BL-0-0467-23

TRADE MARKS ACT 1994

IN THE MATTER OF:
TRADE MARK APPLICATION NO. 3481419

BY JAMES ROBBIE DEAR
(Applicant/Appellant)

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 421179
BY PEEK & CLOPPENBURG KG
(Opponent/Respondent)

AND

IN THE MATTER OF
APPEAL DECISION NO. O/439/22
DATED 23 MAY 2022

SECOND
DECISION

Introduction

1) This is the determination of what I deemed to be an application by James Robbie Dear for me to reconsider my Appeal Decision No. O/439/22 on the basis of alleged misrepresentations (expressed also as "Fraudulent Representations" and "deliberate misrepresentations") by the Opponent and its representatives, Bird & Bird LLP.

2) These are serious allegations which should not be brought lightly. Furthermore, Mr Dear has pursued his allegations with considerable fervour, which included stating he would be raising the matter with the police.

3) I had reservations about whether Mr Dear's complaint merited a formal decision, partly because much of the substance underpinning Mr Dear's complaint had already been dealt with in my First Decision, and because Mr Dear repeatedly failed to comply with deadlines I set for the substantiation of his claims.

4) However, in view of the *prima facie* seriousness of the allegations and in an effort to bring finality to this matter, I now give this Second Decision.

Background

5) For context it is necessary to set out the background at some length and in some detail.

6) Mr Dear filed his application No. 3481419 ("the Contested Mark") on 14 April 2020.

7) Peek & Cloppenburg KG opposed the Contested Mark on 13 August 2020. In those proceedings the Opponent relied on EUTM No. 14557631 Mc Neal in classes 3, 25 and 35 ("the Earlier EU Mark"). The grounds relied on were Sections 5 (2) (b) and 5 (3) of the Trade Marks Act 1994, although ultimately the S. 5 (3) case was abandoned (I shall return to that later).

8) The Earlier EU Mark was filed at the European Intellectual Property Office ("EUIPO") on 15 September 2015. The registration process for that mark was completed on 13 January 2016.

9) Thus, at the date Mr Dear filed the Contested Mark, the Earlier EU Mark had only been registered for 4 years, 3 months and 1 day.

10) Immediately upon the conclusion of Brexit and IP Completion Day (31 December 2020) a UK TM Registration No. 914557631 ("the Comparable Mark"), derived from the Earlier EU Mark, was created under The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. The Comparable Mark shared the same subject matter, filing, priority and registration dates as the Earlier EU Mark but was a separate, distinct registration.

11) Tribunal Practice Notice (2/2020): "End of Transition Period - impact on tribunal proceedings" Paragraph 3 states that for all tribunal proceedings launched before IP Completion Day (i.e. before 11pm on 31 December 2020):

3. The transitional provisions provide that these proceedings should continue to be dealt with under the Act as it existed before IP Completion Day (i.e. the old law continues to apply). Users should note the following:

- *EUTMs and IR(EU)s will continue to constitute earlier trade marks for the purpose of these proceedings. This applies to both registered and pending marks, although, in the case of the latter, this is subject to the earlier mark subsequently being registered or protected.*
- *it will not be possible to substitute in, or add, comparable marks or re-filed EUTM/IR(EU)s into these proceedings.*

12) Thus the Comparable Mark had no relevance to or role in the opposition which continued based on the Earlier EU Mark.

13) In defending the opposition, Mr Dear sought to put the Opponent to "proof of use" of the Earlier Mark.

14) The "Proof of Use" provisions are set out in S. 6A of the Trade Marks Act 1994. The relevant parts provide as follows:

6*A Raising of relative grounds in opposition proceedings in case of non-use*
(1) This section applies where—
(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c)the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

15) As noted in [9] above, at the date Mr Dear filed the Contested Mark, the Earlier EU Mark had not been registered for 5 years, so by virtue of S. 6A (1A) the section and its proof of use provisions did not apply. This was explained to Mr Dear by the IPO in correspondence, and it was further confirmed in Decision No. O/596/21 dated 11 August 2021 (at [15-16]), that the Earlier EU Mark

could not be put to "proof of use" in the Opposition Proceedings. The Hearing Officer explained the position perfectly:

15.In the applicant's counterstatement, they requested that the opponent provided proof of use of the earlier mark. The applicant furthered that "The bulk of income for Peek & Cloppenburg from the Mc(space)Neal is derived from MCNEAL Clothing company which both Bird & Bird LLP and Peek & Cloppenburg know because it is registered in the USA registration number 85679065 which also includes an MCN symbol, also partly used in Europe [sic]".

