

1 THE PATENT COURT

Court Room 1
Harmsworth House
13-15 Bouverie Street
London, EC4Y 8DP

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Wednesday, 22nd January 2003

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B e f o r e:

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THE REGISTRAR'S PRINCIPAL HEARING OFFICER
(MR. J MacGILLIVRAY)

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(Sitting for the Comptroller-General of Patents, etc.)

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In the Matter of the TRADE MARKS ACT 1994

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and

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In the Matter of United Kingdom Trade Mark
Application No. 2207412 STALINSKAYA & Device

12

(a series of two marks) in Class 33 of SC Prodal 94 SRL

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and

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In the Matter of Opposition thereto by
SPIRITS INTERNATIONAL NV No. 50901

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(Computer-aided Transcript of the Stenograph Notes of
Marten Walsh Cherer Ltd., Midway House,
27/29 Cursitor Street, London, EC4A 1LT.

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Telephone No: 0207 405 5010. Fax No: 0207 405 5026.)

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MS. MADELEINE HEAL (instructed by Messrs. David Keltie
Associates) appeared on behalf of the Applicants.

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MR ANDREW NORRIS (instructed by Messrs. Marks & Clerk) appeared
on behalf of the Opponents.

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D E C I S I O N
(as approved by the hearing officer)

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1 THE HEARING OFFICER: I need to make a decision on the
2 preliminary point and I intend to make an oral decision here
3 and now.

4 First of all, my decision is not based on the lateness
5 of the application for cross-examination; although it may be
6 a factor it is not a key factor in this. Secondly, my
7 decision is not based on the cost of Mr. Brasiler's journey
8 to the UK; proportionality is a factor but it will not be the
9 key factor in my decision. My major concern is that
10 cross-examination should be reasonable within all the
11 circumstances.

12 Following discussion, the grounds of opposition are
13 limited to section 5(2)(b) on the basis of normal and fair
14 use; that is the opponent's evidence has been disregarded by
15 the opponent in this case.

16 Ms. Heal quite rightly states that she is entitled to
17 take account of all the evidence that has been submitted.
18 That is a very fair point. However, it seems to me that
19 normal and fair use essentially may consist of a theoretical
20 use of the marks concerned in relation to the identical
21 goods, in this case vodka, and on the product itself.
22 Indeed, it seems to me that must be the most normal and fair
23 use it is possible to make for the marks in question.

24 Ms. Heal states that there are exhibits in SB2 to
25 Mr. Brasiler's declaration which go to the actual use of the

1 mark, which if she was allowed to cross-examine Mr. Brasiler
2 could be key to my determination on the issue of normal and
3 fair use.

4 In the circumstances I am not convinced by those
5 arguments. On the basis of the information before me I find
6 against the applicant in their request to cross-examine
7 Mr. Brasiler.

8 MS. HEAL: Is that on the basis of 5(2)(b) and 3(3)(b)?

9 THE HEARING OFFICER: Both points. As mentioned earlier in
10 relation to 3(3)(b) you did say it was essentially the same
11 point.

12 MS. HEAL: The subject matter is the same.

13 THE HEARING OFFICER: Yes, the subject matter was the same.

14 MS. HEAL: Would you give reasons for your refusal on 3(3)(b).

15 THE HEARING OFFICER: 3(3)(b) essentially relates to absolute
16 grounds. The way in which the opponents used their
17 particular marks and how they use them is unlikely to be of
18 direct assistance to me; in that if I believed that the
19 public were deceived by use of applicant's the mark the way
20 in which the opponents use their marks would be unlikely to
21 affect that decision. First, two wrongs do not make a right;
22 and secondly, it would not necessarily demonstrate how the
23 trade in general operates.

24 (For proceedings: see separate transcript)

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