

1 UK INTELLECTUAL PROPERTY OFFICE

The Rolls Building
7 Rolls Buildings
Fetter Lane
London EC4A 1NL.

4 Friday, 30th May 2014.

5 Before:

6 MR. G. HOBBS QC
7 (The Appointed Person)
- - - - -

8 In the matter of THE TRADE MARKS ACT, 1994

9 and

10 In the matter of Trade Mark Application No. 2583035 in the
11 name of Technopharma Limited and opposition
12 thereto under No. 102865 by Unilever Plc and
Unilever NV

13 and

14 In the matter of Trade Mark Application No. 2346305 by
15 Unilever Plc and opposition thereto under
No. 92847 by Technopharma Limited

16 - - - - -
17 Appeal of the Opponents from the
Decision of Mr. CJ Bowen

18 (Computer-aided transcript of the Stenograph Notes
19 of: Marten Walsh Cherer Limited, 1st Floor, Quality House,
6-9 Quality Court, Chancery Lane, London WC2A 1HP.
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21 MR. ROWLAND BUEHRLLEN (of Beck Greener) appeared for the
22 Applicants/Respondents.

23 MS. ANGELA FOX (of RGC Jenkins & Co.) appeared for the
24 Opponents/Appellants.

25 DECISION
(As approved by the Appointed Person)

1 THE APPOINTED PERSON: On 7th November 2013, Mr. David Landau
2 issued a decision on behalf of the Registrar of Trade Marks in
3 which he rejected Technopharma Limited's opposition to
4 Unilever Plc's trade mark application number 2346305 and
5 upheld the opposition of Unilever plc and Unilever NV to
6 Technopharma Limited's trade mark application number 2583035.

7 Technopharma proposed to appeal to an Appointed Person
8 under section 76 of the Trade Marks Act 1994. In accordance
9 with the provisions of rule 71(2) of the Trade Marks Rules
10 2008, it needed to file a Form TM55 setting out its grounds of
11 appeal and statement of case in support within a period of 28
12 days beginning with the date of the Hearing Officer's
13 decision.

14 During the 28 day period there were two-way
15 communications between the parties' professional
16 representatives in the US and in the UK with a view to
17 achieving a negotiated settlement of the UK proceedings and
18 disputes in other jurisdictions. There was, in
19 particular, a communication between their professional
20 representatives in the UK on 26th November 2013, in which
21 Unilever's professional representative indicated that Unilever
22 would prefer to liaise with Technopharma's professional
23 representatives in the UK with the aim of resolving their
24 differences on the basis of a signed agreement within two
25 weeks: i.e. by 10th December 2013.

1 In addition to considering the potential settlement with
2 Unilever, Technopharma was considering the viability of an
3 appeal and had, for that purpose, requested and received a
4 transcript of the hearing before Mr. Landau, at which there
5 had been cross-examination of one of its directors, Mr. Michel
6 Farah. Technopharma was not ready to file a Form TM55 within
7 the 28 day period prescribed by rule 71(2). It therefore
8 filed a Form TM9 on 5th December 2013 requesting a one month
9 extension of time under rule 77(1). The stated basis for the
10 request was: "The parties are in negotiations which it is
11 believed may resolve the dispute, including disputes in other
12 jurisdictions. We have received a response from Unilever's
13 representatives of 26th November 2013. Our client has
14 indicated it needs to discuss this with its shareholders."
15 The first two sentences of that statement were true and there
16 is no reason to suppose that the third sentence was not also
17 true.

18 In an official letter of 20th December 2013 the Registry
19 expressed a preliminary view to the effect that it was minded
20 to grant the requested extension of time. Unilever might have
21 recognised that it would make little, if any, difference to
22 the progress of the proposed appeal if Technopharma filed its
23 Form TM55 after the Christmas and New Year period, on 5th
24 January 2014, rather than before the Christmas and New Year
25 period, in early December 2013. However, Unilever objected to

1 the request for an extension of time in a letter of 2nd
2 January 2014, in which they maintained that the parties were not
3 in negotiations at the date the request for additional time
4 was filed and that the request did not provide strong and
5 compelling reasons for an extension or indicate why it was not
6 possible for Technopharma to do what needed to be done within
7 the original period allowed. The lesson of that approach, for
8 anyone engaging in settlement negotiations during the period
9 of 28 days allowed for appeal, is to count on objection from
10 the opposite party if the opportunity to prevent the granting
11 of an extension of time presents itself.

12 On 3rd January 2014, Technopharma filed its Form TM55.
13 In an official letter of 30th January 2014, the Registry again
14 confirmed its preliminary view to the effect that the one
15 month extension of time which Technopharma had requested on
16 5th December should be granted. Unilever nevertheless
17 maintained their objection and a hearing was appointed to
18 consider Technopharma's request. That took place by telephone
19 before Mr. CJ Bowen on 18th February 2014. That is to say, more
20 than eleven weeks after the Form TM9 had been filed and more
21 than six weeks after the Form TM55 had been filed.