16.The Tribunal clarified that since the earlier mark had not been registered for more than 5 years at the date the application for registration was filed, the opponent was not required to prove that their mark had been used. This is in accordance with the proof of use provisions in section 6A of the Act. The applicant contested this point several times during the proceedings. Whilst the earlier mark is older than 5 years at the point of writing this decision, the requirement to provide proof of use is calculated from the date the registration was completed to the date that the application is filed. For the avoidance of doubt, I confirm the Tribunal's earlier indication was correct and, thus, the opponent was and is not required to provide use of their earlier mark relied upon.

16) Nevertheless, Mr Dear's position that EU TM No. 14557631 *was* subject to proof of use/more than 5 years old at the relevant date continued into his subsequent appeal. As I understood his position, he had noted that the Opponent's UK TM No. 900306324 Mc Neal, another Comparable Registration, was dated 11 June 1996 (registered 18 August 1998) and was more than 5 years old and that since the same mark – Mc Neal – was identical to EU TM No. 14557631, the two marks should be treated as a single mark for the purpose of calculating the relevant 5-year period. This is how Mr Dear put it in his Grounds of Appeal:

"Mc(space)Neal was first filed for registration in June 1996 and entered into the Regisrty in August 1998. (is this a coincidental date with the Officer's Decision and citation of rulings going as back to 1998?). Trademark UK00900306324. The Mc(space)Neal trademark has been in existence a lot longer than 5 years despite all of the above issues which will now have to be addressed. Peek & Cloppenburg KG then re-applied to have 2 other Classes 3 and 35 added Trademark UK00914557631. But the Existing Mc(space)Neal was not altered or modified in any way. Mc(space)Neal has been on the UKIPO Registry since 1998 and was filed which now important thanks to the introduction of new regulations on June 1996."

17) On 23 May 2022 I issued decision No. BL O/439/22 refusing Mr Dear's appeal against decision BL O/596/21 of Ms B Wheeler-Fowler rejecting Application No. 3481419 (the "Contested Mark") in

its entirety. As part of that Decision I ruled that his appeal on this issue failed [71-83]. I expressly explained that insofar as Mr Dear believed the 5-year non-use period for the Earlier Mark was related in any way to the registration of UK00900306324, he was mistaken.

18) Meanwhile, and in parallel, on 11 August 2021 – the same date as the adverse opposition Decision - Mr Dear's company Global Trademark Services Limited had attempted to file an application to revoke UK TM No. 00914557631, the Comparable Mark derived from the Earlier Mark, on the grounds of non-use under S. 46 (1) (a) & (b) of the Act using a Form TM26 (N). I understand there were several rounds of correspondence before the application was admitted under No. CA000504070 on 22 November 2021 following the filing of an amended form.

19) Although the application for revocation stipulated non-use grounds, Mr Dear did state in Section C of the Form (Supporting Statement):

"I believe this trade mark was filed in bad faith with no intention to use."

20) Whilst I do not know exactly what transpired next, it is apparent that there was at least some correspondence between Mr Dear and the Tribunal because on 24 February 2022, after the appeal hearing, Mr CJ Bowen acting as the Registrar's Hearing Officer issued a lengthy review of the attempts to regularise the TM26(N), including a summary of the Registry's handling of the matter, not all of which (as he acknowledged) was perfect. Notably, on the issue of "bad faith" Mr Bowen referred to a letter from the Tribunal to Mr Dear dated 15 December 2021 which stated:

"As a final point, the registry notes your comments at Section C of your recently filed TM26N, particularly your reference to a bad faith claim. For clarification, you are reminded that a bad faith claim under Section 3(6) has not been specifically pleaded within these proceedings; the grounds relate solely to a revocation for reasons of non-use".

