

TRADE MARKS ACT 1994

IN THE MATTER OF:

OPPOSITION No. 92232

IN THE NAME OF AERO LEATHER CLOTHING LTD.

TO TRADE MARK APPLICATION No. 2339327

IN THE NAME OF LEWIS LEATHERS LTD.

DECISION

1. On 31 July 2005 Lewis Leathers Ltd (*“the Applicant”*) applied to register the following trade mark for use in relation to ‘*articles of leather clothing for wear by motorcyclists*’ in Class 25:



2. The application was opposed by Aero Leather Clothing Ltd (*“the Opponent”*) on 5th January 2004. Objections to registration were raised under Sections 5(2)(a), 5(2)(b), 5(3), 5(4)(a), 5(4)(b) and 3(6) of the Trade Marks Act 1994. On 4th May 2004 the

Applicant filed a counter statement joining issue with the Opponent on the grounds of opposition.

3. The Opponent filed evidence in support of the opposition. This consisted of a Witness Statement of Ken Calder with 11 exhibits dated 6th October 2004. The Applicant filed no evidence in defence of the application for registration.

4. On 1st August 2005 Mr. M. Foley acting on behalf of the Registrar of Trade Marks issued a decision (BL O-216-05) upholding the objection to registration under Section 5(4)(a) of the Act. He ordered the Applicant to pay the Opponent £1,100 as a contribution towards its costs of the Registry proceedings.

5. In paragraph 6 of the decision it was recorded that neither side had requested an oral hearing and both had elected to have the opposition determined on the basis of the papers on file. However, there appears to have been a misunderstanding as to the position of the parties during the period between the filing of the Opponent's evidence and the date on which the decision was issued. According to the Applicant's Statement of Grounds for Appeal filed under Section 76 of the Act on 30th August 2005:

“(3) Subsequent to the Opposition being filed, the Applicant and the Opponent engaged in negotiations aimed at resolving the Opposition.

(4) The Applicant and the Opponent settled the Opposition on the basis that the Applicant would assign the application to the Opponent for a nominal fee, the Opponent would not pursue the Applicant for its costs and the Applicant would not use the word “Highwayman” or any confusing similar mark in relation to clothing.

- (5) On the 1st of August 2005 the Registrar for Trade Marks made an Order in relation to the current proceedings.
- (6) In his Order, the Registrar for Trade Marks upheld the Opposition and refused to grant the Application. The Registrar also ordered that the Applicant make a contribution of £1,100 to the costs incurred by the Opponent.
- (7) This Order was unexpected since solicitors acting for the Applicant had been in contact with the Case Work Examiner Mark King on 19th January 2005 and later with Craig Ashell on 10th May 2005. The Applicant's solicitors informed both the respective Examiners that negotiations with a view to settling the current proceedings had been entered into with the Opponent and that no decision should be issued while such negotiations were ongoing. The Applicant's solicitors were further informed that there was no time limit on responding and to notify the Trade Mark Office on completion of the negotiations. On contacting Jacky Pitt at the Trade Mark Registry on 2nd August 2005, the Applicant's solicitors were informed that an Order had been made by the Registrar on 1st August 2005.
- (8) The Order granted by the Registrar clearly conflicts with the agreement made by the Opponent and the Applicant. As such, it was in neither the Applicant nor the Opponent's interests for the Order to have been granted, and this remains to be the case after the Order has been granted.
- (9) Accordingly, the Applicant, with the consent of the Opponent (that is attached hereto) requests that the Order granted by the Registrar dated the 1st of August 2005 is set aside and that no order for costs in this matter is made."

6. On reviewing the Statement of Grounds for Appeal it appeared to me that it would be appropriate for the parties and the Registrar to consider whether the appeal might be resolved by consent consistently with the approach adopted in OKO Trade Mark (BL O-195-03, 23 June 2003), QUORN HUNT Trade Mark (BL O-127-95, 29 April 2005) and

Revocation Application No. 81755 in the name of Jailhouse Rock Rights Ltd (BL O-121-05, 15 March 2005). The Treasury Solicitor's Department forwarded my observations to those concerned. In response it was confirmed that the Applicant and the Opponent agreed to my proceeding in the manner set out below and the Registrar had no objection to my proceeding in that manner in the circumstances of the present case.

7. It seems to me that the hearing officer's decision can properly be set aside on the basis that: (1) the parties ceased to have opposing interests in the subject matter of the proceedings when they made the agreement referred to in paragraph 4 of the Statement of Grounds for Appeal; (2) the agreement was the result of negotiations between the parties which had been taking place since January 2005; (3) the parties intended the determination of the opposition proceedings to be deferred pending the outcome of their negotiations and believed as a result of communications with the Registry that such would be the case; (4) the Registrar did not intend to render the negotiations ineffective by issuing a supervening decision on the merits of the opposition.

8. I therefore direct and determine with the consent of the parties as envisaged by their settlement agreement that:

- (1) the decision and order of Mr. M. Foley acting on behalf of the Registrar of Trade Marks in Opposition No. 92232 be set aside;
- (2) the Applicant's appeal from that decision and order stands withdrawn with no order as to costs;

(3) Opposition No. 92232 stands withdrawn with no order as to costs.

Geoffrey Hobbs Q.C.

16 January 2006