22 The Hearing Officer felt the need to consider overnight
23 the documentary material and submissions he had received. He
24 issued his decision letter the following day. Having
25 carefully reviewed the materials before him and the arguments

1 of the parties and the case law cited to him, he said, in
2 paragraph 19 on page 7 of his letter: "... I am satisfied
3 that not only were negotiations extant at the time the request
4 for additional time was filed but given the nature of the
5 dispute between the parties and the ground upon which Unilever
6 ultimately succeeded (and against which Technopharma would
7 have to appeal) Technopharma's request to extend the appeal
8 period by one month until 5th January 2014 to allow it inter
9 alia to prepare and consider its Notice of Appeal was reasonable
10 and is granted." Upon that basis he concluded, in paragraph
11 20, on page 8 of his letter, that: "Technopharma's appeal to
12 the Appointed Person filed on 3rd January 2014 was filed in
13 time and will be admitted into the proceedings."

14 Unilever then had 28 days, beginning on 20th February
15 2014, within which to consider whether they wished to appeal.
16 On 17th March they appealed to an Appointed Person contending
17 in substance that the Hearing Officer had wrongly exercised
18 his discretion to extend time under rule 77: [1] by basing
19 himself on grounds not foreshadowed in the Form TM9; [2] by
20 failing to apply the public interest considerations relating
21 to extensions of time for the filing of notices of appeal;
22 and [3] by granting an extension in circumstances where the
23 facts of the case did not merit it. These contentions were
24 further developed in argument at the hearing before me.

25 At this point I must emphasise that the decision under

1 appeal was a case management decision made in the exercise of
2 a discretion which exists for the purpose of enabling just
3 and fair extensions of time to be granted. In order to
4 succeed on appeal in relation to a decision of that kind, it
5 is necessary for the appellant to establish that the
6 decision-taker could not properly have exercised his
7 discretion in the way that he did for the reasons that he did.
8 The width of the discretion available to the Hearing Officer
9 is underscored by the opening words of rule 62(1): "Except
10 where the Act or these rules otherwise provide, the Registrar
11 may give such directions as to the management of any
12 proceedings as the Registrar thinks fit", and by the
13 confirmation provided by rule 77(1), that the Registrar is
14 able on his own initiative to extend the time or period
15 prescribed by the rules or a time or period specified by the
16 Registrar for doing any act; and by the confirmation provided
17 by rule 77(2) that there is no separate regime for the
18 determination of applications made after expiry of the
19 relevant deadline instead of prior to expiry.

20 In view of the reliance that Unilever has sought to
21 place upon the relatively recent decision of the Court of
22 Appeal in *Mitchell v. News Group Newspapers Ltd* [2013] EWCA
23 Civ 1537, I should emphasise that in the even more recent
24 decision of the Court of Appeal in *Hallam Estates Ltd v. Baker*
25 [2014] EWCA Civ 661, at paragraphs [11],[12],[26],[27]and [30]

1 it has been made clear that applications for extension made in
2 time should not be analogised to applications for relief
3 against sanctions and that reasonable extensions of time which
4 neither imperil hearing dates nor otherwise disrupt the
5 proceedings are acceptable in principle.

6 I note before turning to the three main grounds of
7 appeal that there was -- and it is accepted by Unilever that
8 there was -- no abuse of process by or on behalf of
9 Technopharma in connection with the making of its request for
10 an extension of time.

11 With regard to the first main ground of appeal, I was
12 asked to accept that Technopharma had expanded upon its stated
13 basis for seeking an extension of time, as recorded in its
14 Form TM9, to such an extent that it had ended up making, and
15 the Hearing Officer had ultimately acceded to, an application
16 on grounds of which Unilever had not had fair and proper
17 notice. It was suggested that this amounted to a serious
18 procedural irregularity which should lead to the Hearing
19 Officer's decision being set aside and the request for an
20 extension being remitted to the Registry for a fresh
21 determination.

22 It is readily apparent that Technopharma did expand upon
23 its Form TM9 to a substantial degree. It appears to me that
24 it did so in order to meet the case that Unilever were putting
25 against it. There was, as is usual in contested inter partes

1 proceedings, a process of action and reaction in the
2 preparation and presentation of the cases for and against
3 extension. Technopharma's case was foreshadowed in its
4 skeleton argument for the hearing, but only partially
5 foreshadowed in its Form TM9. It can be seen from paragraphs
6 12 to 14 of the Hearing Officer's decision that he considered
7 and rejected a submission on behalf of Unilever to the effect
8 that he should disregard the grounds advanced in the skeleton,
9 which were not foreshadowed in the Form TM9. The making of
10 that submission carried with it the corollary that the grounds
11 to which it related would be considered if the submission was,
12 as it was, rejected.