21) Thus, Mr Dear should have been alerted to the fact that he had not raised an admissible bad faith claim based on lack of intention to use against the Comparable Mark. The correct thing to do, had he wished to bring such a claim, was to apply for a Declaration of Invalidity under S. 47 of the Act. Alternatively he could have applied to cancel the Earlier EU Mark. He did neither.

22) At this stage I pause to note that had Mr Dear filed an admissible application for a declaration of invalidity against the Comparable Mark by the date TPN 1/2021[1] came into force (26 November

[1] Tribunal Practice Notice (1/2021): "Legal changes to the end of Transition Period transitional arrangements" paragraph 3

2021) and had that application been ultimately successful, in theory at least (and I do not say this would have happened in practice) it is possible things would have followed a different path. This is because that TPN provided that if an EU trade mark was relied upon in UK opposition proceedings, its enforceability in those proceedings could, in principle (with some discretion on the part of the Tribunal) be tied to the fate of the comparable mark derived from it where invalidity proceedings against the "comparable" were pending at that date. However, that is not to say such an application would have succeeded. The point is therefore moot.

23) In any event Mr Dear did not bring invalidity proceedings either against the Comparable Mark or the Earlier EU Mark at any time. The upshot was that CA00050470 proceeded as a non-use revocation action only against the Comparable Mark and the Opposition continued to be independently based on the unchallenged Earlier EU Mark.

24) In the course of the appeal, Mr Dear drew my attention to the existence of CA000504070 and in preparing my Decision on his appeal I invited the parties' comments as to what, if any, the significance of those non-use proceedings might be. I subsequently determined that the existence of those non-use proceedings against the Comparable Mark was irrelevant to the Decision I had to make on Mr Dear's appeal (see BL O/439/22 [88-97]). In summary, that mark was not in issue, its revocation, even if successful ,had no bearing on the matter and the Earlier EU Mark was *prima facie* validly registered.

Mr Dear's Claims of Misrepresentation by the Opponent and its Representatives

25) On 31 August 2022 Mr Dear emailed the Appointed Person Secretariat (the "APS") in these terms:

> ***"Subject:*** *Appointed Person Hearing 26th January 2022 OP000421179*
>
> *Dear Enquiries team*
>
> *I am looking for some guidance if possible.*
>
> *The trademark used by my opponent in OP000421179 has been revoked for non use from 14th January 2021. Given the Hearing wasn't until January 2022 Bird & Bird LLP representing Peek & Cloppenburg KG were before the Appointed Person knowing they were not using their trademark, had never used the their trademark and never had any intention to use their trademark when the evidence presented to the Appointed Person, by omission, was never pointed out to the Appointed Person during the Hearing and having just read the Hearing transcript gave every impression that their trademark was in use.*

Having given you my specific information I would like to ask a generic question. What would be the consequences for any party who misrepresented themselves before the Appointed Person in order to win their case?

Kind regards
Jim Dear Director
Global Trademark Services Limited

26) After consulting me, the APS responded on 12 September:

"From: Enquiries
Sent: 12 September 2022 07:35
To: jim dear
Subject: RE: Appointed Person Hearing 26th January 2022 OP000421179
Dear Mr Dear,
Thank you for your email.
I note that your question is "What would be the consequences for any party who misrepresented themselves before the Appointed Person in order to win their case?". The Appointed Persons are an appellant body which decide first instance decisions of the UK IPO tribunal. They are independent of the UK IPO and therefore we are unable to answer your question on what the consequences would be for any party who misrepresented themselves before them. It would be for the AP to consider and take the action they feel appropriate within the legal parameters and powers conferred upon them.
Kind Regards

27) It was believed this had resolved the matter, since in the short-term nothing more was heard from Mr Dear.

28) Subsequently, however, Mr Dear renewed his complaint. The first I was aware of this was an email from Mr Dear to my personal email address on 13 February 2023:

"Dear Mr Harris

I wrote to you a few months ago and just had the files returned as address unknown.

You ruled on a case McNeill trademark application by my company Global Trademark Services Limited Vs Peek & Cloppenburg KG represented by Bird and Bird LLP.

