant and from where the Applicant proposes to form and manage the proposed revived and/or*

*revamped 1970s pop band, Bilbo Baggins operating under the wholly distinctive name “Henry Spurway’s Bilbo Baggins”.*

7. The request for referral was opposed by Edwards Wildman Palmer UK LLP on behalf of the Opponent on the basis of the considerations identified in their letter of 7 November received on 8 November 2013. They emphasised that the Applicant had appealed under Section 76 of the 1994 Act by filing a Form TM55 headed ‘**Notice of appeal to the Appointed Person**’ rather than by filing a Form 41.25 ‘**Form of appeal in appeal under statute to the Court of Session**’ and must accordingly have elected under Section 76(2) of the Act to have its Appeal heard by an Appointed Person rather than by the Court of Session. They further emphasised that the matters relied on in support of the request for referral did not demonstrate that the Applicant would be deprived of any legitimate juridical advantage if it was required to proceed with its Appeal before the Appointed Person rather than before the Court of Session.

8. In relation to the general contours of the exercise of discretion under Section 76(3), the Opponent referred to paragraph [10] of the decision of Mr. David Kitchin QC sitting as the Appointed Person in ELIZABETH EMANUEL Trade Mark [2004] RPC 15 where he derived the following principles from the decisions of the Appointed Persons in AJ and MA Levy’s Trade mark [1999] RPC 291 (Mr. Matthew Clarke QC) and ACADEMY Trade Mark [2000] RPC 35 (Mr. Simon Thorley QC):

- (a) the Appointed person has a discretion whether or not to refer an appeal to the court; he has that discretion even if it appears to him that a point of general legal importance is involved;
- (b) the power to refer appeals to the court should be used sparingly, otherwise the clear object of the legislation

to provide a relatively inexpensive, quick and final resolution of appeals by a specialist tribunal would be defeated;

- (c) it will be very rare to make a reference in circumstances where a point of general legal importance cannot be identified;
- (d) the cost and expense to the party not seeking to refer should be taken into account; this is a matter which may be of particular significance in a case where the party in question is an individual or small company or partnership;
- (e) regard must be had to the public interest generally. There is a public interest in having any uncertainty as to the state of the register resolved as soon as possible. On the other hand there is a public interest in having important points of law decided by the higher courts;
- (f) the attitude of the registrar is important but not decisive.

It was maintained on behalf of the Opponent that the Applicant had identified no considerations of any materiality with respect to any of these factors in support of its application for referral.

9. In a letter of 15 November 2013, Mr. Raoul Colombo acting on behalf of the Registrar of Trade Marks submitted that there was no sufficient or proper basis for referring the Appeal to the Court of Session under Section 76(3). Having drawn attention to the established proposition that an appeal under Section 76 of the Act does not, in inter partes proceedings such as the present, provide an opportunity for the unsuccessful party to have a re-hearing of the case, he observed that: *‘It appears to the Registrar that the appellant is merely seeking to have the Hearing Officer’s decision re-heard and that it believes that it will have greater success if the appeal hearing is determined by the Court of Session in Scotland rather than by the Appointed Person’*.

10. In relation to the main objective of the request, he commented as follows:

In the appellant's request for a transfer, it is asserted that the Hearing Officer failed to take sufficient account of the evidence of the applicant's reputation as a pop group; failed to properly consider the distinctiveness of the prefix 'Henry Spurway' and failed to take sufficient notice of the lack of any evidence to show actual or potential confusion between the applicant's and opponent's trade marks. It is the Registrar's view that these assertions do not amount to points of general legal importance but are instead issues of fact and established law which could be properly determined by the Appointed Person. It was for the appellant to establish the facts on which it seeks to rely in its evidence. The suggestion that the Court of Session might be more familiar with those facts because it is based in Scotland appears to be tantamount to suggesting that the Court may be able to make up for any shortfall or lack of clarity in the appellant's evidence by relying on its own knowledge. It is respectfully submitted that this would not be proper reason to transfer the case to the Court of Session because it amounts to a belief that doing so will give the appellant an evidential advantage over the respondent.

11. He provided the following clarification in response to the suggestion that the Applicant had been prejudiced by being unable to appear personally at the hearing below:

It is the established practice of the Registrar for the Hearing Officer to be located in Newport with the parties attending either in person, or by videoconference or telephone, as preferred. In this case, the respondent's legal representatives chose to attend in person and the appellant's representatives chose to use the videoconference facility in Glasgow. This was later changed to Edinburgh. The transcript of the hearing confirms that there were no contemporaneous issues or complaints in respect of the arrangements for the day. And whilst there was a loss of connection with the Edinburgh videoconference facility, the Hearing Officer took the representatives back to the beginning of the submissions on the particular point which was being made when the connection was lost. The transcript confirms that the parties



were content with the way in which the Hearing Officer conducted the hearing.