13 There was no request by Unilever for an adjournment to
14 consider their position in the event that the Hearing Officer
15 was minded to do what he did: i.e. take account of the
16 grounds to which they objected. Moreover, they are grounds
17 which do not appear to me to have been at all startling or
18 unpredictable and they are grounds of which Unilever had
19 sufficient notice in advance of the hearing to be able to deal
20 with them appropriately as they wished. It was not incumbent
21 upon the Hearing Officer to go through an elaborate process of
22 inviting Technopharma to put the additional grounds forward
23 for consideration as amendments to its Form TM9 and inviting
24 the parties then to make detailed submissions in accordance
25 with the law and practice of amendment in Registry proceedings

1 with a view to ruling on whether they were or were not
2 allowable amendments. He was entitled to do what he did:
3 i.e. recognise that additional grounds were being put forward,
4 consider Unilever's objections to them being put forward,
5 reject those objections and then proceed to give such weight
6 as he thought fit to those additional grounds.

7 I should add that my decision on appeal in the Ministry
8 of Sound case BL O/136/03 does not say or suggest otherwise in
9 the passages quoted in paragraph 12 of the Hearing Officer's
10 decision.

11 The second main ground of appeal proceeds upon the
12 premise that the time limit of 28 days set by rule 71(2)
13 should be regarded as a strict, indeed very strict, time limit
14 having regard to the public interest in finality of litigation
15 and certainty of outcome noted by Mr. Simon Thorley QC in his
16 decision on appeal in the Whiteline Windows case, BL O/290/00.
17 I agree with the proposition that the time limits set by that
18 rule should be seen to have been established with a view to
19 serving those aspects of the public interest. The deadline of
20 28 days is, none the less, extendible under rules 77(1) and (2)
21 and there is a public interest in enabling just and fair
22 extensions of time to be granted under rule 71(2) just as
23 there is in enabling just and fair extensions of time to be
24 granted under other provisions of the rules.

25 The concrete question for determination in the present

1 case was whether the public interest required Technopharma to
2 file its Form TM55 by 5th December 2013, rather than by 5th
3 January 2014. The Hearing Officer was mindful of the Whiteline
4 Windows decision, as indicated in paragraph 11 of his
5 decision, and will have been mindful of it as a result of his
6 knowledge and experience of decision-taking in the Registry in
7 relation to requests for extensions of time. It is implicit
8 in his decision that he was not minded to elevate the public
9 interest argument which had been addressed to him to the
10 status of a fatal objection in the circumstances of this case
11 and that he was, moreover, satisfied that the public interest
12 did not require him to regard 5th December 2013, rather than
13 5th January 2014, as the only acceptable date for the filing
14 of the Form TM55.

15 With regard to the third main ground of appeal, it is
16 clear not only that there was a paucity of evidence as to the
17 degree of diligence with which Technopharma had been and was
18 proposing to address itself to the task of preparing and
19 filing a Form TM55, but also that the Hearing Officer was not
20 particularly comfortable with the position in which that had
21 left him in relation to the decision he was being asked to
22 make: see paragraphs 15, 17 and 23 of the decision letter.
23 That, to my mind, points to him having made the decision he
24 did with his eyes wide open to the evidential deficiencies in
25 Technopharma's case and therefore with particular concern for

1 the view that those deficiencies should ultimately not stand
2 in the way of the requested extension of time.

3 Stepping back from the submissions which were made to me
4 and which I have considered in the decision that I am now
5 delivering, it appears to me that the decision taken by the
6 Hearing Officer was one which it was open to him to
7 take in the legitimate exercise of his discretion under the
8 applicable rules and case law. I do not think this is a case in
9 which it is open to this tribunal to interfere with the exercise
10 of that discretion. For the reasons I have given, the
11 appeal will therefore be dismissed.

12 MR. BUEHRLLEN: Thank you, sir.

13 THE APPOINTED PERSON: Is there anything else?

14 MR. BUEHRLLEN: Can I make an application on costs, sir?

15 THE APPOINTED PERSON: What do you want to say?

16 MR. BUEHRLLEN: Essentially, sir, the challenge to the request for
17 an extension of time, which was originally based on an abuse
18 of process, was essentially challenging the veracity of the
19 request for the extension of time.

20 THE APPOINTED PERSON: That is the proceedings below.

21 MR. BUEHRLLEN: That is correct, sir.

22 THE APPOINTED PERSON: You have not got a cross-appeal or a
23 respondent's notice to set aside or alter the Hearing
24 Officer's order for costs below. You can only address me on
25 the costs of this appeal.