I was writing to demonstrate Peek & Cloppenburg KG knowingly misrepresented themselves before the IPO and yourself.

Could I please have your address to be able to send my files for your review.

Kind regards
Jim Dear Director
Global Trademark Services Limited "

29) I informed Mr Dear that I could not engage with him directly on this matter and that further communications should be via APS. For clarity, I confirm have never seen nor received the files to which he referred.

30) Subsequently, referencing these communications, and taking the view that as a litigant in person it was important that Mr Dear be given as full and fair an opportunity as possible to make his case, I issued the following Direction on 17 February 2023 (through APS) to the parties:

"Dear Sir,
IN THE MATTER OF TRADE MARK APPLICATION NO. 3481419
APPOINTED PERSON DECISION No.BL O-439-22
Subsequent to the Decision of the Appointed Person in this matter, the Applicant Mr Dear approached the Tribunal on 31 August 2022 questioning the conduct of the Opponents on appeal.

For the benefit of the Opponents, in case they have not seen it, Mr Dear put his complaint as follows:
The trademark used by my opponent in OP000421179 has been revoked for nonuse from 14th January 2021. Given the Hearing wasn't until January 2022 Bird & Bird LLP representing Peek & Cloppenburg KG were before the Appointed Person knowing they were not using their trademark, had never used the their trademark and never had any intention to use their trademark when the evidence presented to the Appointed Person, by omission, was never pointed out to the Appointed Person during the Hearing and having just read the Hearing transcript gave every impression that their trademark was in use.

Having given you my specific information I would like to ask a generic question. What would be the consequences for any party who misrepresented themselves before the Appointed Person in order to win their case?

The Office indicated it could not assist Mr Dear and it was thought the matter had been resolved. However, Mr Dear has recently renewed this complaint, saying that he wished to demonstrate that Peek & Cloppenburg KG knowingly misrepresented themselves in the proceedings.

The Appointed Person Mr Harris proposes to treat this as a request by Mr Dear for him to reconsider decision No. BL O-439-22 within the Tribunal's jurisdiction as set out by Mr Richard Arnold QC (as he then was) in BL O- 333-05 MIDEM at para 25 (attached) , on the basis of the alleged misrepresentation. He therefore directs:

a) Mr Dear is to file any written submissions in support of his claim, together with any supporting evidence in proper form (i.e. by witness statement) within 14 days of the date of this communication. Any correspondence or material so filed MUST be copied to Peek & Cloppenburg KG's representatives. If it is not, it will not be taken into account. Mr Dear's submissions and evidence must be confined to his claim of misrepresentation by Peek & Cloppenburg KG concerning the alleged non-use of the earlier trade mark relied on.

b) Within 14 days thereafter Peek & Cloppenburg KG may file any written submissions and evidence strictly in Reply to the matters raised by Mr Dear, copying Mr Dear on the same basis. Any submissions on costs should be included.

Yours faithfully…"

31) No response was received from Mr Dear within the stipulated time frame.

32) However, after the 14 day deadline had expired, on 21 March 2023 Mr Dear wrote to APS as follows:

***"From:** jim dear*
***Sent:** 21 March 2023 10:31*
***To:** Enquiries*
***Cc:** Thomas Hooper*
***Subject:** OP000421179 McNeill*

Morning

apologise for the delay. I don't accept any deadline as I have been passed back and forth by the IPO and the Appointed Person. However, in addition I was off work ill and just returned from holiday. I am a one man organisation at the moment.

I will be calling Police Force Scotland this morning to report the Fraudulent Representation and I will file for the 3rd time with the IPO who have previously refused to accept and referred me to the Appointed Person. I have attempted to file with the PIPCU sometime ago but to date I have not had a response from them.