12. The logistical advantages to the Applicant of having the appeal transferred to the Court of Session were seen by the Registrar to be by the same token logistical disadvantages to the Opponent:

The Registrar acknowledges the possible travel advantages to the appellant, of a transfer of the appeal to the Court of Session, given that he is domiciled in Scotland. However, any such benefit to the appellant would bring an equal disbenefit to the respondent. Further, it might require the respondent to instruct new Scottish legal representatives which would be clearly disproportionately costly for the respondent compared to the appellant travelling to London, or appearing by video link, or by the Appointed Person sitting in Scotland, as has happened in the past.

13. For the reasons indicated and for lack of any point of general legal importance arising out of the Hearing Officer's decision, the Registrar submitted that the request for referral should be refused.

14. On 19 November 2013 the parties and the Registrar were informed that any request for a hearing in relation to the question whether the Appeal should be referred to the Court of Session had to be notified to the Tribunal by no later than 5:00pm on 29 November 2013 and that in the absence of any request for a hearing a decision would be issued in relation to that question taking account of the written representations that had been received.

15. On 26 November 2013 the Applicant's agents of record, MacRoberts LLP, sent a letter stating that they were no longer acting for the Applicant in this matter. They were informed by return that it remained necessary for any request for a hearing to be made by

5:00pm on 29 November 2013 as previously directed. MacRoberts LLP responded saying that they had passed that information to the Applicant.

16. In a letter sent on 27 November 2013, Mr. Spurway of the Applicant wrote to the Tribunal, the Opponent and the Registrar stating:

Success Story Management Ltd notified MacRoberts solicitors that their instructions had not been carried out regarding correct procedure/process with the appeal against the decision of 11 June 2013. The instructions were that the appeal hearing should have been referred directly to the Court of Session in Scotland.

17. That letter followed on from a letter of 13 November 2013 in which MacRoberts LLP had written to the Tribunal on behalf of the Applicant to say that there had been a misunderstanding:

We refer to the letter from Edwards Wildman dated 7 November 2013. For clarification purposes the Appellant's initial election for the Appeal to be heard by the Appointed Person was a result of a misunderstanding with regard to process.

It was understood that (following a discussion with a party at the UKIPO following the issuing of the decision of 11 June 2013) the Appeal was to be filed on or before 9 July 2013 to the Appointed Person and then that the Appointed Person be asked to refer the matter to the Court of Session. It is now understood that this was not the correct procedure.

It was always the intention and wish of the Appellant to have the Appeal heard before the Court of Session. We ask that the Appellant's position is not prejudiced as a result of this misunderstanding of the Appeal process which was not the fault of the Appellant.

18. The Applicant's request for referral of the Appeal to the Court of Session under Section 76(3)(c) of the 1994 Act now falls to be determined without recourse to a hearing

(there having been no request for a hearing to consider the matter) taking account of the written representations received.

19. I begin by observing in relation to appeals from decisions of the Registrar that appellants have the option under Section 76(2) to appeal ‘*either to an appointed person or to the court*’, with ‘*the court*’ being defined for that purpose as: the High Court in England and Wales: Section 76(6); the High Court in Northern Ireland: Section 75(aa); the Court of Session in Scotland: Section 75(b).

20. Decisions taken by the Registrar are accordingly issued to the parties under cover of an official letter informing them in standard terms of the options available with regard to appeal. The information provided by the official letter at the time of the decision in the present case was to the following effect:

A decision in the above matter is enclosed. Under the provisions of the Trade Marks Act 1994, you may appeal against this decision to either the “Appointed Person” or to “the court”. The Trade Marks Act defines the Appointed Person as a person appointed by the Lord Chancellor to hear and decide appeals. Section 75 of the Act defines “the court” in England and Wales and Northern Ireland, as the High Court and in Scotland, as the Court of Session.

An appeal to the Appointed Person will need to be made on a TM55 form (which incorporates the Statement of Grounds), required by The Trade Marks (Amendment) Rules 2008.

The appeal period to the Appointed Person and to the High Court in England and Wales is 28 days beginning with the date of the Registrars decision. Therefore any appeal must be made by [xxxx]. To extend this period for appeals to the Appointed Person, detailed and compelling reasons must be submitted to the Registrar, along with a TM9 and a fee of £100. Jurisdiction to extend the period for appealing to the High Court in England and Wales rests with that court. Different appeal periods may apply for appeals to the High Court in Northern Ireland or to the Court of Session in

Scotland. You should seek further information from those courts if you intend to appeal to them. **If an Appeal to the Court is made then the Trade Marks Registry should be informed in writing.**

21. MacRoberts LLP represented the Applicant at the hearing which took place (by videolink) before the Hearing Officer. I have no reason to believe that there was any departure from the usual practice when the Hearing Officer's decision was subsequently issued to the parties. It also appears to me to be inconceivable that MacRoberts LLP could have filed the Notice and Grounds of Appeal on behalf of the Applicant using a Form TM55 conspicuously headed '*Notice of Appeal to the Appointed Person*' without knowing full well that they were not thereby appealing to any court, including the Court of Session in Scotland. Indeed the statement in paragraph 18 of the Grounds of Appeal that '*The Applicant/Appellant intends to seek leave to have this Appeal heard by the Court of Session under Section 76(3) of the Act*' confirms that they understood not only that the Appeal was proceeding before the Appointed Person, but also that it would continue before the Appointed Person unless and until there was a successful request for referral to '*the court*' (in this case the Court of Session) under Section 76(3).