1 MR. BUEHRLEN: In that case, sir, when it comes to this appeal, I
2 believe that this appeal was mainly tactical, in the hope of
3 trying to deny the appeal on the merits and it also, in my
4 estimation, consisted of having studied a number of cases that
5 appeared to be somewhat irrelevant, sir, which were quite time
6 consuming, in particular because I was unfamiliar with them as
7 they did not really relate to trade mark issues.

8 THE APPOINTED PERSON: Would you be prepared to give an
9 indication, I am only speak roughly but none the less
10 truthfully, an indication of the amount of time and the costs
11 figure that you would associate or allocate with it?

12 MR. BUEHRLEN: I would estimate that there would be about six
13 hours in reading through the documents to prepare for the
14 attendance at the hearing.

15 THE APPOINTED PERSON: Plus today's time.

16 MR. BUEHRLEN: Plus today's time -- well, this morning was two and
17 a half hours.

18 THE APPOINTED PERSON: No, half-past ten to half-past 12, two
19 hours and it will be half an hour by the time we finish. So
20 would you care to put a figure on that?

21 MR. BUEHRLEN: That would be in the region of about £3,000, sir.

22 THE APPOINTED PERSON: So you are asking for an award of costs in
23 respect of this hearing, using the usual rough and ready
24 approach that one does in relation to these proceedings and
25 your benchmark figure is you have indicated £3,000 and you

1 have explained why.

2 MR. BUEHRLLEN: Yes, sir.

3 THE APPOINTED PERSON: What would you like to say?

4 MS. FOX: In the matter of costs, all the costs in this appeal
5 have been incurred because of omissions on the part of the
6 respondent and the respondent failed to file a timely Notice
7 of Appeal, the respondent failed to succinctly and correctly
8 set out the reasons for its request for an extension in its
9 TM9 and ultimately all the costs in this case flow from those
10 omissions. It is, therefore, our submission that the
11 respondent should pay the costs of the appellants in this
12 case, exceptionally, and if you were not minded to be with me
13 on that point, then we would submit that no costs should be
14 ordered in this case.

15 THE APPOINTED PERSON: I am firmly of the view that costs should
16 follow the event. The appeal has been dismissed. There
17 should be a contribution by the unsuccessful party to the
18 successful party. I am particularly concerned that this
19 appeal was persisted with notwithstanding that the form TM55
20 was filed on 3rd January this year, that there were two
21 preliminary views expressed by the Registry indicating that
22 they were minded to grant an extension, that the Hearing
23 Officer eventually came to that conclusion. It is against
24 that background that Unilever has persisted, none the less, in
25 pursuing this matter on appeal and consequently holding up the

1 other proceedings by the length of time it has taken for this
2 appeal to be determined. So I am minded to make an award in
3 favour of Technopharma. Do you want to say anything about the
4 quantum that has been suggested?

5 MS. FOX: Yes, please. It seems to me that this is a case in
6 which no more costs than those in the Registry's published
7 scale of costs should be awarded and I believe that the limit
8 for the costs in an appeal hearing in the Registry's published
9 scale is I believe £1,300. Certainly we would resist any
10 order for costs above that level.

11 THE APPOINTED PERSON: My own perception of the appeal was that it
12 did require Mr. Buehrlen to carry out research into other
13 areas of case law that he would not have been familiar with.
14 It was not what I would regard as a plain vanilla and
15 straightforward appeal, notwithstanding that it touched upon
16 and concerned various decisions of the appointed persons as
17 well. I think that a commensurate award, none the less,
18 without trying to make anything approaching an indemnity
19 order, would be to require the unsuccessful party to pay the
20 successful party £1,200 in respect of his costs of this
21 appeal, that sum to be paid within 14 days of today's date.

22 MR. BUEHRLLEN: Thank you, sir.

23 THE APPOINTED PERSON: I think that concludes it for today. Thank
24 you both very much for your submissions. Thank you both very
25 much for your preparation of the case. I got to it late last

1 night but I got to it and I was able to benefit very much from
2 the opportunity to pre-read the materials which you provided,
3 for which many thanks.

4 I have come to the habit of saying for the sake of the
5 record that the parties are entitled not just to a transcript
6 of the judgment, which I will approve in due course, but also
7 to a transcript of the proceedings. Sometimes that is a bit
8 slow reaching them. If you do not receive it within a week or
9 so, you are at liberty to make enquiries to the Treasury
10 Solicitor's department as to where it might have got to. I am
11 saying a week or so because that is about the sort of time
12 phase that the shorthand writers require in order to produce
13 the transcript.

14 Thank you. That is it for today.

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