Kind regards
Jim Dear"

33) In the light of this correspondence I informed the parties that I would treat Mr Dear's email as a request for an extension of time in which to file submissions and evidence in support of his request for me to reconsider my Decision, but that my preliminary view was that the request should be refused because the reasons for it were inadequate and were not supported by any evidence, in particular as to Mr Dear's illness and holiday and why they should justify his non-compliance. I specified that if Mr Dear wished me to reconsider this refusal to grant an extension of time, he should request a hearing within 7 days of the date of the letter and support it with evidence, in the form of a witness statement and any relevant exhibits, explaining why he was unable to comply with the original deadline. I expressly stipulated that:

"If Mr Dear does not respond with evidence and a request to be heard within 7 days of the date of this letter, I shall confirm my decision to refuse the extension request and shall determine his application for me to reconsider Decision No. BL O-439-22 on the basis of the papers before me."

34) Once again, no response was received from Mr Dear within the stipulated time frame.

35) However, several weeks later, on 4 May 2023, Mr Dear wrote to APS thus:

"Please find enclosed further evidence to my submissions to the IPO Secretariat which I believe shows a "Pattern of Behaviour" by Bird & Bird LLP."

36) Mr Dear attached the following submission which I reproduce in full here to ensure the nature of his position is clear.

"In my orginal submission I pointed out I was able to revoke the Peek & Cloppenburg KC's trademark for None Use of UK00914557631. I claimed it was a deliberate misrepresentation of the use of the trademark UK00914557631. It was a deliberate and calculated filing to be a "catch all" to be able to oppose any remotely similar other trademark. There was absolutely no intention to use the trademark UK00914557631 in direct contravention of the ethos for filing trademarks.

I have found other examples which show it was not an isolated incident, I enclose examples of other filings by Bird & Bird LLP where there are trademarks registered where no use has taken place. I have filed to have these trademarks cancelled for Non Use and Opposition, the 4 x TM26(N)s and a 1 x TM7 are attached.

These cancellations are around another German based firm Lidl Stiftung & Co. KG and not only Bird & Bird LLP but also the firm Murgitroyd based in Glasgow. It is highly improbable that both Peek & Cloppenburg KG and Lidl Stiftung & Co. KG both independently came up with the concept of filing trademarks they had no intention of using.

There is one common actor running through these events and that is Bird & Bird LLP. It maybe that Murgitroyd is like minded in which case the UKIPO has a systematic issue with IP Attorney's and firms behaviours to the general ethos of only filing when there is genuine intent to use. And simply ignoring this requirement on them.

It is quite clear to me, I am willing to accept as a lay person I have misunderstood matters, but I believe the evidence shows a deliberate ploy to file "catch all" trademarks with no intention of use in order to allow their clients a wider range for opposing any trademarks remotely similar.

The evidence I am providing today I believe demonstrates a "Pattern of Behaviour"."

37) Attached to these submissions were copies of Cancellation Actions and a Notice of Opposition directed against registrations/an application made by Lidl Stiftung & Co. KG. I do not know, but suspect (no great feat of deduction or imagination being required) that Mr Dear has, at least to some extent, been prompted into these actions by the recent decision of Mrs Justice Joanna Smith DBE in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor* [2023] EWHC 873 (Ch) (19 April 2023) which also involved Bird & Bird and which involved various findings on Lidl's trade mark

registration strategies. No doubt Lidl Stiftung & Co KG/Bird & Bird will deal with Mr Dear's proceedings as they see fit.

38) As with his original TM26 (N) against the Comparable Mark, it seems to me that Mr Dear has mistakenly conflated two separate issues. First, the issue of the non-use revocation of the Comparable Mark. Secondly, the validity of the Comparable Mark, and the Earlier EU Mark *ab initio.*

Decision

The Basis for a Reconsideration of the Decision

39) That the Appointed Person has power to reconsider a Decision was confirmed by in BL 0/333/05 *MIDEM* by Mr Richard Arnold QC (as he then was), although he noted that the power "*should only be exercised in truly exceptional circumstances"* [2] .

40) The question for me to determine, therefore, is whether there are exceptional circumstances. My conclusion, given without hesitation for the reasons given below, is not only that there are no exceptional circumstances, there are no relevant circumstances at all.

Late Submissions/ "Evidence"

41) Mr Dear failed to meet the original deadline to file submissions, nor did he comply with my Direction of 17 February, nor did he request a hearing within 7 days of the date of the Direction and support his position with evidence, in the form of a witness statement and any relevant exhibits, explaining why he was unable to comply with the original deadline.