22. It appears to me that the only misunderstanding there may have been on the part of MacRoberts LLP with regard to the filing of the Form TM55 was as to the Applicant's prospects of applying successfully to an Appointed Person for referral of the Appeal to the Court of Session, not as to the consequences of appealing to an Appointed Person and applying unsuccessfully for referral of the Appeal to the Court of Session. Seen from that perspective, the assertion by Mr. Spurway that the Applicant's '*instructions were that the appeal hearing should have been referred directly to the Court of Session in Scotland*' does not enable me to determine that its Appeal to the Appointed Person should be

regarded either as a nullity or as exempt from the legislatively prescribed consequence that it should proceed before the Appointed Person unless there is a sufficient and proper basis for referring it to the court under Section 76(3)(c).

23. In the present case, no less than in other cases where a request for referral is made under that section, the starting point is that the Appointed Person is seized of the pending appeal as a result of the valid and effective filing of a Form TM55. The written representations sent on behalf of the Applicant on 28 October 2013 took that as their starting point and sought to make a case for referral on the basis that the Court of Session would be *‘the most appropriate forum geographically to hear the Appeal’* inter alia because the Court of Session *‘will have local knowledge of at least one of the revived and revamped pop bands of latter years where a prefix has been used to identify the specific entity in the same way as is proposed by the Applicant with the mark Henry Spurway’s Bilbo Baggins, namely “Les McKeown’s Bay City Rollers”’*.

24. It would, in my view, be wrong in principle to make an order for referral on the basis of reasoning such as this. In accordance with the requirements of Article 6 ECHR, the Appeal must be determined by an independent and impartial tribunal acting with due and proper regard for the evidence on file and in accordance with the basic principle that it is not the role of an appellate tribunal to determine cases on appeal as if it was deciding them in the first instance. Local knowledge of “Les McKeown’s Bay City Rollers” or of Bilbo Baggins as a pop group formed in Scotland in the 1970’s could not, moreover, be allowed to distract attention away from the fact that the opposed application was for protection of the mark HENRY SPURWAY’S BILBO BAGGINS by registration in Classes 9 and 41 throughout the United Kingdom. It is precisely because the 1994 Act

provides for protection by registration throughout the United Kingdom that the Registrar in the first instance and '*the court*' and the Appointed Person on appeal from the Registrar under Section 76 cannot be regarded as exercising a jurisdiction that is local to England and Wales, Northern Ireland or Scotland.

25. The logistical convenience to the applicant and the logistical inconvenience to the Opponent of having the Appeal determined by a tribunal sitting in Scotland appear to me to be factors which would need to be considered if there was an issue as to which of the three possible candidates should be specified as '*the court*' in the event of an order for referral under Section 76(3). They are not matters which go to the anterior question whether the Appeal should be referred to '*the court*' in the exercise of the discretion conferred by that Section of the Act.

26. It is rightly not contended that the Appeal raises any point of general legal importance. It is not demonstrated that the Applicant would be deprived of any legitimate juridical advantage if it was required to proceed with its Appeal before the Appointed Person rather than before '*the court*'. The domicile of the Applicant (a Scottish company based in Edinburgh) and the Opponent (a Delaware corporation based in Berkeley, California) are immaterial to the question whether the Appeal relating to Opposition No. 102670 to UK Trade Mark Application No. 2588875 ought to be referred. No points of any real significance or substance have been raised in relation to that question in the written representations made on behalf of the Applicant. I am satisfied on the basis of the materials before me that this is not a case in which there should be an order for referral of the appeal to '*the court*' under Section 76(3). The Applicant's request for referral is dismissed. The question of how and by whom the costs of the unsuccessful request are to

be borne and paid is reserved for determination at the conclusion of the proceedings on appeal.

Geoffrey Hobbs Q.C.

27 February 2014

Mr. Euan Duncan of MacRoberts LLP submitted written representations on behalf of the Applicant

Mr. John Olsen and Ms. Frédérique Bodson of Edwards Wildman Palmer UK LLP submitted written representations on behalf of the Opponent.

Mr. Raoul Colombo submitted written representations on behalf of the Registrar.