42) Deadlines are there to be met, absent good reason. Plenty of toner has already been devoted to this subject both in this Tribunal and elsewhere. A party who chooses not to "accept" Tribunal deadlines does so at its own peril. Mr Dear was given ample opportunity and leeway to put his case in order and did not do so.

43) Furthermore, although I could interpret Mr Dear's filing of this material as an attempt to draw attention to something akin to "similar fact" evidence, I cannot see these submissions add anything to Mr Dear's original complaint.

44) Therefore I decline to admit them formally into these proceedings. I will, however, keep the nature of submission in mind solely to enable me to fathom Mr Dear's position.

[2] See Mr Arnold QC's discussion at [3-25]

Irrelevance of the Non-use Revocation of UK TM Reg. No. 914557631

45) As noted, in Opposition No. 421179, and in Appeal No. BL O/439/22, the Respondent Peek & Cloppenburg and its representatives relied only on EU Trade Mark registration No. 14557631. Mr Dear had asked for proof of use of that Earlier Mark but in both detailed correspondence with the IPO and in the Opposition itself it was confirmed that, on the law, this mark was not subject to the proof of use requirements. As long as it remained validly registered, whether the Earlier EU Mark was, or was not, in use was entirely irrelevant to these proceedings. As noted, in my Appeal Decision BL O/439/22 I dismissed Mr Dear's Appeal against this finding.

46) Mr Dear's current complaint is based, at least in part, on the fact that his application to revoke UK TM Registration No. 914557631 for non-use was successful, which Decision he felt was relevant to, or to the way the Opponent conducted, Opposition No. 421179. Specifically, he complains that in the appeal of Opposition 421179 the Opponent represented, by omission, that its mark(s) were in use when it knew they were not and that there had been a decision to that effect.

47) At this point I should note that when I inspected the UKIPO database to confirm the mark's status I found the history to show the mark had been "surrendered", not revoked. However, enquiries revealed that whilst a surrender application was indeed filed by the Opponent, on 22 August 2022 Mr Raoul Columbo issued a formal decision revoking the registration in full on the grounds of non-use, with effect from 14 January 2021.

48) As noted in my original Decision, the non-use revocation of UK TM No. 914557631 was not relevant to the Opponent's reliance on EUTM No. 14557631. It is correct that there are *some* circumstances in which the revocation or invalidity of a UK Comparable Mark is deemed to have equivalent effect on an EU Trade Mark relied on in UK opposition proceedings but revocation for non-use is not one of those, being expressly excluded by the operation of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 SI 2019 No. 638 (as amended), Schedule 5 Reg. 8 (4) (b) (ii). Thus the ultimate revocation of UK TM Registration No. 914557631 did not bear on the Earlier EU Mark and has no effect on these proceedings,.

49) Besides, the effective revocation date, *even if it had been relevant in theory,* would not have helped Mr Dear, since it post-dated the relevant date in the Opposition proceedings.

Alleged Misrepresentations

50) This brings me to Mr Dear's allegations of misrepresentation. To reiterate, his complaints are:

"The trademark used by my opponent in OP000421179 has been revoked for non use from 14th January 2021 (emphasis added). Given the Hearing wasn't until January 2022 Bird & Bird LLP representing Peek & Cloppenburg KG were before the Appointed Person knowing they were not using their trademark, had never used the their trademark and never had any intention to use their trademark when the evidence presented to the Appointed Person, by omission, was never pointed out to the Appointed Person during the Hearing and having just read the Hearing transcript gave every impression that their trademark was in use.

51) Looked at in the round it seems tolerably clear that Mr Dear 's reference to *The trademark used by my opponent in OP000421179* is intended to be a reference to UK TM Registration No. 00914557631, rather than the Earlier EU Mark, but I will assume for this Decision that he conflates the two.

52) In terms, Mr Dear is alleging some form of misrepresentation by the Opponent and Bird & Bird in the way their case was put to me at the appeal hearing (in effect, that they misled the Tribunal).

Did the Opponent or its Representatives Mislead the Tribunal or Make any Misrepresentations?

53) For representatives in particular, this is a very serious matter. The Solicitors' Regulation Authority Guidance on Conduct in Disputes notes "The courts have made it very clear that they regard this as "one of the most serious offences that an advocate or litigator can commit" and there is a positive duty on solicitors and, via the Intellectual Property Regulation Board in essentially identical terms, on Registered Trade Mark Attorneys, not to mislead the court. That duty includes misleading by omission.

54) However, I am satisfied that neither the Opponent nor its representatives made any misrepresentation or misled the tribunal whether by commission or omission.

55) The Opponent's case rested on their possession of an earlier EU mark, impervious to the proof of use provisions and not subject to any "live" challenge to its validity. Thus the Opponent simply relied on the *prima facie* fact that the Earlier EU Mark was protected, under the requirements of S. 5 (2) (b) of the Act, as they were fully entitled to do. Both on paper and in their submissions before me, despite Mr Dear's own references to use and bad faith, the Opponent and its representatives confined themselves to entirely proper representations and submissions in support of that s. 5 case. For clarity, that section reads:

"5 Relative grounds for refusal of registration.

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(2)A trade mark shall not be registered if because—

(b)it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

56) Consistent with this, at the appeal hearing for the Opponent Mr Hooper of Bird & Bird said, absolutely correctly, when responding to Mr Dear's points on proof of use:

"It is not relevant because proof of use is not required here. If we were claiming enhanced distinctiveness or reputation and passing off, sale information could come into it, but here we have not, and proof of use is not relevant. That is the response to that question.

57) For the sake of completeness in the light of Mr Hooper's comment, I note that the Notice of Opposition *did* originally include the reputation-based ground of S. 5 (3), positively citing use of the Earlier Mark as protected by EU registration No. 145576321 in the EU and the UK. However, that ground was not subsequently pursued. Nothing can be read into that, since it is not unusual, in trade mark (or any other) proceedings, for a party's representatives to plead, on instruction, a certain case at the outset but to withdraw or amend it subsequently as matters relevant to proof or any one of a variety of other reasons, come to light. As is a standard principle amongst legal regulators, as long as a representative does not submit in a pleading statements of fact or contentions that are not supported by the evidence or instruction of the client, or contentions that he cannot justify as *prima facie* arguable, all other things being equal the pleading will be ethically justified. There is nothing to suggest the case was not originally properly and ethically pleaded on this ground. Indeed, it is not inconceivable the Opponent could have maintained the ground successfully but simply chose to rely on the S. 5 (2) (b) case. Dropping grounds in favour of a "best case" simply for convenience and cost-efficiency is common in practice.

58) The same is true for the Opponent's defence to CA000504070. I can see from the file that the Opponent pleaded genuine use in its defence, but that ultimately it chose to surrender the Comparable Mark. I have no reason to think the Defence was not properly and ethically pleaded, nor can I conclude otherwise just from the Comparable Mark's surrender.

59) Furthermore the issue of "intention to use"/bad faith, was never properly pleaded as a validity issue against the Comparable Mark in such a way as to bring it into play under TPN 1/2021, nor was the validity of the Earlier EU Mark ever challenged at EUIPO. Thus, as far as the Opponent and Bird & Bird were concerned, and based on how Mr Dear ran his case, they were under no

obligation to say anything about the use, non-use, intention to use or the validity of the relevant marks. What was in issue was the Opponent's case under S. 5 (2) (b), to which use or intent to use was irrelevant, and that is how the Opponent and its Representatives ran their case before me and the Hearing Officer.

60) Thus, I cannot see any basis to conclude that the Opponent or its Representatives made, whether by commission or omission, any misrepresentations as alleged by Mr Dear or that they otherwise misled the Tribunal.

Conclusion

61) On the facts before me, neither the Opponent nor Bird & Bird made any misrepresentations as alleged.

62) **It follows that Mr Dear's application for me to reconsider my Appeal Decision is without any merit and fails accordingly.**

Costs

63) The Opponent indicated that it would take no part in this matter, so notwithstanding it is the successful party I make no order as to costs.

Philip Harris
Appointed Person
18 May 2023